

EU General Court finds two D designs to be similar
European Union - NJORD

Examination/opposition
Confusion

October 25 2017

- Diesel SpA opposed Sprinter's registration of figurative 'D' mark
- Court noted that phonetic and conceptual comparison led to finding of similarity
- Case sent back to EUIPO Board of Appeal to address proof of use

In *Diesel SpA v EU Intellectual Property Office (EUIPO)* (Case T-521/15, July 20 2017), the EU General Court annulled an EUIPO Second Board of Appeal decision which had found that the earlier mark of Diesel SpA and the mark applied for by Sprinter megacentros del deporte, SL were not confusingly similar.

The case began when Sprinter filed an application to register an EU trademark for a list of goods in Classes 18, 25 and 28 of the Nice Classification for the following figurative sign:



Diesel SpA lodged an opposition based on its rights under Article 8(1)(b) of the EU Trademark Regulation for the following European trademark, which covered a broad list of goods in Classes 18 and 25:



The EUIPO Opposition Division rejected the opposition due to lack of similarity between the marks. Diesel SpA appealed and the EUIPO Second Board of Appeal dismissed the appeal, finding that, given the differences between the signs at issue, there was no likelihood of confusion, in particular because the majority of the relevant public would find that the applied-for mark was the letter 'D'. Because both the opposition division and the board of appeal found no similarity between the marks, neither instance examined the opponent's proof of use.

Diesel appealed further to the EU General Court, which reversed the decision and sent it back to the EUIPO Board of Appeal.

While the EUIPO Board of Appeal found that the mark applied for by Sprinter represented a basic geometrical shape, the EU General Court disagreed and stated that both signs were capable of being perceived by a significant part of the relevant public as the letter D. In this regard the court noted that in defence of a third party opposition, Sprinter had itself referred to the mark as the letter D. The court further found that the similarities between the visual characteristics of the marks outweighed the differences, irrespective of the public perception of the sign applied for as the letter D.

The court noted that both the phonetic and conceptual comparison of the signs led to the finding of similarity, since both signs referred to the same letter of the alphabet.

The court stated that, given the undisputed identity of the goods, the marks as a whole were of a significant visual similarity, and phonetically and conceptually identical. The court therefore concluded that there was a likelihood of confusion between the signs in respect of the goods concerned.

The argument brought forward by Sprinter, namely that Diesel had sought to monopolise the letter D, was dismissed by the court, as was the argument of the board of appeal that even if parts of the public may perceive both marks at issue as the letter D, it was important to not give excessive weight to weak mark elements, which coincide only because of the generic elements of the letter. The EU General Court found

that the purpose of the opposition was to prevent a likelihood of confusion with an earlier trademark and not to prevent a mark from being registered simply because it represented the letter D. Accordingly, the case was sent back to the EUIPO Board of Appeal to address the proof of use issue.

Comment

This case is interesting because it again demonstrates the EU General Court's willingness to grant relatively broad rights in relatively weak mark elements, and even to overrule the EUIPO Board of Appeal's decision in this regard. Even though every single stylistic element of the marks apart from the nature of the letter D was found to be different, according to the court this was not enough to outweigh the similarities.

Peter Gustav Olson, NJORD 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.