

### CASE LAW

#### Relative grounds for refusal

##### Reproduction of identical element not sufficient to find likelihood of confusion

In its recent decision of November 11, 2009 (Frag Comercio Internacional, S.L./OHIM-Tinkerbelle Modas LTDA), the Court of First Instance (“CFI” or “Court”) confirmed the Board of Appeal’s decision holding that there was no likelihood of confusion between the marks MI SA KO and Green by Misako depicted as follows:



(earlier mark)



(contested CTM Application)

The Court considered that unlike the element GREEN, the expression “by missako” was not in any way the dominant element in the overall impression conveyed by CTM application.

Despite the presence of this element in the contested CTM Application, due to its near illegibility, the Court considered that it would not influence how the average consumer perceived the sign visually.

Therefore, the Court held that even though some of the goods covered by the marks at issue were identical or similar, the visual, phonetic and conceptual differences between the signs were sufficient grounds for finding that there was no likelihood of confusion for the relevant public.

The CFI, its November 12, 2009 decision (Case T-438/07 SPA MONOPOLE, COMPAGNIE FERMIERE DE SPA/NV/OHIM –DE FRANCESCO IMPORT GMBH), confirmed that there was no likelihood of confusion between the following marks:

**SPA**

(earlier mark)

**SpagO**

(contested CTM Application)

The Court upheld the Board of Appeal's holding that, in spite of the highly distinctive character acquired over time by the earlier mark SPA, the similarities between the signs at issue were not sufficient for a link to be established between the CTM application with respect to alcoholic drinks and the earlier mark for mineral waters.

### Absolute grounds for refusal

#### CLEARWIRE considered descriptive

In its November 19, 2009 decision (Case T-399/08 Clearwire Corp./OHIM), the CFI confirmed the Board of Appeals decision rejecting International Registration designating the European Union CLEARWIFI in connection with telecommunication services in class 38 pursuant to Article 7(1)(b) and (c) CTMR as descriptive and devoid of any distinctive character.

The Court found that the relevant public would have no difficulty in making a link between the sign CLEARWIFI and the specific telecommunications service, namely internet access, as well as with one of the characteristics of this service, the fact that it is disturbance free.

Accordingly, the Court concluded that the Board of Appeal was right to find that the mark CLEARWIFI is likely to be perceived by the relevant public as an indication of the quality and purpose of the services in question and should therefore be refused for registration pursuant to Article 7(1) (c) of the CTMR.

### Rejection of CTM application for failure to accept disclaimer pursuant to CTMR Article 38(2) (now Article 37(2))

The following two CTM applications



claiming protection in classes 16, 28 and 41 were rejected by the Examination Division as descriptive and devoid of distinctive character in conformity with Articles 7(1)(b) and (c) CTMR.

Pursuant to an appeal filed, the President of the Fourth Board of Appeal requested that the applicant agree to disclaim any exclusive right to the numbers 100 and 300 included in the CTM applications. The applicant refused to provide the requested disclaimers and argued that the marks were distinctive. The Board of Appeal dismissed the two appeals.

The CFI, on November 19, 2009 (Joined Cases T- 425/07 and 426/07 *Agencja Wydawnicza Technopol sp. Z o.o./OHIM*), confirmed both of the Board of Appeal's decisions, holding that in the present case, the figures 100 and 300 refer to quantities, and will therefore immediately be perceived by the consumer, without further thought, as a description of characteristics of the goods in question, in particular the number of posters in the sales batches, the number of pages in the publications or the number of pieces in the puzzles and riddles, which determine the degree of difficulty and are essential characteristics in deciding whether to make a purchase. Therefore, the relevant public will perceive those numerical elements as providing information on the goods designated and not as indicating the origin of such goods.

The Court concluded that whether the elements of the marks are distinctive, for the purposes of Article 38(2) of the CTMR, must be assessed not by reference to the overall impression given by those marks but by reference to such individual elements as the goal of such Article is to avoid improperly extending to such descriptive elements the exclusive rights granted by trademark status.