

# Review

## Intellectual Property

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### Jewel Aquarium trade mark left floundering

In Case T-339/07 Jewel Aquarium GmbH v OHIM (28 October 2009) the CFI has upheld a declaration of invalidity against a registered mark on the grounds of descriptiveness.

In February 2004, Jewel Aquarium registered the word mark “Panorama”, as a CTM for goods and services in classes 11, 16 and 20. Later that year, Bavaria Aquaristik applied for a declaration of invalidity on the ground that the mark had been registered in breach of Article 7(1).

In 2006, the application for a declaration of invalidity was refused by the Cancellation Division. In a subsequent appeal to OHIM’s Board of Appeal, this decision was annulled and the application for a declaration of invalidity was upheld.

Jewel Aquarium appealed to the CFI, raising two grounds in support of its application:

- i) infringement of Article 7(1)(c) that the mark was purely descriptive; and
- ii) infringement of Article 7(1)(d) that “Panorama” was customary and generic.

The appeal board had not considered the second limb above as it felt that if the mark was a technical term in relation to aquariums or terrariums, it had a directly descriptive meaning under Article 7(1)(c) and this showed that it was customary. The CFI noted this and added that there was consistent case law showing that each of the absolute grounds under Article 7 was independent and that only one was required as a basis for refusal of a CTM.

The CFI restated the appeal board’s decision, which had been based on paragraphs (b) (devoid of distinctive character) and (c) (descriptiveness) and noted that Jewel Aquarium had not challenged their interpretation of sub paragraph (b). Therefore, there was a possibility that the appeal was not even admissible, as it would not bring any relief to Jewel Aquarium. However, it was noted that under case law, the judge could consider the substance of an appeal, without deciding on its admissibility, in the interests of procedural efficiency.

The CFI reiterated the general interest aim of Article 7(1)(c) to allow descriptive marks to be used freely by any business. It was also noted that under Article 7(1)(c), marks

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‘Panorama’  
was  
descriptive for  
aquariums  
describing an  
all-round clear  
and wide view

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could be considered as descriptive, even if they were descriptive in only part of the EU. However, it should have a sufficiently direct and concrete link, which would make the relevant public immediately think of the goods and services or their characteristics.

The CFI then took the usual approach of considering descriptiveness of the mark in relation to the goods and services in question. The goods were lamps for aquariums, aquariums and terrariums, as well as furniture and frames for aquariums and terrariums. The CFI agreed with the appeal court that the intended public included both aquarium and terrarium enthusiasts who knew how to keep animals in aquariums and terrariums and customers making their first purchase. It rejected Juwel Aquarium's argument that the intended public also included people likely to buy fish in the future, deciding that they were only part of the intended public once they decided to buy goods bearing the Panorama mark.

In light of the above, the CFI decided that the average consumer would have an interest in aquariums and terrariums, whether they were making their first purchase or had good knowledge of the area. As always, the average consumer would be reasonably well informed, reasonably observant and circumspect but it was noted that aquarium enthusiasts would pay a greater level of attention to the goods.

In relation to whether the mark was descriptive, the CFI agreed with OHIM that the term, "panorama" described an all-round view with a wide and clear field of vision as shown by the shape of aquariums and terrariums. This was significant in relation to the goods, as a panoramic view would allow large areas of the aquarium or terrarium to be viewed, which would be an advantage. The mark was also descriptive for aquarium lamps, as well as furniture and frames for aquariums as, in form and function, these would contribute significantly to a panoramic field of vision.

The CFI went on to state that the mark Panorama, when applied to the goods in question, directly informed the relevant public (at least the German-speaking public) of an essential characteristic of the goods, namely a particularly wide view of the contents of an aquarium or terrarium. Indeed, in contrast to Juwel Aquarium's claims, the field of vision offered by an aquarium or terrarium would not be determined, on its own, by the internal arrangement but also by a characteristic inherent to its shape. Further, the furniture, frames and lamps were specially adapted for the specific purpose of creating a panoramic view such that the public would perceive a link between the mark and their characteristics. Therefore, the CFI felt that OHIM was right to consider that the mark was descriptive of the goods.

In response to Juwel's argument that the term "Panorama" had already been registered by OHIM and the German Patent and Trademark Office for goods relating to sight, such as lenses, the CFI stated that there was well-established case law to show that the CTM system was autonomous from national systems and that OHIM decisions could only be interpreted on the basis of what was contained in the EU Regulation and not by reference to previous decisions. Second, the argument relating to the exclusive use of the mark in relation to aquariums, which had allowed it to acquire a distinctive character, received no support from the CFI. Third, in the absence of evidence of distinctive character, the fact that other businesses in the same field used the mark to describe different forms of aquarium would not rule out descriptiveness.

In light of the mark's descriptiveness under Article 7(1)(c), an absolute ground for refusal, the CFI did not consider any other ground. The appeal was rejected and the application for a declaration of invalidity was upheld.

In the past, the CFI has taken a lenient approach to marks that might be argued as descriptive (see, for example, the legendary BABY-DRY case). However, this case is part of a continued trend away from this approach. The consequences of this stricter approach will be harsh for brand owners who register trademarks and subsequently

build up a degree of goodwill in relation to the registered mark (as in the present case), but later discover that the registration should not have been allowed in the first place.

## **FURTHER INFORMATION**

For further information on any of the issues raised in this article, please contact:



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