

Nullità ai sensi dell'Art. 7(1)(d)

[9] Il termine "APP STORE" è di uso comune nel commercio per designare uno negozio (anche un punto vendita virtuale) dove i software applicativi ed i servizi correlati possono essere acquistati. Gli Allegati 6, 7, 8 e 9 dimostrano una larga varietà di usi del termine "APP STORE" per identificare quei servizi originati da una gamma di differenti aziende. L'Allegato 6 si riferisce all'uso del termine "APP STORE" in italiano, l'Allegato 7 in francese, l'Allegato 8 in inglese e l'Allegato 9 in spagnolo. E' pertanto chiaro che "APP STORE" è largamente utilizzato come un termine comune nel commercio nelle lingue sopra indicate, così come in tutte le lingue dell'Unione Europea, per descrivere i servizi per i quali il marchio comunitario in parola è stato registrato. Le ingenti prove, delle quali solo alcuni estratti sono stati depositati sub-allegati 6, 7, 8 e 9 è tale da confermare con assoluta certezza che l'espressione "APP STORE" è incapace di identificare i servizi forniti da un'impresa fra le molte che sono attive nel settore di riferimento, proprio perché il medesimo termine è usato nel commercio e dalla stampa in relazione a stores di software applicativi che sono utilizzati da numerose società. IN particolare si attira l'attenzione sul fatto che altri numerosi operatori del settore utilizzano questa espressione nell'ambito del nome del loro punto vendita in modo generico:

- **AppStoreHQ**
- **Amazon App Store**
- **App store blackberry**
- **Shopify App Store**
- **@metro App Store**
- **WinMoAppStore.com**
- **AndAppStore**
- **DirectTV App Store**

STORE comme désignant un endroit où a lieu la vente de café, ou la consommation de ce produit ou de produits qui lui sont généralement associés.
C'est donc à bon droit que la chambre de recours a considéré que le signe *THE COFFEE STORE* était constitué exclusivement d'indications pouvant servir à désigner la nature des produits et la destination des services relevant des classes 30, 32 et 43 » T-323/05, paragraphi 42 and 43

- Sentrion App Store
- MobiHand App Store
- Mobile App Store Solutions

Nullità ai sensi dell'art. 7(1)(g)

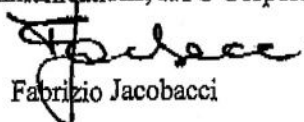
[10] Sebbene "APP STORE" sia generico o descrittivo per un luogo dove possono essere acquistati software applicativi, il marchio è stato altresì registrato per "Assistenza, riparazione e aggiornamento di software per computer" nella classe 37 e "Manutenzione, riparazione ed aggiornamento di [...]software per sistemi operativi computerizzati, software di servizio" nella classe 42. Tuttavia, il software applicativo è chiaramente diverso dal software di sistema operativo (o software di sistema *tout court*). La registrazione e l'uso di "APP STORE" per contraddistinguere servizi connessi con l'assistenza e la riparazione e l'aggiornamento di software diversi dai software applicativi è fonte di confusione per il pubblico circa la natura e la qualità dei prodotti per i quali i servizi di riparazione, assistenza e aggiornamento sono forniti.

Conclusioni

[11] Le Ricorrenti richiedono la dichiarazione di nullità assoluta del marchio comunitario n. 007078314 in relazione a tutti i servizi per i quali è registrato ai sensi e per gli effetti dell'Art. 85(1) e, ai sensi della Rule 94 del Regolamento della Commissione (EC) n. 2868/95 di esecuzione del RMC (IR"), le Ricorrenti richiedono la vittoria delle spese e dei costi.

Con osservanza in nome e per conto di

Microsoft Corporation, Sony Ericsson Mobile Communications, HTC Corporation


Fabrizio Jacobacci

Invalidity Application by Nokia Corporation against Community Trade Mark Registration No. 007078314 APP STORE in the name of Apple Inc.

In the name and on behalf of Nokia Corporation (hereinafter, for ease of reference, referred to as "Nokia" or "the Applicant"), we hereby respectfully submit a request for a Declaration of Invalidity against Community Trade Mark Registration No. 007078314 **APP STORE** in the name of Apple Inc (hereinafter also referred to as "the CTM Registration").

