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A tale of two cornets: General Court confirms lack of likelihood of confusion

European Union - Dr Helen G Papaconstantinou and Partners Law Firm

Examination/opposition
Confusion
International procedures

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- **Court confirmed lack of likelihood of confusion between figurative marks BOBO CORNET and OZMO CORNET**
- **Figure of rabbit holding ice cream cornet was dominant element of BOBO CORNET mark**
- **Difference in figurative elements and lack of meaning of 'bobo' and 'ozmo' resulted in there being no conceptual similarity**

In *Şölen Çikolata Gida Sanayi ve Tikaret AŞ v Elka Zaharieva and the European Union Intellectual Property Office* (EUIPO) (Case T-648/16, April 2018) – which concerned an opposition to the registration of a figurative sign (see Figure 1) as an EU trademark – the General Court upheld a rejection from the EUIPO Fourth Board of Appeal relating to the opposition proceedings between the parties.

In 2013 Elka Zakharieva applied to the EUIPO to register the figurative mark BOBO CORNET to cover goods in Classes 29, 30 and 32 of the Nice Classification.

Turkish company Şölen Çikolata Gida Sanayi ve Tikaret AŞ opposed the registration, claiming that it contravened Article 8(1)(b) of the EU Trademark Regulation.

The opposition was based on Şölen's earlier international mark (No 1148957) for the figurative mark OZMO CORNET, which covers goods in Class 30 of the Nice Classification and is effective in 18 EU member states.

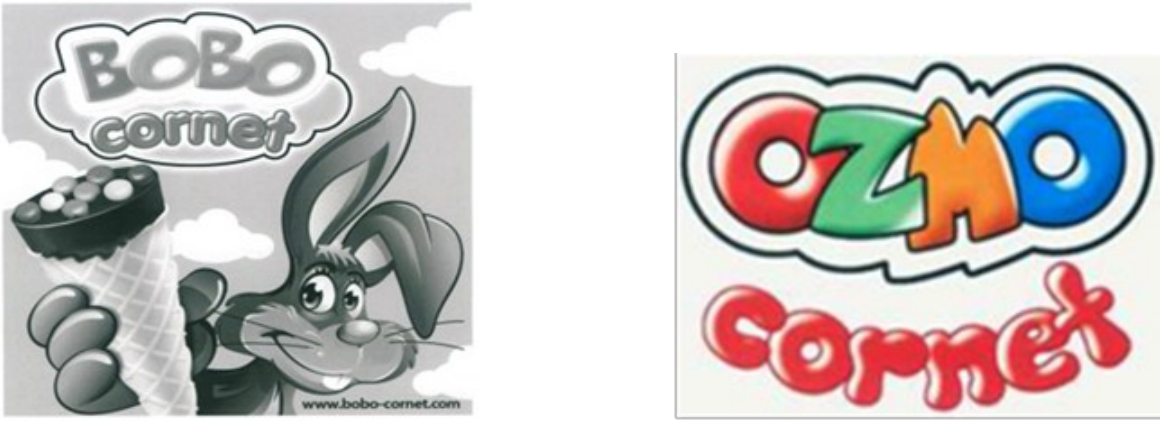

Figure 1. Contested design (left) and earlier mark (right)

The EUIPO Opposition Division rejected the opposition in its entirety.

Following the applicant's appeal, the Board of Appeal confirmed the Opposition Division's decision and dismissed the action.

The applicant brought the case before the General Court, complaining that the board had erred with respect to:

- the comparison of goods;
- the visual, phonetical and conceptual comparison of the marks; and
- the likelihood of confusion between the marks.

The General Court confirmed the board's findings that the relevant territory was the 18 EU member states where the applicant's earlier international mark was effective and that the goods in question were everyday consumer goods directed at the general consumers with an average attention span.

Upon comparing the signs, the General Court confirmed the board's finding that the figure of a rabbit holding an ice cream cornet in the applied-for mark was a particularly striking feature and was therefore its dominating

element.

Regarding the verbal elements of the conflicting marks, the General Court held that, as the Board of Appeal had found, the words ‘bobo’ and ‘ozmo’ were visually more important than the common word ‘cornet’; however, the vowel ‘o’ that the words ‘bobo’ and ‘ozmo’ shared was insufficient to eliminate their visual dissimilarity.

Responding to the applicant’s argument that the Board of Appeal had erred by not considering that the verbal elements of a mark are likely to be more distinctive than the figurative elements, the General Court referred to established case law confirming that the characteristics of a figurative element can either contribute visually to the overall impression of the mark or be said mark’s dominant element. Therefore, it rejected the applicant’s argument that the expression ‘bobo cornet’ was the dominant element of the contested mark.

Regarding the phonetic comparison of the signs, the General Court confirmed, contrary to the applicant’s relevant argument, that the board was correct to attribute more weight to the initial word of each verbal element, because the phonetic impact of the words ‘bobo’ and ‘ozmo’ among the relevant public would be greater than that of the word ‘cornet’. The General Court stressed that, since the two words constituting the verbal part of the two marks form a relatively long combination (ie, the second word of each being the descriptive word ‘cornet’), consumers are more likely to use only the words ‘bobo’ and ‘ozmo’ when purchasing the goods.

Turning to the conceptual comparison of the marks, the General Court agreed with the board that the difference in the figurative elements and the fact that the words ‘bobo’ and ‘ozmo’ had no meaning resulted in there being no conceptual similarity between the two marks.

Regarding the word ‘cornet’, the General Court commented that consumers for which it is meaningless would consider the marks as a whole as conceptually dissimilar, while consumers who understand the word would regard it as descriptive.

Contrary to the applicant’s allegation, the General Court confirmed the EUIPO’s observation that, on assessing the degree of conceptual similarity, the descriptive and potentially descriptive character of the elements that the conflicting marks have in common depend on the goods or services concerned.

Therefore, the General Court held that in this case, the dominant character of the figure of the rabbit in the contested mark and the absence of a comparable element in the opposing mark in combination with the lack of any concept conveyed by the words ‘bobo’ and ‘ozmo’, as well as the non-distinctive character of the descriptive word ‘cornet’, result in the lack of even a low degree of conceptual similarity.

Given the lack of any visual or conceptual similarity and the low degree of phonetic similarity between the marks, the General Court confirmed the Board of Appeal’s findings and observed that the global assessment as to the likelihood of confusion would remain the same even if the goods covered by the two marks were identical. The low degree of similarity between the marks was stressed because the common element ‘cornet’ was overshadowed by the elements that differentiated the marks.

The General Court dismissed the action and allowed the contested mark to proceed to registration.

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