



**QORTI TA'L-APPELL
(SEDE INFERJURI)**

ONOR.IMHALLEF

EDWINA GRIMA LL.D.

Seduta tat-30 ta' Settembru 2015

Appell numru: 01/2012

**Avukat Dr. Luigi A. Sansone bhala mandatarju
specjali tas-socjeta estera Retail Royalty
Company , korp guridiku organizzat that il-
ligijiet tal-Istat ta' New York fl-Istati Unitital-
Amerka.**

Vs

Kontrollur tal-Proprijeta Industrijali

Il-Qorti,

Rat id-decizjoni moghtija mill-Kontrollur tal-Proprijeta Industrijali tat-12 ta' Jannar 2012 fejn gie deciz:-

.... That on the evidence submitted i.e.:

“(1) that the letters AE are always being used in combination with other words or devices; and

(2) that from the evidence submitted these do not show distinctiveness of use in Malta

Your applications cannot proceed for registration unless these are amended with a distinctive label, in which case, these will be registered only in the distinctive manner as shown.

If within ninety (90) working days from the date of this e-mail (i.e. by 27th May 2012) we do not receive the required amendment your applications will be refused in terms of Article 35(3) of the Trademarks Act 2000.

Illi l-appellanti nomine Dr. Luigi Sansone aggravat b'din id-decizjoni ressaq dan l-appell abbazi tas-segwentu aggravvji:

1. ma hemm xejn fil-ligi li timpedixxi r-registrazzjoni ta' "AE" u fi kwalunkwe kaz l-artikolu 4(1)(b) tal-Kapitolu 416 ma japplikax ghal kaz in dizamina, kuntrarjament ghal dak allegat mill-Kontrollur tal-Proprieta Industrijali fil-komunikazzjoni tieghu tat-2 ta' Novembru 2010.
2. Illi is-sinjal "AE" ghandu l-karatteristici indikati fl-artikolu 2 tal-Kapitolu 416 u allura id-decizjoni tal-Kontrollur illi is-sinjal huwa nieqes minn kull karattru distintiv hija erroneja. Illi huwa biss l-appellant nomine li huwa assocjat mal-marka "AE" u allura ma hemmx il-periklu ta' konfliggenza ma' tardemark anterjuri. L-espressjoni "AE" hija wahda fittizja u mhux uzata komunement dwar prodotti u servizzi ohra. Kwindi it-tlett elementi li ghandhom jezistu sabiex sinjal ikun jista' jikkwalifika oggettivament bhala *trademark* huma prezenti.
3. Illi ma hemm ebda dubbju illi "AE" taqa' fid-definizzjoni ta' "kelma" ("word") fis-sens ta' "*a sound or a combination of sounds, or its representation in writing or printing, that symbolizes and communicates a meaning and may consist of a single morpheme or of a combination of morphemes*", li kapaci tidentifika l-prodott minn prodotti ohra, liema rekwizit jinsab pjenament sodisfatt.

4. Illi huwa ezercizzju inutli dak li l-Kontrollur tal-Proprieta Industrijali kien qed jirrikjedi u cioe' li tingieb lilu prova ta' uzu tat-trademarks "AE" *de quo* sabiex minn tali uzu ikun jista' jkun sodisfatt li dawn jintuzaw f'ittri kapitali kbar. Dan ukoll ghaliex skont l-artikolu 42(1)(a) u/jew (b) tal-Kapitolu 416 l-uzu fid-data ta'l-applikazzjoni ma huwiex rikjest mill-ligi.

