

# World Trademark Review *Daily*

**G STOR and G-STAR held to be dissimilar**  
European Union - Bureau DA Casalunga-Josse

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

February 23 2010

In *G-Star Raw Denim kft v Office for Harmonization in the Internal Market (OHIM)* (Case T-309/08, January 21 2010), the General Court has upheld a decision of the Board of Appeal of OHIM in which the latter had rejected an opposition against the registration of the mark G STOR.

ESGW Holdings Ltd filed an application to register the mark G STOR (and design) as a Community trademark for "data processing equipment and computers" in Class 9 of the [Nice Classification](#). G-Star Raw Denim kft opposed the application based on its earlier G-STAR marks, registered for goods in Classes 9 (sunglasses) and 25 (clothing). The Opposition Division upheld the opposition based on Article 8(5) of the [Community Trademark Regulation](#) (40/94). ESGW appealed.

The Board of Appeal upheld the appeal, considering that the conditions for the application of Article 8(5) were not satisfied. First, it held that the visual and conceptual differences between the marks prevented any assumption of a possible connection between them. Second, it found that G-Star had not submitted evidence to suggest that use of the G STOR mark would take unfair advantage of, or be detrimental to, the repute or distinctive character of the earlier marks.

On appeal, the General Court first pointed that the global assessment must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

From a visual point of view, the court held that the figurative element placed at the beginning of the G STOR mark played a particularly important role in the assessment of the visual similarity between the marks, given its position and the fact that it represented a Chinese dragon's head. The presence of that figurative element and of a black rectangle in the G STOR mark had the effect of conferring on the marks at issue a different overall impression, despite the fact that they had certain letters in common. This comparison was valid in respect of the three earlier marks invoked.

The General Court did not contest the board's finding that the marks were similar from a phonetic point of view. Nevertheless, the court held that the marks were conceptually different, and that the board was right to take into account the word 'star' of the prior marks and the word 'stor' in the mark applied for. It considered that the word 'star' is part of the basic English vocabulary and that its meaning is widely understood throughout the European Union. In contrast, it was likely that the majority of the relevant public would not attribute any particular meaning to the element 'stor'.

In this respect, the court stated as follows:

*"According to settled case law, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and aural similarities between them."*

The court thus held that, in the present case, the conceptual differences were sufficient to counteract the aural similarity between the marks. The conceptual differences were also reinforced by the fact that there were significant visual differences between the marks. Insofar as the marks were neither identical nor similar, one of the cumulative conditions for the application of Article 8(5) of the regulation was not satisfied. The action was thus dismissed.

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