



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

**TRADE MARKS DEPARTMENT**

**DECISION**  
**of the Cancellation Division**  
**of 28/10/2005**

**IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY**

OHIM reference number: 969C 002155521

Community trade mark: 2155521, WM 2006

Language of the proceedings: English

**APPLICANT**

**Ferrero oHG mbh**  
Rheinstr. 3-7  
35260 Stadtallendorf  
Germany

**COMMUNITY TRADE MARK PROPRIETOR**

**Federation Internationale de Football Association (FIFA)**  
Hitzigweg 11  
8032 Zurich  
Switzerland

**THE CANCELLATION DIVISION**

composed of: Wouter Verburg (Member), Patricia LÃ³pez Fdez. De Corres (Member) and Ã?lvaro Sesma (Member)

has taken the following decision on 28/10/2005:

- 1. The request for a declaration of invalidity is rejected.**
- 2. The applicant shall bear the costs of the Community trade mark proprietor.**

**And fixes the costs as follows**

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**The amount of costs to be paid by the applicant to the CTM proprietor pursuant to Article 81(6) CTMR in conjunction with Rule 94(3) IR shall be 450 euro, corresponding to representation costs.**

## **FACTS AND ARGUMENTS**

(1) The Community trade mark 2155521 (WM 2006) was registered on 19/11/2003 for the following goods and services in classes 1, 3, 4, 6, 7, 8, 9, 11, 12, 14, 16, 18, 20, 25, 28, 29, 30, 32, 35, 36, 37, 38, 41 and 42:

1 Unexposed films; chemicals used in industry, tanning substances; artificial sweeteners

3 Cosmetics, particularly, soaps, hair lotions, perfumes, colognes, pre-shave and after shave lotions, shaving creams, shampoos, toothpaste, deodorants and antiperspirants for personal use, mouth washes; nourishing creams, skin creams, hair lacquers, beauty additives, cleansing cream, eye shadow, face powder, cosmetic pencils, decorative transfers for cosmetic purposes, sunscreen lotions; cleaning, polishing, scouring, abrasive preparations for household purposes, laundry powder detergents, synthetic household detergents, shoe polish; vehicle deodorisers.

4 Lubricants, motor oils and fuels; candles, waxes

6 Key chains, money clips, figurines, ornaments made of common metals or their alloys; statues and sculptures of common metal, pogs (as far as included in Class 6); all the aforementioned goods relating to or to be associated with football championships.

7 Aerated beverage making machines; blenders, electric for household purposes; dishwashers; electric can openers; electric knives; electric kitchen machine, food preparation machines, electromechanical; fruit presses, electric, for household purposes, electric kitchen machine, domestic mixing machines; sewing machines; spin dryers; vacuum cleaners and accessories thereof, as far as included in this class; domestic washing machines; whisks, electric for household purposes.

8 Hand tools and implements (hand-operated); electric or non-electric razors, including razor blades; cutlery; forks and spoons, depilatory devices, eyelash curlers, scissors for household purposes.

9 Eyeglasses, sunglasses, cases and cords for glasses and sunglasses, binoculars; magnets; apparatus for recording, transmitting and reproducing of sound and images, sound carriers blank or pre-recorded, media for recording images (still or moving) and sounds, computers, modems, electronic pocket translators, electronic agendas, scanners, printers, calculating machines and data processors, credit card machines, cash exchanging machines, security alarms, loudspeakers, video cameras, camcorders, video and audio tapes blank or pre-recorded, facsimile transmission machines, telephones, telephone answering apparatus, video phones, photocopy machines, photographic equipment, namely cameras, projectors, exposed films, flash bulbs, camera cases, batteries and accessories therefor (as far as included in class 9); windsocks; hand-held electronic games adapted for use with television receivers only; video game cartridges, CD Roms, pre-recorded computer software including software for games, non processed compact discs for audio or video, video cassettes, compact discs or magnetic tapes pre-recorded with music, magnetic cards, memory cards, microchip cards, electronic vending machines, directional compasses, holograms; credit-, phone-ATM,

travel- and entertainment-, check guarantee- and debit-cards, magnetic; videotapes and video disks recorded with animation, magnetic tapes, magnetic disks, optical disks, compact discs and CD-Roms, DVD recorded with animation; irons; all the aforementioned goods relating to or to be associated with football championships.

11 Electric laundry or hair dryers, penlights, flashlights, table lamps, decorative lamps, lamp shades, light bulbs and lighting fixtures, refrigerators, freezers, space heaters, air conditioners, air purifying units, ovens, gas stoves, barbecue grills, ranges and microwave ovens, electric coffee machines; electric kettles, toasters, deep fryers, water filters, bicycle lights; drink fountains; drying machines.

