

that FRUTTI was a weak trademark because several trademark registrations in Class 32 included that expression, and therefore, granting the trademark registration for FRUTTI to Sociedad Productora de Jugos would imply accepting a monopoly by the company over a word in common use. Finally, the Office argued that the registration for the trademark TUTTI-FRUTTI had been granted for the combination of those two words and not for each of them separately.

The Council of State held that the word FRUTTI was a term in Italian that meant *fruta* (“fruit”) and that it was a word in common use in the member countries of the Andean Community, and for that reason, even though it was an Italian word, it should be treated as a local expression. The Council further held that, in addition to being a word in common use, FRUTTI was confusingly similar to the prior-registered trademark FRUTTI-FRESKO, because consumers could be led to believe that the same company produced both products (indirect confusion). Therefore, the trademark FRUTTI did not comply with the first requirement of a trademark, which is to indicate the entrepreneurial origin of the product. Finally, following the pre-judicial interpretation of the Andean Court of Justice,²¹⁸ the Council of State held that the applicable trademark law in Colombia did not grant to the owner of a trademark registration the right to register a similar mark. In other words, the fact that Sociedad Productora de Jugos S.A. had previously registered the trademark TUTTI-FRUTTI to cover products in Class 32 did not imply *per se* that the company had the right to obtain a registration for the trademark FRUTTI as well.²¹⁹

The above analysis led the Council of State to conclude that the trademark FRUTTI could not be registered, and for that reason it did not declare the nullity of the Trademark Office’s resolutions refusing the mark’s registration.

COMMUNITY TRADE MARK

I.B.2. Merely Descriptive

The Swiss company Novartis AG filed an application with the Office for Harmonization in the Internal Market (OHIM) for the registration as a Community trade mark (CTM) of the word mark BLUE SOFT,²²⁰ to cover contact lenses in Class 9. The examiner²²¹

218. Proceeding No. 183-IP-2005 (Andean Court of Justice, Oct. 26, 2005), published in *Gaceta Oficial del Acuerdo de Cartagena* No. 1283, Jan. 11, 2006, at 1.

219. Sociedad Productora de Jugos S.A. v. Superintendencia de Industria y Comercio, File No. 2001-0281 (Council of State, Jan. 24, 2008).

220. CTM Application No. 3007846, filed Jan. 14, 2003.

221. Decision of Jan. 26, 2006.

rejected the application on the ground that the mark was descriptive and lacked distinctive character, under Article 7(1) of the CTM Regulation.²²² Novartis's appeal for the revocation of this decision²²³ was rejected by the First Board of Appeal of OHIM.²²⁴

Novartis then appealed to the European Court of First Instance (CFI).²²⁵ It argued as follows:

1. The Board of Appeal was too strict in examining the absolute grounds for rejection.
2. The Board erred in assessing the degree of attention of the relevant public, which was neither more nor less intense than usual, because contact lenses are one-use products that circulate in the market without a physician's prescription and that are sold over the Internet and in supermarkets.
3. Rather than evaluate the mark as a whole, as it should have, the Board assessed the meaning of the words BLUE and SOFT separately.
4. The question of the distinctive character of the mark was essentially a function of its descriptiveness or nondescriptiveness. The average European consumer would not, "immediately and without further thought," understand the mark as indicating "contact lenses which are blue and soft." Nor would the relevant public immediately proceed to analyse the two word elements forming the mark, although Novartis did recognise that the mark could be characterised as suggesting that the covered goods could be soft contact lenses.
5. The mark's lack of distinctive character could not result from a lack of imagination or an excess of it. The Board's holding that there was nothing extraordinary in putting together two adjectives was in error; on the contrary, there was a certain degree of originality and inventiveness in the combination of the words BLUE and SOFT.
6. The Board did not take into consideration the fact that previously the marks PURE GREEN, TINY BLUE, and RED had been registered for apparatus and optical instruments in Class 9, which included contact lenses.

222. Council Regulation (EC) No. 40/94, Dec. 20, 1993. Article 7(1) of the Regulation provides, in pertinent part: "The following shall not be registered: . . . (b) trade marks which are devoid of any descriptive character; [and] (c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service. . . ."

