

### OHIM PRACTICE

#### The OHIM maintains that the use of a CTM in only one Member State is sufficient to constitute genuine use in the EU

A recent ruling by the Benelux Office for Industrial Property has created a controversy concerning the issue of the necessary scope of the use of CTMs. In its decision of January 15, 2010, the Benelux Office Opposition Division stated that the use of a CTM in only one Member State (the Netherlands) was not sufficient to constitute genuine use of a CTM (Leno Merken B.V. /Hagelkruis Beheer).

This finding is in direct contradiction with the Joint Statement of the Commission and the Council which establishes that the use of a CTM within the meaning of Article 15 of the CTM Regulation in one EU Member State is sufficient to constitute genuine use in the EU.

In a very recent note on its web page, the OHIM has maintained its position by asserting that in application of the principle of the unitary character of the CTM, it continues to consider that boundaries of Member States should not play a part in assessing “genuine use” within the EU Single Market.

### CASE LAW

#### RELATIVE GROUNDS FOR REFUSAL

#### Signs must be considered similar for successful opposition on basis of CTMR Article 8(5)

G-STAR

G-STAR RAW DENIM and



In its January 21, 2010 decision ([Case T-309/08 G-STAR Raw Denim kft v. OHIM](#)), the General Court confirmed the Boards of Appeal's decision which reversed the Opposition Division decision upholding the opposition filed on the basis of the above-referenced G-STAR marks registered in class 9 (sunglasses) and 25 (clothing) against CTM

Application G STOR (as depicted above) in connection with “data processing equipment and computers” in Class 9. The Opposition had been upheld on the basis of Article 8(5) of Regulation 40/94.

The Court held that in the present case, the conceptual differences between STAR and STOR counteracted the aural similarity between the signs. Further, the conceptual differences were reinforced by the fact that there were also significant visual differences between the marks at issue.

In light of the above and since there was no similarity between the signs, the Court confirmed that the Board of Appeal was right to find that the visual and conceptual differences between the signs prevented any assumption of a possible link between them and therefore, that the second condition for the application of Article 8(5) of CTMR was not satisfied and the opposition should be rejected on this basis.

### **Inversion of prior mark is not sufficient to create a likelihood of confusion: SOLFRUTTA v. FRUTISOL**

In its recent decision of January 27, 2010 ([Case T-331/08](#)), the Court reversed the Boards of Appeal decision, holding that in certain circumstances and in certain languages, the inversion of a composite mark’s two constituent elements can significantly change the overall visual perception of that word. In the present case, the two signs at issue, SOLFRUTTA and FRUTISOL, were visually similar to some extent as they both contained the elements “frut” and “sol”. Nevertheless, the Court considered that the fact that such elements were presented in a different order created two significantly different signs, since each mark began with a completely different set of letters. The marks were therefore considered to be visually and phonetically only very weakly similar. Therefore, despite the identity or similarity between the relevant products, the Court held that there was no likelihood of confusion.

### **Absolute grounds for refusal**

#### **New hope for slogans**

The European Union Court of Justice annulled the General Court’s decision by accepting the registration of the slogan “Vorsprung dur technik” (advancement through technology)” by Audi AG ([Case C-398/08 P of January 21, 2010](#)).

In this respect and contrary to the General Court’s finding, the EUCJ stated that the fact that the slogan in question could be used as a promotional slogan by other companies to promote their own goods and services was not sufficient to conclude that the mark was devoid of distinctive character.

Further, it held that slogans may be distinctive provided that they are not reduced to an ordinary promotional message, if they possess a certain degree of originality and require a minimum amount of effort to be understood.

Therefore, the Court considered that the slogan “Vorsprung dur technik” (advancement through technology)” could serve as an indication of origin for the products and services for which protection was sought in Classes 12, 14, 16, 18, 25, 28, 35, 36, 37, 38, 39, 40, 42, 42, 43 and 45.