

# World Trademark Review Daily

**Conceptual similarity requiring translation insufficient to create likelihood of confusion**

**European Union - MAQS Law Firm**

**Examination/opposition  
International procedures**

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In *Golden Balls Ltd v Office for Harmonisation in the Internal Market* (OHIM) (Cases [T-437/11](#) and [T-448/11](#), September 16 2013), the General Court has partially annulled decisions of the First Board of Appeal of OHIM in which the latter had found that there was a likelihood of confusion between the marks GOLDEN BALLS and BALLON D'OR. The court held that the relevant public, in particular francophone consumers, would not find the marks confusingly similar.

In 2007 applicant Golden Balls Ltd filed two separate Community trademark (CTM) applications for registration of the word mark GOLDEN BALLS. The first application covered goods and services in Classes 9, 28 and 41, and the second application covered goods in Classes 16, 21 and 24 of the [Nice Classification](#).

Intra-Pressé lodged oppositions against these applications on the basis of its earlier CTM registration for the word mark BALLON D'OR (French for 'ball of gold'), which was registered in 2006 for a broad list of goods and services in Classes 9, 14, 16, 18, 25, 28, 38 and 41. The grounds relied on in support of the oppositions were those set forth in Article 8(1)(b) of the [Community Trademark Regulation](#) (207/2009) (likelihood of confusion) and Article 8(5) (well-known marks).

The Opposition Division of OHIM rejected both oppositions in their entirety, stating:

*"[T]he goods and services covered by the signs at issue were partially identical and partially different. The signs were visually and phonetically different and were slightly similar conceptually for a section of the relevant public. As the signs were globally dissimilar, there was no likelihood of confusion between the signs under Article 8(1)(b) of Regulation No 207/2009. Regarding the ground concerning the reputation of the earlier mark, as the signs were different, Article 8(5) of Regulation No 207/2009 was not applicable".*

On appeal, Intra-Pressé was partially successful before the First Board of Appeal of OHIM. The board upheld the appeal against the first application for the identical goods in Class 16, but rejected it for Classes 21 and 24 (dissimilar goods). As regards the second opposition, the same board also upheld the appeal for the identical goods/services, that is all goods and services in Classes 9, 28 and 41, with the exception of "apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity" in Class 9.

With regard to the comparison of the signs, the board held that they were visually and phonetically different. However, unlike the Opposition Division, the board found that the marks at issue were identical conceptually or, "at the least", were conceptually extremely similar, and concluded that there was a likelihood of confusion or association between the signs in respect of the identical goods and services. The board deemed it unnecessary to consider the plea under Article 8(5).

Golden Balls appealed to the General Court, requesting that it:

- annul the contested decisions as regards the goods and services in Classes 16 (Case T-437/11) and 9, 28 and 41 (Case T-448/11); and
- order OHIM or, in the alternative, Intra-Pressé, to pay the costs.

OHIM and Intra-Pressé requested that the court dismiss the action in its entirety and order Golden Balls to pay the costs. Intra-Pressé also asked the court to reverse the contested decisions insofar as they rejected its opposition with regard to Classes 21 and 24 (Case T-437/11) and Class 9 (Case T-448/11).

Golden Balls based its claim before the court on a single plea, namely infringement of Article 8(1)(b) of the Community Trademark Regulation. In both cases, Golden Balls contested the conclusions of the First Board of Appeal as regards the likelihood of confusion between the goods and services in the relevant classes.

The General Court first noted that it could not be ruled out that a mere conceptual similarity between two marks can create a likelihood of confusion where the goods are similar, if the earlier mark has a high distinctive character. However, here there was only a very weak conceptual similarity, requiring prior translation. This is because GOLDEN BALLS is distinct from BALLON D'OR by the use of the plural. It concerned a basic grammatical point which is also capable of being understood and perceived by the

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francophone public, particularly because the plural of words is formed in the same way in English and in French, namely with an 's'. Accordingly, an average consumer, in particular, a francophone consumer who will have a limited knowledge of English but one which is sufficient to understand the words 'golden' and 'balls', would also notice the use of the plural.

Therefore, the court held that the Board of Appeal was wrong to find that there was a likelihood of confusion on the part of the relevant public for the identical goods covered by the signs at issue. Due to the fact that the signs are in different languages, a manifest distinction was created between them so that the average consumer would not immediately associate them without undergoing an intellectual process of translation. Accordingly, the court agreed with Golden Balls and reversed the decisions of the Board of Appeal.

Intra-Pressé had also put forward an independent counterclaim alleging infringement of Articles 8(5), 64(1) and 76(1) of the Community Trademark Regulation, claiming that the board ought to have addressed the issue under Article 8(5) and that such omission constituted an infringement of an essential procedural requirement and an error in law.

The court noted that:

*"by its application to dismiss the applicant's application and to annul the contested decision insofar as it rejected [Intra-Pressé's] opposition directed against the registration of the mark applied for with regard to the [non-identical] goods, [Intra-Pressé] is making use of the opportunity afforded to it by Article 134(3) of the Rules of Procedure to seek, in its response, a form of order annulling the contested decision on a point not raised in the application".*

As regards the merits of the counterclaim, the court held that the board's failure to carry out a new, full examination of the merits of the opposition, in terms of both law and fact, and to rule on each of the heads of claim submitted for its consideration in its entirety, either by upholding it, rejecting it as inadmissible or rejecting it on substantive grounds, would be an infringement of an essential procedural requirement. However, there was no harm, due to the lack of similarity of the marks, as in the present case:

*"[t]he opposition[s] had, in any event, to be rejected in [their] entirety since both a likelihood of confusion within the meaning of Article 8(1)(b) and a likelihood of a link for the purposes of Article 8(5) of Regulation No 207/2009 were lacking." (Paragraph 73, Cases T-437/11 and T-448/11; emphasis added)*

Accordingly, the counterclaim was rejected.

These cases reveal several interesting aspects of CTM practice. First, the General Court overrules Board of Appeal decisions in favour of the opponent only in very rare instances. Second, conceptual similarity based on translation alone is not likely to be sufficient for a finding of likelihood of confusion, in particular if there are any grammatical differences, such as a plural. As regards the rejection of the counterclaim, one can query whether no harm was done at the Board of Appeal's stage, because the board rejected the opposition for the non-identical goods, which is precisely where Article 8(5) is relevant.

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