

Polo player marks held to have degree of similarity despite difference in mount Examination/opposition
International procedures
European Union - **Casalonga Avocats**

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In *The Polo/Lauren Company LP v Office for Harmonisation in the Internal Market* (OHIM) (Case T-265/13, September 18 2014), 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 a figurative mark representing a boy on a bicycle holding a mallet and earlier figurative marks representing a polo player.

FreshSide Ltd filed a Community trademark (CTM) application for the following mark in connection with a number of goods in Classes 18, 25 and 28 of the [Nice Classification](#):



The Polo/Lauren Company filed a notice of opposition on the basis of:

- an earlier CTM registration covering products in Classes 9, 18, 20, 21, 24 and 25:



- an Austrian registration protecting products in Classes 18 and 28:



The opposition was rejected in its entirety, as the Opposition Division found that there was no likelihood of confusion.

On December 22 2011 The Polo/Lauren Company filed an appeal against the Opposition Division's decision pursuant to Articles 58 to 64 of the [Community Trademark Regulation](#) (207/2009).

By a decision of March 1 2013, the Second Board of Appeal of OHIM confirmed the Opposition Division's decision, considering that the signs at issue were not similar and that, therefore, there could not be a likelihood of confusion. Further, the Board of Appeal found that, in view of the fact that the marks were not similar, one of the cumulative conditions for the application of Article 8(5) of the regulation was not satisfied.

The Polo/Lauren Company filed an appeal before the General Court, seeking the reversal of the board's decision. It argued that the appeal should have been upheld and that the Opposition Division's decision should have been annulled.

The appeal was based on two pleas:

1. infringement of Article 8(1)(b) of the regulation; and
2. infringement of Article 8(5) of the regulation.

The Polo/Lauren Company argued that the Board of Appeal should have taken the enhanced distinctiveness of the earlier marks into account when analysing the similarity of the signs at issue.

The Board of Appeal had considered that the differences between the signs prevailed over their similarities. In particular, the board had emphasised the particular importance attached to the difference in mount (bicycle or horse) in the two signs. Further, it had considered that the signs were not conceptually analogous.

In this respect, the General Court found that it could not be considered that the graphic representation of a bicycle in the mark applied for constituted the dominant element of the mark. Indeed, it found that the graphic representation of a person holding a polo mallet occupied an amount of space similar to that of the mount, with the result that neither of those representations could be given more weight than the other.

In view of the above, the court found that the signs at issue could not be held to be visually dissimilar and that they had, at least, a low degree of visual similarity. At the phonetic level, the Board of Appeal's finding that a comparison was not relevant to the extent that the signs at issue did not contain any word elements was not disputed.

At the conceptual level, the court found that, to the extent that both marks contained the figure of a polo player, there was necessarily a conceptual similarity.

In view of the above, and having regard to the visual and conceptual similarities between the signs at issue, the court found that the Board of Appeal had erred in finding that those signs were dissimilar overall. Instead, it considered that the signs at issue had a certain degree of similarity which may be categorised as low. The finding of the Board of Appeal had therefore been based on an incorrect assessment of one of the factors to be taken into account.

Concerning the second plea, as the Board of Appeal had rejected the opposition brought on the basis of Article 8(5) on the sole ground that the signs at issue were not similar and the contested decision must be annulled on that point, the arguments put forward by The Polo/Lauren Company in the context of the second plea, alleging infringement of Article 8(5), must be also upheld. Therefore, the contested decision must also be annulled on that ground.

This decision will provide comfort to holders of trademarks with a reputation in the European Union: even if there is only a very minimal degree of similarity between an opposed CTM application and a trademark with a reputation, the Opposition Division and Boards of Appeal of OHIM should be required to analyse any claims asserted pursuant to Article 8(5).

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