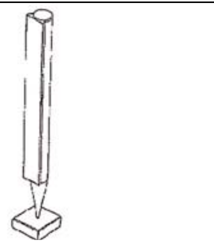
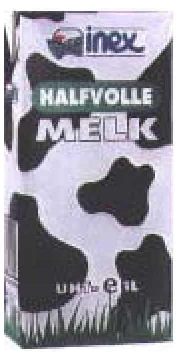
Recent Decisions of the

European Court of Justice (ECJ)
Court of First Instance (CFI)
Office for Harmonisation in the Internal Market (OHIM) and
UK Trade Mark Registry

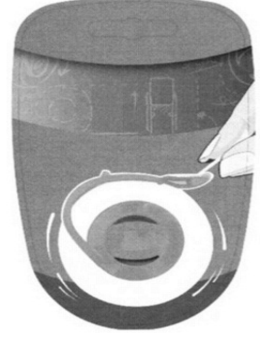
Case	**Comments**
October 2007 **Edgar Rice Burroughs Inc v OHIM (The "Tarzan Yell" Application)** **Case R 708/2006/4 – [2007]**	This application was filed as a **sound** mark, represented graphically by means of a verbal description of the sound and a spectrogram (sonogram) designating the frequency of the sound waves. It was initially rejected on the basis that the application did not contain an adequate representation of the trade mark. The applicant appealed on the basis of Case R781/1999-4 - the "roar of a lion" sound application - which was accepted based on a sonogram. The appeal raised two issues: (i) whether a spectrogram and a description of the sound could constitute a representation of the mark and therefore fulfil the statutory requirements under the CTMR; (ii) if not, does this constitute an absolute ground for refusal under Article 7(1)(a)? Established precedents indicate that whilst a sign may consist of a sign which is not itself capable of being represented visually, it must be capable of graphic representation namely by way of an image, lines or characters, and this representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (the Sieckmann seven part test). Particularly in the case of sound marks, a written description of the sound itself will not suffice, however, a stave consisting of a clef, musical notes and rests will meet the necessary standard of graphical representation. It is necessary that third parties viewing the CTM Bulletin should be able to reproduce the sound without additional technical means, and this is very difficult with respect to a spectrogram without specialised software. Additionally, it is impossible to recognise from the image the source of the sound - i.e. a human voice, violins, bells or a dog's bark. Therefore it is not a clear graphical representation. Therefore, this case seems to suggest that in order to gain protection, a sound trade mark is limited to specific means of graphical representation, such as musical notation.
October 2007 **Bang & Olufsen Speaker Shape Application** **Court of First Instance T-460/05**	Bang & Olufsen (the Applicant) applied to register a pair of narrow, "pencil-shaped" speakers as a **3-D** Community Trade Mark. It was initially rejected by OHIM on the basis that it was devoid of distinctive character as per Article 7(1)(b) of the CTMR 40/94. The CFI noted in this instance, the relevant consumer would be expected to pay a higher than average level of attention than the average consumer, as these were high value, specialist products, which were not everyday purchases. The CFI noted that (i) the average consumers applied a particularly high level of attention when purchasing the goods; (ii) the mark applied was a striking design that could not be considered to be common; and (iii) the mark departed significantly from the usual designs and signs in the sector concerned. Furthermore, the applicant had provided sufficient evidence

