

World Trademark Review Daily

No unconditional right to have evidence submitted out of time taken into account Examination/opposition International procedures
European Union - Bureau DA Casalongo-Josse

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In *Dorma GmbH & Co KG v Office for Harmonisation in the Internal Market* (OHIM) (Case T-500/10, November 16 2011), the General Court has upheld a decision of the Fourth Board of Appeal of OHIM finding that there was no likelihood of confusion between the Community trademark (CTM) application for DOORSA FÁBRICA DE PUERTAS AUTOMÁTICAS, which covered goods in Classes 6, 9 and 19 of the [Nice Classification](#), and the prior German, UK and international trademarks DORMA, which covered goods and services in Classes 6, 9, 16, 19 and 37.

CTM application:



Earlier marks:

DORMA

In particular, the board held that there was no likelihood of confusion between the marks, despite the identity of the goods, because the marks, when assessed as a whole, were not similar. It held that:

- the marks were visually dissimilar;
- there was a low degree of aural similarity; and
- there was no conceptual similarity.

Further, the board found that:

- the evidence provided in relation to the enhanced distinctive character of the earlier marks (as a result of their being well-known in Germany and the United Kingdom) was insufficient; and
- the additional evidence, which had not been submitted for assessment before the Opposition Division, should not be taken into consideration.

On appeal, the General Court upheld the board's decision. The court cited prior case law according to which the assessment of the similarity between two marks does not simply involve taking one component of a composite mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks as a whole; this did not mean, however, that the overall impression conveyed to the relevant public by a composite mark may not, in certain circumstances, be dominated by one or more of its components.

Contrary to what was claimed by the owner of the earlier mark, the board's analysis did take into consideration the descriptive character of the phrase '*fábrica de puertas automáticas*' and the fact that consumers would pay more attention to the verbal element 'doorsa' than to the figurative elements. Even if, as claimed by the owner of the earlier mark, the element 'doorsa' was the dominant component of the mark applied for, the consequence of that would not be that the board should not, in its overall assessment of similarity, have taken into consideration the element '*fábrica de puertas automáticas*', the graphic elements (representation of a blue sky with clouds) and the script of that mark, since those elements could not be regarded as negligible in the overall impression and could not be disregarded.

In light of the foregoing, the court confirmed that the marks at issue, based on their overall impressions, were not similar. Therefore, there was no likelihood of confusion, despite the identity of the products.

Finally, with respect to the additional evidence submitted for the first time before the board, the court confirmed that the latter had exercised its discretion under Article 76(2) of the [Community Trademark](#)

World Trademark Review *Daily*

Regulation (207/2009). The board explained why it had decided not to take the additional evidence into account - namely, the legitimate interest of the other party to the proceedings, as dictated by the principle of equity, and the absence of an explanation by the applicant as to why it had been unable to submit such evidence before the Opposition Division.

In any case, the court concluded that such documents (two catalogues and annual reports) did not have any real relevance to the outcome of the opposition brought before OHIM. In this respect, the court pointed out that "a party has no unconditional right to have facts and evidence submitted out of time taken into consideration by OHIM" (*OHIM v Kaul* (Case C-29/05 P, Paragraph 43) and *CORPO Livre* (Case T-86/05, Paragraph 45)).

This decision is in line with the general criteria applied by the Court of Justice of the European Union in order to establish the existence of a likelihood of confusion between two marks and the discretionary power of the boards of appeal as far as the submission of new evidence is concerned.

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