12 Bicycles, motorbikes, automobiles, trucks, vans, buses, aeroplanes and boats; balloons, airships, prams, strollers, car seats for babies or children, automobile accessories, namely, sun screens, roof racks and sports racks, tyre covers, seat covers, car covers, floor mats (not carpets); automobile engines and components, tyres.

14 Jewellery, watches, clocks, medallions, pins, tie clips, tie pins, trophies, pendants, team and player trading pins; commemorative cups and plates tankards, statues and sculptures, pendants, tea pots, pogs, made of precious metals; medallions, tie clips, tie pins, not made of precious metals; ashtrays and cigarette cases made of precious metals; coins; head adornments; all the aforementioned goods relating to or to be associated with football championships.

16 Gift and party supplies made of paper, namely napkins, table cloths, bags, invitations, gift wrap, coasters, placemats; paper table linen, crepe paper, kitchen aluminium foil, garbage bags of paper or plastic, food storage wrappers, labels (not of textiles), flags of paper, pennants of paper, handkerchiefs of paper, typewriter paper, copying paper, paper coffee filters, towels of paper, wet paper towels, toilet paper, envelopes, babies diapers of paper, paper lanterns; school writing paper, namely notebooks, note paper, binders, writing instruments, including pens, pencils, ball-point pens, pen and pencil kits, felt-tip pens, porous-point pens and rolling ball pens, broad-tip markers; printing blocks correction fluids, rubber erasers; bookends, pencil sharpeners; calendars; adhesive note paper, poster, posters, greeting cards, decals, heat transfers, colouring and drawing books and booklets, printed teaching materials, magazines, newspapers, books and journals, particularly dealing with athletes or sport events, roadmaps, playing cards, tickets, checks, printed timetables, collectable player's cards, bumper stickers and photographs; photograph albums; stationery, office requisites (except furniture); stamps; cards made of paper or cardboard, namely credit-, phone-, ATM-, travel- and entertainment-, check guarantee- and debit cards, autograph books, paper tissue, binder paper, book covers, book stands, confetti, chalk, document holders, paper clips, drawing pins, ink, paint boxes, kitchen towels of paper, writing paper, note pads, clip boards, notepad holders, address books, decorations for pencils, stands for writing implements, ink pads, rubber stamps, rulers, schedules (for recording results), adhesive tape for stationery and office, dispensers for adhesive tape, staplers, stencils, luminous paper, event programs, event albums, boxed tissues made of cardboard; all the aforementioned goods relating to or to be associated with football championships.

18 Umbrellas, parasols, sport and leisure bags, travelling bags, backpacks, tote bags, school bags, belt bags, hand bags, beach bags; suit cases, vanity cases (empty), key cases, passport holders, suit carriers, soccer ball shaped bags, wallets, purses; briefcases; all the aforementioned goods relating to or to be associated with football championships.

20 Keyholders made of plastic; all the aforementioned goods relating to or to be associated with football championships.

25 Clothing, footwear, headgear, including shirts, knit shirts, jerseys and tank tops, T-shirts, skirts, underwear, swimwear, shorts, pants, sweaters, caps, hats, scarves, visors, warm-up suits, sweatshirts, jackets, uniforms, neckties, wristbands and headbands, gloves, aprons, bibs, pyjamas, toddler and infant playwear, socks and hosiery, shoes, belts, suspenders; all the aforementioned goods relating to or to be associated with football championships.

28 Games and playthings; sport balls, board games, stuffed dolls and animals, toy vehicles, jigsaw puzzles, balloons, inflatable toys, soccer equipment, namely, balls, gloves, knee pads, elbow pads, and shoulder pads, shinguards; soccer goals, party hats (toys); hand-held electronic games other than those adapted for use with television receivers only; foam hands; all the aforementioned goods relating to or to be associated with football championships.

29 Meat, fish, poultry and game, meat extracts preserved, and cooked fruits and vegetables, edible oils and fats; potato chips, French fries, processed nuts, jams, preserves and jellies, milk, milk products and dairy products, cheese, canned fruits and vegetables.

30 Coffee, tea, cocoa, sugar, artificial coffee, flour, preparations made from cereals, cereals, bread, pastries, including cakes, cookies and crackers, candies, confections and rice; corn chips, ice cream; honey, mustard, vinegar, sauces (condiments), spices, salt, nutritional additives (not for medical or dietetic purposes, as far as included in class 30).

32 Soft drinks, syrups and powder for making soft drinks, mineral and aerated waters and other non-alcoholic drinks, fruit and vegetable drinks and juices, beers and ales; frozen fruit drinks.

