

You are in preview mode

DISABLE PREVIEW MODE

24 Apr
2019

General Court: common figurative elements will make an impression on consumers, despite their weak distinctive character

European Union - [Grau & Angulo](#)

- DPG opposed registration of mark representing bottle and arrow in Classes 35, 40 and 42 based on earlier mark representing can, bottle and arrow in same classes
- Board of Appeal found that likelihood of confusion could not be excluded
- General Court agreed, finding that common figurative elements were likely to be remembered by consumers, even though they had weak distinctive character

In [Užstato sistemos administratorius VŠĮ v EUIPO](#) (Case T-477/18, 11 April 2019), the General Court (Ninth Chamber) has dismissed an appeal filed by Užstato sistemos administratorius VŠĮ and upheld the decision of the Second Board of Appeal of the EUIPO confirming that the EU trademark No 14.481.519 could not be registered due to a likelihood of confusion with the earlier EU trademark No 4.564.993.

Background

On 17 August 2015 Užstato filed an application for the registration of the EU trademark No 14.481.519, depicted below, for services in Classes 35, 40 and 42 (all related to recycling).



On 15 February 2016 DPG Deutsche Pfandsystem GmbH filed a notice of opposition based on the earlier EU trademark No 4.564.993, depicted below, for the same services in Classes 35, 40 and 42, arguing that

there was a likelihood of confusion under Article 8(1)(b) of [Regulation 207/2009](#) (now [Regulation 2017/1001](#)).



On 21 August 2017 the Opposition Division rejected the opposition on the ground that there was no likelihood of confusion. On 12 October 2017 DPG filed a notice of appeal against the Opposition Division's decision. On 22 May 2018 the Second Board of Appeal annulled the decision of the Opposition Division.

Užstato appealed to the General Court, alleging infringement of Article 8(1)(b) of Regulation 2017/1001.

General Court decision

Having reviewed the relevant legislation and case law, the General Court confirmed the decision of the Board of Appeal that a likelihood of confusion could not be excluded on the basis that the signs at issue produced a different overall impression, on the following grounds:

- The relevant territory for assessing the likelihood of confusion was the whole of the European Union (this was not disputed by the parties).
- The relevant public for assessing the likelihood of confusion was the public at large, but mainly "business customers with specific professional knowledge or expertise in the fields of treatment and waste recycling, advertisement, technological consultation and public relations" (this was not disputed by the parties).
- The elements making up the earlier EU trademark were symbols commonly used to refer to recycling; therefore, they had a weak distinctive character in respect of the services in Classes 35, 40 and 42 (this was not disputed by the parties).
- The distinctive and dominant elements of the signs at issue were the arrow and the bottle. Despite having a weak distinctive character, the arrow and the bottle would likely be remembered by the consumers due to their position and size, even though the can (in the earlier EU trademark) and the frame (in the EU trademark application) were not insignificant.
- The signs at issue had an average degree of visual similarity, in spite of a number of visual differences between them (eg, the can, the frame and the shape of the arrow).
- It was not possible to compare the two signs phonetically, as they were figurative trademarks without any words.
- The signs at issue had an average degree of conceptual similarity, as they both consisted of a bottle and a curved arrow pointing to the left in connection with recycling.

In light of the above, the General Court considered that, even though the earlier trademark had a weak distinctive character and the trademark application was not a complete reproduction of it, there might be

a likelihood of confusion given that the signs were visually and conceptually similar and covered identical services.

The General Court highlighted that that conclusion could not be called into question by the fact that “business customers with specific professional knowledge or expertise” may focus on the differences, since the relevant public also included the public at large and the public having the lowest level of attention must also be taken into consideration.

Consequently, the General Court found that the Board of Appeal had not erred in finding that there was a likelihood of confusion, dismissed UŽstato’s appeal and ordered it to pay the costs.

Guillem Villaescusa

Grau & Angulo

TAGS

[Portfolio Management](#), [Enforcement and Litigation](#), [Consumer Goods](#), [European Union](#), [Europe](#)