

### General Court dismisses opposition to THE ENGLISH CUT European Union - Casalonga & Associés

### Examination/opposition Confusion

December 13 2016

In *El Corte Inglés SA v EU Intellectual Property Office (EUIPO) / The English Cut SL* (Case T-515/12), the EU General Court found against the opposition to the word mark THE ENGLISH CUT.

Bespoke tailoring brand The English Cut filed an application for registration of the word mark THE ENGLISH CUT as a EU trademark for goods in Class 25.

El Corte Inglés filed an opposition on the basis of its previous Spanish word mark EL CORTE INGLÉS as well as the following figurative EU trademark registrations also covering Class 25:



The grounds in support of the opposition were Article 8(1)(b) – likelihood of confusion and Article 8(5) – reputation of the prior marks.

The EUIPO Opposition Division rejected the opposition and El Corte Inglés filed an appeal before the EUIPO Board of Appeal.

The first Board of Appeal confirmed the Opposition Division decision and dismissed the appeal. It found that the signs were not visually or phonetically similar and that in the same way, from a conceptual standpoint, the word sign THE ENGLISH CUT taken as a whole would be perceived as a fanciful name by those of the general Spanish public who do not have a good command of the English language. It also found that in the global assessment of the likelihood of confusion, the words 'El Corte' and 'Cut' were the dominant elements in the signs at issue and that the relevant public would not be able to establish any conceptual link between them. It concluded that there was indeed a minimal degree of conceptual similarity between the signs, but found that the signs were different overall. The opposition on the basis of Article 8(1)(b) was therefore rejected.

In respect to Article 8(5), it found that, in spite of the substantial reputation of the earlier marks, El Corte Inglés had not provided sufficient evidence that there was actually or potentially any detriment to the reputation of those marks or that there was any unfair advantage being taken of or risk that unfair advantage would be taken of the reputation of those marks. Therefore, the appeal was also dismissed in respect of the grounds based on Article 8(5).

An appeal was then filed before the EU General Court alleging infringement of Article 8(1)(b) and 8(5). The court confirmed the Board of Appeal decision and held that the signs were neither visually nor phonetically similar. The action was entirely dismissed.

As regards the conceptual aspect, the court pointed out that Spanish consumers would be able to perceive the meaning as being identical only after translating the word sign THE ENGLISH CUT into their own language, which precluded them from making an immediate conceptual connection between the signs at issue. Consequently, it found a low degree of conceptual similarity.

Therefore, without visual or phonetical similarity between the signs, the court held that the Board of Appeal was right to find that the signs were different overall.

In respect of Article 8(5), the court found that, although the earlier marks had a considerable reputation, the

condition as to their identity or similarity was not satisfied in the present case.

El Corte Inglés then filed an appeal before the European Court of Justice (ECJ) on the basis of distortion of the facts and infringement of Articles 8(1)(b) and 8(5). The first and second arguments were rejected as inadmissible.

In respect of the third ground of the appeal, the ECJ found that it was apparent from the wording of Article 8(5) that its application was subject to three conditions:

- The signs were identical or similar;
- The earlier mark had a reputation; and
- The use by someone – without due cause, in respect of which registration as a trademark was applied for – would take unfair advantage of (or detrimental to) the distinctive character or the repute of the earlier mark.

These conditions were cumulative and therefore the condition that the signs at issue must be identical or similar is common to Article 8(1)(b) and Article 8(5).

Nevertheless, it was noted that the degree of similarity between the signs at issue required by Article 8(1)(b) and Article 8(5) was different. Whereas Article 8(1)(b) required a similarity which could give rise to a likelihood of confusion, Article 8(5) merely required a similarity which was capable of leading the relevant public to make a connection between the signs at issue, in order to establish a link between them. Therefore the protection which that provision lays down in favour of the mark with reputation may apply even if there is a lower degree of similarity between the signs at issue.

The ECJ held that the EU General Court was wrong in its finding, as it should have examined if the degree of similarity between the signs was sufficient for applying Article 8(5). It therefore sent the case back to the EU General Court.

In its decision on October 27 2016 the EU General Court held that the cumulative conditions for the application of Article 8(5) were not met.

It noted that although the reputation of the prior marks was admitted, it required the applicant to demonstrate the existence of effective damage to the reputation or the distinctive character of the trademarks – or that such risk could occur in the future. As the applicant was unable to do this, the claim on the grounds of Article 8(5) was rejected and the decision was confirmed.

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