

# World Trademark Review *Daily*

**GC reiterates criteria for determining whether goods and services are complementary**  
**European Union - Casalonga & Associés**

**Examination/opposition**  
**International procedures**

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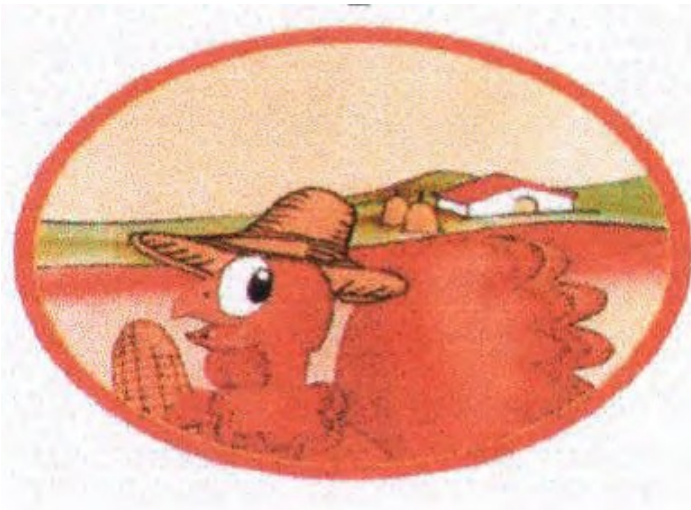
In *Sanco SA v Office for Harmonisation in the Internal Market* (OHIM) (Case T-249/11, February 17 2011), the General Court has annulled a decision of the Second Board of Appeal of OHIM in which the latter had found that there was no likelihood of confusion between two figurative marks.

Marsalman SL filed a Community trademark (CTM) application for a figurative mark (depicted below) in connection with the following goods and services:

- “chickens” in Class 29;
- “advertising, commercial agencies, franchising, export and import; wholesaling and retailing of all kinds of foodstuffs and selling via global computer networks of foodstuffs of all kinds” in Class 35; and
- “transport, storage and distribution of chickens” in Class 39 of the [Nice Classification](#).



Sanco SA filed a notice of opposition on the basis of its earlier Spanish figurative mark (depicted below) for “meat, poultry and game; meat extracts” in Class 29 and “live animals” in Class 31.



The Opposition Division of OHIM upheld the opposition in part and refused registration of the mark applied for with regard to “chickens” in Class 29 and “wholesaling and retailing of all kinds of foodstuffs and selling via global computer networks of foodstuffs of all kinds” in Class 35. However, it rejected the opposition for “advertising, commercial agencies, franchising, export and import” in Class 35 and “transport, storage and distribution of chickens” in Class 39.

Marsalman filed a notice of appeal with OHIM insofar as it partially rejected the opposition. The Second Board of Appeal of OHIM confirmed the Opposition Division’s decision insofar as it rejected the opposition in part.

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The Board of Appeal found that the relevant public consisted of both the average consumer from the general public and the average consumer from a specialised public. It further considered that the services covered by the mark applied for, namely "advertising, commercial agencies, franchising, export and import" and "transport, storage and distribution of chickens", were not similar to the goods covered by the earlier mark, namely "meat, poultry and game; meat extracts" and "live animals".

Sanco filed an appeal before the General Court, seeking the annulment of the board's decision and the refusal of the registration of the mark applied for with regard to all of the goods and services claimed.

In the contested decision, the Board of Appeal had found, in essence, that because of the lack of similarity between the goods protected by the earlier mark and the services of "advertising, commercial agencies, franchising, export and import" and "transport, storage and distribution of chickens" covered by the mark applied for, there was no likelihood of confusion within the meaning of Article 8(1)(b) of the [Community Trademark Regulation](#) (207/2009), without there being any need to compare the signs at issue.

In this respect, the court noted that goods or services that are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking. Thus, for the purposes of the assessment of whether goods and services are complimentary, the perception of the relevant public of the importance of a product or service for the use of another product or service should, ultimately, be taken into account.

In the present case, the Board of Appeal had found that "advertising, commercial agencies, franchising, export and import" and "transport, storage and distribution of chickens" cover services aimed, first, at the general public and, second, at a specialised public. It had pointed out that some of those services were generally aimed at commercial undertakings. It had therefore concluded that the relevant public for the assessment of the likelihood of confusion consisted of both the average consumer from the general public and the average consumer from a more specialised public.