	that the mark had acquired distinctive character through use. The Court determined that the shape of the speakers were so distinctive as to be a recognisable indication of the commercial origin of the goods.
September 2007 **Céline SARL v Céline SA** **European Court of Justice C-17/06**	Céline SA, a French company whose principal activity is the manufacture and sale of fashion clothing and accessories, brought an action against Céline SARL who were trading using the company name Céline for a shop. Céline SA hold a trade mark for the word CÉLINE in all classes from 1-42, and in particular clothes and shoes, which has been renewed since its registration in 1948. Céline SARL registered its company name in 1992, in order to operate a business trading in couture, clothing, furs, lingerie and so on. Céline SA brought proceedings against Céline SARL seeking an order to prevent their infringing use of the CÉLINE trade mark and unfair competition. The Nancy Regional Court granted their application and prohibited the use of Céline by Céline SARL - ordering them to change their company and shop name to one which could not be confused with the applicant's earlier registered mark. Referring to precedents, the Court determined that the proprietor is entitled to prevent the use of a sign where the following conditions are met: (i) use must be in the course of trade; (ii) it must be without the consent of the proprietor; (iii) it must be in respect of the goods or services which are identical to those for which the mark is registered; (iv) it must affect or be liable to affect the functions of the trade mark, in particular - its essential function of guaranteeing origin of the goods/services. The matter was referred to the French Grand Chamber on appeal, who determined that unauthorised use by a third party by way of a company name of a sign which is identical to the earlier word mark, in connection with goods which are broadly identical to those for which the mark was registered, constitutes use which the proprietor of the mark may stop in accordance with Article 5(1)(a) of Directive 89/104/EEC, where the use is in relation to goods in such a way as to affect the function of the trade mark. However, Article 6(1)(a) of the Directive can operate as a bar to such use being prevented only if use by the third party of his company/trade name is in accordance with honest practices. On referral to the ECJ, it was determined that the proprietor of a trade mark can only prevent its unauthorised use where such use affects the essential function of the mark; the purpose of a company name is generally not to distinguish the goods it produces, but to designate the business being carried on. It is only when this company name is affixed to goods/services that infringement can occur, and this is a question of fact to be determined on a case by case basis. However, in the UK, s.69 Part 5 of the Companies Act 2006 provides a remedy for brand owners in this situation - the right to object to misleading company names which would seem to be the chief means of recourse for a brand owner following this decision.
Eden's Application ("Smell of Ripe Strawberries") [Case CFI T-305/04]	The applicant applied to register an **olfactory** mark described as the "smell of ripe strawberries" and included the colour image of a strawberry (as shown) in respect of, inter alia, soaps, cosmetics and hair care products, as well as a range of leather goods and clothing. The application was rejected on the grounds that the mark was not capable of being represented

	graphically. In the decision of the CFI, the Court acknowledged that '*a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically by means of images, lines or characters and that the representation is clear, precise, self-contained., easily accessible, intelligible, durable and objective.'* The CFI produced evidence that the smell of strawberries differs according to the variety and therefore concluded that since the "smell of ripe strawberries" could refer to several distinct smells, the applicant's description '*is neither unequivocal nor precise and does not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed.'* Nor did the visual image add any additional information to the description in words. The application was accordingly dismissed. This decision reinforces the difficulty of registering unconventional trade marks, but provides useful guidance on the Office's practice relating to acceptable forms of graphical representation.
De Waele's Application ("Twisted Helix Sausage") [Case CFI T-15/05]	In this case, the applicant applied to register a **three dimensional** mark, being the twisted helix shape (as shown) in respect of, inter alia, gut for sausage making. Whilst the graphical representation of the mark was acceptable, the application was nevertheless rejected, in respect of sausages (although allowed for other goods such as dairy products included in the application), on the grounds that although the twisted shape was slightly more pronounced than usual shapes in the trade, the appearance was not sufficiently distinctive to enable consumers to perceive it as an indication of the origin of the goods. The applicant argued that the geometric shape was unique and departs significantly from all existing shapes of gut for making sausage. The CFI, however, noted that "*novelty or originality are not relevant criteria in the assessment of distinctive character...for a three dimensional mark...it must differ substantially from the basic shapes in question, commonly used in the trade, and not look like a mere variant of those shapes.*" The application was dismissed. This decision also confirms that the Office is enforcing its stringent practice in relation to the registration of shape marks absent distinctiveness acquired through use.
PAPERLAB [Case CFI T-19/04]	In this case, the Applicant sought to register the **word mark** PAPERLAB in respect of computer equipment and measuring installations for surveying and testing. The application was refused on the grounds of non-distinctiveness and descriptiveness and this decision was upheld on appeal. The CFI upheld the decision of the Appeal Board and dismissed the application, having concluded that PAPERLAB *'described in English in a simple and straightforward manner the intended function of the goods for which registration was sought.'* This decision appears to further distance the CFI from the BABY-DRY decision (although it continues to cite BABY-DRY with approval) and confirms that not all lexical inventions or syntactically unusual juxtapositions of words will result in a registrable trade mark.
EUROHYPO [Case CFI T-439/04]	This application sought registration for the **word mark** EUROHYPO in respect of, inter alia, financial, real estate, monetary affairs. The mark was refused on the grounds that the elements 'euro' and 'hypo' are descriptive of those services in relation to the German language ('hypo' is a commonly used abbreviation in German speaking countries for the word 'hypothek' meaning 'mortgage', while 'euro' is the currency of the EU). The CFI held that EUROHYPO is a *'straightforward combination of two descriptive elements, which does not create an impression sufficiently far removed from that produced by the mere combination of the elements of which it is composed to amount to more than the sum of its parts.'* The CFI rejected the argument that the word EUROHYPO was a 'lexical invention' which had an unusual structure (the basis of the acceptance of

