



Office for Harmonization in the Internal Market

(Trade Marks and Designs)

Electronic disclosures as source of:
prior art and infringement

OHIM practices

FICPI 13th Open forum – Rome – 10 November 2011

Ohim, Wouter Verburg

WWW.OAMI.EUROPA.EU



Overview

- Standard of proof
- Designs – Prior Art
- Trade Marks – Prior Use
- How valid are electronic disclosures to prove prior art or prior use?



More than likely or more likely than not?

Manual on proof of use:

Therefore the evidence submitted by the opponent must consist of proof, i.e. substantial evidence that the mark has been put to genuine use. Making merely a *prima facie* case is not sufficient.

The Office does not require an excessively high threshold of proof of genuine use.



More than likely or more likely than not?

Manual on proof of use:

The assessment as to the relevance, pertinence, conclusiveness and efficacy of evidence stays within the discretion and power of judgment of the Office, and not with the parties, and falls outside the adversarial principle which governs *inter partes* proceedings.



More than likely or more likely than not?

Manual on proof of use:

The Office has to evaluate the evidence submitted in an *overall assessment*. All the circumstances of the specific case have to be taken into account. Furthermore, all the materials submitted must be assessed *in conjunction with each other*.



More than likely or more likely than not?

Manual on proof of use:

The Court of First Instance has held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: *Hiwatt*, CFI T-39/01, nr. 47; *Vitakraft*, CFI T-356/02, nr. 28.¹⁰



More than likely or more likely than not?

GC T- 427/09 of 15/09/2011:

Genuine use of a trade mark cannot be proven by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (see *LA MER*, paragraph 59, and case-law cited).

The Court's finding that genuine use has not been proven in the present case is not attributable to an excessively high standard of proof, but because the intervener chose to restrict the evidence adduced.



Case law General Court

- Case T-9/07 Tazos/Rappers on the basis of an earlier Spanish design;
- Case T-148/08 Marker on the basis of an earlier German TM registration;
- Case T-153/08 Communications equipment on the basis of an international design, brochure, press cuttings and advertisements;
- T-513/09, sitting figure on the basis of CTM;
- T-68/10 watch attached to a lanyard.... On the basis of various earlier designs – shipping invoice;
- T-10,11/08, Internal combustion engine on the basis of an earlier US design
- T-246/10, Mechanical speed reducer on the basis of an earlier Community design;
- T-53/10, Hampers, crates and baskets on the appeal period;
- C-281/10P, appeal to the Court of Justice of T-09/07.



OHIM Practice

Designs Invalidity Manual, p. 8:

“Where the applicant claims that the contested Community design lacks novelty or individual character (Art. 25(1)(b) CDR), the application must contain an indication and a reproduction of the prior design(s) that could form an obstacle to the novelty or individual character of the contested Community design, as well as documents proving the earlier disclosure of those prior designs.”



Case law OHIM

- ICD 3150 of 03/04/07:

Several copies of excerpts of the Holder's website are not evidence for the disclosure of a prior design because none of them bears any indication of a date.

- ICD 2707 of 23/04/07:

A printout of the website <http://web.archive.org> regarding the website www.belladecor.pl and a printout of the website www.belladecor.pl containing the remark "2003-2005 © Bella Decor" are not evidence for such a disclosure because none of them bears any indication of a date.



Case law OHIM

- ICD 3184 of 11/12/07:

The “excerpt” of the Applicant’s website is not accompanied by evidence certifying the correctness of the contents and the date of the excerpt.

Such means could have been for instance provided where the “excerpt” had been produced by the Wayback Machine which is run by the Internet Archive (www.Archive.org) as an independent institution giving certain credibility to the search results.



Case law OHIM

R 316/2008 of 14/10/2009:

During the appeal proceedings, the invalidity applicant submitted some new evidence...

The evidence consists of a written affidavit by a consultant to the invalidity applicant, responsible for the updating of the website during the relevant period, confirming that the copy of the printout of the website from 22 September 2005 is correct and genuine.



Case law OHIM

R 9/2008 of 26/03/2010:

There is nothing to suggest that the website was not active: no such usual sentences like 'website under construction' or 'visit us soon' can be seen.



Case law OHIM

ICD 3812 of 21/12/2007 (DE)



As is explained under the “Frequently Asked Questions” of this web archive, the date code embedded in the archived url. is the real date on which the website page was available. This code proves that the website was available on 10 August 2003.



Case law OHIM

ICD 4570 of 31/03/2008

Taking into account the way the contents of the web pages are made available on the internet and the way the printouts of the web pages are dated when being printed on computer printers, it is considered that the contents of the printouts have been publicly disclosed at least on the date of the printout.