223. Appeal No. R 270/2006-1, filed Feb. 17, 2006.

224. Case R 270/2006-1 (OHIM First Board of Appeal, Sept. 14, 2006).

225. Appeal No. T-330/06, filed Nov. 27, 2006.

In response, OHIM offered the following arguments:

1. Color contact lenses were not marginal products. OHIM submitted evidence showing that these products had been a great success in the marketplace.
2. Contact lenses served the purpose of correcting deficiencies of vision, and therefore the relevant public paid close attention when buying such products.
3. The juxtaposition of the two adjectives was to be interpreted merely as enumerating different qualities of the goods.
4. The registrability of a mark should be assessed by reference to the relevant regulation as interpreted by the Community judge, and not on the basis of earlier decisions of the Board of Appeal. With regard to the prior-registered marks referred to above, these could not be taken into consideration in the present case because they covered a larger range of goods and thus could not be compared with the mark in question.

The CFI held that the CTM application had been filed for “contact lenses” in general, without reference to whether they were corrective or not. The prime function of contact lenses was correction of visual deficiencies, and accordingly consumers would pay particular attention when buying such goods, whereas when purchasing noncorrective lenses they would have received the advice of a qualified person in order to determine the appropriate type of product.

The Court further held that the descriptive character of the mark could not be assessed by examining the two words separately, but only by examining the mark as a whole. It found that the mark, taken as a whole, could be interpreted by consumers as designating certain qualities of the products covered, namely that the contact lenses were soft and blue.

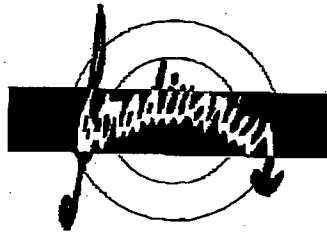
The CFI confirmed that in the decision under appeal the Board had concluded that “the trade mark as a whole” had been found to be descriptive. It also confirmed OHIM’s allegation that the registrability of a mark should be assessed by reference to the regulation as interpreted by the Community judge, not by reference to prior decisions of the Board. Finally, it found that the Board had correctly applied the conditions for assessing the descriptive character.

Consequently, the CFI rejected the appeal.²²⁶

226. Novartis AG v. OHIM, Case T-330/06 (CFI (1st Chamber), June 10, 2008), available at <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en&Submit=Rechercher&alldocs=alldocs&docj=docj&docop=docop&docor=docor&docjo=docjo&numaff=T-330/06&datefs=&datefe=&nomusuel=&domaine=&mots=&resmax=100> (in French).

I.D.1. Similarity of Marks

In another opposition case, the CFI was concerned with whether there was a risk of confusion between the marks at issue in light of the covered goods that were common to both marks, namely, goods in Class 18. The Class 18 specification for the opposed mark, STRADIVARI 1715 & Device (below, illustration at left),²²⁷ read “leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.” The opponent’s mark, STRADIVARIUS & Device (below, illustration at right),²²⁸ designated “bags, handbags, clutches, suitcases, luggage trunks, umbrellas, parasols, sunshades, sticks, brushwoods and accessories.”



Both the Opposition Board²²⁹ and the First Board of Appeal²³⁰ dismissed the opposition.

The CFI considered whether the Board of Appeal had erred in holding that “1715” was an important additional element in the applicant’s mark, and that the words STRADIVARI and STRADIVARIUS were illegible and therefore not likely to cause any confusion of the consuming public, notwithstanding their similarities if seen in nonfigurative representations. The Court found that the STRADIVARIUS mark was actually legible while the STRADIVARI mark was not. It accepted the Board’s determination that the STRADIVARI inscription, in the manner written, was actually likely to be perceived by consumer as “stvadinari,” “jtvadinary,” “stvdivari,” “jtdivari,” or “jeudivari.” Therefore, the CFI was satisfied that the applied-for mark was sufficiently distinctive from a conceptual, visual, and phonetic

227. CTM Application No. 7490402 (Classes 14, 16, and 18), filed June 20, 2001, in the name of Cristina Ricci.

228. CTM No. 506469 (Classes 18, 24, and 25), filed Apr. 9, 1997, registered Nov. 19, 1998, in the name of Stradivarius España, S.A.

