

CRITICAL APPRAISAL OF THE RECENT CASE-LAW OF THE EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

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Abstract: *Trademark protection has a temporal and territorial character. The European Union Intellectual Property Office facilitates the protection of trademarks at the European Union's level. The present study analyzes the conditions of admissibility for the registration of a mark in case of opposition. In the elaboration of the study, we considered the European legislation in the field, the decisions and resolutions that constitute a source of law in the field. In this regard, we analyzed the recent case law of the European Union Intellectual Property Office and formulated a series of critical theses.*

Keywords: intellectual property, trademarks and inventions, trademark registration in the European Union, opposition to trademark registration

1. Introduction

In this study, we will critically address EUIPO case law in a case involving the application of legal provisions on the similarity of a trademark in the context of opposition to registration. From an argumentative point of view, the stated theses will be based on EUTMR [1] and the case law of EUIPO and the CJEU.

2. Conditions for trademark registration in the European Union. Opposition to registration

Legal persons have the right to operate under a trademark in order to differentiate themselves from other persons carrying out similar activities and to effectively promote their products and services in relation to the recipients of their services. Clearly, in order to effectively protect the legitimate interests of trade mark proprietors, trademarks must have a high degree of legal protection and differentiation from other trademarks.

In this sense, art. 8 (1), (b) EUTMR [2] provides for the likelihood of confusion of a newly established mark with that of a pre-existing mark. Obviously, the interest of the pre-existing trademark will prevail. To that end, the proprietor of the pre-existing trademark will oppose registration and, if the likelihood of confusion between the two marks is high, then the opposition will be allowed and the registration of the trademark applied for will be rejected by EUIPO.

Obviously, the likelihood of confusion cannot be assessed according to pre-established criteria as it is an abstract and relative notion. Indeed, there is a likelihood of confusion in the case of derived or identical elements, but the likelihood of confusion is assessed only in general terms between the elements which make up the trademark. The Office for Harmonization in the Internal Market (OHIM) and *Limonchello v. Limoncello* also rule in that

regard. Although there is a high degree of similarity between one of the elements, the assessment of the likelihood of confusion cannot be limited to considering only one element of the complex trademark. The comparison is made by examining all the elements of the brand, and the assessment of similarity can be made exclusively on the basis of the dominant element only if the others are negligible.

3. Criteria for assessing the existence of a likelihood of confusion

In evaluating the similarity of the two trademarks, the similarities are important, and the comparison is first done from a phonetic, then visual and finally semantic/conceptual point of view. Similarity of the trademarks is analyzed according to the criteria established by specialists in the field, on the basis of recommendations made by the CJEU experts when discussing the various infringements of intellectual property rights in court.

The global analysis of the likelihood of confusion from the point of view of visual, phonetic and conceptual similarity of the conflicting trademarks must be based on the overall impression of the trademarks, regarding to their dominant and distinctive features. It must also be borne in mind that, in order to assess the degree of similarity between the trademarks at issue, the importance of the components of those trademarks must be assessed.

The mentioned trademarks are protected in the European Union and consequently the impression these marks create upon European consumers, as well as the meaning and pronunciation of the trademark names in all EU languages relevant to this comparison are to be taken into account.

The impact of the graphic element contained in the required trademark cannot be ignored (*Decision of 13/02/2007, OHIM, no.801 524, NYTECH v SYTECH*) [2], in particular because of the design and color

used, which play an essential role in the overall impression of the conflicting trademarks (*Decision of 27.03.2007, OHIM, no. B 828568, United Cinemas vs. UCI*) [3].

The visual element of the required trademark produces a much stronger impression and prevails over the verbal elements (common letters) of the conflicting trademarks (*Decision of 12.12.2008, OHIM, no. B 118 3896, POWER ONE vs. Powercon*) [4]. We appreciate that the similarity of the common letters in the names of the trademarks is removed by their additional elements: the trademark of our mandate contains a suggestive, graphic and color figurative element, being totally distinct from the opposing trademark, which does not include any figurative elements.

As for the other elements of the trademarks, there is no visual similarity. The beginning of the trademark name is different; F, respectively W (see *Decision of 23/05/2008, OHIM, no. B 1019340, Piccolini vs. Picolisimo*) [5].

The verbal elements of WELLO and FELLO are short. As a rule, and in view of the jurisprudence in the matter, as regards trademarks with verbal elements which have relatively short names, the starting elements are much more important than the others (see *Decision of 28/03/2008, OHIM, no. B 998 478, IMPEC vs. IMPACT*) [6]. Moreover, in addition, it should be taken into account that the length of the signs may influence the effect of the differences between them. As a rule, the shorter the sign, the easier it is for consumers to perceive the singular elements it contains as differences to other trademarks (see *Decision of 31/08/2007, OHIM, no. B 972226, ISS vs. ISSE*) [7], so small differences can produce a different overall impression. Of course, in addition to these aspects, the figurative elements, the special graphics and the colors used must also be taken into account, since all of these elements clearly create a completely

different impression and image and will be perceived by consumers distinctly the earlier trademark.