	BABY-DRY) and, in the absence of any secondary meaning acquired through use, the application was dismissed.
Robert Wiseman & Sons Ltd.'s Application ("Cowhide") [Case CFI T-153/03] 	In this case, the Applicant sought to register a **figurative mark** representing a cowhide (shown left, upper picture) in respect of, inter alia, milk and dairy products. The application was opposed by Inex, the owner of the earlier Benelux registration for a figurative mark (shown left, lower picture) registered in respect of identical goods. The opposition was rejected on the grounds that the marks were sufficiently different to avoid any likelihood of confusion and this decision was upheld on appeal. The opponent appealed to the CFI which held that even though the cowhide design constitutes an essential element in the visual impression of the earlier complex mark, that design has a weak distinctive character owing to the fact that the element is strongly allusive to the goods in question, milk and dairy products. The opponent failed to file evidence to support its claim that its cowhide design had acquired a highly distinctive character through use. The CFI concluded that *"although the cowhide design is essential to the visual and conceptual impression given by the earlier mark, neither the significant visual differences between the signs at issue nor the weak distinctive character of the cowhide design in this case lead to the conclusion that there is a likelihood of confusion between the marks at issue'.* The case was duly dismissed.
Daimler Chrysler's Application for PICARO (v PICASSO) [ECJ C-361/04]	The Estate of Pablo Picasso filed an opposition against Daimler Chrysler's CTM application for the mark PICARO in respect of vehicles on the grounds that the mark was confusingly similar and was to be registered in respect of the same/similar goods as the Estate's earlier trade mark PICASSO. The opposition was rejected, as were subsequent appeals to the Boards of Appeal and CFI, on the grounds that there was no likelihood of confusion between the two marks. The appeal to the ECJ was likewise rejected. The ECJ quoted the CFI with approval that "*account must be taken, for the purposes of assessing the likelihood of confusion, of the level of attention of the average consumer at the time when he prepares and makes his choice between different goods'*. Clearly, in view of the nature of the goods concerned, and in particular their high price and technological character, the degree of attention paid by the consumer would be very high, thereby avoiding any likelihood of confusion between the respective marks. The case was duly dismissed.
MATRATZEN MARKT CONCORD & Device [T -6/01]	This case, together with the following case (Medion v Thomson), has significantly clarified the position regarding the test for likelihood of confusion involving composite marks. In the subject case, the mark applied for was MATRATZEN CONCORD MARKT plus the device of a man carrying a mattress ('matratzen' means 'mattresses' in German). The application was opposed by the owner of an earlier Spanish trade mark MATRATZEN registered in respect of, inter alia, beds and bedding. The applicant argued that the word 'CONCORD' was the most distinctive element of the overall mark, while the opponent argued that the shared element 'MATRATZEN' was sufficient to give rise to a likelihood of confusion. The Opposition Division refused the application in respect of beds and bedding, but allowed the application for inter alia cushions and mattresses. Both the opponent and applicant appealed. The Board of Appeal upheld the appeal of the opponent and dismissed that of the applicant, holding that, in Spain, the marks would be seen as being similar and there would be a likelihood of confusion were the marks to be used on the same/similar goods. The applicant appealed to the CFI, which determined that a complex trade mark, one of whose components is identical or similar to another mark, *"cannot be regarded as being similar*