Illi l-appellanti nomine ipprezenta tlett applikazzjonijiet mal-Kontrollur appellat ghar-registrazzjoni ta' tlett *trademarks* li jikkonsisti fl-ittri "AE" ghall-klassifikazzjoni ta' hwejjeg, basktijiet tal-gilda u servizzi ta' *retail*. Illi l-appellanti huwa mandatarju tas-socjeta estera amerikana "Retail Royalty Company" li tinneozja taht l-isem "American Eagle Outfitters". L-Kontrollur appellat irrifjuta li jirregistra dawn it-trademarks kif proposti billi kien tal-fehma illi l-ittri wahedhom "AE" ma kellhomx karattru distintiv u ghalhekk ma kenux jissodisfaw il-provvedimenti tal-Kapitolu 416 tal-Ligijiet ta' Malta. Illi l-ligi taghna hija riproduzzjoni fidila tad-Direttiva Ewropeja u regolamenti in materja. Illi l-artikolu 2 ta'l-Att jiddisponi illi:

"trademark" tfisser kull sinjal li jista' jigi rapprezentat b'mod grafiku u li bih jistghu jintgharfu l-oggetti u s-servizz ta' xi impriza minn daww ta' imprizi ohra. Trademark tista', b'mod partikolari, tkun tikkonsisti fi kliem (inkluzi ismijiet personali), elementi figurattivi, ittri, numri jew il-forma ta' oggetti jew l-ippakkettjar taghhom:

Bl-artikolu 4 imbaghad jelenka liema minn dawn il-marki huma oggetti ghal rijfut b'mod assolut mill-Kontrollur:

Dawn li ghejjin ma ghandhomx jigu registrati bhala trademarks –

- (a) sinjali li ma jinkwadrawx fit-tifsira ta' trademarks fl-artikolu 2;**
- (b) trademarks li huma neqsin minn kull karattru distintiv;**

(c) trademarks li jikkonsistu esklużivament f'sinjali jew indikazzjonijiet li jistghu jservu, fil-kummerç, biex ifissru ix-xorta, kwalità, skop intiż, valur, oriġni ġeografika, żmien ta' produzzjoni ta' oġġetti jew ta' għoti ta' servizzi, jew karatteristiċi oħrajn ta' oġġetti jew servizzi;

(d) trademarks li jikkonsistu esklużivament f'sinjali jew indikazzjonijiet li saru konswetudinarji fl-ilsien mitkellem jew fl-użanzi bonafidi u stabbiliti ta' dak ilkummerç: Izda trademark ma għandhiex tiġi rifjutata milli tiġi registrata minhabba fil-paragrafu (b), (c) jew (d) hawn aktar qabel jekk, qabel id-data tal-applikazzjoni għar-registrazzjoni, tkun filfatt kisbet karattru distintiv b'rizultat tal-użu li jsir minnha f'Malta.

Illi in succinct l-oggezzjoni ewlenija imressqa mill-Kontrollur appellat għar-registrazzjoni tal-marka "AE" kif miltub mill-appellanti nomine hija għaliex tali marka m'għandhiex karatteristiċi distintivi u dan kif mehtieg fl-artikolu 4(1)(b) tal-Kapitolu 416 għalkemm fid-definizzjoni li tagħti il-ligi tal-kelma "*trademark*" hemm inkluz ukoll l-użu ta' ittri wahedhom. Illi l-ghan wara dan l-element mehtieg għar-registrazzjoni ta' *trademark* essenżjalment għandu fil-mira tieghu l-protezzjoni tal-konsumatur li ma jigix imfixkel meta huwa ikun qed jagħzel il-prodott mixtieq u dan ma prodotti oħra simili fis-suq. Allura l-ghan tat-*trademark* huwa li ma johloqx konfuzjoni fis-suq bejn prodott u iehor. Għalhekk huwa essenżjali illi il-marka tkun kapaci tiddistingwi prodott minn iehor. Jinghad illi marka issir wahda distintiva "*by nature or nature*", u cioe' jew billi min-natura tagħha l-konsumatur mal-ewwel jassocjaha mal-prodott partikolari jew inkella issir tali bl-użu u dan kif anke previst fl-artikolu 4 innifsu meta jinghad:

"Izda trademark ma għandhiex tiġi rifjutata milli tiġi registrata minhabba fil-paragrafu (b), (c) jew (d) hawn aktar qabel jekk, qabel id-data tal-applikazzjoni għar-registrazzjoni, tkun fil-fatt kisbet karattru distintiv b'rizultat tal-użu li jsir minnha f'Malta."

