

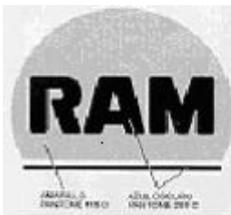
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Applicant could foresee that Board of Appeal would base assessment on different mark **Examination/opposition International procedures**
European Union - Casalunga & Associés

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In *Lidl Stiftung & Co KG v Office for Harmonisation in the Internal Market* (OHIM) (Case T-237/11, January 15 2013), the General Court has dismissed an appeal against a decision of the Fourth Board of Appeal of OHIM in which the latter had confirmed a decision of the Opposition Division upholding the opposition filed by *Lactimilk SA* against the application for BELLRAM on the basis of the following prior marks:

- Spanish registration No 2414439 ('the first earlier figurative mark') for products in Class 29 of the [Nice Classification](#):



- Spanish registration No 98550 ('the second earlier figurative mark') for goods in Class 29:



- Spanish registration No 151890 for the word mark RAM in connection with products in Class 29.

On August 31 2009 the Opposition Division upheld Lactimilk's opposition, solely on the basis of a comparison between the mark applied for and the first earlier figurative mark. With regard to the comparison of the goods, the Opposition Division considered that they were identical. With regard to the comparison of the signs, the Opposition Division first observed that there was a medium degree of visual and phonetic similarity between them. Second, it observed that neither of the signs had a particular conceptual meaning in Spanish. Taking account of the average distinctiveness of the first earlier figurative mark, the Opposition Division thus concluded that there was a likelihood of confusion. Further, it considered that, as there was a likelihood of confusion between the mark applied for and the first earlier figurative mark, there was no need to compare the mark applied for with the second earlier figurative mark and the earlier word mark.

Applicant *Lidl Stiftung & Co KG* appealed, but the Fourth Board of Appeal dismissed the appeal.

The board considered, first, that because only proof of registration of the earlier word mark had been adduced by Lactimilk, the assessment of the likelihood of confusion could be undertaken only with respect to that mark, to the exclusion of the two earlier figurative marks. Second, in the context of the assessment of the likelihood of confusion between the mark applied for and the earlier word mark, the Board of Appeal considered that the proof of the genuine use of the earlier word mark had been adduced only for "milk, cream, milk drinks in which milk is the predominant ingredient", so that this mark could be deemed to be registered only for those goods.

In addition, the board considered that there was a similarity between "milk, cream and milk drinks in which milk is the predominant ingredient" covered by the earlier word mark and "cheese" covered by the mark applied for. Furthermore, it considered that the signs in question were similar and that it had been established that the earlier word mark had acquired enhanced distinctiveness through intensive use. In light of those findings, the Board of Appeal concluded that there was a likelihood of confusion between the mark applied for and the earlier word mark, even though the earlier word mark had only an average distinctiveness.

The applicant appealed to the General Court, relying on five pleas in law:

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1. breach of its right to be heard and of the Board of Appeal's power of assessment;
2. an error by the Board of Appeal relating to the goods covered by the earlier word mark that must be taken into account when assessing the likelihood of confusion;
3. errors linked with evidence of the genuine use of the earlier word mark;
4. an error with respect to the distinctiveness of the earlier word mark; and
5. errors in the assessment of the likelihood of confusion between the signs.

All five pleas were rejected as unfounded.

In respect to the first plea, the court held that, although the Board of Appeal had based its assessment of the likelihood of confusion on an earlier mark that the Opposition Division had not taken into account, the opponent had relied upon such mark in support of the opposition in both the notice of opposition and the explanation of grounds. Second, the court held that Lidl had an opportunity to present, both before the Opposition Division and the Board of Appeal, its arguments in reply to the opposition, but that it chose not to develop its arguments in that regard before the board.

In view of the above, the court held that the applicant could not claim that it could not foresee that the Board of Appeal would base its assessment of the likelihood of confusion on the earlier word mark.

With regard to the second plea in law, Lidl argued, in essence, that the Board of Appeal ought to have taken into consideration only "fresh milk, condensed milk and powdered milk, cheese, butter, yoghurt, kefir, and other derivatives of milk" covered by the earlier word mark, insofar as only those goods were identified in the Registration Certificate filed with the notice of opposition lodged within the three-month period prescribed by law following publication of the application for registration of the Community trademark.

This plea was also rejected, as the court considered that the opposition had been filed within the prescribed three months and completed within the deadline given to the opponent. In light of the above, the court noted that the Board of Appeal had not erred in taking account of all of the goods covered by the earlier mark when assessing the likelihood of confusion, as this was indicated in the notice of opposition and subsequently substantiated by the opponent.

With regard to the third plea in law, Lidl claimed that the Board of Appeal had made errors linked with the proof of the genuine use of the earlier word mark and, in so doing, had infringed Articles 15 and 42(2) and (3) of the [Community Trademark Regulation \(207/2009\)](#).

In this respect, the court held that, as the Board of Appeal had rightly found, the large number of invoices provided by Lactimilk in which the various goods sold are specifically identified by the earlier word mark covered the entire five-year period preceding the date of publication of the application for registration of Lidl's mark. Second, in addition to those invoices, not only the first earlier figurative mark but also the earlier word mark appeared in several photographs of advertisements and packaging.

Therefore, the court held that, in light of the documents referred above, the Board of Appeal was right to find that there was genuine use of the earlier word mark.

With regard to the fourth plea in law, Lidl claimed that the Board of Appeal had infringed Article 76 of Regulation 207/2009 and Rules 19(1) and (3) and 50(1) of the [Community Trademark Implementation Regulation \(2868/95\)](#). It considered, essentially, that the Board of Appeal had wrongly taken account of the enhanced distinctiveness of the earlier word mark to the extent that Lactimilk did not produce any arguments or proof in that regard within the prescribed period.

In this respect, the court considered that, insofar as the relevant public was made up of average end consumers, the goods at issue were highly similar and the signs were similar, there was a likelihood of confusion between the marks, whether or not the earlier word mark had enhanced or weak distinctiveness.

In its fifth plea in law, Lidl submitted that the Board of Appeal had infringed Article 8(1)(b) of Regulation 207/2009. It considered that there was no likelihood of confusion between the mark applied for and the earlier word mark. In this respect, the court confirmed that "cheese" was similar to "milk".

Concerning the similarity between the signs, the court held that the marks involved have an identical syllable 'RAM' which, on the one hand, constitutes the only word element making up the earlier word mark and, on the other, is one of the two syllables which make up the mark applied for. It thus concluded that the marks were similar. In this respect, it noted that, even though it may be considered, in principle, that consumers normally attach more importance to the beginning of words, that was not so in the present case.

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Although it is not a common practice that the Boards of Appeal base their decisions on marks which were not the basis of the Opposition Division's decision, the decision in the present case is, in its essence, in accordance with OHIM's practice regarding the similarity between marks and goods.

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