The Community Trademark Registration

The above Community trademark which was filed at the Office on July 21, 2008 (claiming priority of Trinidad and Tobago application no. 39582, filed on March 7, 2008) matured to registration on June 5, 2009 for the following services in International classes 35, 37, 38 and 42:

Retail store services featuring computer software provided via the internet and other computer and electronic communication networks; retail store services featuring computer software for use on handheld mobile digital electronic devices and other consumer electronics; internet services, namely, creating indexes of information, sites and other resources available on global computer networks for others; searching, browsing and retrieving information, sites, and other resources available on global computer networks and other communication networks for others (class 35).

Maintenance, repair and updating of computer software and of handheld mobile digital electronic devices and other consumer electronics, namely, MP3 players, hand held computers, personal digital assistants, electronic organisers, electronic notepads, magnetic data carriers, mobile digital electronic devices, computers, notebook computers, computer hardware, computer peripherals, computer batteries, remote controls, disk drives, power cords, power converters, hard drives for computers, video cameras, speakers for computers, microprocessors, computer memory boards, keyboards, computer servers, computer docking stations, computer terminals, printers, cellular telephones, electronic games, video game machines, consoles for use with computers, electronic games consoles, video and computer game software and programs, set top boxes, video projectors, radios, microphones, headphones, earphones, tuners, automatic vending machines, fax machines, scanners, computer displays and monitors, touch screens, computer mice, trackballs, track pads, light pens, joysticks, game controllers, graphic tablets, digitisers, cables and connectors, flash memory drives, network interfaces, modems, cable modems, routers, bridges, gateways, and hubs, wireless routers, cards, and access points, telephones, personal digital assistants, video recorders, televisions, stereo receivers, video disc players, audio disc players, digital audio players and recorders, audio amplifiers, music synthesisers, video special effects generators, still cameras, digital cameras,

semiconductors, integrated circuits, video game cartridges, magnetic disc and optical discs (class 37).

Communications services; telecommunication services; electronic transmission of computer software via the internet and other computer and electronic communication networks; provision of connectivity services and access to electronic communications networks for transmission or reception of computer software; provision of on-line communications services; communications via a global computer network or the Internet; electronic mail, message sending and receiving services; broadcasting services; provision of access to web pages; transmission and distribution of data or audio-visual images via a global computer network of the Internet; providing access to MP3 websites on the Internet; delivery of digital music by telecommunications; providing access to digital music websites on the Internet; leasing time to a computer database; information, advisory and consultancy services relating to all the aforesaid (class 38).

Maintenance, repair and updating of computer software, computer operating system software, computer utility software; providing information concerning computer software via the internet and other computer and electronic communication networks; providing consulting services and technical troubleshooting support for computer software and for handheld mobile digital electronic devices and other consumer electronics; providing search engines for obtaining data via communications networks; providing temporary use of computer software and online facilities to enable users to access and download computer software; computer hardware and software consulting services; rental of computer hardware and software apparatus and equipment; multimedia and audio-visual software consulting services; computer programming; support and consultation services for developing computer systems and databases; graphic design for the compilation of web pages on the Internet; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; design and development of web-sites featuring multimedia materials; hosting the web-sites of others; information, advisory and consultancy services relating to all the aforesaid(class 42).

The Grounds on which the Invalidity action is based

Invalidity of the above registration is hereby sought on the basis of Articles 52(1)(a) and 7 of Council Regulation (EC) No. 207/2009 of 26 February 2009 (hereinafter referred to as the "Community Trademark Regulation" or "the CTMR").

In this respect, Article 52(1)(a) CTMR, 'Absolute Grounds for Invalidity' provides that:

"1. A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) where the Community trade mark has been registered contrary to the provisions of Article 7".

Article 7 CTMR, 'Absolute Grounds for Refusal' provides, inter alia, that:

"1. The following shall not be registered:

[omissis]

(b) trademarks which are devoid of any distinctive character;

(c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

(d) trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade";

[omissis]

(g) trademarks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

It is on the basis of the combined provisions of the articles cited above that invalidity of the CTM registration is hereby sought.