From a phonetic point of view, regardless of pronunciation rules in different parts of the relevant territory, the signs have different rhythms and intonations - the previous trademark is pronounced as | FELLO | and the applied trademark | WELLO | in most of the languages spoken in the European Union, such as English, French, German, Italian, Spanish, Dutch and Portuguese.

The signs coincide in the final sound „LLO” and the differences are found in the starting sound / FE / versus / WE /, in which the letter ”F” is pronounced distinctively as consonant, while the letters WE pronounce UE, with distinct syllables. The trademarks in question will be pronounced differently as “uello” compared to the previous sign “ello”. Signs share the last letters of “ELLO”, but differ in the pronunciation of the first syllable. It follows that the beginning of the trademark applied for registration is different from that of the earlier trademark. Signs share the last letters of “ELLO”, but differ in the pronunciation of the first syllable.

Conceptually, the term FELLO in English does not mean anything, but it is used as a truncated abbreviation of the word ”FELLOW” meaning ”man or boy”, while the trademark in question or the word ”WELLO” does not make sense in all relevant languages. The word WELLO in English does not mean anything, but is used on a colloquial level with the meaning of Well hello / Wello.

We emphasize that none of the two verbal elements of the conflicting trademarks are found in English dictionaries. This shows that although one has a clear and specific meaning so that the public is able to identify the trademark due to the abbreviation of the term “fellow”, the other cannot directly mean anything. In any case, because one of the signs has no meaning,

namely “WELLO”, the signs are not conceptually similar.

In the context of this conflict, the consumer will not dissociate the different parts of the trademark. The word WELLO does not have a clear meaning and will rather be perceived as a whole and as an invented word.

The analysis of the trademarks within the meaning of Article 8 (1) (b) of the EUTMR always relates to the consumer’s perception of the trademark as well as to the products and services to which it applies having regard to the average consumer. The average consumer is the one who is reasonably well informed, alert and circumspect.

As regards the products/services, it is noted that both trademarks refer to classes (9, 35, 42) which is not self-sufficient to establish the existence of the required similarity. There are cases where products, particularly those related to information technology, have the same operating principle and are of a different nature.

The mere fact that potential customers can coincide does not automatically represent an indication of similarity. In many cases, either one or both lists of products/services are intended for the general public, but their purpose (meeting customer needs) differs in each case. Such circumstances are arguments to the detriment of similarity.

Relevant elements of product comparison include, inter alia, the nature and purpose of the goods or services, the distribution channels, the points of sale, the manufacturers, the method of use and whether they are in competition with each other or complementary to each other.

The assessment of the likelihood of confusion involves some interdependence between the relevant factors and, in particular, similarity between the trademarks and between the goods/services, respectively. Therefore, a lower degree of similarity between products/services may be offset by a greater degree of similarity between the trademarks and vice versa.

4. Conclusions

Consequently, taking into account the visual, phonetic and conceptual aspects of each trademark, it can be concluded that the trademarks are not confusingly similar, the visual / phonetic similarity, given by the verbal element, is contradicted by the phonetic and visual difference, the trademark in question being perceived as an invented word. The WELLO trademark has no meaning in most of the languages spoken in the European Union, such as English, French, German, Italian, Spanish, Dutch, Portuguese. The sign as a whole is an invented name. The existence of conceptual differences will not reinforce the

phonetic similarity between the signs that are most relevant for the purpose of distinction.

Despite the identity at the end of the signs, it can be concluded that there is no likelihood of confusion, including a risk of association, at European level. The European public is unlikely to associate the word “WELLO” with the earlier trademark “FELLO” because of these different meanings because even if they could be considered common in some Member States, they are not usually used in the European Union.

References

- [1] EU Regulation 2007/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark was published on 16 June 2017 in the Official Journal of the European Union under no. L154 / 1.
- [2] Decision of 13/02/2007, Office for Harmonisation for Internal Market, no.801 524, NYTECH v SYTECH.
- [3] Decision of 27.03.2007, Office for Harmonisation for Internal Market, no. B 828568, United Cinemas vs. UCI.
- [4] *Decision of 12.12.2008, Office for Harmonisation for Internal Market, no. B 118 3896, POWER ONE vs. Powercon.*
- [5] *Decision of 31/08/2007, Office for Harmonisation for Internal Market, no. B 972226, ISS vs. ISSE.*
- [6] Decision of 23.05.2008, Office for Harmonisation for Internal Market, no. B 1019340, Piccolini vs. Pocolisimo.
- [7] Decision of 28.03.2008, Office for Harmonisation for Internal Market, no. B 999 478, IMPEC vs. IMPACT.