

The General court has confirmed that CTM Registration no. 6110423 for



is invalid on the basis of Art 7(1)(i) CTMR.

The General Court confirmed that, for the registration of a mark to be contrary to Art 7(1)(i) CTMR, it must either be an identical copy, or an imitation of an emblem of particular public interest that is not covered by the Paris Convention, *and* must mislead the general public to believe that there is a connection between the goods and/or services offered under the mark, and the organisation to which the emblem relates.

The mark was originally registered in respect of goods and services in classes 9, 16, 35, 36, 39, 41, 42, 44 and 45, in the name of Heinrich Kreyenberg (HK) on 4 August 2008, despite observations being submitted by the EU Commission arguing that registration of the mark would infringe Art 7(1)(h) CTMR, on the basis of the following EU emblems, protected by the Paris Convention:



[Q0188]



[Q0189]

The EU Commission also referred to one of its communications dating from 23 July 1997, entitled "The use of the Euro symbol", which identifies the specific dimensions and colours in which the symbol should be used, alleging that registration of the mark would be contrary to Art 7(1)(i) CTMR.

Following registration of the mark, the EU Commission applied to invalidate HK's registration, under Art 7(1)(h) CTMR on the basis of earlier protected emblems Q0188 and Q0189, and under Art 7(1)(i) CTMR in respect of the € symbol. OHIM's cancellation division refused the application for invalidation, on the basis that the mark would not be interpreted as a heraldic imitation of the protected emblems, and that the use of the € symbol within the mark was not an identical reproduction of the Euro symbol, as envisaged by Art 7(1)(i) CTMR.

The European Commission appealed the decision of the cancellation division to OHIM's second Board of Appeal (BoA), on the basis that the mark should not have been registered under Art 7(1)(h) CTMR, due to the following protected emblem that was not referred to in the initial invalidity proceedings:



[Q0867]

Whilst the BoA rejected the inclusion of this additional earlier protected emblem in proceedings, on the basis that no new arguments or evidence could be admitted at the appeal stage, it did consider the invalidity of HK's registration on the grounds that the mark included the € sign, following the EU Commission's communication concerning use of the € sign. The BoA found that the mark in question would be considered by the public to be an identical reproduction of the € sign, and, in light of the goods and services covered by the application, would mislead the public into believing that there was a connection between the goods and services covered by the registered mark, and the EU institutions.

HK appealed this decision to the General Court (GC), on the following grounds:

## 1) The Representation of the € symbol is not excluded from trade mark registration under Art 7(1)(i) CTMR

The GC provided guidance on the interpretation of Art 7(1)(i) CTMR, finding that it prevented registration of identical and imitative reproductions of emblems of particular public interest, not protected by Art 6ter of the Paris Convention. In particular, it based this finding on the use of "including" within Art 7(1)(i) CTMR. So that the protection afforded by this provision was not broader than that provided in respect of emblems protected by the Paris Convention, the GC emphasised that, for the registration of a mark to be prevented under Art 7(1)(i), it must mislead the public that there is a connection between the mark and the organization to which the emblem relates.

HK based his argument that the representation of the € symbol was not an emblem under the definition of Art 7(1)(i) CTMR on the following grounds:

