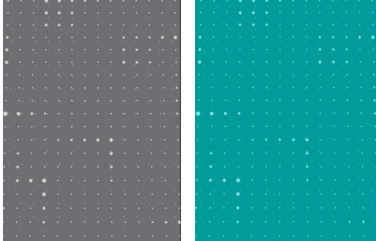
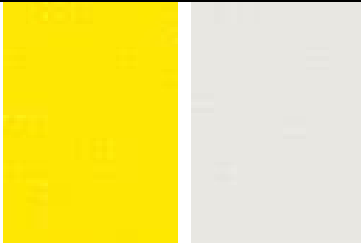







## TRADE MARKS

## Decisions of the GC

Ref no.	Application (and where applicable, earlier mark)	Comment
<p>GC  <b>T-714/13</b>  <i>Gold Crest LLC v OHIM</i>            (08.09.15)</p>	<p><b>MIGHTY BRIGHT</b>            - portable clip-on reading lights and light bulbs (11)</p>	<p>The GC dismissed the appeal from the BoA's decision that the mark was devoid of any distinctive character under <b>Art 7(1)(b)</b>.</p> <p>The BoA was correct to find that the expression 'mighty bright' taken as a whole, and also when considering the two components of the mark as separate words, immediately informed the relevant public, without further reflection being required, that the goods covered by the mark applied for were powerful, bright lights and light bulbs, thus eclipsing any impression that the mark could indicate a commercial origin.</p> <p>The GC confirmed that the allegedly unusual nature of the combination of the words 'mighty' and 'bright' did not preclude the application from being descriptive. Although the adjective 'mighty' could not, in principle, according to the rules of grammar, be used to qualify the adjective 'bright', the designation did not deviate enough from everyday language to affect its descriptiveness.</p> <p>The BoA's finding that the mark had not become distinctive through use was not disputed. Consequently, the GC confirmed that the BoA was right to find that the sign at issue was devoid of any distinctive character.</p>
<p>GC  <b>T-74/14; T-94/14</b>  <b>T-143/14; T-144/14</b>  <i>EE Limited v OHIM</i>            (10.09.15)</p>		<p>The GC upheld the BoA's decisions which rejected the applications for four figurative colour marks on the basis that the marks lacked distinctive character in respect of the goods and services at issue under <b>Art 7(1)(b)</b>.</p> <p>The GC upheld the BoA's finding</p>



	 <p>The marks were described as <i>'the combination of the specific Pantone colour [as further defined below] with white particles in a certain infinite pattern'</i>.</p> <p>The Pantone colours claimed in each mark were as follows:</p> <p>Grey: Pantone No 431  Aqua: Pantone No 326  Ivory: Pantone No 9143  Yellow: Pantone No 012</p> <p>- various goods and services in Classes 9, 16, 25, 35, 36, 37, 38, 39, 41, 42 and 45</p>	<p>that the signs as a whole could not function as indicators of origin for any of the goods or services applied for.</p> <p>As regards EE's submission that the BoA had not assessed the distinctiveness of the signs in respect of all the goods/services at issue, the GC held that while the examination of the absolute grounds for refusal must be carried out in relation to each of the goods or services for which trade mark registration is sought, the competent authority may group them in broader categories and apply only general reasoning where they were interlinked in a sufficiently direct and specific way.</p> <p>The GC was satisfied that the BoA took account of the goods and services covered by the marks applied for, specified the different groups in which they could be classified and actually assessed distinctive character in relation to as many of them as possible.</p> <p>The GC concluded that, given the widespread use of the basic colours at issue in relation to goods and services in many sectors, including the sectors relevant to this case, those colours, per se, were not capable of indicating the origin of the goods and services applied for</p>
<p>GC  <b>T-323/14</b>  <i>Bankia, SA v OHIM; Banco ActivoBank (Portugal), SA</i>  (17.09.15)</p>	 <p>- insurance, financial and banking services; real estate administration; real estate services via telecommunication networks, data transmission networks and global computer communications networks; real estate services (36)</p> <p><b>BANKY</b></p> <p>- financial and banking services, including those provided through the internet or other means of telecommunications (36)</p>	<p>The GC partially upheld the BoA's decision that there was a likelihood of confusion between the marks under <b>Art 8(1)(b)</b>, but disagreed with the finding of similarity in relation to 'real estate services' and annulled the BoA's decision in this regard.</p> <p>The GC held that the nature, intended purpose and method of use of the 'financial and banking services' were not the same as those associated with 'real estate services'. The services at issue were not complementary and, although financial and banking services might be necessary in order to use real estate services, the services</p>

