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General Court issues second decision in PRIMART saga

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- These opposition proceedings were ongoing for several years and the case went all the way to the CJEU
- The CJEU set aside the General Court's decision on the ground that it had misconstrued the scope of Article 76(1) of Regulation 207/2009
- The General Court has now confirmed again that there was a likelihood of confusion between PRIMART and PRIMA

On 28 April 2021 the General Court issued its decision in [Przedsiębiorstwo Produkcyjno-Handlowe „Primart” Marek Łukasiewicz v European Union Intellectual Property Office](#) (EUIPO) (Case T-584/17 RENV).

Background

Facts of the case and EUIPO proceedings

The applicant, Przedsiębiorstwo Produkcyjno-Handlowe „Primart” Marek Łukasiewicz, filed an application for the EU figurative mark depicted below in connection with goods in Class 30:



An opposition was filed by Bolton Cile España SA on the basis of a likelihood of confusion with its prior Spanish trademark PRIMA, also covering goods in Class 30, pursuant to Article 8(1)(b) of Regulation 207/2009 (now Regulation 2017/1001).

The Opposition Division of the EUIPO rejected the opposition in its entirety on the ground that there was no likelihood of confusion between the signs on the Spanish market.

Bolton appealed and the Fourth Board of Appeal of the EUIPO annulled the Opposition Division's decision, essentially concluding that there was a likelihood of confusion between the marks at issue on the part of the relevant public.

First General Court decision

The applicant filed an appeal before the General Court relying on a single plea in law, alleging infringement of Article 8(1)(b) of the regulation. The General Court [dismissed the action](#) in its entirety and upheld the Board of Appeal's findings as regards the existence of a likelihood of confusion. In particular, it held that the applicant's argument concerning the weak distinctive character of the earlier mark was inadmissible on account of Article 76(1) of the regulation, since that argument had been put forward before it for the first time.

CJEU decision

An appeal before the Court of Justice of the European Union (CJEU) was filed by the applicant, alleging infringement of Article 8(1)(b) of the regulation. The CJEU [held](#) that, in the context of opposition proceedings based on Article 8(1) of the regulation, the assessment of the inherent distinctive character of the earlier mark constitutes an issue of law which is necessary to ensure the correct application of that regulation, so that the instances of the EUIPO are required to examine that issue, if necessary, of their own volition. As that assessment does not presuppose any matter of fact which is for the parties to establish and does not require the parties to provide facts, arguments or evidence tending to establish that character, the EUIPO alone is able to detect and assess the existence thereof having regard to the earlier mark on which the opposition is based. Consequently, that issue formed part of the subject matter of the proceedings before the Board of Appeal within the meaning of Article 188 of the Rules of Procedure of the General Court. In light of the above, it was found that, accordingly, the reasoning of the General Court misconstrued the scope of Article 76(1) of the regulation. The CJEU thus set aside the judgment and referred the case back to the General Court.

General Court decision

The General Court confirmed that the goods had been found to be identical, highly similar or similar to an average degree, and that the degree of attention of consumers would be average given the nature of such goods.

With respect to the comparison between the signs, the court confirmed that the word 'Primart' was the most distinctive and dominant element of the mark applied for. It therefore held that the marks were visually similar to an average degree and also similar from a phonetic point of view, since the remaining elements of the contested application would not be pronounced in light of their unclear and very small letters. It was also confirmed that the marks were not similar from a conceptual point of view.

Regarding the distinctive character of the earlier mark, the court confirmed that the Board of Appeal had not erred in finding that the Spanish general public, when faced with the word 'prima', would certainly see the word in its language as meaning 'female cousin' or 'bonus payment', but would not regard that word as an adjective having a simple laudatory connotation. Therefore, the board had not erred in finding that the earlier mark had no meaning as regards the goods in question in Class 30, and confirmed that the inherent distinctive character of the mark was average.

In light of the above considerations, the General Court confirmed that the Board of Appeal had not infringed Article 8(1)(b) of the regulation by concluding that:

- the goods at issue were similar and identical;
- the marks at issue were visually similar to an average degree, and phonetically similar to a higher-than-average degree;
- the level of attention of the relevant public was average at most; and
- the distinctive character of the earlier mark was average.

Finally, it was noted that, in view of the fact that most of the goods in question are everyday consumer goods bought in the supermarket, the visual comparison was of a particular importance.

Comment

The outcome of this case is not surprising since the decision is in line with the EUIPO's current practice and the CJEU's jurisprudence.

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