

World Trademark Review Daily

CTM wins even though weak in two countries
European Union - MAQS Law Firm

Confusion

July 27 2011

In *Inter IKEA Systems BV v Office for Harmonisation in the Internal Market (OHIM)*, the General Court upheld a decision of the Second Board of Appeal of OHIM finding that there was a likelihood of confusion between GLANZ and GLÄNSA for goods in class 11, in contravention of Article 8(1)(b) of Regulation No 207/2009.

Inter IKEA Systems BV (IKEA) had applied for GLÄNSA for “apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes” in Class 11 of the Nice Classification. Meteor Controls International Ltd lodged an opposition based on its CTM registration for the word mark GLANZ, registered for identical or nearly identical goods. The OHIM Opposition Division upheld the opposition, and this decision was confirmed by the OHIM Second Board of Appeal. The board first held that, because the applicant’s mark and the opponent’s mark were CTMs, the relevant territory was the European Union. Secondly the goods in question were partially identical and partially highly similar, and the customers were average consumers. Lastly, in the light of the visual and phonetic similarities of the signs at issue, the Board of Appeal held that there was a likelihood of confusion, albeit only in one part of the territory of the European Union: in Germany and Sweden there were phonetic differences and conceptual differences and the opponent’s trademark would be considered weak, but in the rest of the European Union there were no such differences or weaknesses.

On further appeal to the General Court, IKEA argued that consumers in certain member states of the European Union would pronounce the letter ‘ä’ like the letter ‘e’, and so create a distinction. The court rejected that argument because the earlier mark upon which the opposition is founded is a CTM. For a CTM application to be refused based on an older CTM under Article 8(1)(b) of Regulation No 207/2009 it is not necessary that the likelihood of confusion must exist in all member states and in all linguistic areas of the European Union. The unitary character of the CTM means that an earlier CTM can be relied upon in opposition proceedings against any application for registration of a CTM which would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union.

Similarly, the court held that the fact that the signs at issue have a particular meaning in some languages of the European Union is irrelevant for the purposes of the conceptual comparison when the relevant territory is that of the European Union and not that of Germany or Sweden. Nor did the court find that the fact that the earlier mark has a weak distinctive character because it would be understood as meaning ‘gloss, lustre, radiance, brilliance, etc’ in Germany and Sweden would alter the conclusion.

After a rather straightforward likelihood of confusion analysis, including restating that the beginnings of marks were the most important in such analysis and the identity of goods meant that less similarity of marks was necessary for a finding of a likelihood of confusion, the court upheld the opposition and rejected IKEA’s application.

This case is in conformity with recent trends in CTM practice giving strength to relatively weak mark elements, confirming that the CTM is, generally speaking, opponent-friendly.

Peter Gustav Olson, MAQS Law Firm, Copenhagen

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.