Facts, arguments and evidence in support of the Invalidity Action

The Community Trademark Registration consists merely of the term APP STORE which:

- is devoid of distinctive character within the meaning of article 7(1) (b) CTMR;

- consists exclusively of a sign or indication which serves, in trade, to designate the kind or intended purpose of the services, or other characteristics of the services for which protection has been claimed in classes 35, 38, 39 and 42, within the meaning of article 7(1) (c) CTMR;
- has become customary in the current language or in the *bona fide* and established practices of the relevant trade circle within the meaning of article 7(1) (d) CTMR;
- is of such a nature as to deceive the public as to the nature of certain services for which the mark has been registered within the meaning of article 7(1) (g) CTMR.

For the sake of analysis, we shall examine the constituent elements of the mark in turn before considering the mark as a whole.

The word APP

It is worth recalling from the outset that the descriptive character of a mark, or one of its constituent elements, must be assessed in relation to the goods/services for which the mark was registered.

In the context of the services covered by the CTM registration, the word APP is exclusively descriptive of **application software**, as attested, amongst others, by the relative entry on the "Free Dictionary by Farlex" which is available online at <http://www.thefreedictionary.com/app> (**Attachment 1**).

Use of the abbreviated term APP to denote Application software dates back to the 1980s when it was commonplace for companies in the Information and Communications Technology (ICT) industry to invest heavily in research and development activities in search of the so-called "killer app". In support of the above claim we hereby submit:

Attachment 2 which is an extract from the September 18, 1989 edition of Info World and contains a reference to the term "killer app";

Attachment 3 which is a screenshot from the Cambridge dictionary's online entry for "Killer App" (<http://dictionary.cambridge.org/dictionary/british/killer-app>);

Attachment 4 which is a print out from the WIKIPEDIA® entry for Killer app which traces the use of the term "killer app" since the 1970s.

Attachment 5 which is a print out from Dictionary.com's entry for "app" which indicates that the word has been used since the 1985-1990 period.

Attachment 6 which is a print out from the WIKIPEDIA® entry for Application Software http://en.wikipedia.org/wiki/Application_software

Thus, regardless of the significance of the word "app" in a general context, and without prejudice to our comments below on the potential deceptiveness of the mark, we are of the opinion that in the context of the services claimed in the CTM registration, the word app is exclusively descriptive (if not generic) of application software.

Moreover, whilst article 7 [2] of the CTMR provides that absolute grounds for refusal "*shall apply notwithstanding that the grounds of non-registrability obtain in only one part of the Community*" we are of the opinion that, in the present case, the grounds of non-registrability apply in most, if not all, parts of the Community in view of the global tendency in the ICT sector to use original English language terms and not translate the same into local equivalents. In any case, given the Latin origin of the word "application", in many European jurisdictions the word is very similar or identical to the English term (e.g. *applicazione* in Italian, *application* in French, *aplicación* in Spanish).

In support of the above, we hereby submit:

Attachment 7 which is a screenshot from the website of the CTM Registration's owner in which descriptive/generic use is made of the word app in the Italian language (with English translation of relevant parts);

Attachment 8 which is a screenshot from the website of the CTM Registration's owner in which descriptive/generic use is made of the word app in the French language (with English translation of relevant parts);

Attachment 9 which is a screenshot from the website of the CTM Registration's owner in which descriptive/generic use is made of the word app in the Spanish language (with English translation of relevant parts);

Thus, considered per se, the term APP falls foul of the provisions of articles 7 (1) (b) and (c) of the CTMR.

The word STORE

The term STORE traditionally referred to a shop where goods and services were retailed and provided and/or where repair and maintenance services were provided. Nowadays, it retains the above meaning and additionally, in the

online world, has been employed to designate the same scenario (a platform where goods and services are retailed and provided and/or where repair and maintenance services are provided in the virtual marketplace).

It is therefore devoid of distinctive capacity in relation to the provision of the services covered by the CTM registration.