Illi fil-kawza **BORCO-Marken-Import Matthiesen GmbH & Co. KG**, istitwita mill-OHIM – (Case C-265/09 P) fejn kien qed jigi imfittex li tigi irregistrata bhala **trademark** l-ittra wahedha “a” inghad hekk mill-Qorti tal-Gustizzja Ewropeja (First Chamber)

“As a preliminary point, it should be recalled that, according to Article 4 of Regulation No 40/94, letters are among the categories of signs of which a Community trade mark may consist, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

However, the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

Under that provision, marks which are devoid of any distinctive character are not to be registered.

According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public’s perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case

C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).

In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v Erpo Möbelwerk*, paragraph 36, and *Audi v OHIM*, paragraph 38).

It is apparent from the case-law of the Court on Article 3 of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), the wording of which is identical to that in Article 7 of Regulation No 40/94, that the distinctive character of a mark must always be assessed specifically by reference to the goods or services designated (see, to that effect, *Libertel*, paragraph 76, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraphs 31 and 33).

..... In that regard, it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely *prima facie* to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

In relation, more particularly, to the fact that the sign at issue consists of a single letter with no graphic modifications, it should be borne in mind that registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark (Case C-329/02 P *SAT.1 v OHIM* [2004] ECR I-8317, paragraph 41).

It follows that, particularly as it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks, OHIM is required to assess whether the sign at issue is capable of distinguishing the different goods and services in the context of an examination, based on the facts, focusing on those goods or services.” (sottolinjar tal-Qorti)

Dan ifisser allura illi wiehed ma iridx jieqaf biss lejn dak li jidher mad-daqqa t’ghajn ghaliex bhal fil-kaz tat-*trademark* in dizamina l-ittri kbar wahedhom “AE” ma jaghtu l-ebda karatteristika distintiva, izda huma zewg ittri vokali kapitali li essenzjalment ma ifissru xejn. Illi gustament ukoll kif deciz mill-Kontrollur billi l-prodotti ta’ din il-marka ghadhom ma dahhlux fis-suq lokali allura dak l-element ta’ distintivita ma jistax jinkiseb permezz tal-uzu. B’dan madanakollu ma ifissirx illi l-marka ma ghandhiex dak l-element distintiv

mehtieg biex jigi irregistrat. Illi allura dak li kellu jagħmel l-Kontrollur huwa li jzammina dik il-marka meta imqabbla mal-prodotti li magħhom hija marbuta, sabiex jara jekk hija għandhiex dak l-element li jiddistingwieha minn prodotti oħra u allura jekk tistax dik il-marka toħloq konfuzjoni fis-suq ma' prodotti oħra simili.

Fil-“GUIDELINES FOR EXAMINATION IN THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS) ON COMMUNITY TRADE MARKS (PART B EXAMINATION SECTION 4 ABSOLUTE GROUNDS FOR REFUSAL)” inghad:

“It is therefore necessary to carry out a thorough examination based on the specific factual circumstances of the case in order to assess if a given single letter represented in standard characters can function as a trade mark in respect of the goods/services concerned. This need of a factual assessment implies that it is not possible to rely on assumptions (such as that consumers are generally not accustomed to seeing single letters as trademarks). Consequently when examining single letter trade marks, generic, unsubstantiated arguments such as those relating to the availability of signs should be avoided, given the limited number of letters. The Office is obliged to establish, on the basis of a factual assessment, why the applied for trade mark would be objectionable. It is therefore clear that the examination of single letter trade marks should be thorough and stringent, and that each case calls for a careful examination of whether a given letter can be considered inherently distinctive having regard to the goods and/or services concerned.”

