

**OHIM fails to assess distinctiveness for sufficiently homogeneous categories of goods/services**  
European Union - **Casalonga Avocats**

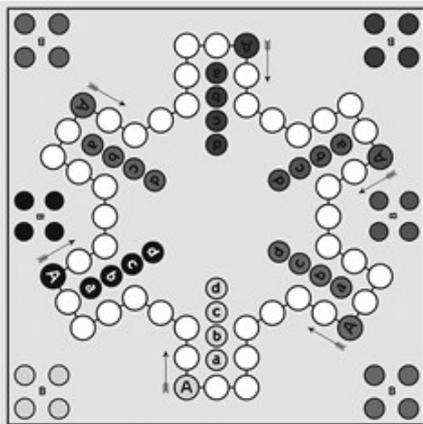
**Examination/opposition  
International procedures  
Non-traditional marks**

March 20 2015

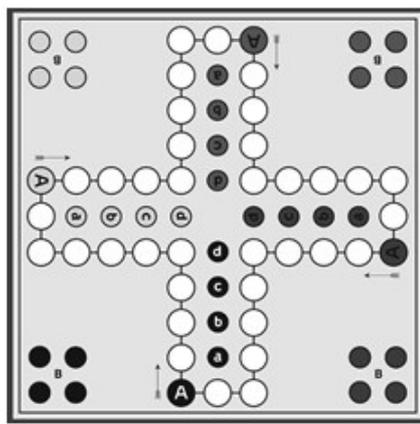
In *Schmidt Spiele GmbH v Office for Harmonisation in the Internal Market* (OHIM) (Joined Cases T-492/13 and T-493/13, March 3 2015), the General Court has partially annulled two decisions of the First Board of Appeal of OHIM in cases concerning applications for the registration of figurative signs representing boards for parlour games.

In January 2012 *Schmidt Spiele GmbH* filed Community trademark applications for the signs depicted below:

Case T-492/13:



Case T-493/13:



The applications claimed protection for various goods and services in Classes 9, 16, 28 and 41 of the [Nice Classification](#).

The applications were rejected in their entirety by the examiner and an appeal was filed. By two decisions of July 3 2013, the First Board of Appeal of OHIM dismissed the actions in their entirety. In particular, the Board of Appeal considered that the relevant public consisted of the general public, who had an average level of attention, in the whole of the European Union. Further, the Board of Appeal found that the signs applied for consisted of the graphical representation of a typical board for parlour games and, therefore, consisted of a simple reproduction of the external appearance of the products.

The Board of Appeal also noted that the signs could not be distinguished sufficiently from the usual forms of boards for parlour games on the market and that the relevant public would not perceive the signs as marks indicating the commercial origin of the goods and services at issue, but only as an objective indication of their content. Further, the Board of Appeal found that the documents submitted by the applicant to prove distinctiveness acquired through use on the basis of Article 7(3) of the [Community Trademark Regulation](#) (207/2009) were inadequate, notably because they were limited to Germany.

The applicant filed an appeal before the General Court on the basis of two pleas:

- infringement of Article 7(1)(b) of the regulation; and
- infringement of Article 7(3).

The court first noted that the Board of Appeal had found that the signs consisted exclusively of the outward appearance of a board for parlour games. In this respect, the applicant claimed that the applications did not claim protection simply for "game boards" but, rather, were figurative signs designating a series of products and services including "games".

The court stated that it was certainly true that the contested trademark applications consisted of figurative signs designating a series of products and services, including, among others, "games" in Class 28. However, when assessing the ability of the signs - a square frame containing a star or cross-shaped figure, formed by circles and arrows - to perform a trademark function, it could not be ignored that the specific configurations of these

shapes and circles represented, as a whole, a board for two variants of a parlour game, including the game "*Mensch ärgere Dich nicht*". Such game is particularly popular in German-speaking countries (Germany, Austria, Belgium and Luxembourg), as well as in other Central European countries, such as Hungary, the Czech Republic, Slovakia and Slovenia. The average consumer in those countries would thus easily recognise the signs in question as representing variants of that game, despite the fact that the signs are represented in black and white and not in their usual colours.

