

No. 06-05, March 15, 2005

Table of contents

1. Law

- **Community Trade Marks***Draft amendment of the official fees*

2. Office Practice

- **OHIM***Alicante News # 03/2005*- **WIPO***Well-known registers*

3. Case Law

- CFI – **T169/03** – SISSI ROSSI*CFI dismissed the appeal - Given the differences between the goods, and the differences between the marks, the Court takes the view that consumers will not be confused by the marks in question.*- CFI – **T185/03** – ENZO FUSCO*CFI dismissed the appeal - the Italian consumer generally attributes greater distinctiveness to the surname than the forename, he will keep in mind the name 'Fusco' rather than the forenames 'Antonio' or 'Enzo'*- CFI – **T32/03** – jello SCHUHPARK dev.*CFI dismissed the appeal - jello SCHUHPARK and Schuhpark are confusingly similar*- CFI – **T33/03** – HAI*CFI dismissed the appeal - The degree of similarity between the marks at issue is not sufficiently great for the Court to make a finding that the public might believe that the goods in question come from the same undertaking or, as the case may be, from undertakings which are economically linked.*

4. ECTA News

- ECTA meets Commissioner **Charlie McCreevy***Report*- ECTA meets **WIPO Officials**

5. ECTA Communication

- **Bernhard Posner****1. LAW****COMMUNITY TRADE MARK****Fees regarding Community Trade Marks**

ECTA has provided the European Commission with further comments regarding the draft Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) with regard to adapting certain fees.

The document can be retrieved on ECTA's website in the [Law Committee – Paper Section](#).

2. OFFICE PRACTICE

1. OHIM

Alicante News

The OHIM has released issue # 03/2005 of the [Alicante News](#):

We specifically draw your attention to the following:

- The summary on the “*Processing, registering and publishing of Community Designs*”.
- On the summary of various Decisions of the Board of Appeal Division on substance and procedural issues as well as recent decisions of the Court of First Instance of the European Court of Justice.

2. WIPO

ECTA has provided WIPO-OHIM and various national Patent and Trade Mark Offices with a Position paper on the creation of a special register for well-known trade marks supporting the Position paper of the Association des Industries des Marques (European Brand Association). The document can be retrieved on ECTA’s website under the [Law Committee – Papers Section](#).

3. CASE LAW

On opposition

1. **Case No:** [T-169/03](#)

Date: 1 March 2005

Parties: Sergio Rossi vs OHIM

Concern: Opposition by Calzaturificio Rossi S.p.A. – today Sergio Rossi SpA against CTM application No [837906](#) – SISSI ROSSI applied for inter alia “leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags” in class 18

The opposition was based on:

- Italian trade mark registration No 553 016 - MISSIO ROSSI registered on 11 November 1991 for footwear
- International registration No 577 643 – MISSO ROSSI registered on 11 November 1991 for footwear

The Opposition Division refused the application for registration in respect of all the goods covered by the opposition. It found, essentially, that the applicant had proven genuine use of the earlier marks only in relation to the goods ‘women’s footwear’ and that those goods and the goods ‘leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags’ covered by the trade-mark application were similar. Moreover, the Opposition Division held that the marks were similar in the mind of the French consumer. (9)

The Board of Appeal of OHIM annulled the decision of the Opposition Division and rejected the opposition. The Board of Appeal found, essentially, that the marks in question were only vaguely similar. Moreover, having compared the distribution channels,

functions and nature of the goods in question, it found that, for the most part, the differences between the goods outweighed their few common points. In particular, it examined and rejected the argument that the goods 'women's footwear' and 'women's bags' were similar because they were complementary. Therefore, there was, in its view, no likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94. (11).

Most relevant paragraphs:

On the similarity of the goods

The court only has to examine whether there is a similarity between the goods 'women's bags' falling under 'goods made of leather and imitation leather not included in other classes' in Class 18 which are covered by the application for a Community trade mark and the goods 'women's footwear' in Class 25 designated by the earlier marks (48).

The intended purposes of the goods are different, shoes being used to dress feet and bags to carry objects. It follows that the goods are not interchangeable and, therefore, not in competition. (57)

The applicant has failed to establish that, in terms of their function, the goods in question are complementary. (61)

On the similarity of the signs

The degree of similarity is average, if not slight (76).

The marks bear a resemblance in some respects but are also different in others. (73) The common word 'Rossi' occupies the second place in the marks in question and is by no means prominent in those marks. (74)

On the likelihood of confusion

Given the differences between the goods, and the differences between the marks, the Court takes the view that consumers will not confuse the marks in question. (80)

Outcome: The action is dismissed

2. Case No: [T-185/03](#)

Date: 1 March 2005

Parties: Fusco vs OHIM

Concern: Opposition by Antonio Fusco International SA Lussemburgo, succursale di Lugano against CTM application No [727735](#) – ENZO FUSCO applied for "soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices" in class 3; "spectacles, spectacle cases" in class 9; "leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; bags and rucksacks; umbrellas, parasols and walking sticks" in class 18; "textiles and textile goods, not included in other classes; bed and table covers" in class 24 and "clothing, footwear, headgear" in class 25.