The court found that the Board of Appeal was correct to find that the abovementioned services were aimed at professionals. Further, it could not be excluded that some of those services are aimed at the general public. In addition, with regard to "meat, poultry and game; meat extracts" and "live animals", it should be noted that, although those goods are produced by professionals and although the rearing of live animals is principally carried out by professionals, those goods are bought by both individuals and professionals.

However, concerning to the similarity of the goods at issue and the services of "advertising, commercial agencies, franchising and export and import", the Board of Appeal had found that there was no similarity between, on the one hand, "meat, poultry and game; meat extracts" and "live animals" covered by the earlier mark and, on the other hand, "advertising, commercial agencies, franchising, export and import" covered by the mark applied for.

In this respect, the court noted, first, that the Board of Appeal was correct to find that "meat, poultry, game, meat extracts" and "live animals" differed from "advertising, commercial agencies, franchising and export and import" by their nature, their intended purpose and their method of use. The abovementioned goods and services are neither interchangeable nor in competition (which was not disputed by the applicant).

With regard to the distribution channels, the Board of Appeal had found (without it being challenged by the applicant) that they were different on the ground that it was unlikely, even impossible, that a farm or a poultry plant would be used to provide the services of "advertising, commercial agencies, franchising or export and import" to undertakings. However, the court considered that, when assessing the similarity of the goods and services, it was also necessary to take into account whether those goods and services are complementary.

In this respect, the complementarity between the goods and services in the context of a likelihood of confusion does not rely on the existence of a connection between the goods and services at issue in the mind of the relevant public from the point of view of their nature, their method of use and their distribution channels, but on the close connection between those goods and services.

It followed that the Board of Appeal could not reject the existence of a complementarity between the goods and services concerned on the sole ground that there was no connection between their nature, their method of use and their distribution channels. By proceeding in that way, it had again taken into account the nature, method of use and distribution channels of the goods and services at issue without deciding on the importance of one for the use of the other from the point of view of the relevant public. The fact that the method of use of a product or service is unrelated to the method of use of another product or service does

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not imply in each case that the use of one is not important or indispensable for the use of the other.

Accordingly, the court found that the Board of Appeal had not correctly examined whether, from the point of view of a professional purchaser of chickens or of meat, the services of "advertising, commercial agencies, franchising or export and import" were important during the purchase of chickens or meat to the extent that he/she would think that the responsibility for the production of those goods or provision of those services lies with the same undertaking. The board had thus erred in the assessment of the complementarity between the goods covered by the earlier mark and the services of "advertising, commercial agencies, franchising, export and import" covered by the mark applied for.

Therefore, the board's decision was annulled in that regard.

With respect to the similarity between the goods at issue and the services of "transport, storage and distribution of chickens", the court found that, in order to assess the complementarity of those goods and services, it was necessary to determine not only the specialisation of the undertakings, but also whether the consumers of those goods and services might think that the responsibility for the production of those goods or provision of those services lies with the same undertaking due to the connection between those goods and services. Consequently, the existence of undertakings specialised in the production of goods of the earlier mark and in the provision of the services of "transport, storage and distribution of chickens" was not sufficient to establish a lack of complementarity between those goods and services.

The court maintained that the complementarity of the goods and services for the requirements of the assessment of the similarity between those goods and services must be assessed on the basis of the perception by the relevant public that the responsibility for the production of those goods or provision of those services lies with the same undertaking or with different undertakings. In this respect, it was found that the wholesale purchaser of chickens, which also needs a chicken transport service, is likely to take the view that there is a strong link between the production of chickens and the transport, storage and distribution of chickens, so that the consumer of those goods and services will consider that they come from the same undertaking.

In light of the above, the board's decision was annulled insofar as it held that the goods of the earlier mark are not in any way similar to the services of transport, storage and distribution of chickens claimed in the contested application.

Finally, in respect of the head of claim seeking refusal to register the CTM applied for, the court recalled that the review carried out by the court is a review of legality. Where there has been an error, it may annul the decision of the Board of Appeal and, if it has been applied for in the successful party's pleadings, alter it. However, the court confirmed that it was not for the court to register or refuse registration of a mark; under Article 266 of the [Treaty on the Functioning of the European Union](#) and Article 65(6) of the Community Trademark Regulation, OHIM is required to take the measures necessary to comply with any judgment ordering annulment that may be given by the courts of the European Union.

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