	(Portuguese mark)	<p>were not so intrinsically linked that the relevant public would consider them to originate from the same undertaking. Subject to this exception, the GC upheld the BoA's assessment of similarity for the remaining services applied for.</p> <p>The GC agreed with the BoA's finding that the marks possessed a certain degree of visual and conceptual similarity and also agreed that the marks had a high degree of phonetic similarity to the relevant Portuguese public. On the basis of the similarity of the marks and the high level of attention of the relevant public, the GC upheld the BoA's decision that there was a likelihood of confusion in respect of all services deemed to be identical or similar, with the exception of 'real estate services'.</p>
<p>GC</p> <p><b>T-387/13</b></p> <p><i>Federación Nacional de Cafeteros de Colombia v OHIM; Nadine Hélène Jeanne Hautrive</i></p> <p>(Contested Decision 1)</p> <p><b>T-359/14</b></p> <p><i>Federación Nacional de Cafeteros de Colombia v OHIM; Accelerate s.a.l.</i></p> <p>(Contested Decision 2)</p> <p>(18.09.15)</p>	<p><u>Mark in Contested Decision 1</u></p> <p style="text-align: center;"><b>COLOMBIANO</b>  <b>HOUSE</b></p> <p>- services for providing food and drink, restaurants, bars and cocktail bar services, catering services, stores administering of food and drink indoor or take away, food and beverage services, sandwich bars, snack bars (43)</p> <p><u>Mark in Contested Decision 2</u></p> <p style="text-align: center;"> COLOMBIANO COFFEE HOUSE</p> <p>- tea, cocoa, sugar, rice, tapioca, sago, flour and preparations made from cereals, bread, pastry and confectionery, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice (30)</p> <p>- services for providing food and drink, temporary accommodation</p>	<p>Contested Decision 1 related to an opposition and Contested Decision 2 related to an application for a declaration of invalidity, each based on an earlier Protected Geographical Indication (PGI). In Contested Decision 1 the GC annulled the BoA's decision to reject the opposition and in Contested Decision 2 the GC annulled the BoA's decision to find the mark applied for only partially invalid (for goods covered in respect of 'tea, cocoa, sugar' in Class 30).</p> <p>The BoA erred by applying <b>Art 14</b> of the Regulation in conjunction with <b>Art 8(4)</b> when it should have applied <b>Art 13</b> of the Regulation.</p> <p><b>Art 8(4)</b> required the earlier non-registered mark to confer on its proprietor the right, pursuant to the law governing that mark, to prohibit the 'use' of a subsequent trade mark. The BoA had taken account of the Regulation when assessing the applicant's rights and applied <b>Art 14</b> of the Regulation entitled 'Relations between trademarks, designations of origin and geographical indications', requiring that: (1) the filing date of</p>

	<p>(43)</p> <p><u>Earlier Mark</u></p> <p><b>CAFÉ DE COLOMBIA</b></p> <p>(Protected Geographical Indication registered under Council Regulation (EC) No <b>510/2006</b> on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (the "<b>Regulation</b>"))</p> <p>- coffee</p>	<p>the PGI was earlier than the mark (this was not disputed); (2) that the PGI and the mark applied for related to the same class of product; and (3) that one of the situations in <b>Art 13</b> of the Regulation existed. Since condition (2) did not apply, the BoA rejected the opposition.</p> <p>The GC held that <b>Art 8(4)</b> only requires that the PGI prevent the use of the later trade mark and not its registration. Therefore, <b>Art 14</b> of the Regulation was not applicable. Instead, <b>Art 13</b> which defined the scope of the protection conferred on a PGI was to be applied. This did not contain the requirement that the PGI and the mark applied for related to the same class of product. This decision was supported by the OHIM Guidelines.</p> <p>The BoA's error in applying the incorrect article of the Regulation led to a failure to fully examine whether the opposition and the declaration of invalidity could be upheld and therefore each of the BoA's decisions were annulled.</p>
<p>GC</p> <p><b>T-60/13</b></p> <p><i>Reiner Appelrath-Cüpper Nachf. GmbH v OHIM; Anne Christine Lizenzmanagement GmbH &amp; Co. KG</i></p> <p>(23.09.15)</p>	 <p>- various goods and services in Classes 9, 14, 18, 25 and 35, notably clothing and footwear (25) and the operation of retail outlets and retail services in relation to the goods designated in the specification (35)</p>  <p>- various goods and services in Classes 9, 14, 18, 25 and 35</p>	<p>The GC annulled the BoA's decision that there was a likelihood of confusion between the mark and the earlier marks under <b>Art 8(1)(b)</b>.</p> <p>Disagreeing with the BoA's finding that the marks were visually similar to an average degree, the GC held that the marks had only a low degree of visual similarity. The graphical representation of the word element 'AC' (being the element which would primarily attract the attention of the relevant public) differed considerably between the mark applied for and the earlier marks. Furthermore, the mark applied for did not contain the word elements 'Ann Christine'. The similarity was even lower for the earlier marks which included the use of colour and the additional word elements 'ocean'</p>