In support of our assertion, we hereby submit:

Attachment 10 which is a print out (first page only) from the WIKIPEDIA® entry for Online Store (redirect to Online Shopping)

By way of confirmation of our argument on the lack of distinctive capacity of the word STORE, we note that this word appears in the claim of services in class 35 of the CTM registration, which is the object of the present proceedings, also in its virtual / online meaning:

Retail store services featuring computer software provided via the internet and other computer and electronic communication networks; retail store services featuring computer software for use on handheld mobile digital electronic devices and other consumer electronics;

Moreover, once again recalling the principle that that the descriptive character of a mark, or one of its constituent elements, must be assessed in relation to the goods/services for which the mark was registered, we note that in the context of the services covered by the CTM registration, the word STORE has a second meaning, namely that of a repository where data is stored; in other words, a data store.

Data storage can refer to: computer data storage; memory, components, devices and media that retain digital computer data used for computing for some interval of time; or any data storage device that records (stores) or retrieves (reads) information (data) from any medium, including the medium itself (source: http://en.wikipedia.org/wiki/Data_storage).

Application storage (in an app store), is a feature of many of the services covered by the CTM registration and is, per se, a telecommunications service.

Therefore, the word STORE, considered per se, also falls foul of the provisions of articles 7 (1) (b) and (c) of the CTMR in respect of all of the services covered by the CTM registration as it refers to both the online point of sale where apps are retailed and/or stored.

The combination of APP and STORE

In view of the above observations and arguments, it would appear that the applicant's intention in registering the mark **APP STORE** is that of asserting exclusive rights over the combination of the terms APP and STORE. However, we are of the opinion that this particular combination falls short of conferring distinctive capacity on the mark as a whole in the context of the services for which registration has been granted.

From the case law of the European Court of Justice it has emerged that, as a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 7(1)(c) of Regulation 40/94.

By way of mere example, in Case T- 160/07 (Lancôme parfums et beauté & Cie SNC v OIIM), the Court held that *"a trade mark composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of the characteristics of those goods or services for the purposes of Article 7(1)(c) of Regulation No 40/94, unless there is a perceptible difference between the mark applied for and the mere sum of its parts. That assumes that, because of the unusual nature of the combination in relation to the goods or services, the mark applied for creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed (the earlier case of PAPERLAB - Case T- 19/04 Metso Paper Automation v OHIM [2005] ECR II- 2383 was cited in support of this finding).*

The sum of the parts of the CTM registration (APP and STORE) is not of an unusual nature in relation to the services covered by the CTM registration; as a matter of fact, with reference to the above observations and attachments, it would appear that quite the opposite is true and that "app store" is a term which has become customary in the current language or in the *bona fide* and established practices of the relevant trade circle.

In other words, an APP STORE is (as its intrinsic meaning suggests) a store (including an online store) where apps are offered for sale and can be acquired by customers and where services related to the buying, selling and use of apps (such as maintenance, repair and updating services) are provided and acquired by customers.

The abbreviation of the word APPLICATION to APP is insufficient to create an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which the mark is composed

since, as illustrated above, APP and APPLICATION are interchangeable as the generic term for application software.

Moreover, no unusual juxtaposition of elements has taken place: the mark has been formed in accordance with normal lexical and grammatical rules of the English language.

Without prejudice to our comments below on the potential deceptiveness of the mark APP STORE in relation to some services of the CTM registration, the mark is exclusively descriptive and devoid of distinctive capacity in relation to the services covered because:

retail store services featuring computer software provided via the internet and other computer and electronic communication networks is the core business of an app store;

retail store services featuring computer software for use on handheld mobile digital electronic devices and other consumer electronics is the core business of an app store;

internet services, namely, creating indexes of information, sites and other resources available on global computer networks for others are services which are typically available in an app store or which are essential characteristics of the apps which are provided in such a store;

searching, browsing and retrieving information, sites, and other resources available on global computer networks and other communication networks for others are services which are typically available in an app store or which are an essential characteristic of the apps which are provided in such a store;

Maintenance, repair and updating of computer software and of handheld mobile digital electronic devices and other consumer electronics are services which are typically available in an app store or are essential characteristics of the apps which are provided in such a store;

