

ECJ decision addresses degrees of similarity
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In *El Corte Inglés SA v Office for Harmonisation in the Internal Market (OHIM)* (Case C-603/14P, December 10 2015), the European Court of Justice (ECJ) set aside the EU General Court's judgment of October 15 2014 (T-515/12, EU:T:2014:882) insofar as it held that, since the degree of similarity between the signs at issue did not suffice to result in the application of Article 8(1)(b) of the EU Community Trademark Regulation, the conditions for the application of Article 8(5) were therefore also not satisfied.

Opposition

On February 9 2010 The English Cut filed a Community trademark application for the word mark THE ENGLISH CUT for goods in Class 25.

On October 4 2010 El Corte Inglés filed an opposition pursuant to Articles 8(1)(b) and (5) of the Community Trademark Regulation based on:

- its prior Spanish trademark 166450 EL CORTE INGLES (word mark)
- its Community trademark registrations Figurative Mark 5428255



- its Community trademark registrations Figurative Mark 5428339



The OHIM Opposition Division rejected the opposition.

OHIM Board of Appeal decision

On August 16 2011 the opponent filed a notice of appeal against OHIM's decision.

The Board of Appeal dismissed the appeal, as it found that the signs were not visually or phonetically similar and, despite a minimal degree of conceptual similarity, were different overall. Further, it held that the opponent had not provided sufficient evidence supporting actual or potential detriment to the reputation of its prior marks.

General Court decision

On November 22 2012 the opponent brought an action for annulment of OHIM's decision, alleging infringement of Articles 8(1)(b) and 8(5) of the Community Trademark Regulation.

Article 8(1)(b)

The General Court dismissed the action in its entirety and confirmed the Board of Appeal's decision in finding that the signs at issue were neither visually nor phonetically similar, considering the following factors:

- The words were in different languages;
- They contained a different number of letters; and
- Their pronunciation and number of syllables were different.

Conceptually, the General Court considered that the signs at issue had the same meaning, which Spanish consumers would be able to understand – but only after translating the applied-for trademark into Spanish, which precluded them from making an immediate conceptual connection between the signs.

The General Court therefore concluded that there was a low degree of conceptual similarity, and no visual or phonetic similarity, consequently confirming the Board of Appeal's decision that the signs were different overall.

Article 8(5)

Since the signs at issue were not found to be similar, the General Court considered that the condition as to

their identity or similarity, which is necessary for the application of Article 8(5) of the Community Trademark Regulation, was not satisfied.

ECJ decision

The opponent appealed the General Court's decision, alleging that it:

- distorted the facts;
- infringed Article 8(1)(b) of the Community Trademark Regulation; and
- infringed Article 8(5) of the Community Trademark Regulation

The ECJ rejected the first two grounds of appeal, as it found them respectively unfounded and inadmissible.

With regards to the third ground, unlike the General Court, the ECJ found that Article 8(5) requires not that the similarity between the signs result in a likelihood of confusion for the public, as required by Article 8(1)(b), but rather that it simply lead the relevant public to establish a link between the signs at issue.

It concluded that the General Court had erred in law by ruling that it was apparent from the comparison of the signs at issue, which was carried out in the context of Article 8 1(b), that those signs were not similar and therefore that the conditions for the application of Article 8(5) were not satisfied – in particular, as it was concluded that there was conceptual similarity between the signs.

Therefore, with respect to Article 8(5), the General Court should have examined whether the degree of similarity was sufficient for the relevant public to establish a link between the signs at issue – a different analysis from that required under Article 8(1)(b).

This decision confirms that the required degree of similarity required varies greatly between Article 8 (1)(b) and Article 8(5) of the Community Trademark Regulation.

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