	(CTM, International and German marks)	<p>and 'intimate'.</p> <p>Furthermore, the relevant public would have the tendency to restrict its pronunciation of the earlier marks to the word elements 'Ann Christine' as opposed to the acronym 'AC'. The BoA had therefore erred in its finding of phonetic identity. The lack of conceptual similarity was not disputed by the parties.</p> <p>Despite the identity or similarity between the goods and services at issue, the GC concluded that there was no likelihood of confusion due to the low similarity of the marks. Visual similarity was more important in the fashion sector and so carried greater weight when assessing likelihood of confusion.</p>
<p>GC <b>T-193/14</b> <i>Cristiano di Thiene SpA v OHIM; Nautica Apparel, Inc</i> (23.09.15)</p>	<p><b>AERONAUTICA</b> - various goods and services in Classes 9, 18, 20, 25, 35 and 42</p> <p><b>NAUTICA</b> - various goods and services in Classes 8, 9, 25, and 35</p> <p><b>NAUTICA BLUE</b> - various goods in Classes 9, 18, 20 and 25</p>	<p>The GC upheld the BoA's decision that there was a likelihood of confusion between the marks under <b>Art 8(1)(b)</b>.</p> <p>The BoA was correct to find an average degree of visual and phonetic similarity between the marks. Despite its presence at the beginning of the mark applied for, the differentiating element 'aero' was insignificant in comparison with the overall visual impression given by the length and position of the common element 'nautica'. There was no requirement for the overall impression produced by the common element to dominate the mark applied for in order for the marks to be considered similar.</p> <p>The BoA was also correct to find that any conceptual differences between the marks did not reduce their similarity. Whilst Spanish, French, Portuguese and English speakers may associate 'nautica' with nautical navigation and 'aeronautica' with aerial navigation the conceptual comparison would be neutral for consumers who did not speak those languages.</p> <p>Given the similarity of the marks and the identity or similarity of the goods and services, there was a</p>

		likelihood of confusion between the marks.
<p>GC <b>T-633/13</b> <i>Reed Exhibitions Ltd v OHIM</i> (23.09.15)</p>	<p><b>INFOSECURITY</b></p> <ul style="list-style-type: none"> <li>- printed material relating to information security and printed information relating to trade shows, exhibitions and educational events (16)</li> <li>- organising, arranging and conducting exhibitions and job fairs, recruitment services and the provision of business information relating to strategy and technique of information security (35)</li> <li>- provision and dissemination of information relating to organising, arranging and conducting exhibitions, publication of texts, books, reviews and magazines, provision of publications, magazines, journals, reviews, books, and newsletters in the field of strategy and technique of information security (41)</li> </ul>	<p>The GC upheld the BoA's decision to refuse registration of the mark on the basis that it was descriptive under <b>Art 7(1)(c)</b> and had not acquired distinctive character under <b>Art 7(3)</b>.</p> <p>The BoA had been correct to find that the mark designated the subject matter of all the goods and services applied for in that they related to the provision of information relating to information security. The BoA had not breached its obligation to state reasons for its decision by providing this single reason why the mark was descriptive. The goods and services formed a sufficiently homogeneous category as they were all media for the dissemination of information in writing or in print. A separate explanation was not required in relation to each of the goods and services.</p> <p>The combination of the words 'info' and 'security' was not an unusual lexical invention and could not alter the assessment that the sign was descriptive of the goods and services applied for.</p> <p>The BoA had also been correct to find that acquired distinctive character had not been established.</p>
<p>GC <b>T-382/14</b> <i>Bernhard Rintisch v OHIM; Compagnie laitière européenne, SA</i> (24.09.15)</p>	<p><b>PROTICURD</b></p> <ul style="list-style-type: none"> <li>- pharmaceutical preparations and dietetic substances for medical purposes (5)</li> <li>- milk powders, whey proteins; milk beverages, with milk predominating; proteins of animal or vegetable origin...for human food consumption (29)</li> </ul> <p><b>PROTI</b> <b>PROTIPLUS</b></p>	<p>The GC annulled the decision of the BoA to reject the opposition on the basis that, contrary to <b>Art 75</b>, the BoA had failed to give reasons for its decision to not take into account evidence of genuine use of the earlier marks for Class 29 submitted in support of the opposition.</p> <p>The BoA had partially annulled the Opposition Division's decision, rejecting the opposition in respect of the Class 5 goods and some of the Class 29 goods. Although the BoA concluded that there had been genuine use of the earlier PROTI</p>

