

No. 02-05, January 17, 2005

1. OFFICE PRACTICE

OHIM

- ECTA has provided the European Commission with comments on the possible lowering of the Community Trade Mark official fees. The document can be retrieved on [ECTA's website](#).
- The OHIM has released issue # 2 of the Alicante News: <http://oami.eu.int/en/office/newsletter/04002.htm>

We specifically draw your attention to the following:

- The Office's Practice note to the examiners further to the judgment of the Court of Justice of 12th February 2004 in case C-363/99, "Postkantoor", regarding the possibility to restrict lists of goods and services using a negative wording.
- The response to ECTA's concern raised in its letter to Mr Wubbo De Boer on 10 November 2004 in connection with Communication 11/04 of the President of the Office dated 21 October 2004 regarding the early information on the outcome of absolute grounds examination and more specifically regarding which situations might cause the examination to be reopened.
- The note on "Learning from design invalidity cases" in particular on Novelty and the Individual Character.

WIPO

- WIPO's non-working days for 2005 can be retrieved at: http://www.wipo.int/edocs/madrdocs/en/2005/madrid_2005_1.doc

Table of contents

1. Office Practice
- OHIM – lowering of fees
- WIPO – non working days
- WIPO - Restriction of the Holder's Right
- OHIM – Alicante News # 2
2. Case Law
- T-334/03 – EUROPREMIUM
- T-367/02 – T-368/02 and T-369/02 - SnTEM
3. ECTA News
- ECTA meets sister Associations

- The information notice No 1/2005 regarding the "Restriction of the Holder's Right of Disposal: Establishment of a New Unofficial Form" is now available on WIPO's website at: http://www.wipo.int/edocs/madrdocs/en/2005/madrid_2005_2.doc

2. CASE LAW

On absolute grounds for refusal

1. Case No: T-334/03

Date: 12 January 2005

Parties: Deutsche Post Euro Express vs OHIM

Concern:

Refusal on basis of Article 7(1)(b) – distinctive character and Article 7(1)(c) - descriptive sign and of Regulation No 40/94 of CTM application No 1575521 – EUROPREMIUM for goods and services of classes 16, 20 35 and 39, in particular goods in various materials intended for packaging, storage or transport, advertising, management or business assistance service and transport and storage services..

The examiner refused the CTM applications on the ground that the marks the basis of Article 7(1)(b) and (c) of Regulation No 40/94.

The Board of Appeal dismissed the appeal on the ground that Article 7(1)(c) of Regulation No 40/94 precluded registration of the mark EUROPREMIUM since the mark was likely to be perceived by consumers as an indication of the notable quality and European origin of the goods and services covered by the mark application. .

Most relevant paragraphs:

The court considers that EUROPREMIUM is not composed of elements descriptive of the goods and services referred to by the applicant. (34-44)

The court notes that origin is not an essential characteristic of goods and services relating to postal transport. The geographical origin of goods in classes 16 and 20, which are, essentially, goods intended for packaging of items of all kinds, is manifestly not a characteristic which determines the consumer's choice, which will be made on the basis of factors such as the dimensions of the packaging or its durability. With regard to the services in classes 35 and 39, there is again no reason to believe that origin is a characteristic taken into account by the average consumer when making his choice. Consequently the prefix "euro" does not designate the goods and services at issue either directly or by reference to one of their essential characteristics and is therefore not descriptive of them. (36)

It therefore remains to consider whether, despite that lack of descriptiveness of the elements of which the sign in question is composed, that sign, taken as a whole, enables the target public to establish a direct and concrete link to the goods and services for which registration was sought. (44) As the Board of Appeal did not establish that the term "EUROPREMIUM", taken as a whole, was or could be a generic or usual name to identify or distinguish goods applied for, the decision is annulled. (45-46) Indeed, the contested decision merely indicates that the word sign evokes in the consumer's mind the impression of high quality European goods and services without showing that that characteristic would enable the consumer immediately and without further thought to establish a direct and concrete link to the abovementioned goods and services. (45)

Outcome: The decision is annulled.

2. Cases No: T-367/02 – T-368/02 and T 369/02

Date: 12 January 2005

Parties: Wieland-Werke vs OHIM

Concern:

Refusal on basis of Article 7(1)(b) – distinctive character and Article 7(1)(c) - descriptive sign and of Regulation No 40/94 of CTM applications No 1421734 – SnTEM, 1421755 – SnPUR and 1422294 - SnMIX for “Metallic semi-finished products in the form of sheets, trips, wires, tubes, sections, rods or the like, especially in non-ferrous metals, such as copper or a copper alloy, having a metallic coating on one side or both sides of tin or a tin alloy” in class 1.

The examiner refused the CTM applications on the basis of Article 7(1)(b) and (c) of Regulation No 40/94.

The Board of Appeal dismissed the appeal and held that, since specialist circles would know the meaning of the chemical symbol ‘Sn’ and of the abbreviations ‘TEM’, ‘PUR’ and ‘MIX’, the trade marks sought indicate tempered tin, pure tin or a tin alloy, respectively.

Most relevant paragraphs:

All the elements namely Sn (referring to “tin”), PUR (referring to “purit”), MIX (referring to “mixture”) as well as TEM (referring to the verb “temper”) are to be considered as descriptive. Indeed, in connection with “TEM” indicating the process by which a product is manufactured also concerns a characteristic of that product. (25)

Further, it must be considered that the word signs SnTEM, SnPUR and SnMIX are themselves descriptive of characteristics of the goods concerned, because there is no perceptible difference between those signs and the mere sum of their parts. In relation to the goods in question, the nature of the combinations SnTEM, SnPUR and SnMIX is not unusual (37)

So far as concerns the applicant’s argument that the terms SnTEM, SnPUR and SnMIX are not used to designate the intermediary products themselves, or one of their essential characteristics or yet the quality following from the treatment they have undergone, it is enough to observe that it is not necessary that the signs and indications composing the mark that are referred to in Article 7(1)(c) of Regulation No 40/94 should actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient that those signs and indications could be used for such purposes (see, by analogy, *Campina Melkunie*, paragraph 38), (40)

The applicant’s argument that there are other terms for designating the same characteristics of its products is not persuasive. It is immaterial whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration. (41)

Outcome: The appeal is dismissed.

These decisions can be retrieved at:

<http://curia.eu.int/jurisp/cgi-bin/form.pl?lang=en&Submit=Submit&docrequire=alldocs&numaff=&datefs=&datefe=&nomusuel=&domaine=INTE&mots=&resmax=100>

3. ECTA NEWS

- On January 17, 2005, the **OHIM Link Committee** is meeting **OHIM officials** in Alicante (Spain). A report will be made available as soon as possible.
- On February 18, 2005, ECTA is having a meeting with ITMA (UK) – APRAM (FR) – BMM (Benelux) – GRUR (Germany) and MARQUES in Cambridge (UK). ECTA will be represented by Max Oker-Blom (President), Simone Reeves (Second Vice-President) and Sandrine Peters (Legal Co-ordinator).