- a) HK argued that the European monetary union was not relevant to Art 7(1)(i) because it did not cover all of the member states of the EU. HK attempted to argue that the OHIM manual of trade marks practice did not indicate that the € sign was a protected emblem, that there were no decisions that indicated that the Euro sign was a protected emblem, *and* that it should be considered as an important everyday symbol, such as the recycling mark, and therefore should not be afforded protection under Art 7(1)(i). The GC dismissed these arguments as they did not provide sufficient evidence that the € sign should not be protected by this provision.
- b) HK also attempted to argue that the € sign was an everyday symbol that indicated currency. The GC disagreed, stating that the EU commission communication of 23 July 1997, made it clear that the € symbol should be used in a certain way, that its reproduction or imitation is not authorised, and therefore that it is an emblem of particular public interest.
- c) HK argued that Art 7(1)(i) CTMR only applied where emblems of particular public interest were identically reproduced. If the provision also applied to imitations of such emblems, this would afford broader protection than Art 7(1)(h) CTMR. HK also argued that the term “including” within the provision meant that only identical reproductions of emblems would be refused registration. The GC dismissed both arguments, stating that even allowing protection for imitative reproductions of emblems would not necessarily afford a greater scope of protection to emblems not protected by virtue of Art 6ter of the Paris Convention. The GC stated that HK had misunderstood the significance of the word “including” within the provision, which clearly suggested that an imitative reproduction of an emblem of public interest was also precluded from registration as a trade mark.
- d) HK also alleged that the reproduction of the € symbol within the contested registration was an altered reproduction of the € symbol that the public would not confuse with an identical reproduction. HK argued that the € symbol within the contested mark differed in colour from the € symbol, and was linked to the letter “e”, and therefore was sufficiently distinct from the € sign not to be precluded from registration. The GC dismissed this argument, and found that the contested mark was an imitation of the € sign. Given that the GC had indicated that Art 7(1)(i) also referred to imitative reproductions of emblems that were in the public interest, and that the differences between the contested mark and the emblem in question were not particularly significant, the mark was considered an imitation of the € emblem within the meaning of Art 7(1)(i).

The GC dismissed this ground of appeal.

## **2) Even where the representation of the € symbol is precluded from registration under Art 7(1)(i) CTMR, the mark in question is not of such a nature to suggest a connection between the applicant and the institutions of the EU**

HK argued that the public would not believe that there was a connection between the contested mark and the European Institutions, to which the € symbol refers.

- i) HK argued that the € symbol did not refer to any particular authority or organisation and was merely an indication of currency, or even where it did refer to an authority, this was merely the European monetary union, which was not considered to be a relevant authority under Art 7(1)(i). The GC disagreed, on the basis that the monetary union was not distinct from the EU, as it was established by the relevant EU treaties.
- ii) HK added that the goods and services designated by the contested registration would not be provided by the European Institutions. The GC dismissed this argument, stating that Art 7(1)(i) CTMR applies where the application of an identical or imitative reproduction of an emblem to the goods and/or services covered by a mark would mislead the public that there was a connection between the goods and/or services and the organisation represented by the emblem. This included where the public believed that the goods and/or services originated from, were guaranteed, or endorsed by the organisation in question. On the basis that the Treaty on the Functioning of the EU refers to the industries and sectors specified by the contested registration, the public would believe that there was a connection between products or services bearing the mark and the European Institutions.
- iii) HK also argued that the € element of its mark was not sufficiently dominant to mislead the public. However, the GC dismissed this argument, considering that the additional elements of the crown semi-circle, the additional “e” and the use of the terms “EURO EXPERTS” did nothing to neutralise the impression created by the € element of the contested mark, and its link to the European Institutions.

On this basis, the GC dismissed HK’s appeal, and found the registration to be invalid.

Whilst this ruling highlights the differences between provisions Art 7(1)(h) and (i) CTMR, it is interesting that the GC has chosen to interpret Art 7(1)(i) within the spirit of the Paris Convention, despite this provision not being expressly referring to the treaty. Whilst some symbols of particular public interest may not be specifically protected by the Paris Convention, it is clear that they should not automatically be eligible for trade mark registration. In this case, the € symbol has clear relevance to the single European market, and the European Institutions. However, it is noteworthy that the GC has interpreted the Art 7(1)(i) in the spirit of the Paris Convention, requiring an identical copy or imitation of an emblem of particular public interest to mislead the public that there is a connection between the relevant authority to which the emblem refers, and the goods and or services to which the mark is applied. This is not explicitly stated in the CTMR, and it remains unclear whether this interpretation was intended by the legislators. Whilst interpreting the CTMR at face value would not assist the trade mark proprietor in this case, whether this approach will be followed remains to be seen.

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