



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

Cancellation Division

**DECISION
of the Cancellation Division
of 28/10/2011:**

IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY

OHIM reference number: 4525 C
Community trade mark: 922 765
ThermoWood
Language of the proceedings: English

APPLICANT **Terramark Markencreation GmbH**
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Germany

REPRESENTATIVE **Boehmert & Boehmert**
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**COMMUNITY TRADE MARK
PROPRIETOR** **Lämpöpuuyhdistys ry**
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THE CANCELLATION DIVISION

composed of: Gianluigi Mannucci, José Antonio Garrido Otaola and Mark Jefferiss has taken the following decision on 28/10/2011:

1. **The request for a declaration of invalidity of Community trade mark No 922 765 is rejected.**
2. **The applicant shall bear the fees and costs of the Community trade mark proprietor.**
3. **The costs are fixed as follows:**

The amount of costs to be paid by the applicant to the Community trade mark proprietor shall be 450 EUR, corresponding to representation costs.

FACTS AND ARGUMENTS

- (1) The Community trade mark No 922 765 “Thermowood” (word mark) (“the CTM”) was filed on 25/08/1998, registered on 27/09/2000 and duly renewed for *building materials* in class 19.
- (2) On 15/06/2010, the applicant filed a request for a declaration of invalidity against the CTM on the basis of absolute grounds pursuant to Article 52(1)(a) CTMR, namely that the CTM was registered in breach of Article 7(1)(b) and (c) CTMR.
- (3) The applicant files its request for a declaration of invalidity in respect of all the goods covered by the CTM.
- (4) The CTM proprietor was duly notified of the invalidity application and the parties were given ample opportunity to comment upon the observations made by the counterparty in accordance with the relevant provisions of the CTMR and the CTMIR.
- (5) The applicant argues that the word “thermowood” combines the common prefix “thermo”, meaning temperature, and the word “wood” and it is thus devoid of any lexical invention or any unusual and arbitrary element, so that the average consumer will interpret it as referring to any wooden product resistant to heat. This term was first developed and used in Finland at the beginning of the 1990’s to describe the resistant wood produced by steam heating Scandinavian softwood at a very high temperature, and its meaning has expanded to include all kind of thermally modified timber, which is mostly used as a building material.
- (6) The applicant further argues that the use of the word “thermowood” is widespread in the commercial sector, as shown by the websites of several suppliers, and its equivalent German version “Thermoholz” has been refused by the German trade mark office for goods in class 19.

- (7) The applicant concludes that the CTM is devoid of distinctive character and it consists exclusively of a sign which actually serves in trade to designate the kind, quality and intended purpose of the goods in question.
- (8) In support of its arguments, the applicant filed the following documents:
- Printout from the website of the Canadian wood producer “Superior Thermowood”, printed on 27/01/2010 and 27/04/2010, which mentions “Thermowood” as one of its products.
 - Printout from the website of the Spanish wood supplier “The Wood Warehouse”, printed on 27/04/2010, which refers to “Thermowood” timbers.
 - Printouts from the websites of three suppliers of “Thermowood”, printed on 27/01/2010 and 04/03/2010.
 - Printout from the German version of the online encyclopaedia “Wikipedia”, printed on 27/04/2010, concerning “Thermally modified timber”. The article contains several times the word “Thermoholz” which, according to the applicant, corresponds to the English term “Thermowood”.
 - Printout from the website of the German timber supplier “IHB”, printed on 04/03/2010, which mentions once the word “ThermoWood”.
 - Printouts from the websites of seven German, Austrian and Swiss wood suppliers, printed on 27/01/2010, which offer thermally modified timber described as “Thermoholz”. Some of the websites also mention the English term “Thermowood”.
 - Printout from the website of the “Institut für Holztechnologie Dresden”, printed on 27/04/2010, which refers to “Thermoholz”.
 - Press release, dated 24/04/2007, about a research project involving “Thermoholz”.
 - Extracts from CTM-Online, which show the term “thermowood” used in the specification of four Community trade marks as a translation from the German “Thermoholz”.
 - Extracts from the database of the German trade mark office showing, *inter alia*, the refusal of an application for “Thermo-Holz” (word mark) for goods in classes 19, 20, 28 and 37, due to “lack of distinctiveness as well as descriptive specification”.
- (9) The CTM proprietor argues that the applicant has not submitted sufficient evidence to support its claims. In particular, it argues that some of the evidence of use of the word “thermowood” simply relates to companies having their own “thermowood” brands, such as the Canadian firm which uses the brand “Superior Thermowood”, the British firm Quality Timber Decking Co. Ltd. or the Swiss company Stark AG. The CTM proprietor has confidential coexistence agreements with some of these companies. Several other companies mentioned by the applicant have or have had client relationship

with a member company of the CTM proprietor's association, such as the Spanish company The Wood Warehouse, the Swiss company Kälin & Co. AG or the Austrian company Mareiner Holzindustrie GmbH, and therefore had permission from the CTM proprietor to use the CTM.

