

World Trademark Review Daily

**'Blue' marks held to be confusingly similar in 'surprising' decision
European Union - Casalonga & Associés**

**Examination/opposition
International procedures**

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In *MOL Magyar Olaj- és Gázipari Nyrt v Office for Harmonisation in the Internal Market* (OHIM) (Case T-367/12, June 27 2013), the General Court has upheld a decision of the Second Board of Appeal of OHIM in which the latter had annulled an Opposition Division decision rejecting the opposition filed by *Banco Bilbao Vizcaya Argentaria SA*.

Applicant MOL Magyar Olaj- és Gázipari Nyrt obtained an international registration for the word mark MOL BLUE CARD, designating the European Community. The trademark claimed protection for services in Classes 35 and 36 of the [Nice Classification](#), including credit card services.

Banco Bilbao filed a notice of opposition on the basis of its earlier Community trademarks:

- the word mark BLUE for services in Class 35;
- the word mark BLUE BBVA for services in classes 35 and 36; and
- the word mark TARJETA BLUE BBVA for services in Class 36.

The Opposition Division rejected the opposition, considering that there was no likelihood of confusion between the marks at issue.

Upon appeal, however, the Second Board of Appeal annulled the Opposition Division's decision, considering that there was a likelihood of confusion. As a preliminary matter, the Board of Appeal held that the relevant public was made up of both professionals working in the relevant sector and the general public in the European Union. It considered that the services claimed in Classes 35 and 36 were identical and that the earlier marks and the contested mark were visually similar insofar as they contained the identical element 'blue'. In this respect, the board deemed that there was only a low degree of phonetic similarity and that the marks were conceptually similar to a certain extent.

With regards to the element 'blue', the board found that, insofar as no direct relation with the services in question had been established, such element had an average distinctive character. Accordingly, the board considered that, even if that element, as such, does not constitute an isolated dominant element of the contested mark, in the present case, that element had an independent distinctive role in the composite mark. Therefore, it found that there was a likelihood of confusion.

The applicant filed an appeal before the General Court on the basis of the violation of Article 8(1)(b) of the [Community Trademark Regulation](#) (207/2009), arguing that there was no likelihood of confusion.

The court first considered that the Board of Appeal had rightly observed that the word 'blue' is a basic English word that refers to a primary colour and that, as such, it will probably be understood by the relevant public in non-English-speaking countries of the European Union.

Second, it confirmed that the board had also rightly found that:

- the word 'card' will be understood by the majority of the relevant public of the European Union, since it is a basic English word, in particular with regard to financial services; and
- it will be considered to have a weak distinctive character in connection with the services covered by the contested mark.

With regard to the relevant Spanish-speaking public, the same conclusion applied to the word '*tarjeta*', a Spanish word meaning 'card'.

Third, the terms 'BBVA' and 'MOL' seemed to have no meaning, apart from being acronyms of the names of Banco Bilbao and the applicant. Nevertheless, it was considered that the dissimilarity between the marks at issue, due to the presence of the word elements 'MOL' and 'card' in the mark applied for, were not sufficient to counteract the aforementioned similarities.

The court considered that, visually, there were no dominant elements in the marks at issue such as to render the other elements of those marks negligible.

With respect to the alleged reputation of the acronym of the applicant's business name, the court considered that such reputation had not been proved.

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Concerning the argument that 'MOL' may be considered as being more distinctive than the other two elements of the contested mark, the court found that it could not be regarded as dominating the overall impression produced by the mark MOL BLUE CARD or the imperfect picture which the relevant consumer will keep in his/her mind.

The applicant's argument that the term 'blue' was commonly used in the banking and financial sector was also rejected, because the applicant failed to establish the descriptive character of the term 'blue' in respect of the services in question.

In view of the above, the court held that the Board of Appeal had rightly found that the element 'blue' - to the extent that it constitutes in itself one of the earlier marks - still had an independent distinctive role in the mark MOL BLUE CARD, without necessarily constituting the element dominating the overall impression created by the mark.

The court thus concluded that the services in question were identical and that the marks at issue were:

- visually similar in that they contain the word 'blue';
- phonetically similar to a very low degree; and
- conceptually similar to a certain extent.

Consequently, the common element 'blue' still has an independent distinctive role in the contested mark and there was a likelihood of confusion on the part of the relevant public, made up of the average consumer who is reasonably well informed and reasonably observant and circumspect.

This decision is surprising as the additional term 'MOL' in the application is very distinctive. It is not yet final and may be appealed before the Court of Justice of the European Union.

Cristina Bercial-Chaumier, Casalonga & Associés, Alicante, and Karina Dimidjian-Lecomte, Casalonga Avocats, Paris

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