Communications services and telecommunication services is the core business of an app store;

electronic transmission of computer software via the internet and other computer and electronic communication networks; provision of connectivity services and access to electronic communications networks for transmission or reception of computer software; provision of on-line communications services; communications via a global computer network or the Internet is the core business of an app store;

electronic mail, message sending and receiving services are services which are typically available in an app store or are essential characteristics of apps which are provided in such a store;

broadcasting services; provision of access to web pages; transmission and distribution of data or audio-visual images via a global computer network of the Internet; providing access to MP3 websites on the Internet; delivery of digital music by telecommunications; providing access to digital music websites on the Internet; leasing time to a computer database; information, advisory and consultancy services relating to all the aforesaid are services which either fall within the core business of an app store or are anyhow typically available in an app store or are essential features of the apps that are acquired therein;

Maintenance, repair and updating of computer software, computer operating system software, computer utility software are services which consumers might reasonably expect to find in an app store, without prejudice to our comments below on the potential deceptiveness of the mark in the context of software other than application software.

providing information concerning computer software via the internet and other computer and electronic communication networks; providing consulting services and technical troubleshooting support for computer software and for handheld mobile digital electronic devices and other consumer electronics; providing search engines for obtaining data via communications networks; providing temporary use of computer software and online facilities to enable users to access and download computer software; computer hardware and software consulting services; rental of computer hardware and software apparatus and equipment; multimedia and audio-visual software consulting services; computer programming; support and consultation services for developing computer systems and databases; graphic design for the compilation of web pages on the Internet; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; design and development of web-sites featuring multimedia materials; hosting the web-sites of others; information, advisory and consultancy services relating to all the aforesaid are the core business of an app store, or services which are typically available in an app store or which are an essential characteristic of the apps which are provided in such a store;

Thus, even the combination of the elements APP and STORE falls foul of the provisions, not only of articles 7 (1) (b) and (c) of the CTMR but also of article 7(1)(d) insofar as the term APP STORE has become customary in the current language or in the bona fide and established practices of the relevant trade circle within the meaning of article 7(1) (d) CTMR.

In support of the above argument, we hereby submit **Attachment 11** which shows use of the term “app store” by diverse operators in the ICT field in the context of the services which have been claimed in the CTM registration. In the online marketplace for apps, it is necessarily the “house mark” which consumers will rely upon to distinguish one app store from another such as the “Amazon app store” from the “App Store HQ” and the “Blackberry App Store” from the “Shopify App Store”. Other examples include:

O2 App Store;
Intel app store;
@metro App store;
Nokia apps store;
Sendmail Sentrion App Store;
AndAppStore;
WinMoAppstore;
Asus App Store;
Notes App Store (Lotus)

Copies of the above uses of app store are attached (relevant pages only)

Also submitted, at **Attachment 12**, is an extract (relevant pages only) from the report of Apple Inc’s (the CTM owner) “Earnings Call” of October 18, 2010 during which the founder of Apple Inc., Mr Steve Jobs, referred to competitors’ app stores:

“In addition to Google’s own app marketplace, Amazon, Verizon and Vodafone have all announced that they are creating their own app stores for Android. So there will be at least four app stores on Android, which customers must search among to find the app they want and developers will need to work with to distribute their apps and get paid. This is going to be a mess for both users and developers. Contrast this with Apple’s integrated App Store, which offers users the easiest-to-use largest app store in the world, preloaded on every iPhone. Apple’s App Store has over three times as many apps as Google’s marketplace and offers developers’ one-stop shopping to get their apps to market easily and to get paid swiftly”.

If Apple’s app store is indeed, as claimed, “*the largest app store in the world*” then the inference can be drawn that there are other (smaller), third party app stores.

Finally, with respect to those services covered by the CTM registration which are not strictly related to **application (app) software** the mark could be held to fall foul of the provisions of article 7(1) (g) CTMR insofar as it is capable of deceiving the public as to the nature of such services within the meaning of the aforementioned article.

We refer, in particular, to services such as “*maintenance and repair of handheld mobile digital electronic devices and other consumer electronics*” (in class 37) and “*maintenance, repair and updating of computer operating system software and computer utility software*” (in class 42).

In view of the above, we hereby ask the Cancellation Division to Declare the Invalidity of Community Trade Mark Registration No. 007078314 for **APP STORE** in the name of Apple Inc on the grounds of articles 7 (1) (b), (c) and (d) of the CTMR and order the costs of the present proceedings to be borne by the owner of the CTM registration.

Respectfully submitted on behalf of Nokia Corporation.

Barzanò & Zanardo



Peter McAleese