	 <p>- milk products, namely milk-protein and whey-protein for mixing in foodstuffs, foodstuffs with high protein content; protein and carbohydrates particularly in powder form; dietetic foodstuffs not for medical purposes (29)</p> <p>- preparations, particularly protein and carbohydrates, particularly in powder form, for beverage preparation (32)</p> <p>(German marks)</p>	<p>mark in relation to goods in Class 32, it was not clearly and unequivocally apparent whether the BoA had agreed with the Opposition Division's assessment of genuine use of the earlier marks in respect of the goods in Class 29 as the BoA did not mention proof of use of the Class 29 goods in its decision.</p> <p>The GC held that since the extent to which genuine use of these goods had been established was essential to the assessment of the likelihood of confusion between the marks, the failure of the BoA to give express reasons was an infringement of an essential procedural requirement which prevented Mr Rintisch from properly defending his rights and undermined the ability of the courts to review the legality of the BoA's decision.</p>
<p>GC</p> <p><b>T-641/14</b></p> <p><i>Alexandra Dellmeier v OHIM; Dell Inc.</i></p> <p>(24.09.15)</p>	<p><b>LEXDELL</b></p> <p>- various goods and services in Classes 16, 25, 41 and 45, including legal services in respect of intellectual property</p>  <p>- various goods and services in Classes 9, 16, 25, 35, 36, 37, 38, 40, 41 and 42</p>	<p>The GC upheld the BoA's decision that the use without due cause of the mark applied for in relation to various services in Classes 41 and 45 would take unfair advantage of the repute of the earlier mark under <b>Art 8(5)</b>.</p> <p>The BoA was correct to find that there was a certain degree of visual similarity between the marks, that there was a low degree of phonetic similarity and a partial conceptual similarity between the marks given their common component 'dell', which means a 'small, wooded hollow' in English. In these circumstances, the BoA correctly concluded that there was a certain degree of similarity between the marks at issue.</p> <p>The BoA's assessments regarding the unfair advantage which would be taken by the mark applied for (in particular, referring to the degree of closeness between legal services in respect of intellectual property and the technology forming the subject matter of the IP, for which Dell was well known)</p>

		was not called into question.
<p>GC  <b>T-366/14</b>  <i>August Storck KG v OHIM</i>  (25.09.15)</p>	<p><b>2good</b>  - confectionery, chocolate, chocolate products, pastries, ice cream, preparations for making the aforementioned products (30)</p>	<p>The GC upheld the BoA's decision that the mark was devoid of distinctive character under <b>Art 7(1)(b)</b>.</p> <p>The BoA was correct to find that the relevant public, being the average English-speaking consumer with a reduced level of attention, would at first glance perceive the combination of the number 2 with the word 'good' as corresponding to the English word 'too', meaning 'extremely', and would not perceive the sign as meaning 'twogood'.</p> <p>When applied to the goods in question, the expression 'too good' would therefore be understood by the relevant public as an advertising slogan or, at the least, as a description of an essential feature of those goods, namely their gustatory qualities. The GC held that the BoA's decision was not contradicted by registration for the sign '2good' in Germany since registrations in Member States may be taken into consideration but need not be given decisive weight for the purposes of registering a CTM.</p>
<p>GC  <b>T-707/14</b>  <i>Grundig Multimedia AG v OHIM</i>  (25.09.15)</p>	<p><b>DetergentOptimiser</b>  - textile washing machines; washing machines (laundry machines/ dishwashing machines); electrical machines for cleaning floors and carpets (7)</p>	<p>The GC dismissed the appeal from the BoA's decision that the mark was descriptive of the characteristics of the goods concerned under <b>Art 7(1)(c)</b>.</p> <p>The GC confirmed that upon reading the English word 'detergent' the relevant public would assume the word 'optimiser' was also an English word and would not speculate as to meanings in other languages. Moreover, the capital letter 'O' allowed the relevant public to distinguish immediately, first, the word 'detergent' and, second, the word 'optimiser'.</p> <p>The GC held that the meaning of the word 'detergent' was clear: it described a chemical substance</p>



