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Card manufacturer dealt a blow by cancellation decision

In *Naipes Heraclio Fournier SA v Office for Harmonization in the Internal Market (OHIM)*, the European Court of First Instance (CFI) has upheld a decision to cancel the registration of three figurative Community trademarks covering "playing cards" in Class 16 of the Nice Classification.

In total, Naipes Heraclio Fournier SA registered 23 figurative signs as Community trademarks representing Spanish playing cards or symbols appearing on those cards. The three signs at issue in this case were representations of a sword, the knight of clubs and the king of swords. On April 7 1999 France Cartes SAS applied for these three registrations to be declared invalid pursuant to Article 7(1)(b) to (e)(iii) of the Community Trademark Regulation. It further argued that Naipes had acted in bad faith when filing the applications.

The OHIM's Cancellation Division rejected the application for cancellation and the case came before the Second Board of Appeal. The board allowed the appeal, reasoning that the signs at issue were both devoid of distinctive character and descriptive, in that they would be seen by the average user of such playing cards as representing characteristics of Spanish playing cards. Naipes appealed to the CFI.

Naipes argued that the Board of Appeal erred in holding that the marks in question were composed exclusively of signs descriptive of characteristics of the goods at issue. In its view, the board failed to consider the fact that the devices making up the marks in question were unusual and particular signs. It pointed out that there are hundreds of different representations to identify the cards that form part of a Spanish pack of cards. Accordingly, a potential user of the playing cards at issue will perceive them as being signs associated with a given manufacturer of the cards.

In response, the OHIM pointed out that the Board of Appeal made a correct decision in that the representations making up the marks referred immediately and directly to the goods claimed, namely playing cards. Thus, the signs were descriptive of playing cards.

The CFI first noted that the goods designated by the marks at issue were Spanish playing cards, which are in common usage in Spain. Even if part of the target public was not acquainted with Spanish playing cards, the designs would directly conjure up playing cards for that public. Although there are numerous different representations to enable cards of a certain suit to be identified, every manufacturer of Spanish playing cards necessarily uses the symbols at issue to identify the respective cards.

Accordingly, in particular for the Spanish public, there was a direct and specific association between the marks in question and playing cards, meaning that the marks in question were descriptive.

Accordingly, the CFI dismissed the application and upheld the decision of the Second Board of Appeal to cancel the registrations.