229. Decision of June 22, 2005.

230. Case R 1024/2005-1 (OHIM First Board of Appeal, Sept. 7, 2006).

perspective. Consequently, it affirmed the Board of Appeal's decision dismissing the opposition.²³¹

This decision is important because the CFI relied on the legibility of the marks under comparison in assessing risk of confusion, although, in practice, commercial transactions would use their actual phonetic representation.

I.F. Famous and Well-Known Marks

The Spanish company Citi S.L. applied for the registration as a CTM of the trade mark CITI (below, illustration at left),²³² for "customs agencies, property valuers, real estate agents, evaluation and administration of house contents" in Class 36. The American company Citicorp, which subsequently merged with Citigroup Inc., opposed registration of the mark.

Citicorp's opposition was based on the following: (1) German registration for the word mark CITI,²³³ covering "real estate services and financial services" in Class 36; (2) CTM application for the figurative mark CITI,²³⁴ to cover "real estate services and financial services" in Class 36; and (3) CTM registration for the word mark CITICORP,²³⁵ for goods in various classes and "financial services and real estate services" in Class 36.

Simultaneously, the American company Citibank NA filed an opposition against registration of the same trade mark on the basis of its CTM registrations for 11 word marks: CITIBANK,²³⁶ CITIBANKING,²³⁷ CITICARD,²³⁸ CITIGOLD,²³⁹ CITIPHONE,²⁴⁰ CITIBASICS,²⁴¹ CITIBUSINESS,²⁴² CITIONE,²⁴³ CITIDIRECT,²⁴⁴ CITINETTING,²⁴⁵ and THE CITI NEVER SLEEPS.²⁴⁶

231. *Stradivarius España, SA v. OHIM*, Case T-340/06 (CFI (8th Chamber), July 2, 2008), available at <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en&Submit=Rechercher&alldocs=alldocs&docj=docj&docop=docop&docor=docor&docjo=docjo&numaff=T-340/06&datefs=&datefe=&nomusuel=&domaine=&mots=&resmax=100> (in French).

232. CTM Application No. 1430750, filed Dec. 20, 1999.

233. Trade Mark No. 39847157, filed Aug. 19, 1998, registered Mar. 17, 2000.

234. CTM Application No. 1084532, filed Feb. 23, 1999.

235. CTM No. 65367, filed Apr. 1, 1996, registered Dec. 9, 1998.

236. CTM No. 179531, filed Apr. 1, 1996, registered Mar. 29, 1999.

237. CTM No. 112458, filed Apr. 1, 1996, registered Sept. 8, 1999.

238. CTM No. 179473, filed Apr. 1, 1996, registered Mar. 29, 1999.

239. CTM No. 179549, filed Apr. 1, 1996, registered May 20, 1999.

240. CTM No. 179572, filed Apr. 1, 1996, registered Jan. 21, 1999.

241. CTM No. 679266, filed Nov. 19, 1997, registered June 22, 1999.

242. CTM No. 679282, filed Nov. 19, 1997, registered Aug. 13, 1999.

243. CTM No. 679175, filed Nov. 19, 1997, registered June 22, 1999.

244. CTM No. 679241, filed Nov. 19, 1997, registered Aug. 13, 1999.

245. CTM No. 539460, filed May 21, 1997, registered Aug. 13, 1999.

246. CTM No. 112425, filed Apr. 1, 1996, registered May 26, 1998.



The two cases were dealt with jointly, and the opposition was accepted.²⁴⁷ Citi lodged an appeal at OHIM against that decision,²⁴⁸ and the First Board of Appeal upheld it. The Board accepted that CITIBANK was a well-known mark but held that CITIBANK was not similar to CITI. Accordingly, it partially annulled the contested decision, upheld the opposition (based on Citigroup's CITI mark) with respect to the services of property valuers and real estate agents and services of evaluation and administration of house contents, and rejected it with respect to services of customs agencies.²⁴⁹ Citibank and Citigroup appealed to the CFI.²⁵⁰