Case law OHIM

ICD 7176 - 7178 of 10/03/2011:

As a matter of principle, disclosures on the internet form part of the prior art. Information disclosed on the internet or in online databases is considered to be publicly available as of the date the information was publicly posted.

Internet websites often contain highly relevant information. Certain information may even be available only on the internet from such websites. This includes, for example, online publications of design registrations by IP Offices.



Case law OHIM

ICD 7176 - 7178 of 10/03/2011:

The nature of the internet can make it difficult to establish the actual date on which information was made available to the public: for instance, not all web pages mention when they were published. Also, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records which enable members of the public – including examiners - to establish precisely what was published and when.



Case law OHIM

ICD 7176 - 7178 of 10/03/2011:

It is theoretically possible to manipulate the date and content of an internet disclosure (as it is with traditional documents). However, in view of the sheer size and redundancy of the content available on the internet, it is considered very unlikely that an internet disclosure has been manipulated. Consequently, unless there are specific indications to the contrary, the date can be accepted as being correct.



Case law OHIM

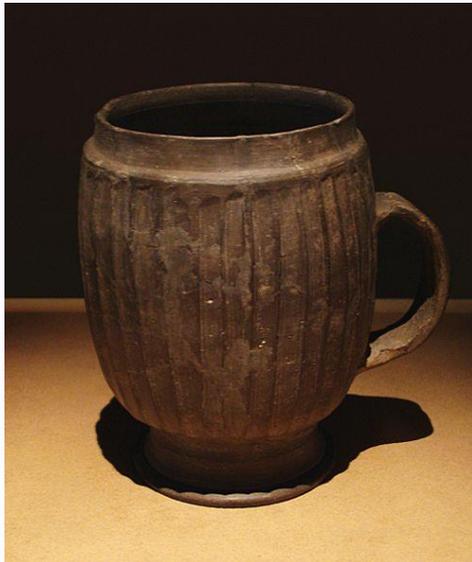
ICD 7176 - 7178 of 10/03/2011:

In the present case, the publication appeared on a blog with an exact indication of the date, even the time when it was put on the blog. It lies in the nature of a blog that it is addressed to the public and that the contributions published on a blog are dated exactly. Consequently, there is no doubt that the prior designs shown were made available to the public prior at the date indicated in the blog which is a date more than 12 months prior to the date of filing of the RCD.



OHIM Practice

A well documented date is necessary. 'Wayback machine evidence' *seems to be* convincing evidence. Submitting other, additional evidence is at least advisable.





OHIM Practice

Trade Marks Examination Manual, p. 35

“An Internet search is also a valid means of evidence for the descriptive meaning, in particular for new terms or slang words, but the evidence should be carefully assessed whether the word is actually used in a descriptive manner, as often the difference between descriptive and trade mark use on the Internet is vague and the Internet contains a vast amount of unstructured, unverified information or statements.”



Board of Appeal decisions

R 1743/2007-1 of 03/12/2009 on 7(1)(d) CTMR:

Internet extracts filed in the form of paper printouts with valid dates which could all be traced back as they were either still on the Internet, or could be confirmed by using the 'wayback' search engines for the dates indicated.



OHIM Practice

Manual on Proof of Use, p.13

The mere presence of the mark on a website shows nothing more than that the website is accessible. This is in itself not sufficient to prove genuine use.

This may be different in cases where concrete evidence is submitted that the specific web-site has been visited and, in particular, orders for the relevant goods and services have been affected by a certain number of customers in the relevant period.



Opposition decisions

B 1514911 on reputation:

The print-outs of archived version of web-pages provided by Wayback Machine^[1] is to be evaluated together with the other evidence.

[1] http://en.wikipedia.org/wiki/Wayback_Machine



Opposition decisions

B 1699647 on POU:

Exhibit 4: 12 pages of Internet extracts in English from the website www.waybackmachine.org showing saved pages from the website www.gnu.com from various dates in 2007. The extracts show various shirts and hats for sale bearing the mark.

Deemed acceptable and valid together with other evidence.



Designs & Trade Marks:

Internet disclosures form part of the prior art, but careful with the dates.

Evidence from the web archive is valid evidence, at least together with other evidence.



Designs: More likely than not?

Trade Marks: More than likely?



OHIM Contact Information:



(+ 34) 965 139 100

fax

(+ 34) 965 131 344



information@oami.europa.eu



Office for Harmonization in the Internal
Market (Trade Marks and Designs)



Avenida de Europa, 4

E-03008 Alicante

SPAIN

