

RESUMÉ

Afslag på designering af MP1486463 TomoStage <w> - AN 2020 00016

Patent- og Varemærkestyrelsen meddelte afslag på designering af MP1486463 TomoStage <w> i Danmark som følge af utilstrækkelig beskrivelse i den ansøgte varefortegnelse. Denne afgørelse blev indbragt for Ankenævnet for Patenter og Varemærker, som hjemviste sagen til fornyet behandling i styrelsen.

Ankenævnet for Patenter og Varemærker

KENDELSE

afsagt den 4. januar 2021

Sag AN 2020 00016

Klage over

Patent- og Varemærkestyrelsens afgørelse af 18. juni 2020 vedr. afslag på designering af MP1486463 TomoStage <w> i Danmark

fra

ansøger om designeringen:
Carl Zeiss Industrielle Messtechnik GmbH, Tyskland
(Carl Zeiss AG, Tyskland)

Afgørelsen er truffet af formand Henrik Rothe og næstformand Tine Sommer.

Ankenævnet har behandlet sagen skriftligt.

Sagens baggrund

Patent- og Varemærkestyrelsen modtog den 17. september 2019 designeringsdokument vedrørende det ansøgte mærke TomoStage for vareklasse 9:

“Mounting scaffold for use in the field of industrial computed tomography.”

Styrelsens meddelte den 24. oktober 2019 foreløbigt afslag til ansøger, idet beskrivelsen af varefortegnelsen ikke var tilstrækkeligt præcis. Ansøger fik frist til den 24. februar 2020 til at anmode styrelsen om en ny vurdering i sagen.

Den 18. juni 2020 meddelte Patent- og Varemærkestyrelsen afslag på ansøgningen om designering af MP1486463 TomoStage i Danmark, da styrelsen ikke havde modtaget et svar fra ansøger på styrelsens henvendelse af 24. oktober 2019 om foreløbigt afslag. Fra styrelsens afgørelse i sagen citeres følgende:

”... Designation of Denmark concerning the international registration 1486463 TomoStage

We refer to our provisional refusal of 24 October 2019, in which we informed you that the above designation would be refused if we did not receive any reply from you.

We have not received any reply, and we therefore refuse your designation.

The grounds for refusal are that the list of goods is too vague, cf. the Danish Trademarks Act, Section 12.

According to the Danish Trademarks Act and the ruling of the ECJ in C-418/02, a trademark application must contain a precise list of the goods and services covered by the registration of the mark.

The term “*mounting scaffold for use in the field of industrial computed tomography*” is not sufficiently clear and precise in class 9 as it is not evident from the current wording of the term what the goods actually are.

Scaffolding are mainly classified in class 6 and 19 depending on whether they are of metal or not.

However, if goods are very specific and can be considered as accessories for specific goods, which are classified in other classes, the goods in some cases may be classified in the class where the goods for which they are accessories for are classified.

The decision has been made pursuant the Danish Trade Marks Act Section 16(1), cf. Section (12)..."

Denne afgørelse blev med brev af 13. august 2020 fra klagers repræsentant, Carl Zeiss AG, indbragt for Ankenævnet for Patenter og Varemærker med følgende:

"... We herewith submit an appeal against above-mentioned decision of the Danish Patent and Trademark Office.

In order to overcome the grounds of refusal, we submit following specification of goods:

"assembly frame for use with computer tomography apparatus in the field of industrial computer tomography".

We respectfully request our trademark application to be allowed on this basis to registration..."

I brev af 10. december 2020 afgav Patent- og Varemærkestyrelsen følgende udtalelse i sagen:

"... In response to the Board of Appeal's letter of 21 August 2020, the Danish Patent and Trademark Office states the following:

The applicant has proposed a clarification of the wording in class 9 as follows:

"assembly frame for use with computer tomography apparatus in the field of computer tomography".

As this clarification makes it clear that the goods covered by the designation of Denmark in class 9 are accessories to a product in class 9, it is the Office's opinion that this wording is sufficiently clear and precise.

On this basis, the Office recommends to the Board of Appeal that the case be returned to the Office for further processing..."

I mail af 15. december 2020 kommenterede klagers repræsentant, Carl Zeiss AG, styrelsens udtalelse med følgende:

”... We submit that we can fully agree with the statement and that the case can proceed to voting...”

Ankenævnets begrundelse og resultat [The Board of Appeal’s opinion]

In the appeal, the complainant has submitted a clarification of the wording in class 9 to the Board of Appeal for Patents and Trademarks in order to overcome the grounds of refusal.

In its statement of 10 December 2020, the Danish Patent and Trademark Office responded that the proposed clarification makes it clear that the goods covered by the designation of Denmark in class 9 are accessories to a product in class 9. Thus, it is the opinion of the Office that this wording is sufficiently clear and precise. On this basis, the Office recommends to the Board of Appeal that the case be returned to the Office for further processing.

The Board of Appeal endorses the Office’s statement and refers the case back to the Office for further processing.

Herefter bestemmes [Decision]

The Board of Appeal hereby sets aside the Office’s decision of 18 June 2020 and refers the case back to the Office for further processing.

Ankenævnet for Patenter og Varemærker



Henrik Rothe
Formand