

Conditions for limiting list of goods and services highlightedExamination/opposition
International procedures**European Union - Maiwald Patentanwalts GmbH**

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In *Eliza Corporation v Office for Harmonization in the Internal Market (OHIM)* (Case T-130/09, March 24 2010), the General Court has held that the stylized trademark ELIZA was confusingly similar to the earlier word mark ELISE.

Eliza Corporation filed an application for the registration of ELIZA as a Community trademark (CTM) (Application 4279048). *Went Computing Consultancy Group BV* filed a notice of opposition based on its earlier CTM ELISE (Registration 3142999). Both marks covered goods and services relating to computer programs.

The Opposition Division and the Board of Appeal of OHIM found that the marks were confusingly similar within the meaning of Article 8(1)(b) of the [Community Trademark Regulation](#) (207/2009). In particular, OHIM found that:

- the goods at issue were identical or similar;
- the marks were visually and phonetically similar; and
- the marks were conceptually identical, as the relevant public would perceive both signs as diminutive forms of the female name Elisabeth.

Eliza appealed to the General Court. At the same time, *Eliza* wrote to OHIM, seeking the amendment of the list of goods and services in Classes 9, 37 and 42 of the [Nice Classification](#), to the effect that these goods and services are “exclusively for use in the field of healthcare institutions”. In response, OHIM stated that this restriction should be disregarded for the purpose of reviewing the legality of the contested decision, as it was liable to alter the subject-matter of the dispute pending before the court within the meaning of Article 65 of the regulation and Article 135(4) of the court’s Rules of Procedure.

The court first referred to Article 43(1) of the regulation, which provides that an applicant for a CTM may, at any time, restrict the list of goods or services covered by the application. The court further held that, according to Article 65 of the regulation, the purpose of the present action was to review the legality of the Board of Appeal’s decision based on the factual and legal context of the dispute, as it was brought before the board (see *SPAG v OHIM* (Case T-57/03)). However, a restriction to the list of goods or services carried out after the adoption of the board’s decision may be taken into account by the court, provided that such restriction does not change the factual or legal subject-matter of the dispute.

The court went on to hold that limitations carried out in accordance with Article 43(1) may be taken into consideration by the court where the applicant limits itself to withdrawing certain goods or services from the original application, since the subject-matter of the dispute has not been changed, but merely restricted. In contrast, where the restriction consists in specifications capable of influencing the assessment of the similarity of the goods and services, or the determination of the target public, the factual context examined by the Board of Appeal has changed.

In the present case, Eliza reduced the scope of the goods and services by adding that they were “exclusively for use in the field of healthcare institutions”. Such restriction was capable of affecting the definition of the relevant public and of influencing the comparison of the goods and services, as well as the likelihood of confusion. Therefore, the court held that it could not take this limitation into consideration in reviewing the board's decision.

Based on the findings that the marks were similar, and that the goods and services were identical or similar, Eliza’s action was dismissed.

The decision highlights the fact that, despite the wording of Article 43(1), an applicant should ensure that any limitation to the goods and services is carried out, at the latest, during the appeal proceedings before OHIM.

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