- (10) The CTM proprietor explains that it is an association and that use of the CTM by its member companies is in fact strictly regulated and has been respected by highly recognized technical magazines, such as that of EUWID, which refrain from using the CTM as a generic term. The CTM proprietor also claims that it has undertaken legal actions on several occasions in cases of unauthorized use of the CTM (in particular in relation with one of the companies that uses the term in its website as shown by the applicant).
- (11) The CTM proprietor considers that the evidence submitted by the applicant as regards the use of the German term "Thermoholz" is not relevant, since it is different from the CTM, and claims that there is no such word as "thermowood" in the English language. The generic term used by almost all professionals in the wood product sector is "thermally modified timber (TMT)", which has also been recognized by the European Committee for Standardization. The fact that the Office may have incorrectly translated a few times the German term "Thermoholz" as "thermowood" cannot be considered sufficient to make the CTM a generic term. The CTM proprietor also refers to the registration of the mark "ThermoWood" in the US, Japan, Switzerland and China.
- (12) Finally, the CTM proprietor argues that, even if it was considered that the CTM was not sufficiently distinctive at the time of registration, it has subsequently acquired distinctiveness through use.
- (13) In support of its arguments, the CTM proprietor submitted the following documents:
- Database extract showing that the company Stark AG is the owner of the Swiss trade mark "ThermoWood".
 - Article published in the EUWID magazine on 24/06/2009 which states, *inter alia*, that the term "ThermoWood" is a registered trade mark that can only be used by members of the International ThermoWood Association.
 - Copies of two cease and desist letters sent by the lawyers of the CTM proprietor to two companies in Austria and The Netherlands on 21/2/2005 and 20/05/2005, respectively.
 - Copies of the certificates of registration of the mark "ThermoWood" in Japan, the United States, Switzerland and China.
 - Presentation on "The activities of Finnish ThermoWood Association to Commercialize ThermoWood" at the 3rd European Conference on Wood Modification which took place in Cardiff (United Kingdom) on 15-16 October 2007. In this presentation the word ThermoWood appears followed by the sign ®, indicating a registered trade mark.
- (14) In reply, the applicant argues that the fact that the CTM proprietor is an association and that the CTM is used by its member companies, subject to an

audited quality control system, means that the CTM is not being used as a trade mark (indicating the individual source of the goods) but rather as a collective trade mark. It further claims that, if the term “thermowood” had any distinctive character at the time of filing, it has lost it while being used by the applicant and its member companies not as a trade mark, but only as a term to describe certain standards for the production of thermally modified timber (thermowood).

(15) In addition, the applicant submitted further evidence in support of its arguments:

- Printout from the website of the CTM proprietor, date of printing illegible, with the list of members of the ThermoWood association.
- Printouts from the webpage www.translate.eu, printed on 07/03/2011, which shows, *inter alia*, that the name of the CTM proprietor in Finnish is translated into English as “Thermowood Association” and the German term “Thermoholz” as “Thermowood”.
- Printout from the webpage of the German environmental program “Fabrik der Zukunft”, in English and German, printed on 03/03/2011. It contains an article on a research project in which “thermowood” is mentioned.
- Printouts from the webpage www.ihb.de, showing two news items, dated 12/02/2010 and 12/08/2010. They refer to a section that has been created within the German federation of the sawing and wood industry formed by six German “producers of thermowood”.
- Brochure from the German producer Hagenskier GmbH & Co. KG, undated, which uses the expression “Thermo Wood”.
- Printouts from the websites of five wood suppliers, printed in March 2011, showing use of “thermowood” and “Thermo Wood”.

(16) The CTM proprietor rejects the applicant’s arguments and states that the CTM has been used as a trade mark: the consumers know that all wood products bearing the CTM originate from the same source (the CTM proprietor), who is responsible for their quality. It further claims that the additional evidence submitted by the applicant only shows some cases of unauthorized use of the CTM and that it has already been proved that the CTM proprietor has taken appropriate measures, within its limited financial capabilities, to prevent any such unauthorized use.

(17) On 31/05/2011, the parties were informed that the adversarial part of the proceedings was closed and that a decision would be taken in due course.

GROUNDS FOR THE DECISION

On the admissibility

(18) The request complies with the formalities prescribed in particular in Article 56(1) CTMR and Rule 37 CTMIR and is, therefore, admissible.

On the substance

- (19) The request is not well-founded. The Cancellation Division considers that the CTM has not been registered in breach of Article 7(1)(b) or (c) CTMR.
- (20) Pursuant to Article 52(1)(a) and (3) CTMR a Community trade mark shall be declared invalid on application to the Office where the Community trade mark has been registered contrary to the provisions of Article 7 CTMR. Where the ground for invalidity exists in respect of only some of the goods or services for which the Community trade mark is registered, it shall be declared invalid as regards those goods or services only.
- (21) As regards the assessment of the absolute grounds of refusal pursuant to Article 7 CTMR, which forms part of the *ex officio* examination prior to the registration of the CTM, it should be noted first that the Cancellation Division will not carry out its own research but will confine itself to an examination of the facts and arguments presented by the parties (see also Manual, Part D, Section: Cancellation Proceedings, Substantive Provisions, Chapter 4.1.).
- (22) These facts and arguments must relate to the time of the application for the CTM. However, facts concerning the time thereafter might give an indication also as to time of the application (see order of 23/04/2010, C-332/09 P, 'Flugbörse', at paragraphs 41 and 43).