35 Employment agencies services, personnel recruitment services; publication advertisement services, advertising agency services, Internet advertising services, dissemination of advertising, billboard leasing services, advertising space rental services, outdoor advertising services, TV advertising services, promotion agency services, advertising in the form of animation; marketing research services, public opinion polling services; promotion and organisation of commercial exhibitions; database compilation and management; archive services for still and moving images; sport record and statistical information services; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof) enabling customers to conveniently view and purchase those goods via the Internet; all the aforementioned services relating to or to be associated with football championships.

36 Credit card services; issuance of credit cards; travellers check services; financing services; banking services, including credit and loan services; insurance services; promotion of soccer events and exhibitions, namely, financial support of such events; all the aforementioned services relating to or to be associated with football championships.

37 Vehicle service stations, vehicle cleaning, vehicle lubrication, vehicle maintenance, vehicle wash and vehicle repair.

38 Communication services, namely communications by mobile phones and telex; communications by electronic computer terminals; communications by telegraph; communication by telephones; communications by facsimile; paging by radio; teleconferencing for meeting, television broadcasting; cable television broadcasting; radio broadcasting; press and information agency service, news transmission services; leasing of telephones, facsimiles and other communication equipment; all the aforementioned services relating to or to be associated with football championships.

41 Education; providing of training; entertainment, including organisation of lotteries; sporting and cultural activities, organisation of sporting and cultural events and activities; exploitation of sporting facilities; rental services for audio and video equipment; radio, television program and

video tapes production services, production of animation movies, production of animation TV programs, seat booking services for shows and sporting events; timing of sports events ; management of entertainment services; promotion of soccer events; production of photographs; leasing, in particular leasing of recorded sound and images; all the aforementioned services relating to or to be associated with football championships.

42 Providing of food and drink, in particular with Fast Food, in cafeterias and restaurants; catering services, hotel resort, lodging and boarding services; translation services; printing of photographs, computer consulting services; data processing (programming); guard and security services; medical, dental and hospital services; drug testing services; hair dressing, barber and beauty parlour services; apparel outfitter services; uniform leasing services; computer software design services; printing services; hosting of websites on the Internet; licensing of intellectual property rights; database licensing; all the aforementioned services relating to or to be associated with football championships.

(2) The request for a declaration of invalidity was filed in English on 11/08/2004. The applicant bases its request on Article 51(1)(a) and Article 7(1)(b) and 7(2) of Council Regulation (EC) No 40/94 on the Community trade mark (?CTMRâ??) (OJ OHIM 1/95, p. 53) and claims that the mark should not have proceeded to registration pursuant to Article 7 CTMR because WM 2006 is devoid of any distinctive character.

(3) The applicant directs its request against all of the goods and services contained in the Community trade mark.

(4) In essence, the applicant states the following:

- The combination of the letters WM and the year 2006 stands for ?Weltmeisterschaft 2006â??, which means World cup or World championship 2006, a championship organised by the CTM proprietor. A search in Google reflects this fact.

- The trade mark owner is using this sign only to promote and to advertise the event of 2006, the World football competition. Consequently, none of the consumers would or could ever take this sign to be capable of distinguishing goods or services from those of others.

- The trademark owner should accept that other traders may use this message which transmits to the public that the production company or service provider has spent money in supporting the ?WORLD CUPâ?? event organized by FIFA (the proprietor) in Germany. The expression should be kept free for general public use and for all other organisers of world championships.

- FIFA trademarks are not worthy of protection if the public assumes that the products labelled with the trademarks have also been produced by FIFA.

- The following German registrations have been cancelled: ?WM 2006â??; ?WM 2006â?? and ?FUSSBALL WM 2006â??.

- Each year more than fifty world championships/cups are organized around the world.

(5) The proprietor seeks the rejection of the request for a declaration of invalidity as unfounded and that the applicant be ordered to pay the costs, alleging the following grounds:

- It is common practice to grant protection to marks identifying sporting and cultural events.

- The applicant invokes Article 7 (1)(b) and 7(2) CTMR in the invalidity request, however, it simultaneously states that the trade mark is descriptive.