		<p>presented in powder or liquid form designed to eliminate dirt used in the washing process. The word 'optimiser' was known in English even if it did not feature in all English dictionaries; it referred to a person or thing which drew out the best from something. The juxtaposition of those two words was not particularly surprising or unusual and would describe the goods at issue as enabling optimal use of detergents.</p> <p>The BoA was therefore entitled to hold that the mark designated to the relevant public the kind and quality of the goods.</p>
--	--	--

**The geographical scope of a CTM's reputation necessary for Article 4(3)**

***Iron & Smith kft v Unilever NV (CJ (Fourth Chamber)); C-125/14; 03.09.15)***

The CJ has given a preliminary ruling (in which it agreed with the opinion of AG Wahl, reported *CIPA Journal*, April 2015) on questions relating to **Article 4(3)** of the Trade Mark Directive, in which it found that a mark would be held to have a reputation in the EU if the reputation of the earlier CTM was established in a substantial part of the EU, even though, in some circumstances, that 'substantial part' might coincide with the territory of a single Member State. It was not necessary that the 'substantial part' included the Member State in which the application for the later national mark was filed and, if this was not the case, the proprietor of the earlier CTM would need to show that a commercially significant part of the public was familiar with its mark, made a connection between it and the later national mark, and that there was, taking account of all the relevant factors in the case, either actual and present injury to the earlier CTM or, failing that, a serious risk that such injury may occur in the future, to take advantage of **Article 4(3)**.

Unilever opposed an application by Iron & Smith for the registration of the colour figurative mark BE IMPULSIVE as a Hungarian trade mark on the basis of its earlier CTM, IMPULSE. The Hungarian Intellectual Property Office found that Unilever had sold large quantities of, and publicised, goods under the mark IMPULSE in the UK and Italy, with the mark having a 5% market share in the UK and a 0.2% market share in Italy. On the basis of the market share (which did not relate to Hungary) the Hungarian Intellectual Property Office found that the reputation of the earlier CTM had been proven in a substantial part of the EU. It also found that a risk of the later mark taking unfair advantage could not be ruled out.

The Hungarian Intellectual Property Office refused registration of its mark and Iron & Smith appealed. The Budapest Municipal Court stayed the proceedings and requested a preliminary ruling from the CJ on four questions regarding the interpretation of **Article 4(3)**.

First condition: Substantial part of the EU

The CJ answered the first three questions put to it together and held that, for a mark to have a reputation in a substantial part of the EU, it must be well known by a significant part of the public concerned in a substantial part of that territory. A substantial part of that territory could in some circumstances coincide with the territory of a single Member State (which did

not necessarily have to be the same Member State as the one in which the application for the later national mark was filed) (*PAGO International*, C-301/07, reported in *CIPA Journal*, November 2009).

Furthermore, the CJ held that the principles used to establish genuine use pursued a different objective than those relating to establishing reputation and were therefore not relevant.

#### Second condition: Detriment or unfair advantage

The CJ found that the question of whether the second condition under **Article 4(3)** (namely, whether the use of the later mentioned mark must take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier CTM) was fulfilled firstly depended on whether a commercially significant part of the relevant public in the Member State in which the registration of the later mark had been sought were familiar with the earlier CTM and might make a link between it and the later mark.

