

European Union - Dr Helen G Papaconstantinou - John V Filias & Associates

In *Trapeza Probank AE, also trading as Probank AE v Probanka dd* (Opposition B 1 144 817, April 12 2010), the Opposition Division of the Office for Harmonization in the Internal Market has upheld, in part, an opposition against the registration of the trademark PROBANKA.

Slovenian company Probanka dd applied for the registration of the mark PROBANKA (and design) as a Community trademark for goods and services in Classes 9, 35 and 36 of the Nice Classification. Greek company Probank AE filed an opposition based on its earlier Greek trademark ΤΡΑΠΕΖΑ PROBANK PROBANK for goods and services in Classes 9 and 36. The opposition was directed at some of the goods and services in Classes 9 and 36. Probank mainly argued that there was a likelihood of confusion between the marks due to:

- their high degree of similarity (since the most distinctive element of the marks was practically identical); and
- the fact that the goods and services at issue were either identical or highly similar.

In response, Probanka argued that Probank:

- had not translated all the elements in the registration certificate of the earlier Greek mark; and
- had not represented the earlier mark correctly, having omitted to repeat the second 'Probank'.

The Opposition Division rejected these two arguments, stating as follows:

- The element that had not been translated would be translated as 'word mark'. Such information was self-evident from the representation of the mark.
- The second 'Probank' was missing because of a typographical error.

When comparing the goods and services concerned, the Opposition Division focused on the nature of the goods, their purpose and method of use, as well as

whether they were complementary. It specifically held that the contested goods in Class 9 ("identity cards, magnetic; integrated circuit cards [smart cards]") were of the same nature as the goods protected by the earlier mark. Despite the fact that they might differ in their exact purpose, they were all manufactured and put on the market by the same companies, and could even, at times, be considered complementary. The Opposition Division pointed out that a "banking card" could be considered as "data media". The only difference between the goods covered by the two marks was that Probank's goods were "electronic", whereas Probanka's goods were "magnetic". As for the rest of the goods in Class 9, the Opposition Division found that they were dissimilar.

Regarding the services in Class 36, the Opposition Division held that all the services covered by the application that related to monetary, financial and banking affairs were identical to Probank's Class 36 services. The Opposition Division further held that, although insurance services were different from the services usually provided by a bank (ie, providing credit, asset management and credit card services, financial evaluation, or stocks and bonds brokerage), "insurance services" and "banking services" did have some similarities:

- they have a similar nature;
- they may be provided by the same or related undertakings;
- they are distributed through the same channels; and
- they are used in combination with each other.

As for the "real estate activities" covered by the contested mark, the Opposition Division found that they were different from the monetary, financial and banking services protected by the earlier mark, since they had a different purpose and the common trend in the market was that they had a different commercial origin. The Opposition Division also found that "charity contributions" and "customs intermediations" were different from Probank's services.

Turning to the comparison of the signs, the Opposition Division held that the marks coincided in seven out of eight letters and differed only as to:

- the last letter of the contested mark;
- the Greek word 'τραπεζα';
- the duplication of the word 'Probank'; and

- the figurative element of the contested mark.

From a phonetic point of view, the marks were found to be similar as to the pronunciation of the word elements 'Probank' and 'Probanka', but dissimilar as to the pronunciation of the word 'τραπεζα'. From a conceptual point of view, the Opposition Division pointed out that 'τραπεζα' was the Greek word for 'bank'. It further stated that the relevant public would understand the English term 'bank' in the earlier mark, as well as the element 'banka' in the contested mark. The Opposition Division further held that the prefix 'pro' would be understood in a number of ways (eg, 'professional'). Thus, it concluded that there was a semantic link between the marks.

Turning to the global assessment of the marks, the Opposition Division held that, in view of the fact that the goods and services at issue targeted both average consumers and specialists in the field of insurance and finance, the level of attention of the public would vary - it would be lower in relation to electronic banking cards than in relation to certain financial services (eg, the issuing of money market securities). Regarding the distinctive character of the earlier mark, the Opposition Division found that the term 'τραπεζα' was descriptive of the banking and financial services due to its meaning. Thus, it found that the words 'probank' and 'probanka', although not completely distinctive for the goods and services in Classes 9 and 36, were more distinctive than 'τραπεζα', since they consisted of a combination of words that could be understood as 'professional' and 'bank'. As to the figurative element of the contested mark, the Opposition Division found that it was not particularly striking, since it consisted of an unremarkable combination of colours and a not-so-imaginative geometric figure.

Consequently, the Opposition Division concluded that consumers would connect the marks through their most distinctive parts, 'probank' and 'probanka', and would attribute the same commercial origin to the goods and services, or think that they originated from economically linked enterprises. Therefore, the Opposition Division upheld the opposition with regard to "identity cards, magnetic; integrated circuit cards [smart cards]; magnetic data media" in Class 9 and all services related to monetary, financial and banking affairs in Class 36.

Maria Athanassiadou, Dr Helen Papaconstantinou, John Filias & Associates, Athens