The CFI based its decision on Article 8(5) of the CTM Regulation,²⁵¹ which requires that (1) the marks under comparison be identical or similar, (2) the earlier trade mark enjoy a reputation, and (3) the use without due cause of the trade mark applied for would take advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The Court accepted that the trade mark CITIBANK had a reputation, and thus did not deem it necessary to examine the reputation of the rest of the trade marks. Regarding the similarity between the marks, the CFI found that that the presence of the word element CITI in both marks made them similar; that element was, the Court stressed, the most dominant and distinctive element in the CITIBANK trade mark. The CFI concluded that the

247. Decision No. 419/2004 on joined oppositions No. B 364 812 and No. B 364 8950 (OHIM Opposition Division, Feb. 24, 2004).

248. Appeal No. R 173/2004-1, filed Mar. 2, 2004.

249. Case R 173/2004-1 (OHIM First Board of Appeal, Mar. 1, 2005).

250. Appeal No. T-181/05, filed May 10, 2005.

251. Article 8(5) provides:

Upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

word element CITI had distinctive character, and it held that the similarity between the marks was sufficient for the public to be able to establish a link between them.

As to the third of the conditions set out in Article 8(5), the Court held that it had to be assessed with regard to the three distinct types of risk; the existence of one of the three types of risk was sufficient for that provision to apply. Accordingly, the CFI held that the proprietor of the earlier mark was not required to demonstrate actual and present harm to his mark, but he had to adduce prima facie evidence of a future risk of unfair advantage or detriment, which risk was not hypothetical. Such a conclusion could be established on the basis of logical deductions made from an analysis of the probabilities and by taking into account the normal practice in the relevant commercial sector. The concept of taking unfair advantage of the distinctive character or repute of the earlier mark was intended to encompass instances where there was clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation.

In light of the above, the CFI concluded that (1) the reputation of the trade mark CITIBANK in the European Community in respect of banking services was not disputed, (2) there was a clear relationship as well as an overlap in the clients of the parties, and (3) it was possible that use of the opposed trade mark CITI could lead to the perception that Citi was associated with or belonged to Citigroup and Citibank and therefore could facilitate the marketing of services covered by the opposed mark.

The CFI therefore annulled the decision of the First Board of Appeal.²⁵²

II.C.1.d. Geographical Names

In *Rewe-Zentral AG v. OHIM*,²⁵³ the applicant sought to register the word mark PORT LOUIS for goods in Classes 18, 24, and 25.²⁵⁴ The examiner refused registration on the ground that the mark had geographical significance. The Board of Appeal upheld the refusal.²⁵⁵

On the applicant's further appeal, the CFI had to determine whether PORT LOUIS, which is the name of the capital of the island of Mauritius, would be allowed registration as a trade mark

252. *Citigroup, Inc. & Citibank, NA v. OHIM*, Case T-181/05 (CFI (1st Chamber), Apr. 16, 2008), available at <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en&Submit=Rechercher&alldocs=alldocs&docj=docj&docop=docop&docor=docor&docjo=docjo&numaff=T-181/05&datefs=&datefe=&nomusuel=&domaine=&mots=&resmax=100>.

253. Case T-230/06 (CFI (7th Chamber), Oct. 15, 2008), available at <http://curia.europa.eu/jurisp/cgi-bin/gettext.pl?lang=de&num=79918984T19060230&doc=T&ouvert=T&seance=ARRET> (in German).

254. CTM Application No. 3664133, filed Feb. 13, 2004.

255. Case R 25/2006-1 (OHIM First Board of Appeal, June 21, 2006).

notwithstanding Article 7(1)(b) and (c) of the CTM Regulation, under which it is an absolute ground for refusal of registration if the mark is an indication of geographical origin or is devoid of distinctiveness.²⁵⁶

The CFI determined that the name Port Louis was not a well-known geographical indication in the countries of interest, that is, the United Kingdom and France, notwithstanding that Mauritius was a colony of first France and then the United Kingdom. Moreover, it found that, according to the evidence, Port Louis had no specialty in the textile industry (the products of which the CFI focused on, aside from the other goods covered; in fact, Mauritius has a specialty trade in sugar, not textiles).

