

Review

Intellectual Property



Number is up for numeral trade marks at the CFI

In joined Cases T-425/07 and T-426/07, T-298/06, T-200/07 to 202/07 and T-64/07 to 66/07, *Agencja Wydawnicza Technopol sp. zo.o. v OHIM* (19 November 2009), the CFI has upheld OHIM's refusal of nine marks consisting of a combination of numerals.

In 2004, Agencja applied to OHIM for registration of two figurative marks which incorporated the numbers 100 and 300 respectively, printed in bubble typography and with a yellow strip above the relevant number and a red ribbon below. Each application covered goods and services in classes 16, 28 and 41.

The examiner refused to register either figurative mark for classes 16 and 28 on the basis that, for these classes, the marks were descriptive and the colours and graphics used would not affect this conclusion. On appeal, Agencja refused to disclaim an exclusive right to the non-distinctive elements 100 and 300 and its appeal was dismissed.

In 2005, Agencja also applied to OHIM for registration of the following word marks:

- 1000, initially for goods and services in classes 16, 28 and 41 but later limited to class 16;
- 150, 250 and 350 for goods in class 16; and
- 222, 333 and 555 for goods in class 16.

OHIM rejected each application and subsequently, the 2005 applications were also rejected by the Board of Appeal on the following grounds:

- I) the marks might be used to indicate the content of the goods, being brochures, magazines and periodicals;
- II) article 12 of the Trade Mark Regulation, relating to limitations on the scope of a CTM, could not be used by Agencja to relax the conditions for registration of a CTM;
- III) references made by Agencja to other registered trade marks were not relevant because these marks were not similar to its marks;

Nine marks consisting of a combination of numerals were not sufficiently distinctive to be registerable

- IV) the marks were not distinctive because (a) consumers would not be able to identify the trade origin of the goods covered in the application; (b) for the 350, 250, 150 and 1000 marks, the use of round numbers had the effect of promoting the publication's success; and (c) for the 1,000 mark only, OHIM held that the applicant had failed to prove that the mark had become distinctive through use.

Agencja filed appeals against all of the OHIM decisions.

In its consideration of each application, the CFI made the preliminary observation that numbers may be registered as trade marks where they are distinctive as regards the goods and services covered in the application and not merely descriptive of these.

THE TWO FIGURATIVE MARKS

In respect of the two figurative marks only, the CFI considered Article 38(2) of the Trade Mark Regulation, which was raised by OHIM in its request to Agencja to disclaim an exclusive right to the numbers contained within the applicant marks. This Article gives OHIM the right to make registration conditional if an applicant mark contains an element which is not distinctive, and where inclusion of that element could give rise to doubts as to the scope of protection afforded. The CFI reiterated that failure to agree to OHIM's conditions could result in a refusal of a CTM application.

Accordingly, the CFI took a two-part approach in considering whether OHIM was entitled to find a) that the elements 100 and 300 were not distinctive; and b) that their inclusion in the marks would give rise to doubts as to the scope of protection.

In terms of the presence of non-distinctive elements under (a), the CFI felt that 100 and 300 would designate the nature of the goods and services covered in each application and referred to its reasoning in its previous decision for the 1000 word mark (see below) in support of this conclusion.

In respect of the scope of protection under (b), the CFI felt that the figurative elements such as the colours, typography and ribbon were too ordinary to affect consumers and the numerals were more likely to be a dominant part, thereby attracting the consumer's attention. It concluded that if there were no conditions to the registration, the impression would be that exclusive rights extended to the numbers 100 and 300, preventing others from using these. Therefore, the CFI agreed with OHIM's dismissal of the appeal.

THE WORD MARKS

The CFI reiterated the wording of Article 7(1)(c) and supporting case law, noting that it was well-established that a sign would be considered descriptive if there was a sufficiently direct and specific link between the mark and the relevant goods and services, which would make the relevant public think that the mark was descriptive of the goods or their characteristics.

In respect of the 1000 mark, the goods were brochures and periodicals, including those containing crosswords and puzzles and newspapers. In respect of the 350 (etc) and 222 (etc) marks, the goods were periodicals, books and games periodicals.

Further, since the goods were intended for readers, whatever their age, sex or academic level and since the numbers were recognisable in every EU language, the CFI felt that the relevant public would be any average reasonably well-informed, reasonably observant and circumspect consumer in the whole of the EU.

In considering whether the relevant public would perceive a sufficiently direct link between the numbers and the goods and services, the CFI noted that the numbers

alluded to a quantity such as the number of pages or works, amount of data or number of puzzles in a collection or, in respect of the 1000 mark, the ranking of items referred to in them. Indeed, such numbers were often used on the cover of periodicals. The association would be immediate for the relevant public and taken into consideration by the average consumer when making a purchase. This conclusion was also supported by the CFI in relation to Agencja's figurative marks (see above).

For round numbers such as 1000, there was an additional risk that the number would be seen to be some sort of ranking of the publication/collection, which strengthened the descriptive nature of the mark. In this regard, the CFI repeated the example given by OHIM of the German "1000 Questions and Answers" publication.

In addition, the fact that different links existed between the marks and certain characteristics of goods was irrelevant as only one potentially descriptive meaning was required for an applicant mark to fall within an absolute ground for refusal.

As a result of the above reasoning, and the fact that there were no other elements to the applicant marks which would make them distinctive, the CFI held that all of the applicant marks were descriptive under Article 7(1)(c) of the Trade Mark Regulation. The applicant's other arguments were rejected on the same grounds as the OHIM appeal decision. As such, all of the appeals were dismissed.

Yet again, these related cases called for the CFI to clarify the subjective notion of descriptiveness in relation to a certain class of goods and services. The CFI's decisions follow the general approach taken by the court in relation to numerical marks. As illustrated by the present decisions, there is always a risk that an application will be refused if it comprises a number and the risk is even greater if that number is a round figure (such figures often being used for model or product numbers for goods as well as advertising their ranking).

FURTHER INFORMATION

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