The opposition was based on CTM registration No 654509 – ANTONIO FUSCO – registered on 8 March 1999 for a large range of goods falling in classes 3-9-18-24 and 25.

The Opposition Division rejected the application for registration pursuant to Article 8(1)(b) of Regulation No 40/94. (9)

The Board of Appeal dismissed the appeal. The Board of Appeal found essentially that the surname 'Fusco', which appears in both signs and which in Italy was neither rare nor particularly common, was more distinctive than the forenames 'Antonio' and 'Enzo' which were both common forenames. It described the degree of similarity between the signs as neither negligible nor marked, but average. As the goods covered were identical, the Board of Appeal concluded that the presence of the word 'Fusco' in both signs was such as to give rise to a plausible likelihood of confusion in the mind of the reference public. (10)

Most relevant paragraphs:

On the similarity of the signs

The Court notes that Italian case-law generally considers that the surname constitutes the heart of a sign made up of a forename and a surname. Moreover, it is common ground between the parties that 'Fusco' is not one of the most common surnames in Italy (53). The Italian consumer will, as a general rule, attribute greater distinctiveness to the surname than to the forename in the marks in question. (54)

The Court considers that there is a certain similarity between the signs in question by reason of the fact that their most characteristic feature is the same. In the light of the other features present in the signs, that is the forenames 'Antonio' and 'Enzo', that similarity is neither negligible nor marked. (55)

Outcome: The action is dismissed and the Court concludes that since the Italian consumer generally attributes greater distinctiveness to the surname than the forename, he will keep in mind the name 'Fusco' rather than the forenames 'Antonio' or 'Enzo'. Moreover, the goods in question are the same. In those circumstances, the Board of Appeal was entitled to find without erring in law that a consumer faced with goods bearing the trade mark applied for ENZO FUSCO might confuse it with the earlier trade mark ANTONIO FUSCO, so that there is a likelihood of confusion (67)

3. Case No: [T-32/03](#)

Date: 8 March 2005

Parties: Leder & Schuh AG vs OHIM

Concern: Opposition by Schuhpark Fascies GmbH against CTM application No [1269372](#) – jello SCHUHPARK device in the name of Leder & Schuh AG applied initially for inter alia :

- in class 18 : Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- in class 25 : Clothing, footwear, headgear.
- in class 28 : Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

On the basis of German trade mark registration No 1 007 149 - Schuhpark registered on 3 September 1980 for all kinds of footwear.

The Opposition Division partially upheld the opposition. In view of the identity of the dominant element of the marks – Schuhpark – there is a likelihood of confusion as far as clothing and footwear is concerned.

The Board of Appeal confirmed the decision rendered by the opposition division. It concluded that there is a likelihood of confusion as the marks are very similar, that “footwear” is identical in both parties’ mark and that “clothing” is very similar to the “footwear”.

Most relevant paragraphs:

On the similarity of the signs

The Court confirms that the word combination Schuh – Park is unusual and provides a normal distinctive character to the earlier mark (43). This word combination is further not descriptive for clothing (45).

On the other hand, the element jello will be understood by Germans as being the “yellow” colour. (46)

The signs are to be considered similar. (47)

On the similarity of the goods

As far as footwear is concerned there is no discussion that there is identity. (49)

Regarding footwear vs clothing, they both are used for the same purpose even if they cannot be replaced by each other. (50)

On the likelihood of confusion

The Court reminded that in the clothing field it is common practice to have various trade marks all having the same dominant element. The public may therefore reasonably conclude that jello SCHUPARK is a line extension of Schuhpark. (51)

Outcome: The action is dismissed and the decision rendered by the Board of Appeal is confirmed.

4. Case No: [T-33/03](#)

Date: 9 March 2005

Parties: Osotspa vs OHIM

Concern: Opposition by OSOTSPA Co., Ltd against CTM application No [628171](#) – HAI in the name of Distribution & Marketing GmbH applied for inter alia goods and services falling in classes 5-32-33-35 and 42

On the basis of

- Austrian trade mark registration No AM 537/96 registered on 10 May 1996.
- CTM registration No 168 427 applied on 1 April 1996 – SHARK device registered for “Non-alcoholic drinks; syrups and other preparations for making beverages” in class 32.

