

**Action brought on 19 December 2011 — Asos v OHIM — Maier (ASOS)****(Case T-647/11)**

(2012/C 58/20)

*Language in which the application was lodged: English***Parties***Applicant:* Asos plc (London, United Kingdom) (represented by: P. Kavanagh, Solicitor)*Defendant:* Office for Harmonisation in the Internal Market (Trade Marks and Designs)*Other party to the proceedings before the Board of Appeal:* Roger Maier (San Pietro di Stabio, Switzerland)**Form of order sought**

- Annul the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 17 October 2011 in case R 2215/2010-4;
- Authorise registration of the application mark in respect of all of the goods and services covered by the specification of the application mark; and
- Order the defendant to pay the costs of the action.

**Pleas in law and main arguments***Applicant for a Community trade mark:* The applicant*Community trade mark concerned:* The word mark 'ASOS', for goods and services in classes 3, 14, 18, 25 and 35 — Community trade mark application No 4524997*Proprietor of the mark or sign cited in the opposition proceedings:* The other party to the proceedings before the Board of Appeal*Mark or sign cited in opposition:* Community trade mark registration No 4580767 of the word mark 'ASSOS', for goods in classes 3, 12 and 25*Decision of the Opposition Division:* Partially upheld the opposition*Decision of the Board of Appeal:* Partially annulled the decision of the opposition division*Pleas in law:* The Board of Appeal failed to properly consider co-existence and its effect on the global assessment of the likelihood of confusion, and erred in dismissing the relevance of the evidence of co-existence. Further, the Board of Appeal erred in its assessment of the conceptual meaning of the application mark and failed to take into account the correct conceptual meaning of the application mark in assessing likelihood of confusion based on a global assessment.**Action brought on 21 December 2011 — Smart Technologies/OHMI (SMART NOTEBOOK)****(Case T-648/11)**

(2012/C 58/21)

*Language of the case: English***Parties***Applicant:* Smart Technologies ULC (Calgary, Canada) (represented by: M. Edenborough, QC, T. Elias, Barrister, and R. Harrison, Solicitor)*Defendant:* Office for Harmonisation in the Internal Market (Trade Marks and Designs)**Form of order sought**

- Annul the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 29 September 2011 in case R 942/2011-1;
- In the alternative, alter the contested decision of the First Board of Appeal to state that the application possesses sufficient distinctive character that no objection to its registration may be raised under Articles 7(1)(b) or (c) of the Regulation; and
- Order that the costs of the proceedings be borne by the defendant.

**Pleas in law and main arguments***Community trade mark concerned:* The word mark 'SMART NOTEBOOK' for goods in class 9 — Community trade mark application No 9049313*Decision of the Examiner:* Rejected the Community trade mark application*Decision of the Board of Appeal:* Dismissed the appeal*Pleas in law:* Infringement of Articles 7(1)(b) and 7(1)(c) of Council Regulation No 207/2009, as the Board of Appeal wrongly found that the Community trade mark application was devoid of any distinctive character. Further, the applicant submits that the application is not descriptive of the applicant's goods, rather it has a distinctive character that enables the application to function as an indication of trade origin for the goods in question. In particular the applicant submits that the Board: (a) applied the wrong test when considering whether or not a mark was descriptive of the goods for which registration was sought; (b) failed to consider the fact that the applicant had a family of 'Smart' marks, and wrongly confused this issue with the concept of acquired distinctiveness under Article 7(3) of the Regulation; and (c) wrongly dismissed the submission relating to legitimate expectation in the circumstances where the other marks upon which reliance was placed were all owned by the applicant, as opposed to marks owned by third parties.