

# CASALONGA

## Community Trade Mark Alert : September 2009

### CASE LAW

#### Similarities between figurative elements sufficient for likelihood of confusion

On September 3, 2009 (Case C-498/07), the European Court of Justice confirmed the Court of First Instance's (CFI) decision finding that there was a risk of confusion between the following figurative marks for identical and similar goods:

CTM Application



Prior Marks



The OHIM Opposition Division's decision rejecting the opposition, since the signs produced different visual overall impressions, was confirmed by the Board of Appeal.

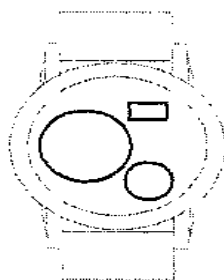
The CFI reversed this decision, however, holding that the Board erred in considering that the figurative elements of the marks had weak distinctive characters. Further, the CFI considered that the terms LA ESPAÑOLA had a very weak distinctive character in light of the fact that the products in question were produced in Spain.

The ECJ confirmed the CFI's decision, finding that the CFI had correctly considered that the figurative elements of these marks were dominant in comparison to the verbal elements. Consequently, it confirmed that there was a likelihood of confusion.

#### CFI confirms that acquired distinctiveness must be demonstrated in the entire European Union

In its recent September 14, 2009 decision, the CFI confirmed the OHIM's refusal of the 3d CTM Application for the representation of a watch as depicted below on the grounds of 7(1)(b) CTMR (Case T-152/07).

Further, the applicant's claim that the mark had acquired distinctiveness by use pursuant to Article 7(3) CTMR was also rejected as the documents provided were deemed to be insufficient and did not cover all of the Member States of the EU at the time of filing.



### Registering slogans as CTMs continues to be an uphill battle

#### Case T-80/07

On September 16, 2009 (Case T-80/07), the CFI confirmed the OHIM's refusal to register the slogan BUILT TO RESIST in connection with a range of products in classes 16, 18 and 25 pursuant to Article 7(1)(c) CTMR. In particular, the CFI found that the slogan applied for would be understood by the relevant consumers as a laudatory indication informing that the goods in question are of good quality and therefore resistant against wear and tear. This characteristic is of particular importance in connection with the claimed goods.

## OHIM PRACTICE

The OHIM's "Manual of Trade Mark Practice" was amended, applicable as of September 1, 2009, further to the adoption of a number of amendments to the Common Regulations under the Madrid Agreement and the Madrid Protocol. The aim of these amendments is to improve the accessibility of information regarding the interim and final status of International registrations (see <http://www.wipo.int/madrid/en/>)

The "*First Statement of Grant of Protection*" will be now referred to as the "*Interim Status of the Mark*" and will be sent, including when preceded by a provisional refusal on absolute grounds, provided the refusal has been waived in the meanwhile and the opposition period is still running.

The "*Second Statement of Grant of Protection*" will become the only "*Statement of Grant of Protection*" and will be sent in all cases where an International Registration designating the EC has been finally accepted, whether totally or partially.