In light of the above, notwithstanding evidence of an increase in tourism and the manufacture of several brands of merchandise in the island of Mauritius (because of lower salaries, etc.), the CFI determined that no sufficient nexus existed between the textile industry and Port Louis that would justify the Board of Appeal's finding that the use of the particular geographical indication would be a misleading indication of origin, as Port Louis was not famous for its textiles.

This decision is important because it provides some important guidance on how to determine the applicability of factors that would render a trade mark inadmissible as a misleading indication of geographical origin but would not, *ab initio*, dismiss it without this type of examination or consideration.

II.C.1.f. Device and Design Marks

A device-only mark consisting of a handbag design in Class 18 (see below) was considered by the CFI in *Jean Cassegrain SAS v. OHIM*.²⁵⁷

256. Article 7(1) provides, in pertinent part:

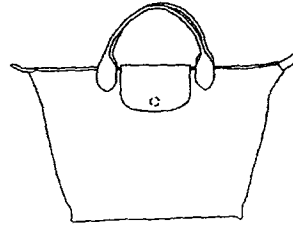
The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character; [and]

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service. . . .

257. Case T-73-06 (CFI (2d Chamber), Oct. 21, 2008), available at <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en&Submit=Rechercher&alldocs=alldocs&docj=docj&docop=docop&docor=docor&docjo=docjo&numaff=T-73/06%20&datefs=&datefe=&nomusuel=&domaine=&mots=&resmax=100> (in French).



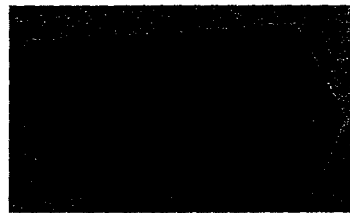
The examiner had rejected the application on the basis that the mark lacked the requisite distinctiveness.²⁵⁸ The Board of Appeal upheld the examiner's decision.²⁵⁹

The CFI had to determine whether the design of the handbag, which was in the plaintiff's LONGCHAMP range, was distinctive enough to be accepted for registration as a trade mark, as the mark was not accompanied by any word elements at all. It found that the test of the "distinctive character" of a trade mark that consists only of the design of the goods it aims to cover is that the design be significantly different from what is "standard" and "usual" in the relevant trade. The Court held that the particular handbag design in question, whether seen as a whole or examined part by part, was not significantly different from the usual representation of handbags. Therefore, it affirmed the earlier decisions and rejected the applicant's appeal.

This case shows that the CFI is reluctant to accept device-only trade marks consisting of representations of articles. That the mark applied for was a well-known handbag design, identifiable as one of Cassegrain's LONGCHAMP line in most countries of the European Union, not only in the plaintiff's home country of France, illustrates the difficulty that such applications will face.

II.C.1.g. Two- and Three-Dimensional Marks

The three-dimensional shape of the 2 × 4 LEGO plastic brick (see below) was the subject of *Lego Juris A/S v. OHIM*. The case concerned an application to register the shape as a CTM in Classes 9 and 28.



258. Decision of Apr. 18, 2005.

259. Case R 687/2005-2 (OHIM Second Board of Appeal, Dec. 8, 2005).

The CFI had to consider whether the mark consisted exclusively of a shape that was necessary to obtain a technical result (Article 7(1)(e)(ii) of the CTM Regulation). On the basis of that provision, the OHIM Cancellation Division declared the registration invalid with respect to “construction toys” in Class 28.²⁶⁰ The applicant appealed.