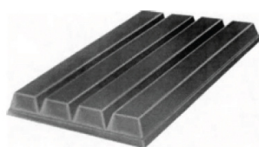
The existence of such a link had to be assessed globally taking into account all factors relevant to the circumstances of the case. Such a link was not, in itself, sufficient to establish that there was one of the types of injury referred to in **Article 4(3)**: in addition, the proprietor of the earlier CTM must show that use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark and therefore show that there was either actual and present injury to its earlier CTM for the purposes of **Article 4(3)** or, failing that, that there was a serious risk that such injury might occur in the future. The existence of one of the types of injury referred to in **Article 4(3)**, or serious risk of such injury, must also be assessed globally, taking into account all factors relevant to the circumstances of the case. In particular, the more immediate and strongly the earlier CTM was brought to mind by the later mark, the greater the likelihood that the current or future use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier CTM. It was then for the proprietor of the later mark to establish that there was due cause for its use of that mark.

#### **Registration of 3D shape marks**

##### ***Société des Produits Nestlé v Cadbury UK Ltd* (CJ (First Chamber)); C-215/14; 16.09.15)**

The CJ has delivered its ruling on questions referred to it from the English High Court concerning the registrability of the 3D shape of a Kit Kat chocolate bar.

Nestlé applied to register the mark reproduced below in the UK for 'chocolate; chocolate confectionery; chocolate products; confectionery; chocolate-based preparations; bakery goods; pastries; biscuits; biscuits having chocolate coating; chocolate coated wafer biscuits; cakes; cookies; wafers' in Class 30.



Cadbury opposed the registration on the basis of the provisions of the Trade Marks Act 1994 which transposed **Articles 3(1)(b), 3(1)(e)(i) and (ii), and 3(3)** of the Directive.

The examiner found the mark devoid of inherent distinctive character and that it had not acquired distinctive character through use. The examiner noted that the shape had three features: (i) the basic rectangular slab shape; (ii) the presence, position and depth of the grooves running along the length of the bar; and (iii) the number of grooves which, together

with the width of the bar, determined the number of 'fingers'. The examiner concluded that feature (i) was a shape which resulted from the nature of the goods themselves and could not be registered, except in respect of 'cakes' and 'pastries' where it departed from the norms of the sector. Features (ii) and (iii) were necessary to obtain a technical result.

Nestlé appealed the decision to the High Court and Cadbury cross appealed ([2014] EWHC 16 (Ch), reported in *CIPA Journal*, February 2014). In order to assess whether the examiner had erred in his application of the provisions which transposed **Article 3(1)(e)(i)** (sign consisting exclusively of the shape which results from the nature of the goods themselves) and **3(1)(e)(ii)** (sign consisting exclusively of the shape of the goods necessary to obtain a technical result), Arnold J referred three questions to the CJ.

The CJ addressed the questions relating to the interpretation of **Article 3(1)(e)** before considering the High Court's first question relating to acquired distinctive character under **Article 3(3)**, because it had to be ascertained, firstly, that there was no obstacle under **Article 3(1)(e)** that would preclude registration before going on to analyse whether the sign at issue had acquired distinctive character.

By its second question, the High Court asked whether **Article 3(1)(e)** must be interpreted as precluding registration of a shape where that shape contained three essential features, one of which resulted from the nature of the goods themselves and two of which were necessary to obtain a technical result. The CJ concluded that **Article 3(1)(e)** would preclude registration of such a shape, provided that at least one of the grounds for refusal was fully applicable to that shape. Following *Hauck v Stokke*, **C-205/13** (reported in *CIPA Journal*, October 2014), the three grounds for refusal operated independently, so it was irrelevant whether a sign could be denied registration on the basis of a number of grounds for refusal.

By its third question, the High Court asked whether **Article 3(1)(e)(ii)** must be interpreted as referring only to the manner in which the goods at issue functioned, or whether it also applied to the manner in which they were manufactured. Disagreeing with the opinion of AG Wathelet (reported in *CIPA Journal*, July 2015), the CJ concluded that **Article 3(1)(e)(ii)** only referred to the functioning of the goods, and did not apply to the manner in which they were manufactured. On a literal interpretation, **Article 3(1)(e)(ii)** was restricted to the manner in which the goods functioned, since the technical result was the outcome of a particular method of manufacturing the shape in question. Furthermore, from the consumer's perspective, the manner in which the goods functioned was decisive and their manner of manufacture was not important. Following *Philips v Remington*, (**C-299/99**, reported in *CIPA Journal*, July 2002), this position was reflected in case law; registration of a shape attributable solely to the technical result must be refused even if that technical result could be achieved by other shapes (and consequently, by other manufacturing methods).