Dan il-hsieb huwa rifless anke fil-gurisprudenza lokali fejn inghad:

“Ma jistax ikun qatt dubitat illi, fl-istat attwali tal-ligi introdotta bil-Kapitolu 416, l-uzu ta' “ittri” alfabetici fit-trademark jirrientraw fid-definizzjoni li l-Att jagħti lill-kelma ‘trademark’ fl-Artikolu 2 tieghu u għalhekk, rebus sic stantibus u salv konsiderazzjonijiet oħra, trademark konsistenti minn semplici ittri hi brevettabbli jekk dawn ma jkollhomx funzjoni intrinsikament deskrittiva tal-karattru u tal-kwalita` tal-

prodott; Dan affermat, il-punt hawn involut jibqa' dak tal-karattru distintiv tat-trademark. Jinghad fil-Kerly's "Law of Trade Marks and Trade Names" (10 th Edition, 1972 pagna 145) illi "A tribunal considering the question of distinctiveness must consider all the circumstances, in particular the area and period of use". Oltre dan, dejjem fl-accertament ta' l-istess karattru distintiv jokkorri li jinzammu in mira l-karatteristici inerenti ghal trademark u, fuq kollox, illi l-konsumaturi tal-kategorija tal-prodott koncernat - vetturi ta' certu lussu u kostuzi - hu ragonevolment diga ben informat u, x' aktarx ukoll, aktar akkurat fl-ghazliet tieghu.¹

Applikati dawn il-kuncetti ghal kaz in ezami hi l-fehma konsiderata ta' din il-Qorti illi fis-suq Malti, u dan hu wara kollox dak li jikkoncernana hawn, it-trademark intiza li tigi registrata hi bizzejjed distinta kemm fiha nnifisha, kemm ghall-uzu taghha f' pajjizna. Dan ghaliex fl-ewwel lok ma jirrizultax illi hemm trademark ohra simili in uzu la ghal prodott simili u lanqas ghal xi wiehed differenti minn dak in dizamina. Illi l-marka *di piu'* hija assocjata mad-ditta "American Eagle" li tinnegozja fil-qasam tal-hwejjeg u abbiljament iehor inkluz basktijiet u zraben. Illi l-ittri allura abbinati flimkien u miktuba fil-verzjoni kapitali taghhom jirreferu bhala inizjali ghal marka amerikana shiha. Il-Qorti ghalhekk hija tal-fehma illi ma ghandux jinholoq ebda konfuzjoni fis-suq ma' prodotti ohra simili jew xi marka ohra billi din hija unika ghal prodott abbinat maghha biex b'hekk allura ghandha dak il-karattru distintiv rikjest fil-ligi. Illi l-fatt wahdu illi l-marka hija wahda semplici ta' zewg ittri ta' l-alfabet ma ghandux ifisser illi din mhijiex distintiva, l-iktar illum il-gurnata fejn permezz ta' mezzi ta' komunikazzjoni avvanzati l-fatt illi l-prodott ghadu mhux ikkommercializzat fis-suq lokali ma ifissirx illi l-konsumatur ghadu ma akkwistax prodotti ta' dik il-marka jew inkella illi huwa injar ta' l-ezistenza ta' tali marka.

¹ Avukat Dottor Luigi A. Sansone bhala mandatarju specjali tas-socjeta` estera DaimlerChrysler AG vs Kontrollur tal-Propjeta` Industrijali – App.Inf. 19/10/2005

Illi kif gie rimarkat fiis-sentenza “Magro Brothers (Marketing) Limited Vs Azzopardi Anthony Pro Et” (App.Sup – 28/01/2005), dan huwa kaz li jitratta kwistjonijiet li jirrigwardaw il-protezzjoni tal-proprjeta` industrijali li ma ghandux jigi imfixkel ma’ kwistjonijiet dwar konkorrENZA sleali li mhux il-kaz ghall-marka in dizamina.

Ghal dawn il-motivi l-appell qed jigi milqugh u id-decizjoni tal-Kontrollur tal-Proprjeta Industrijali tat-12 ta’ Jannar 2012 revokata. Tordna lil-Kontrollur tal-Proprjeta Industrijali jirregistra t-trademarks numri “49400” CV – “AE”, “49401”CV – “AE” u “49402”CV – “AE” fir-Registru tat-*Trademarks* ta’ Malta fl-istess forma li ghalih saru l-applikazzjonijiet relattivi.

L-ispejjez ikunu ghak-karigu tal-Kontrollur appellat.

(ft) Edwina Grima

Imhalled.

VERA KOPJA

Franklin Calleja

Deputat Registratur