- The expression WM 2006 is not descriptive, it does not designate nor specify any particular features of the claimed goods and services, but only evokes in the mind of the consumers the sporting event created by FIFA. The combination of elements of the mark as a whole constitutes a fanciful, evocative mark.
- The expression WM 2006 is formed of words which considered separately may not be distinctive but considered together are distinctive.
- Additionally, the trademark owner informs that the applicant has applied for registration of comparable trade marks at the German PTO.
- FIFA created its own sports event of football in 1928, the FIFA World Cup.
- The trademark owner confirms the argument put forward by the applicant for invalidity in the sense that other traders may use the message WM 2006 which transmits to the public that the production company or service provider has spent money in supporting the "WORLD CUP" event organised by FIFA (the proprietor) in Germany. Those traders have been authorised by FIFA as licensees to use the message in question in relation with their own trademark. FIFA controls its licensed or sponsored products or services, by a careful selection and monitoring of quality.
- The trademark owner argues that the fact that similar trade marks consisting of well known events have been registered in many trade mark offices, shows that the trade mark is registrable.
- The public is aware of two aspects: that the trade mark refers to a specific event and that only one specific organiser exists.
- Further, whoever refers to "World Cup 2006 Germany", "World Cup 2006", "World Cup Germany", "Germany 2006" or "WM 2006" means the FIFA World Cup, i.e. the football world championship.

(6) Both parties submitted observations within the time limits set. On 31/08/2005 the Office informed the parties that it would take decision.

## **GROUNDS FOR THE DECISION**

### *On the admissibility*

(7) The request complies with the formalities prescribed in the CTMR and in Commission Regulation (EC) No 2868/95 implementing the CTMR ("IR") (OJ OHIM 2-3/95, p. 258) and is, therefore, admissible.

### *On the substance*

(8) The question in dispute is to ascertain whether or not the expression WM 2006, when applied to the challenged goods and services, is devoid of any distinctive character.

(9) The Fédération Internationale de Football Association (FIFA) was founded in 1904. It comprised several associations from several countries and has been the sole organiser of worldwide football competitions, which take place every four years since 1930. There are currently 207 associations affiliated to FIFA all of them from different countries all over the world. For more than 70 years FIFA has been the only organiser of soccer world championship tournaments.

(10) Every four years, FIFA selects a country where the end round, including the final, is played. The end round is preceded by a qualifying round which takes about two years. Since 1978 the end round has been played in Argentina, Spain (1982), Mexico (1986), Italy (1990), the United States (1994), France (1998), Japan/South Korea (2002). In 2006 the end round will be played in Germany.

(11) The competition is the world's most important event both sports wise and economic wise. The tournament is immensely popular. In this sense, the CTM proprietor has submitted that the event has the highest TV viewing figures in the world, namely the TV audience for the event in 1998 achieved the highest ever viewing figures by increasing to 33.4 billion, the final alone was watched on TV by almost 1 billion people in their homes world wide. Matches were broadcasted in 196 countries, no other sport event has ever approached such a total.

(12) The CTM proprietor has also submitted that the World Football Cup has economic, social and even political significance. It is the biggest business in the world, which employs approximately 400 million people world wide and creates an annual working value of approximately 150 billion US dollars.

(13) Under Article 7(1)(b) CTMR, trade marks which are devoid of any distinctive character are not to be registered.

(14) The signs referred to in this Article are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (see Case T-79/00 *Rewe Zentral AG v OHIM* (LITE), paragraph 26).

(15) The distinctive character of a sign has to be assessed, firstly, by reference to the goods and services concerned and, secondly, on the basis of the perception of that sign by the relevant public, which is composed of consumers of those goods and services (see, *inter alia*, Case T-345/99 *Harbinger v OHIM* (TRUSTEDLINK), paragraph 32 and Case T-130/01, *Sykes Enterprises Incorp. v OHIM*, (REAL PEOPLE, REAL SOLUTIONS), paragraph 21).

(16) In the present case, the goods and services covered by the mark applied for are mainly aimed at the public in general. In the light of the nature of the goods and services in question, the awareness of the relevant public will be that of the average consumer who is reasonably well informed and reasonably observant and circumspect. Moreover, since the expression WM 2006 is composed of a German abbreviation and the year 2006, the relevant public by reference to which the absolute ground for refusal must be examined is the average German speaking consumer in the Community.

(17) According to the Court of First Instance, the fact that a sign is made up of components which may allude to certain features of some of the registered goods and services is not sufficient to justify application of the absolute ground for refusal laid down by Article 7(1)(b) CTMR, unless it amounts to proof that such a sign, looked at as a whole, would not enable the section of the public targeted to distinguish the applicant's goods and services from those of its competitors (see Judgment of the CFI in Case T-34/00, *Eurocool Logistik GmbH v OHIM*, EUROCOOL, paragraph 43).

(18) The sign consists of the words WM 2006, a German abbreviation for 'Weltmeisterschaft', which means World cup or World championship, and the year 2006. Though it may be true that isolated terms such as the indication of a year may not be distinctive or even descriptive for some goods and/or services, this does in any event not apply to the combination WM 2006, a German abbreviation and a year. Since there is no relation between a world championship and any of the goods and services for which the sign is registered.

