

General Court: no likelihood of confusion between marks consisting of same two letters in different order
European Union - Grau & Angulo

**Examination/opposition
International procedures**

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- **Court found no likelihood of confusion between figurative mark EW and word mark WE**
- **Rights over earlier mark did not grant unjustified monopoly over letters 'w' and 'e'**
- **Differences between short signs will draw relevant public's attention**

In *El Corte Inglés SA v EU Intellectual Property Office* (EUIPO) (Case T-241/16, May 4 2018), the General Court has annulled the decision of the Second Board of Appeal of the EUIPO, thereby allowing the registration of the EU figurative mark EW.

Background

Spanish company El Corte Inglés SA (hereinafter 'ECI') filed an application for registration of the EU figurative mark EW for goods in Classes 3 (soaps and perfumery, among other things), 18 (leather and walking sticks, among other things) and 25 (clothing, among other things):



The application was the subject of an opposition filed by Luxembourg company WE Brand Sàrl, alleging infringement of Articles 8(1)(b) and 8(5) of [Regulation 207/2009](#), based on the earlier EU word mark WE (No 7209571) covering, among other things, goods in Classes 3, 18 and 25.

The Opposition Division of the EUIPO granted the opposition in respect of all the goods, (except for "walking sticks" in Class 18). ECI filed a writ of appeal against this decision. ECI's appeal was rejected by the Second Board of Appeal of the EUIPO, which considered that there was a likelihood of confusion between the mark applied for and the earlier mark on the part of the relevant public, namely the average Italian and Spanish-speaking consumers.

ECI then brought an action before the General Court, seeking the annulment of the board's decision by alleging infringement of Article 8(1)(b) of Regulation 207/2009.

General Court decision

The General Court annulled the board's decision by applying the following reasoning.

Relevant public

The General Court considered that the Board of Appeal had not erred in deciding to assess the likelihood of confusion between the signs at issue with regard to the Italian and Spanish-speaking publics in the European Union, since it is sufficient that a relative ground for refusal exists in one part of the European Union.

Comparison of the signs

Visual comparison

The court pointed out that there is nothing to prevent a determination as to whether there is any visual similarity between a word mark and a figurative mark. Nevertheless, the court stated that the mere presence of the same two letters in the signs at issue cannot be sufficient to conclude that there is an average degree of visual similarity. Furthermore, the court stated that, when faced with short signs, the relevant public is likely to perceive the differences between them more clearly.

Taking the above into account, the court concluded that there was a low degree of visual similarity between

the signs at issue, firstly because the letters that form the signs are not arranged in the same order and, secondly, because the mark applied for has an interconnection in the upper part of the letters which reinforces the impression that the mark forms a single syllable and an indivisible whole.

Phonetic comparison

The court held that the signs at issue were phonetically similar to a low degree, or even different for the part of the relevant public with a knowledge of English, since they will be pronounced differently, especially taking into account the fact that the mark applied for begins with a vowel while the earlier mark begins with a consonant.

Conceptual comparison

The court concluded that the conceptual comparison was neutral as far as the part of the Italian and Spanish-speaking publics with no knowledge of English was concerned. However, for the part of those publics which does have a knowledge of English, the signs are not similar conceptually, since the earlier mark refers to the personal pronoun of the first person plural, while the mark applied for does not have any meaning.

In addition, the court stated that the fact that the signs are understood as abbreviations did not, on its own, make it possible to ascertain whether there is any conceptual similarity or difference between those signs.

Likelihood of confusion

The court considered that the inherent distinctive character of the earlier mark was normal with regard to the goods at issue, since the relevant public would not make an immediate and direct link between the earlier mark and those goods. In addition, the court stated that the rights over the earlier mark could not grant WE Brand Sàrl an unjustified monopoly over the two letters 'w' and 'e'. Furthermore, the court held that the signs are short and, therefore, the differences between them would draw the attention of the relevant public. Additionally, as opposed to the earlier mark, the interconnection between the letters 'e' and 'w' conferred unity to the mark applied for.

Having stated the above, the court considered that the overall impression made on the relevant public by the signs at issue was incapable of giving rise to a likelihood of confusion, even though the goods at issue were identical or similar.

In conclusion, the court upheld the only plea filed by ECI, considering that the Board of Appeal had erred in finding there was a likelihood of confusion between the marks.

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