

### CASE LAW

#### **CTM's reputation in only one EU Member State considered sufficient**

On October 6, 2009 (Case C-301/07), the European Court of Justice replied to a prejudicial question raised by the Austrian Supreme Court regarding the requirements as to the geographical extent of the reputation of a Community trademark.

The question was raised in the context of a conflict based on the Community trademark PAGO, which is very well known in Austria, as to whether the reputation in Austria was sufficient to hold that the CTM had a reputation in the European Community as whole.

The Court's decision is in line with its prior decision rendered in the General Motors case on November 14, 1999 concerning a Benelux registration that had a reputation only in one part of the Benelux territory.

The Court held that based upon the specific circumstances of the case, the reputation in Austria of the mark PAGO was sufficient to hold that the mark had a reputation in the European Community as a whole.

#### **RELATIVE GROUNDS FOR REFUSAL**

#### **Differences in figurative elements considered sufficient despite identical verbal elements**

In its decision of September 23, 2009 (Case T-103/08), the Court of First Instance (CFI) confirmed the Boards of Appeal decision, holding that there was no likelihood of confusion between the following trademarks:



(Earlier Mark)



(Contested CTM application)

The trademarks involved, both claiming protection in class 25, were considered visually and conceptually different. Although the Court recognized a certain aural similarity, it was not sufficient to offset the visual and conceptual differences.

An influencing factor in this decision was that with respect to the relevant goods, clothing, the visual aspects of trademarks were considered to be very important. Therefore, when analyzing the likelihood of confusion between two signs, it is very important to take into consideration the relevant goods or services, as this may increase the importance of the visual, phonetic or conceptual comparison, as the case may be.

### Pharmaceutical trademarks found to be sufficiently different despite identical endings

In its recent decision of September 23, 2009 (Joined Cases T-493/07, T-26/08 and T-27/08), the CFI confirmed that there was no likelihood of confusion between the following signs:


**LANOXIN**  
(Earlier Mark)

**FAMOXIN**  
(Contested CTM application)

In spite of considering that the goods had a certain degree of similarity although they were for different therapeutic indications, the Court found that the trademarks were visually, aurally and conceptually sufficiently different, in particular in light of the fact that the public's degree of attentiveness is higher than average, for both professionals and patients, to eliminate any likelihood of confusion.

### ABSOLUTE GROUNDS OF REFUSAL

#### Sometimes a smile is just not enough

In its September 29, 2009 decision (Case T-239/08), the CTM Application  claiming protection in classes 14, 18 and 25 was rejected as considered devoid of any distinctive character. The CFI stated that as the sign consisted of a very simple and banal design that had an exclusively decorative function, it would not be perceived as an indication of the origin of the goods in question.

#### No CTM protection for exclamation point

In its recent decision of September 30, 2009 (Case T-191/08), the CFI rejected the following CTM



Application claiming protection in classes 14, 18 and 25 as it was deemed to be devoid of distinctive character. The Court held that it could not be perceived by the relevant public as an indication of the origin of the goods in question.

Further, concerning the applicant's argument based on Article 7.3 CTMR, the Court held that the applicant had failed to demonstrate that the mark had become distinctive through use since it only provided evidence for Germany whereas the mark lacked the minimum degree of distinctive character in all of the EU Member States. This is in line with prior case law holding that the CTM applicant must provide proof of acquired distinctiveness based on use in all of the territories in which the mark lacks distinctive character.