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General Court provides guidance on proof of enhanced distinctiveness

European Union - Dr Helen G Papaconstantinou and Partners Law Firm

- **Papadopoulos opposed the registration of a figurative sign containing the element 'caprice' based on the earlier figurative sign CAPRICE**
- **The Board of Appeal rejected the opposition, finding, among other things, that Papadopoulos had failed to show that its mark possessed any degree of enhanced distinctiveness**
- **The General Court agreed that evidence concerning the volume of sales and advertising expenditures is not direct evidence of a mark's high level of distinctiveness as a result of the public's recognition**

In ***Viomichania mpiskoton kai eidon diatrofis El Papadopoulos SA v European Union Intellectual Property Office*** (EUIPO) (Case T-628/18, 17 October 2019), the Eighth Chamber of the General Court has upheld a decision of the Fifth Board of Appeal of the EUIPO rejecting an opposition against the registration of a figurative mark containing the element 'caprice'.

Background

In 2014 Spanish company Europastry SA applied to the EUIPO for the registration of the figurative sign FRIPAN VIENNOISERIE CAPRICE PUR BEURRE (depicted below) to cover "flour and preparations made from cereals, bread, pastry and confectionery (- all frozen)" in Class 30.

Greek company Viomichania mpiskoton kai eidon diatrofis EI Papadopoulos SA ('Papadopoulos') opposed the registration, alleging infringement of Article 8(1)(b) of Regulation 207/2009 (now Regulation 2017/1001). The opposition was based on the earlier figurative sign CAPRICE (EUTM registration No 5386289, depicted below) covering "stuffed wafers in the form of cigarillos" in Class 30.

The Opposition Division rejected the opposition.

Finding that said decision contained substantial errors and procedural errors concerning the assessment of proof of genuine use of the earlier mark, as well as concerning the question of whether the evidence produced proved that mark's enhanced distinctiveness, the Fifth Board of Appeal of the EUIPO annulled the decision in its entirely and remitted the case to the Opposition Division.

After re-examining the case, the Opposition Division again rejected the opposition. It opined that, although the evidence showed genuine use of the earlier mark, it was not sufficient to prove its enhanced distinctiveness. Further, there was no likelihood of confusion, since, despite the fact that the goods were identical and similar, the signs at issue were phonetically dissimilar and presented limited visual and conceptual similarities.

Papadopoulos appealed to the Board of Appeal, which dismissed the appeal, finding, among other things, that:

- while Papadopoulos had submitted evidence, including a sworn affidavit by its sales department director, to show genuine use of the earlier mark, it had failed to show that its mark possessed any degree of enhanced distinctiveness; and
- the differences between the marks were overwhelming: the common word element 'caprice' was not sufficient to cause a likelihood of confusion, while the distinctive and dominant feature of the contested mark was the word element 'fripan'.

Papadopoulos appealed to the General Court.

General Court decision

The General Court confirmed the findings of the Board of Appeal concerning the existence of very limited similarities between the marks at the visual, phonetical and conceptual level, and agreed that the word 'fripan' was the dominant element of the contested mark. The court further stressed that Papadopoulos' allegation that the word 'caprice' had an independent distinctive role could not be accepted: pursuant to relevant case law, the application of such notion presupposes that the earlier trademark is contained in the mark applied for. In this case, however, the earlier mark comprised a figurative element that was not contained in the contested mark.

Turning to the likelihood of confusion, the court held as follows, among other things:

- Given the dominant position of the word 'fripan' in the contested mark and the numerous differences between the signs at issue, the mere semantic concordance produced by the common word 'caprice' was not sufficient to cause confusion to the relevant public.
- Papadopoulos' allegation that the Spanish company intended to cause a likelihood of confusion by attempting to register the mark shown below was ineffective, since a) the examination did not concern this mark, but the contested mark as registered, and b) bad faith is not an accepted ground of opposition.

- Although the interdependence between the public recognition of a mark and its distinctive character was acknowledged, a high degree of recognition within the relevant section of the public does not necessarily mean that a mark enjoys a reputation within the meaning of Article 8(5) of the regulation.

Within this context, the General Court commented on the evidentiary material submitted by Papadopoulos to demonstrate the alleged enhanced distinctive character of the earlier mark. The court agreed with the Board of Appeal that, although the evidence submitted (eg, invoices, emails from distributors, studies, details of advertising expenses, volumes of sales, awards certificates and promotional photographs) was sporadic, selected at random and in a disorganised manner, it was sufficient to prove genuine use. However, it did not prove enhanced distinctiveness. The court stated that any declaration drawn up in the interests of its author must be supported by additional objective evidence in order to have evidential value. Such evidence could be information on the market share held by the mark or independent statements from chambers of commerce. With that in mind, the court considered that the affidavit of Papadopoulos' sales department director was insufficient proof: it was subjective evidence that was only partially supported by objective material such as advertising expenditures in certain countries and invoices showing sales figures in others. The General Court agreed with the board that evidence concerning the volume of sales and advertising expenditures does not form direct evidence of a mark's high level of distinctiveness as a result of the public's recognition.

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

Maria Athanassiadou

Dr Helen G Papaconstantinou and Partners, Law Firm

TAGS

Enforcement and Litigation, **Food and Beverage**, **European Union**, **Europe**