	to that other mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it." Since the word 'matratzen' had no meaning in Spanish, it was held that this word, along with CONCORD, were equally important elements. However, as MATRATZEN was the first word in the mark, and did not resemble any Spanish word, the CFI concluded that this word would be kept in mind by the consumer, rather than the second word, CONCORD. On this basis, the CFI concluded that there would be a likelihood of confusion, given the degree of similarity between the goods.
THOMSON LIFE (Medion v Thomson) [ECJ C-120/04]	Following the above decision of the CFI, a somewhat refined test for confusing similarity between composite marks resulted from the decision in this case. Here, the opponent, Medion, who is the owner of the earlier German trade mark LIFE, brought a trade mark infringement action against Thomson, which is a leading manufacturer in the leisure electronic devices sector. The German court rejected the action on the grounds that there was no likelihood of confusion between LIFE and THOMSON LIFE. Medion appealed the decision to the Oberlandesgericht which referred a question for preliminary ruling to the ECJ. In essence it queried whether there would be a likelihood of confusion where the contested sign composed of a combination of a company name (THOMSON) of another and a registered trade mark (LIFE) **which has normal distinctivenss**, and which has an independent distinctive role therein, and is used on identical goods. The ECJ opined that *"it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element."* Its conclusion on the referral was that *"...there may be a likelihood of confusion ..where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed y the composite sign, still has an independent distinctive role therein."* The National Court subsequently held that there would be a likelihood of confusion between the earlier trade mark LIFE, having a normal level of distinctiveness, and the proposed mark THOMSON LIFE.
UK Trade Mark Registry Decision Nos 0/194/06 and 0/193/06 Applications by Henkel KGaA to register two shape marks 	Henkel KGaA filed applications for registration of the shape marks (Images 1 and 2). Each application was the subject of an application for International Registration based upon prior registrations in Germany. The specifications of goods for which registration was sought were: Image 1: Class 16: Stationery, namely Indian ink; correction materials and instruments for writing, drawing, painting, signing and marking; self-stick notes, self-adhesive labels and pads, adhesive corners for photographs, adhesives tapes for stationery or household purposes; adhesives for do-it-yourself and household purposes; instructional and teaching materials (except apparatus) in the form of printed matter and games; preparations and instruments for the deletion of writing made with ink, ball-point pens, pencils and felt pens; rubber erasers; stamps and stamping ink Image 2: Class 16: Adhesive tapes and self-adhesive tapes for stationery or household purposes; adhesives for do-it-yourself and household purposes; office articles, namely adhesive tape dispensers, as far as included in this class, respectively

	The applications were refused on the basis of S3(1)(b) of the Trade Marks Act 1994 as it was deemed that the marks was devoid of distinctive character because the shape was not considered to stand out from the usual variety of shapes used for the goods at issue and was therefore not capable of distinguishing itself from those goods of other commercial undertakings. In addition, the application was refused on the basis of S3(2)(b) of the Act, namely that the shape of the goods was necessary in order to achieve a technical result. Registry practice in relation to Shape Marks states that in order to avoid an objection on absolute grounds, a shape mark must be sufficiently different from a shape which is: i) characteristic of the product ii) the norm or customary in the sector concerned iii) a shape likely to be taken by the product concerned In other words, the shape must not be descriptive, must stand out from the crown and must not be a shape likely to be taken for the product concerned. In relation to the first shape mark set out above, the Hearing Office held that the message that this shape mark “sent out” was that this particular item dispenses correcting tape, is translucent for ease of use and is of a convenient shape to make it easy and comfortable to use, none of which were capable of turning this mark from a representation of the goods into a distinctive trade mark. There was nothing particularly unusual or striking about the shape mark and thus it was refused protection in the United Kingdom. In relation to the second shape mark set out above, it was held that the mark consisted of a device showing fingers pulling tape from a tape dispenser. The device was devoid of distinctive character as it would be seen as demonstrating a tape dispenser in use and not as an indication of origin. The Applicants had argued that the mark for which registration was sought, was in fact a ‘container’. The Hearing Officer considered this but stated that even if this was so, it would need to be assessed in the same was as a 3D container for the goods. He found that there was nothing unusual or striking about the shape and as such was not capable of performing the function of a trade mark namely that it would distinguish the goods of the Applicant from those of other commercial undertakings. The application was refused protection in the United Kingdom.
UK trade mark application no. 2338980 METRIX ELECTRONICS (& device) in the name of Metrix Electronics Ltd and Opposition thereto by Chavin Arnoux	Chavin Arnoux (“Chavin”) filed an opposition against UK trade mark application no. 2338980 METRIX ELECTRONICS under section 5(2)(b) UK Trade Marks Act 1994 on the basis of the UK designation of International trade mark registration no. 797522 MULTIMETRIX. Metrix Electronics Limited (“Metrix) applied to register UK trade mark application 2338980 METRIX ELECTRONICS in respect of the following goods: Digital multimeters; analogue multimeters; air/humidity testers; airflow testers; oscilloscopes analogue and digital; clamp meters