The Grand Board of Appeal dismissed the appeal. It held that, under Article 7(1)(e)(ii), the mark at issue was not registrable in respect of “construction toys” in Class 28. The Grand Board considered that the word “exclusively,” as used in Article 7(1)(e)(ii), means that the shape has no purpose other than that of achieving a technical result and that the word “necessary,” as used in that same provision, means that the shape is required to achieve that technical result, but that it does not follow that other shapes cannot also perform the same task.²⁶¹

After reviewing the evidence and arguments submitted in conjunction with the earlier decisions, the CFI made the following determinations:

1. The essential characteristics of a shape must be determined objectively for the purposes of applying Article 7(1)(e)(ii) of the CTM Regulation, on the basis of its graphic representation and any descriptions filed at the time the trade mark application is submitted. The perception of the target consumer is not relevant to the analysis of the functionality of the essential characteristics of a shape. The target consumer may not have the technical knowledge necessary to assess the essential characteristics of a shape, and therefore certain characteristics may be essential from his or her point of view even though they are not essential in the context of an analysis of functionality, and vice versa.
2. It was apparent from the case law that only the three-dimensional shape as reproduced in the device mark (not including in the analysis invisible features, such as the hollow underside and the secondary projections thereof) could be the subject matter of the examination of the application for registration.
3. Notwithstanding the above, there was nothing to prevent the Grand Board of Appeal, when analysing the functionality of the essential characteristics thus determined, from taking account of invisible features of the LEGO brick, such as the hollow underside and the secondary projections, as well as any other relevant evidence. The functionality of a shape must be assessed independent of whether other shapes exist, and the term

260. Decision of July 30, 2004.

261. Case R 856/2004-G (OHIM Grand Board of Appeal, July 10, 2006).

“necessary” in Article 7(1)(e)(ii) means that the shape must combine characteristics that are technically sufficient to obtain the result in question.

Based, *inter alia*, on the above findings, the CFI affirmed the Grand Board of Appeal’s decision and held that the shape of the LEGO 2 × 4 brick should not be afforded trade mark protection as a three-dimensional mark.²⁶²

The decision concerns the “functionality” versus “distinctiveness” debate regarding trade marks, which is not a commonly adjudicated issue. It is a useful precedent, supplementing the European Court of Justice’s decision in the *Philips* case.²⁶³

II.D.6. Flags, Coats of Arms, and Other Insignia

The Belgian company American Clothing Associates SA filed an application for the registration as a CTM of a mark consisting of the figure of a maple leaf and the letters RW,²⁶⁴ for goods and services in Classes 18, 25, and 40 (below, illustration at left). The application was rejected in its whole on the basis of Article 7(1)(h) of the CTM Regulation,²⁶⁵ which makes reference to Article 6*ter* of the Paris Convention.²⁶⁶ It was found that the figure in the applied-for mark was an imitation of the Canadian national emblem (below, illustration at right), as notified by Canada to the World Intellectual Property Organization, and that the mark was likely to give rise to an impression on the part of the public that there was a link between the applicant and Canada.

The examiner refused to register the mark on those grounds.²⁶⁷ American Clothing’s appeal against this decision²⁶⁸ was rejected;²⁶⁹ the company then appealed to the CFI.²⁷⁰

262. *Lego Juris A/S v. OHIM*, Case T-270/06 (CFI (8th Chamber), Nov. 12, 2008), available at <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en&Submit=Rechercher&alldocs=alldocs&docj=docj&docop=docop&docor=docor&docjo=docjo&numaff=T-270/06&datefs=&datefe=&nomusuel=&domaine=&mots=&resmax=100>.

263. *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd*, Case C-299/99, [2002] ECR I-5475 (ECJ, June 18, 2002).

264. CTM Application No. 2785368, filed July 23, 2002.

265. Article 7(1)(h) provides: “The following shall not be registered: . . . trade marks which have not been authorized by the competent authorities and are to be refused pursuant to Article 6*ter* of the Paris Convention. . . .”

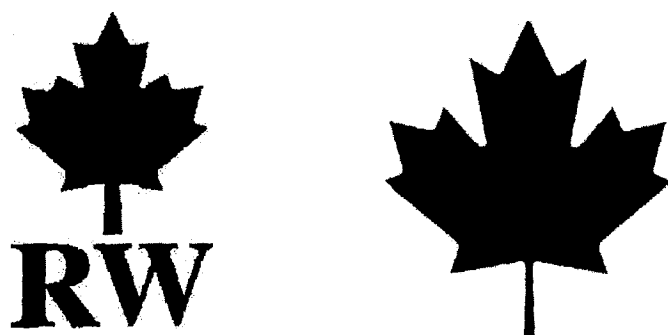
266. Article 6*ter* paragraph (1)(a) provides: “The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.”