The Opposition Division rejected the opposition, on the ground that there was no likelihood of confusion between the marks in question. Observing that it is necessary to take account of the average distinctiveness of the earlier marks, it considered that the conflicting signs are entirely different on the visual and aural level and that they have a completely different structure. (7)

The Board of Appeal dismissed the appeal. Essentially, it considered that, in spite of the fact that the goods covered by the conflicting marks were partially identical and in view of

the average distinctiveness of the earlier marks as well as the aural, visual and conceptual differences which can clearly be perceived between the conflicting signs, there was no significant likelihood of confusion on the part of the public of the Member States of the European Union, and in Austria in particular. That conclusion is all the more apparent because that assessment must take account of the average, reasonably well informed and reasonably observant and circumspect consumer who perceives a mark as it is presented to him, without subjecting it to in-depth analysis or translating it into another language (9)

Most relevant paragraphs:

On the similarity of the goods

It must be concluded that the goods within Class 32 are identical. The goods in Classes 5 and 33 referred to in the trade mark application are linked to the goods in Class 32, covered by the earlier marks, to the extent that they must be regarded as similar. On the other hand, the services included in Classes 35 and 42, named in the trade mark application, and the goods covered by the earlier marks cannot be regarded as being similar. (46)

On the similarity of the signs

Visually, the two signs Hai and SHARK are clearly distinguished by their graphic representation since only the SHARK mark appears in figurative form. (49)

Aurally, it is clear that the signs in question do not have any similarity. (50)

On the conceptual level, it is not disputed that the English word 'shark' is translated as 'Hai' in German and Finnish, as 'haai' in Dutch and as 'haj' in Danish and Swedish. It is therefore probable that people who speak those languages understand both 'shark' and 'Hai' as meaning 'shark'. That is above all the case for the targeted public, given that they are young people who generally have sufficient knowledge of English to understand the meaning of the word 'shark'. That is also the case for people who do not immediately recognise the English word 'shark', but who understand its meaning when they see the shark image. The semantic content of the earlier marks is supplemented by their graphics in the form of a shark which make their meaning even more accessible and clear. It should therefore be found that there is a conceptual similarity between the signs in question which, however, depends on prior translation. (51)

On the likelihood of confusion

The significant visual and aural differences between the marks in question are such as to cancel out, to a large extent, their conceptual similarity which depends on prior translation. The degree of conceptual similarity between two marks is of less importance where the relevant public, at the time of purchase, is called on to see and pronounce the name of the mark. (64)

Outcome: The action is dismissed – The degree of similarity between the marks at issue is not sufficiently great for the Court to make a finding that the public might believe that the goods in question come from the same undertaking or, as the case may be, from undertakings which are economically linked. (65) Having regard to the differences between the conflicting signs, that assessment is not invalidated by the fact that the goods and services covered by the mark applied for are partly identical to the goods covered by the earlier marks. (66)

4. ECTA NEWS

ECTA meets EU Commissioner DG Internal Market and Services Mr. Charlie McCreevy

On March 1, 2005, Max Oker-Blom (President), Simon Reeves (Second Vice-President), Norman MacLachan (Treasurer) and Sandrine Peters (Legal Co-ordinator) met EU Commissioner DG Internal Market and Services **Mr. Charlie McCreevy**. He is from Ireland, and the meeting had been arranged through the auspices of ECTA's Irish Treasurer, Norman MacLachlan. This is the first time that ECTA has been granted an audience with the Commissioner ultimately in charge of EU trade mark and design affairs. Also present were: Mrs Claire Bury, Deputy Head of Cabinet of Mr Charlie McCreevy and Mrs Susana Pérez Ferreras, Administrator Industrial Property, DG Internal Market.

The meeting was conducted in a warm and friendly atmosphere and ECTA was fully able to express its views, and in particular regarding the following:

- The draft proposals to Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs). This draft proposes that certain fees should be adapted. ECTA has put its views in writing but at the meeting it expressed its sincere wish that the opposition, appeal and cancellation fees would not be raised.
- The possible creation of a Judicial Panel. The Commission is looking to create a special chamber to the Court of First Instance of the European Court of Justice which would deal only with (the large number of) trade mark cases appealed from the Boards of Appeal of the OHIM. As yet ECTA does not have a fully formed position on this, but asked that, when dealing with this matter, regard should be given to the whole system at all judicial levels (including the opposition division and the Boards of Appeals of the OHIM). The reason for the great quantity of appeals to the CFI could lie in disappointment with decisions in the system lower down the chain.
- The lack of cooperation between the various DG's dealing with IP issues. ECTA has learnt however that a first inter-DG's meeting has been held in that connection which according to ECTA is an excellent first step in the right direction.

Finally, ECTA also indicated to the Commissioner its willingness to be involved in the legislation process at a much earlier stage. Much time and trouble could be saved if discussions and an exchange of views with all the interested circles were to take place even before any concrete draft proposal was provided for comments.

Reported by Sandrine Peters, ECTA legal Co-ordinator

ECTA meets WIPO Officials

On March 21, 2005, Max Oker-Blom (President), Mireia Curell (First Vice-President) and Sandrine Peters (Legal Co-ordinator) are meeting WIPO Officials.

5. COMMUNICATION

Bernhard Posner

Bernhard Posner has decided to retire, after a long and distinguish career in Intellectual Property, at the end of March 2005.

ECTA would like to take this opportunity to thank Bernhard, the retiring Chairman of the Design Committee and a member of the Anti-Counterfeiting Committee, for his enormous contribution to the Association. His last work as an ECTA Member, the Design Law Book, will be issued shortly and will enable all of us to retain a part of him in our daily practice.

We wish all the best to Bernhard and his wife in their new life of retirement.