

General Court considers scope of examination by Board of Appeal under Article 64(1) Examination/opposition International procedures
European Union - Maiwald Patentanwalts GmbH

October 10 2014

In *Koscher + Würtz GmbH v Office for Harmonisation in the Internal Market* (OHIM) (Case T-445/12, September 26 2014), the General Court has agreed with the Board of Appeal of OHIM that the figurative mark KW SURGICAL INSTRUMENTS was similar to the earlier German word mark KA WE, but has ordered the board to first assess whether the earlier mark had been put to genuine use under Article 42 of the [Community Trademark Regulation](#) (207/2009).

Koscher + Würtz GmbH filed an application for the following figurative Community trademark for goods in Class 10 of the [Nice Classification](#), namely “surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials”:



Kirchner & Wilhelm GmbH + Co filed an opposition based on its earlier German registration for the word mark KA WE, which also covers surgical instruments and devices in Class 10. The opposition was based on Article 8(1)(b) of the regulation (alleged likelihood of confusion between the respective marks). The applicant challenged the genuine use of the earlier mark under Article 42(1).

The Opposition Division of OHIM found that there was no likelihood of confusion and, therefore, did not examine the issue of the genuine use of the earlier mark. Following an appeal filed by *Kirchner*, the Board of Appeal of OHIM annulled the Opposition Division's decision and refused to register the mark applied for due to a likelihood of confusion under Article 8(1)(b); in doing so, however, the Board of Appeal did not examine the question of the genuine use of the earlier mark.

Koscher then filed an action before the General Court under Article 65 of the regulation, alleging that the Board of Appeal had infringed Articles 42(2) and 8(1)(b), since it had not examined the genuine use of the earlier mark and had wrongly held that there was a likelihood of confusion between the marks.

Referring to Article 64(1) of the regulation, the General Court held that the Board of Appeal has the obligation to examine the case in its entirety, with regard to both the facts and the legal issues, based on the functional continuity between the Opposition Division and the Board of Appeal. The court stated that the Board of Appeal must examine all the arguments put forward by a party before the Opposition Division, without the need for the appealing party to base its appeal explicitly on all the arguments set forth earlier in the proceedings. For this reason, the General Court remitted the case to the Board of Appeal to examine the genuine use of the earlier mark under Article 42(1). The court also noted that it cannot undertake such examination itself, but can only review attacked decisions.

On the question of the likelihood of confusion, the General Court agreed with the board's decision, noting that the German-speaking public would pronounce the letters 'K' and 'W' as 'Ka' and 'We' and, therefore, the signs were highly similar phonetically. As the respective goods were identical and similar, a likelihood of confusion could not be ruled out.

The decision is not yet final.

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