(19) The expression WM 2006 taken as a whole is suggestive. The combination does not form a grammatically correct expression, and at best evokes or suggests the celebration of a world championship that will take place sometime during the year 2006.

(20) As mentioned, the words WM 2006 are likely to be used, each of them, in common parlance, in combination with other words in order to construct grammatically correct sentences or expressions when referring to a World Cup tournament which will take place in the year 2006. At the most, the combination suggests to the consumer a sports championship competition. However, this cannot lead to the conclusion

that the mark is devoid of any distinctive character for the goods and services for which it is registered.

(21) It should be stated that, contrary to the applicants assertion, the expression WM 2006 does not describe in any case that such championship is going to take place in Germany, since such geographical term does not appear in the expression at issue.

(22) Therefore, the mark applied for may serve in trade to distinguish the goods and services of one undertaking from those of other undertakings. The sign applied for taken as a whole has distinctive character and, consequently, complies with the trade mark function.

(23) In reply to the applicant's argument that WM 2006 should be kept free for general public use and for all other organisers of world championships, it is pointed out that the applicant relied on Article 7(1)(b) CTMR rather than on Article 7(1)(c) CTMR, descriptiveness. In any event, as the registered trade mark is at the most suggestive, this argument must be rejected. The mark does not describe any characteristics of the goods and services for which it is registered.

(24) Contrary to what is argued by the applicant, the way in which the CTM proprietor is using the sign at issue is not relevant for assessing the registrability of a trade mark under article 7 (1)(b) CTMR.

(25) In view of the foregoing, the Cancellation Division considers that the sign is not devoid of distinctive character for any of the goods and services for which it is registered.

(26) Even if this were not the case for the services of class 41, in view of the well known character of the world championship soccer event organised by the CTM proprietor the public will immediately perceive the mark's origin, thus allowing it to distinguish the services rendered under the mark from those of a third party.

(27) The applicant itself recognizes FIFA as the organizer of the football competition. This would support the finding that consumers do not only identify that the expression WM 2006 for the registered goods and services comes from one undertaking but will immediately identify this undertaking, namely the FIFA. The Cancellation Division agrees with the applicant in the sense that, the requested limitation to classes 6, 9, 14, 16, 18, 20, 25, 28, 35, 36, 38, 41 and 42 which reads "all the aforementioned goods/services relating to or to be associated with football championships" would have only been necessary, if at all, for sporting events in class 41.

(28) In invalidity proceedings, the determining date for examination whether a trade mark falls foul of Article 7(1)(b) is the registration date. The CTM was applied for on 04/06/2001 and registered on 18/08/2003. Furthermore, even if the CTM were registered for the services in class 41 in breach of the provisions of Article 7(1)(b) CTMR, the Cancellation Division would apply Article 51(2) CTMR, according to which the mark may not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired distinctive character in relation to these services.

(29) As soon as it became known on 06/07/2000 that the tournament will be held in Germany, the general public became aware of this. Considering the importance of the event, the selection of the country where the end round will be held receives major attention in the press. Since then, the awareness of the public that the world soccer championship will be played in Germany has only increased. As a consequence, when the mark is used in relation to the services of class 41, it will directly refer to the sports event organised by the CTM proprietor, and will serve as a trade mark.

(30) In this respect it must be taken into account that soccer is the most popular sport in Europe, that the transmission of the world cup final is the most attended television programme and that the tournament will take place in Germany, i.e. within the European Union.

(31) Finally, as regards the argument of the applicant that similar German trademark registrations have been cancelled and that the OHIM should do likewise, it is settled case law that the Office, must examine applications against the relevant regulations, without being bound by previous decisions. Decisions adopted at national offices are not binding for the Office.

(32) In view of all the aforementioned, it is concluded that the request for a declaration of invalidity be rejected as unfounded.

## **COSTS**

(33) Pursuant to Article 81(1) CTMR and Rule 94 IR, the party losing cancellation proceedings shall bear the fees and costs of the other party.

## **THE CANCELLATION DIVISION**

**WOUTER VERBURG PATRICIA LÃ?PEZ FZ. DE CORRES Ã?LVARO SESMA**

### **Notice on the availability of an appeal:**

Under Article 58 of the Community Trade Mark Regulation any party adversely affected by this decision has a right to appeal against this decision. Under Article 59 of the Regulation notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of 800 euro has been paid.

### **Notice on the review of the fixation of costs:**

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94 (4) of the Implementing Regulation such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of 100 euro (Article 2 point 30 of the Fees Regulation) has been paid.