

General Court confirms that SYMPATHY INSIDE and INSIDE. are similar

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Legal updates: case law analysis and intelligence

- The EUIPO found that there was a likelihood of confusion between SYMPATHY INSIDE and the earlier mark INSIDE. in Classes 25 and 35
- The General Court confirmed that genuine use of the earlier mark had been proven, finding that the omission of the full stop in the mark as used did not alter its distinctive character
- The relevant Spanish public would not understand the concept of 'inside', and neither 'sympathy' nor 'inside' was dominant in the mark applied for

In its decision of 8 March 2023 in [Sympatex Technologies GmbH v European Union Intellectual Property Office](#) (EUIPO) (Case T-372/21), the General Court has upheld a decision of the Board of Appeal of the EUIPO finding that there was a likelihood of confusion between INSIDE. and SYMPATHY INSIDE.

Background

Sympatex Technologies GmbH filed an EUTM application for the word mark SYMPATHY INSIDE for a broad list of goods in Class 25, and retailing of a broad list of goods, including clothing and accessories, in Class 35. Liwe Española SA lodged an opposition against SYMPATHY INSIDE on the basis of an earlier EUTM for the word mark INSIDE. (*sic*). The INSIDE. registration covered a broad list of goods and services in Classes 25 and 35, and was more than five years old.

Sympatex demanded proof of use, and Liwe Española filed evidence which the Opposition Division of the EUIPO found sufficient to prove use of the INSIDE. mark. The Opposition Division went on to partially uphold the opposition, finding a likelihood of confusion in relation to the following goods/services covered by SYMPATHY INSIDE:

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- Class 25: clothes - articles; footwear; headgear; gloves [clothing]; outwear; clothing.
- Class 35: "retailing and wholesaling and online and catalogue mail order sales in the fields of knitwear, textile goods, coated textile goods, laminated textile goods, clothing, footwear, headgear, gloves, outer-clothing, items of clothing."

Sympatex appealed, but the Board of Appeal of the EUIPO upheld the decision of the Opposition Division.

Sympatex appealed further to the General Court, but did not fare better.

General Court decision

Sympatex's first claim was that Liwe Española's proof of genuine use was insufficient. This was because Liwe Española's registration was for INSIDE., but the documentation provided was for the following figurative marks:



The court held that, although some of the proof of use included the above figurative marks, there was ample evidence of use of the word mark alone, albeit without the full stop. The differences, including the absence of the full stop, did not alter the distinctive character of the mark as registered. The court thus accepted the proffered evidence of use.

Next, Sympatex challenged the time and extent of the use, pointing out, among other things, that some of the evidence was undated. The court noted that Sympatex had not raised this argument in the first appeal, but nevertheless reviewed the evidence. The court concluded that the Board of Appeal had properly addressed these issues with reference to the decision of the Opposition Division.

Finally, Sympatex challenged the finding that there was similarity between the marks and a likelihood of confusion. Here, the court held that the relevant Spanish public would not understand the concept of 'inside', and that neither 'sympathy' nor 'inside' was the dominant element in the mark applied for. Further, the court found that the opponent's mark had a reputation and enjoyed enhanced distinctiveness. In conclusion, there was a likelihood of confusion.

Comment

This case is interesting for several reasons. First, it shows that the EUTM tribunals are relatively opponent-friendly when faced with English-language marks, in that conceptual (dis)similarity will play a minor role. The case also shows that it is important to criticise all aspects of an opponent's proof of use at first instance and before the Board of Appeal of the EUIPO.

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