267. Decision of Oct. 7, 2005.

268. Appeal No. R 1463/2005-1, filed Dec. 6, 2005.

269. Case R 1463/2005-1 (OHIM First Board of Appeal, May 4, 2006).

The Court held that Article 6ter of the Paris Convention did not refer to service marks. It went on to hold that if the Community legislature had intended to prohibit the registration of marks containing “armorial bearings, flags, and other State emblems” in respect of services, it would not have made a mere reference to Article 6ter but would have inserted an explicit reference to such prohibition, and that such an extensive interpretation of Article 6ter would be *contra legem*. Thus, the CFI concluded that the mark in question should be accepted for registration for services.



The CFI further proceeded to consider the registrability of the mark as far as goods in Classes 18 and 25 were concerned. It made a comparison between the Canadian state emblem and the maple leaf of the mark in question in order to determine whether the figure in the mark was an imitation of the emblem “from a heraldic point of view.” The Court held that the word element RW did not preclude the application of Article 6ter. It further held that in the assessing of a complex mark in light of the provisions of Article 6ter, the fact that one of the elements of which the complex mark consists is a state emblem or an imitation of a state emblem is a sufficient basis on which to preclude registration of the mark concerned.

With regard to the graphic differences between the mark and the emblem, the CFI made a distinction between the “heraldic description” of an emblem, which is simple and general, and the “geometric description” of that emblem, which is by nature much more detailed. It held that there may be various artistic interpretations of one and the same emblem, and that although there might be differences in detail between each of those interpretations (as in this case), they were still all imitations, “from a heraldic point of view,” of the emblem concerned. The difference in colour, the Court held, was irrelevant in this case, as the application in question did not mention the colours of the mark

sought to be registered and the Canadian state emblem could be reproduced in black and white.

In light of the above, the CFI concluded that the average consumer would perceive the mark as an imitation of the Canadian state emblem. Accordingly, it confirmed the decision of the Board of Appeal as far as goods in Classes 18 and 25 were concerned.²⁷¹

CZECH REPUBLIC

I.D.1. Similarity of Marks

The Industrial Property Office refused the opposition against the application for registration of the trademark XPRESS in Classes 29, 30, and 32, which was based on the existence of the prior-registered trademark EXPRESSA in Class 30.

On the opponent's appeal, the Appeals Panel of the Industrial Property Office confirmed the first instance decision.²⁷² The Panel held that a detailed comparison of the marks would not be decisive for consumers, as they relied on the overall impression conveyed by a mark. It found that the overall impression created by the trademark XPRESS was unusual, in that the letter X would be pronounced "iks" in the Czech language. By contrast, the first syllable of the opposing trademark would be pronounced "eks." This difference, plus the fact that the opposing mark contained an additional final letter A, created a sufficient dissimilarity between the marks under comparison to eliminate any likelihood of confusion.

II.C.6. Domain Names

The Industrial Property Office rejected the opposition against the registration of the trademark NOVERA, which was based in part on the existence of an earlier industrial property right, namely a prior-registered domain name.

The Office held that a domain name was not an industrial property right, as it was regulated neither by international conventions (the Paris Convention or the TRIPS Agreement) nor by Czech legislation concerning industrial property rights. A right to a domain name was merely a right in the establishment and administration of the name in a registrar's database: registration of a domain name was a result of a contract between the applicant

271. American Clothing Associates SA v. OHIM, Case T-215/06 (CFI (5th Chamber), Feb. 28, 2008), available at <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en&Submit=Rechercher&alldocs=alldocs&docj=docj&docop=docop&docor=docor&docjo=docjo&numaff=T-215/06&datefs=&datefe=&nomusuel=&domaine=&mots=&resmax=100>.

272. Decision No. O-356535 (Appeals Panel, Industrial Property Office, Oct. 3, 2007).