The court reiterated that the distinctive character of a mark within the meaning of Article 7(1)(b) means that the mark identifies the product for which registration is sought as originating from a particular undertaking, and thus distinguishes that product from those of other undertakings. Further, the distinctive character must be assessed, first, in relation to the goods or services for which registration is sought and, second, in relation to the perception of the relevant public.

Further, it is clear from the case law that if OHIM must consider a Community trademark in relation to all the products and services for which registration is sought, it is not obliged to conduct an analysis of each of the products or services included in each category, as long as the goods or services concerned have a sufficiently direct and specific link, so that they form a category or group of products or services that is sufficiently homogeneous (see *Euro-Information v OHIM* (Case T-497/11), Paragraph 40).

The court confirmed that the signs applied for were devoid of distinctive character with regard to "games" or "parlour games" in Class 28. In relation to these products, the relevant public would perceive the signs as an objective indication of the contents of the goods, and not as an indication of their commercial origin.

With respect to the other goods and services claimed, however, the court held that the Board of Appeal had not sufficiently analysed the descriptive nature of the signs in connection with all of the different goods and services. Rather, the Board of Appeal had merely examined the lack of distinctiveness of the signs generally in relation to all the products and services in each of the classes (Classes 9, 16, 28 and 41) by citing some of the products and services concerned, but without examining them one by one. According to the court, the degree of proximity of the products and services differed significantly and, for some of them, such degree of proximity seemed rather weak or even inexistent. Under these conditions, the products and services covered by the signs in Classes 9, 16, 28 and 41 did not form respective categories or groups that were sufficiently homogeneous to allow the Board of Appeal to analyse them by referring only to some of the goods or services in each class.

In those circumstances, the court found that the Board of Appeal had infringed Article 7(1)(b) of the regulation, since the examination of the distinctiveness of the signs applied for was carried out in relation to categories of products and services that were not sufficiently homogeneous.

Therefore, the contested decisions were annulled to the extent that they rejected the applicant's appeals for products and services other than "computer programs; computer games; recorded video game programs, floppy disks, CD-ROMs, cassettes, tapes and mini discs; software, computer programs (downloadable)" in Class 9, "paper and cardboard products printed in colour" in Class 16, "games [including electronic games and video games] except as apparatus devices for external screens or monitors, playing cards, board games; card games, portable devices for electronic games, board games; video games for a screen to peripherals or external monitor" in Class 28 and "entertainment, organisation and conducting entertainment events and leisure-related services" in Class 41.

The second plea - infringement of Article 7(3) - was also rejected. In this respect, the applicant had argued that the Board of Appeal had misinterpreted Article 7(3) by requiring proof that the signs had acquired distinctive character through use for the whole territory of the European Union. The applicant maintained that such proof should be provided only for the German-speaking member states, where the signs applied for were not inherently distinctive and that, in those member states, the signs enjoyed a high reputation.

OHIM rejected those arguments and requested that, in the absence of sufficiently founded allegations, the applicant's second plea should be dismissed as inadmissible within the meaning of Article 44(1)(c) of the Rules of Procedure.

In this respect, the court first noted that the reasoning of the applicant was based on the premise that the signs actually have intrinsic distinctiveness outside the German-speaking member states. However, as was found in connection with the examination of the first plea, such inherent distinctiveness was excluded for those products and services which have a close relationship with "games" and "board games" in Class 28.

Second, the court stated that the Board of Appeal had based its refusal to apply Article 7(3) not only on the fact that the elements relied on by the applicant concerned only Germany, but first and foremost on the fact that, even if the said elements were likely to prove the reputation of the game "*Mensch Dich nicht ärgere*" and its

board in Germany, they did not demonstrate that the board at issue was used as a mark indicating the commercial origin of the products. Therefore, the second plea was also rejected.

This decision is not surprising and should be welcomed, as OHIM should base its decision to refuse an application on all the products or categories of products affected by the objection.

Concerning the scope of the evidence of acquired distinctiveness required under Article 7(3), it has been established that it should concern the countries in which the objection applies so that, even if the court does not enumerate the concerned countries, the conclusion reached in this respect could be expected given the circumstances of the case and the findings of the Board of Appeal.

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