Article 7(1)(c) CTMR

- (23) Under Article 7(1)(c) CTMR, trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristics of the goods or services, shall not be registered. Thus Article 7(1)(c) CTMR pursues the aim, which is in the common interest, of ensuring that signs or indications which describe the categories of goods or services in respect of which registration is applied for remain available. Hence, this provision does not permit such signs or indications to be reserved for use by one undertaking as a result of their registration as a trade mark (see judgment of 12/02/2004, C-265/00, 'Biomild', paragraph 31).
- (24) The signs and indications referred to in Article 7(1)(c) CTMR are those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought. Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by a specific intended public.
- (25) The goods at hand are directed at professional customers (builders) as well as at the public at large (since they will also be sold at do-it-yourself stores). Given the kind of goods in question (building materials are used in connection with the construction or repair of buildings and they are usually chosen with care) the degree of attention is deemed to be higher than average. As the CTM consists of English terms, the relevant public to be taken into consideration must possess a certain command of the English language. In this respect, it should be noted that according to Article 7(2) CTMR a trade mark shall not be registered even if the grounds of non-registrability only exist

in part of the Community. Thus, an obstacle as regards the English-speaking population of the Community is sufficient to declare the CTM invalid.

- (26) Taking into account the goods concerned in the present case (*building materials*) and the specific intended public (in particular, the English-speaking part of that public), it is clear, as the applicant argues, that the word “wood”, as such, is descriptive of a type of building material. The prefix “thermo”, on the other hand, appears in several other English words and it is likely to be perceived as meaning that the goods are in some way related to heat. However, the word combination “ThermoWood” is an unusual combination with no clear meaning. It could be considered, at most, to be allusive to both wood and heat in general, but it will not be understood as referring to any specific kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods in question.
- (27) In addition, it should be noted that none of the evidence filed by the applicant refers to the time of the application for the CTM (25/08/1998) or to that of its registration (27/09/2000). In fact, the applicant itself argues that the term “thermowood” was first developed and used in Finland at the beginning of the 1990’s (presumably in Finnish) and only claims that the English term has become generic nowadays, apparently as a result of the translation of an equivalent German word. Since the current proceedings concern an application for invalidity under Article 52(1)(a) CTMR and not an application for revocation under Article 51(1)(b) CTMR, said evidence, as well as the additional arguments of the applicant about the manner in which the CTM has been used by the CTM proprietor, are considered irrelevant.
- (28) It follows from the above that the applicant has not proved that the CTM was registered contrary to Article 7(1)(c) CTMR.

Article 7(1)(b) CTMR

- (29) For a trade mark to possess a distinctive character within the meaning of Article 7(1)(b) CTMR, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings. It is also apparent from settled case-law that that distinctive character must be assessed, first, by reference to the relevant goods and, second, by reference to the perception of the relevant public (see judgment of 08/05/2008, C-304/06 P, ‘Eurohypo’, at paragraphs 66 and 67).
- (30) Whilst Articles 7(1)(b) and 7(1)(c) CTMR call for a separate examination on account of the specific public interest pursued by each ground of refusal, both grounds have a certain overlap, in particular as regards descriptive terms, which might not only designate a characteristic of the goods and services in question pursuant to Article 7(1)(c) CTMR, but for the same reason also do not serve to distinguish the goods and services as regards their commercial origin pursuant to Article 7(1)(b) CTMR. As follows from the assessment above, the CTM did not fall foul of this provision on account of a descriptive meaning.
- (31) Furthermore, the required distinctive character of a Community trade mark can also be missing where the sign in question is commonly used in connection with the marketing of the goods concerned. In this respect, the

applicant has presented no evidence that supports that the term “ThermoWood” was commonly used in the trade at the time of filing of the CTM or its registration in 1998 and 2000 respectively. As it has already been mentioned, all the evidence filed in relation with the use of said term is dated much later and cannot be considered relevant for the present proceedings.

Conclusion

- (32) It follows from the above that the request for a declaration for invalidity must be rejected.

COSTS

- (33) Pursuant to Article 85(1) CTMR and Rule 94 CTMIR, the party losing cancellation proceedings shall bear the fees and costs of the other party. The applicant, as the party losing the cancellation proceedings shall bear the costs of the CTM proprietor.
- (34) The amount of the costs to be paid by the applicant to the CTM proprietor pursuant to Article 85(6) CTMR in conjunction with Rule 94(3) CTMIR shall be: EUR 450, corresponding to representation costs.



THE CANCELLATION DIVISION

<hr/> Gianluigi Mannucci	<hr/> José A. Garrido Otaola	<hr/> Mark Jefferiss
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Notice on the availability of an appeal:

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR 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 EUR 800 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) CTMIR 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 EUR 100 (Article 2 point 30 of the Fees Regulation) has been paid.