<table>
<tr>
<td>Decision of the Appointed Person</td>
<td>analogue and digital; power meters; panel meters analogue and digital; voltage detectors analogue and digital; thermometers; satellite strength meters; function generators; frequency counters.

The goods covered by Chavin’s International registration are as follows:

Scientific, surveying, electric (including by wireless telegraphy), photographic, cinematographic, optic, weighing, measuring, signalling, monitoring, rescue and teaching apparatus and instruments; coin or token-operated automatic apparatus; speaking machines, cash registers, calculators; fire extinguishers; but not including apparatus, instruments or equipment for providing, maintaining, validating and identifying security features on items nor including optical apparatus, instruments, devices and elements.

The Hearing Officer held that the goods covered by the respective marks were identical or similar and that the trade marks were similar by virtue of the fact that METRIX operated as the distinctive and dominant element of both marks. As such, the trade marks were visually, phonetically and conceptually similar. Notwithstanding that the consumers of the goods in question would exercise a good degree of care when purchasing the goods in question, there was a likelihood of confusion on the part of the consumer.

On appeal, the Appointed Person rejected the Applicant’s request that the case be “reheard and reconsidered”. The Appointed Person relied upon the decision in REEF TM [2002] EWCA Civ 763 and held that it was not the function of the Appointed Person to re-hear a case in the absence of “a distinct and material error of principle” on the part of the Hearing Officer. The grounds of appeal did not identify any error on the part of the Hearing Officer and none was found following a review of the decision. As such, the appeal was dismissed.</td>
</tr>
<tr><td></td><td></td></tr>
<tr>
<td>UK trade mark application no. 2335900

NT STORE MANAGER (& device) in the name of Nisa-Today’s (Holdings) Limited

Image 1

Image 2</td>
<td>The Applicant applied to register the mark shown at Image 1:

in respect of a range of goods in class 9 ;

Following examination at a Hearing, the application was refused based on similarity with the two cited marks, which are shown left (Images 2 and 3), and were registered for classes 9 and 16 and classes 9, 38 and 42 respectively.

The Hearing Officer held that the goods were identical and the trade marks were similar on the grounds that the element NT operated as the distinctive and dominant element of the Applicant’s mark and all of the cited marks. As such, the trade marks were visually, phonetically and conceptually similar such that there was a likelihood of confusion on the part of the public.

On appeal, the Applicant argued that:
1. the Hearing Officer had erred by failing to pay sufficient attention to the differences between the marks - the Applicant argued that the distinctive character of the element NT was low and that the distinctiveness of the mark was not localised in these characters but was evenly distributed across the various elements that comprised each of the marks.</td>
</tr>
</table>

  Image 3	2. the Hearing Officer had erred by failing to take account that each mark included a device element and that the goods in question were often purchased in circumstances where the marks would be perceived visually 3. the Hearing Officer had erred by failing to take into account the degree of care which would be exercised by the consumer of the goods which, it was argued, would be reasonably high. The Appointed Person responded as follows: 1. NT was not highly distinctive but, at the same time, no evidence had been submitted to establish that it was descriptive, generic or in common use. The analysis of the Hearing Officer was difficult to fault. 2. The Hearing Officer did consider the visual presentations of the marks. 3. The Hearing Officer did not expressly refer to the degree of care exercised by the consumer of the goods in question but it was clear from the decision that he had borne in mind the reasonably circumspect consumer. The Appointed Person held that the Hearing Officer had not erred in any principle of law and dismissed the appeal.