Finally, the CJ responded to the first question, namely, whether in order to register a trade mark which had acquired a distinctive character following the use made of it within the meaning of **Article 3(3)**, it was sufficient for the applicant to prove that a significant proportion of the relevant class of persons recognised that mark and associated it with the applicant's goods, or whether the applicant must prove that the relevant class of persons perceived the goods designated exclusively by that mark, as opposed to any other mark which might also be present, as originating from a particular company. In agreeing with the AG, the CJ concluded that the applicant must prove the latter, i.e., they must prove that that mark alone, as opposed to any other trade mark which may also be present (regardless of whether the use is as part of another registered mark or in conjunction with such a mark), identified the particular undertaking from which the goods originated.

## DESIGNS

### H&M unsuccessful in invalidity actions against two Yves Saint Laurent designs

***H&M Hennes and Mauritz BV & Co. KG v OHIM; Yves Saint Laurent (GC; T-525/13 and T-526/13; 10.09.2015)***

The GC upheld two earlier BoA decisions which dismissed applications for the invalidity of two Community design registrations for bags held by Yves Saint Laurent ("YSL") under **Article 6**.

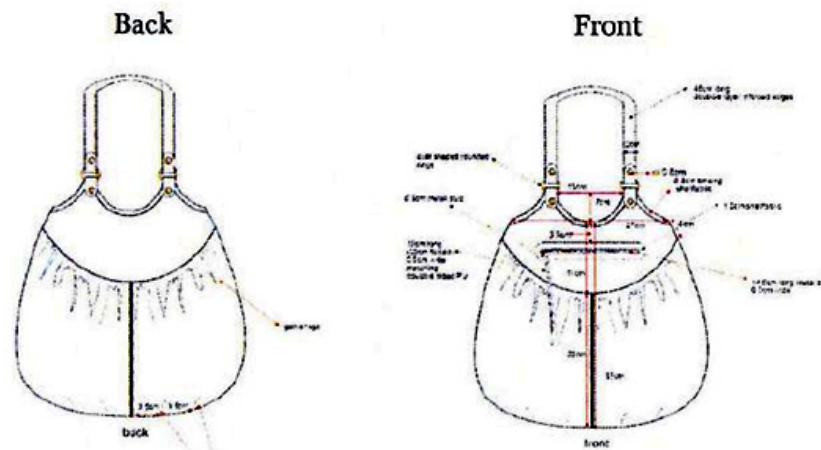
YSL owned the following design registrations for 'handbags':



**Design 1**

**Design 2**

H&M filed applications for a declaration of invalidity of the two designs, alleging that the designs lacked individual character under **Article 6**, in light of one of its earlier Community designs reproduced below:



Both the Cancellation Division and the BoA rejected H&M's applications for declarations of invalidity. The GC dismissed H&M's appeal.

The GC agreed with the BoA's assessment that while the degree of design freedom was high, there were significant differences between the YSL and H&M designs in terms of the overall shape, structure and surface finish, which produced a different overall impression on the informed user. YSL's designs were characterised by classic lines and formal simplicity whereas the impression produced by H&M's design was more that of a worked bag, characterized by curves and ornamental motifs on the surface of the bag. Further, the mode of use of YSL's and H&M's designs were different. While the bags designed by YSL were intended to be carried by hand, H&M's designs were for shoulder bags. Both designs consisted of an upper contour and strap handle attached to the body by rings and reinforced by rivets. These common features were not however sufficient to give the designs the same overall impression - unlike the H&M design, the rings in the YSL design were clearly visible, and let light through.

The GC therefore concluded that as the differences between the designs were significant, and the similarities insignificant, the designs produced a different overall impression on the informed user.

In reaching its decisions, the GC noted that while degree of design freedom could not on its own determine whether a design had individual character, it was a factor which had to be taken into consideration in that assessment, so as to moderate the perception of the informed user.

**Katharine Stephens and Zoe Fuller**

**Reporters' note:** We are grateful to our colleagues at Bird & Bird LLP for their assistance with the preparation of this report: Cristina Garrigues, Toby Bond, Toby Sears, Ahalya Nambiar, Mark Livsey, Mo Karim, Ning-Ning Li, Emma Green and Tom Darvill.

The reported cases marked \* can be found at <http://www.bailii.org/databases.html#ew> and the CJ and GC decisions can be found at [http://curia.europa.eu/jcms/jcms/j\\_6/home](http://curia.europa.eu/jcms/jcms/j_6/home)