

Success for Marriott: General Court finds that winged mythical creatures are similar
European Union - Casalunga

**Cancellation
International procedures**

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- **Marriott sought cancellation of mark representing a winged bull based on earlier marks representing a griffin**
- **Board of Appeal had refused, finding no similarity between marks**
- **Court found that board had erred in assessment of visual and conceptual similarities**

In *Marriott Worldwide Corp v European Union Intellectual Property Office* (EUIPO) (Case T-151/17), the General Court has found that figurative marks representing a winged animal-like creature were similar.

Background

EUTM No 010511723, depicted below, was registered on April 18 2012 in connection with “services for providing food and drink; catering and providing food and drink for cafes, hotels and restaurants” in Class 43:



On June 6 2014 Marriott Worldwide Corp filed an application for a declaration of invalidity on the following basis:

- Relative grounds:
 - Article 53(1)(a) of [Regulation 207/2009](#), read in conjunction with Article 8(1)(b) and Article 8(5) of Regulation 207/2009; and
 - Article 53(2)(c) of Regulation No 207/2009 (prior copyright).
- Absolute grounds: Article 52(1)(b) of Regulation 207/2009.

The application was based on two identical earlier marks representing a griffin, depicted below, namely EUTM Registration No 8458259 and UK Registration No 2536999, both protected in Class 43:



By decision of December 18 2015, the Cancellation Division of the EUIPO rejected the application for a declaration of invalidity in its entirety.

On January 25 2016 Marriott filed an appeal, which was dismissed by the Fourth Board of Appeal of the EUIPO on January 17 2017. The board found that the signs at issue were visually and conceptually different and that it was not possible to compare them phonetically. Therefore, Article 8(1)(b) did not apply.

As regards the ground based on Article 53(2)(c), the board found that Marriott had failed to demonstrate the existence of the alleged copyright, doubting that the design could constitute an original artistic work within the meaning of the UK legislation. It concluded that the contested mark did not constitute a reproduction of the design of a griffin.

As regards the ground based on Article 52(1)(b), the board confirmed that Marriott had failed to demonstrate that the EUTM application had been filed in bad faith.

General Court decision

Marriott filed an appeal before the General Court on the basis of three pleas.

Infringement of Article 76(1) of Regulation 207/2009

Marriott argued that the board had examined of its own motion facts and arguments which the owner of the contested mark had not raised, in particular its holdings that the signs were visually and conceptually different and that Marriott had failed to demonstrate valid copyright protection.

With respect to the visual and conceptual comparison, the General Court dismissed the plea, finding that the board could make such comparison in light of the question of the likelihood of confusion between the signs.

Concerning the copyright question, the court confirmed that such finding was simply made for the sake of completeness, and that the board did not draw any conclusion from it. Rather, it examined the ground for invalidity on the basis of the copyright protection, concluding that it should be rejected since it did not constitute a reproduction of the work protected by the copyright.

Infringement of Article 53(1)(a) of Regulation 207/2009, read in conjunction with Article 8(1)(b)

With respect to the visual similarity, the court found that both signs featured a black-on-white silhouette of an animal-like creature viewed in profile. The wings, the body and the tail of the animals are depicted in similar proportions in the two signs. The court concluded that the visual similarities between the signs at issue could not be regarded as negligible in the overall impression of the signs. It further stated that the differences between the signs were not such as to counteract the similarities.

With regard to the conceptual aspect, the court found that there was conceptual similarity for the relevant public to the extent that both signs evoked an imaginary creature merging the characteristics of several animals. Although the heads of the creatures in the signs at issue were those of different animals, namely a bull and an eagle, the court noted that the wings, bodies and hind legs in each of the signs evoked very similar animals. In view of the above, it found that there was a conceptual similarity of a degree which, at the very least, must be classified as low, and that the board had erred in refusing to find any conceptual similarity between the signs.

Therefore, the court found that the refusal of the application for a declaration of invalidity of the mark at issue on the basis of Article 8(1)(b) of Regulation 207/2009 was incorrect, and the second plea was admitted.

Infringement of Article 53(2)(c) of Regulation 207/2009

In the course of the examination of the ground based on the existence of an earlier copyright, the court found that, as the board had relied on the incorrect assumption that the signs at issue were different, the third plea should be also upheld.

In view of the above, the decision of the Board of Appeal was annulled. The case will now be sent back to the board for a determination as to a likelihood of confusion.

Comment

This decision demonstrates once again that the concepts of visual, phonetic and conceptual similarity, in particular between purely figurative trademarks, are subjective, and the outcome is therefore very difficult to predict.

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