

Stephan N. Schneller of Maiwald Patentanwalts GmbH in Munich

Judgement of the Court of First Instance

Case T-115/02

On June 5, 1998, the applicant filed an application for a Community trademark at the Office for Harmonisation in the Internal Market (OHIM) for a figurative sign consisting of the letter a, as reproduced below:



The application covered goods and services in international Class 9, 16, 25, 35 and 41 with the following description for Class 25: "Clothing, footwear, headgear; non-Japanese style outerwear, coats, sweaters and the like, nightwear, underwear, swimming suits, shirts and the like, socks and stockings, gloves, ties, bandanas, mufflers, hats and caps, shoes and boots, belts, jackets, T-shirts".

Upon publication of the application, an opposition was filed on 22 December 1999, based on, in particular, Community figurative mark No. 270 264, registered on 28 February 2000 and relating, in particular, to "suits, vests, jackets, anoraks, trousers, coats, jeans, jeanswear, shirts, sweatshirts, T-shirts, sportswear, caps, working clothes, leisurewear" falling within Class 25, reproduced below:



By decision of 2 May 2001, the Opposition Division of OHIM rejected the application for registration of the mark applied in its entirety, following which the applicant filed an appeal at OHIM against the decision of the Opposition Division.

By decision of 11 February 2002 (Case R 634/2001-1) the First Board of Appeal partially annulled the contested decision of the Opposition Division to the extent to which it rejected the trade mark application in respect of the goods and services falling within Classes 9, 16, 35 and 41. However, it dismissed the appeal as regards the goods falling within Class 25. Against this decision, the applicant filed action according to Article 63 of Regulation No. 40/94 with the Court of First Instance.

The Court of First Instance (Second Chamber) found that, even though a single letter is potentially devoid of distinctive character, both the marks in question include as a dominant element the lower-case white letter 'a', of a commonplace typeface, on a black background and the conflicting signs are thus very similar from the visual point of view. Moreover, the Court came to the conclusion that, all in all, the goods at issue must be regarded as similar, even if they are so in only a limited way. Consequently, the Court of First Instance dismissed the applicant's petition, following which the Community trademark was rejected for Class 25.

This decision is of particular interest inasmuch as the opposition mark itself was subject to initial rejection based on absolute grounds (Second Board of Appeal, May 28, 1999, case R-91/1998-2). In allowing the registration of the opposition mark it was held that it was particularly the graphic

presentation of the letter "a", namely its precise position at the lower bottom of the square, which also leads to an overlapping of the colour white of the letter "a" and the white-colour surrounding. Contrary hereto, in the opposition matter the Court of First Instance noted that here only the "graphic presentation of the trademark applied for (being) very close to that adopted of the earlier trademark" (see ref. 21) was of relevance. Thus, there appears to exist a considerable conflict between the scope of protection defined by the Second Board and as viewed by the Court of First Instance. Additionally, these decisions also cast an ambiguous light upon the applicant's mark which - when considering the Second Board's decision on the registrability of the opposition mark - may not have been allowed for registration.