

General Court confirms likelihood of confusion between OMNI marks

Maria Athanassiadou
Dr Helen G Papaconstantinou and Partners Law Firm
16 January 2025



Shutterstock/PeopleImages.com - Yuri A

EUROPEAN UNION

Legal updates: case law analysis and intelligence

- The EUIPO upheld an opposition against the mark OMNISAN in Class 5 based on the earlier mark OMNISTRIP, also in Class 5
- On appeal, the court agreed that ‘omni’ was not descriptive and had normal distinctive character for the goods in question
- While the suffixes ‘strip’ and ‘san’ could be understood as referring to different concepts, the common element ‘omni’ would be understood as alluding to an identical concept

In opposition proceedings between Paul Hartmann AG and Drinks Prod SRL, the Eighth Chamber of the General Court has ruled in favour of the German company ([Case T-189/24](#)).

Background

In November 2020 Romanian company Drinks Prod applied for the registration of the figurative sign shown below as an EU trademark to cover goods in Class 5, among others:



In February 2021 German company Paul Hartmann filed an opposition against the above trademark for several goods in Class 5 based on its EU word mark OMNISTRIP (No 7196587), registered on 5 May 2009 and covering “sanitary preparations for medical use, plasters, materials for dressings, disinfectants, hygienic bindings and bandages, suture strips for wounds” in Class 5. The

opposition was based on the ground that there was likelihood of confusion within the meaning of Article 8(1)(b) of [Regulation 2017/1001](#).

The opposition was upheld by the EUIPO's Opposition Division, whose decision was appealed by the applicant. The Board of Appeal confirmed the decision, finding that there was a likelihood of confusion. The applicant turned to the General Court, challenging the board's conclusions as regards the level of attention of the relevant public, the comparison of the goods, the comparison of the marks, and the global assessment of the likelihood of confusion.

Decision

Regarding the level of attention of the relevant public, the General Court noted that the applicant contested the Board of Appeal's conclusions concerning "disinfectants" and "antiseptic products". The court acknowledged that these products fall within the category of "sanitary preparations for medical use", thereby requiring a level of attention comparable to that for pharmaceuticals. Consequently, the court found that the board's determination that the level of attention of the relevant public ranged from average to high was well founded.

With regard to the comparison of the goods, the court agreed with the board that the goods were partly identical and partly similar. The court confirmed that "first aid boxes, filled" and "first aid boxes sold filled" were similar to the "sanitary preparations for medical use" covered by the earlier mark due to their complementary nature. Similarly, it found that "air deodorising sprays" were comparable to the earlier mark's "disinfectants" for the same reason.

Coming to the comparison of the signs, the General Court considered the applicant's claim that, contrary to the board's findings, the element 'omni' shared by the marks is a descriptive Latin term commonly used in trademarks for goods in Class 5, and thus lacked distinctive character. The court disagreed, explaining that:

1. the mere fact that a term in a mark has a clear meaning does not automatically render it descriptive; and
2. a trademark registration does not inherently indicate that the mark is actively used in the market or for all the goods covered.

Therefore, additional evidence of actual market use is crucial. Since the applicant failed to prove the presence of several marks containing the term 'omni' on the market to support the argument that that term lacked distinctive character, the court upheld the board's finding that 'omni' was not descriptive and possessed normal distinctive character for the goods in question. The court further observed that the figurative elements of the mark applied for had limited capacity to differentiate it from the earlier mark, emphasising that the stylised cross did not have a dominant character, with this quality being instead attributed to the word element 'omnisan'.

The court further determined that the marks exhibited an average degree of similarity, basing its conclusion on the presence of the identical element 'omni' and the letter 'S' in both marks, which were likely to significantly influence the perception of the relevant public. These shared features were deemed to outweigh the visual differences, such as the distinct suffixes and the figurative elements in the mark applied for. The court further noted that the first two syllables of the marks were phonetically identical ("om" and "ni"). In addition, although the final syllable of the marks differed, both began with the same sound ("s"). Lastly, while the pronunciation of the final syllables ("san" and "strip") varied, this difference only partially offset the phonetic similarities created by the shared sounds "om", "ni" and "s". The court thus concluded that, contrary to the board's finding, the degree of phonetic similarity between the marks was average rather than high.

As to the conceptual similarity, the court pointed out that, while it was true that the suffixes 'strip' and 'san' could be understood by a part of the relevant public as referring to a different concept, the common element 'omni' would be understood as alluding to an identical concept, namely 'all' or 'of all things'. Although the term 'omnisan' lacked any clear or specific meaning, the same applied to the term 'omnistrip'. The meaning attributed to the earlier mark by the applicant, namely "a long, flat, narrow piece", was conveyed solely by the element 'strip', and not by 'omnistrip' as a whole. The court emphasised that the fanciful nature of the marks did not change the fact that the relevant public was likely to break down the marks into word elements that suggested a concrete meaning or resembled familiar words. Among these elements, the public would attribute a clear meaning to the common element 'omni'. While the element 'strip' in the earlier mark could also hold a clear meaning for part of the public, this did not negate the conceptual similarity between the marks arising from the shared element 'omni'.

Further, the court confirmed the board's finding that the earlier mark had normal distinctive character.

Finally, considering the interdependence between the similarity of the goods and the similarity of the marks, the court, in the context of a global assessment, took into account the level of attention of the relevant public and the normal intrinsic distinctive character of the earlier mark, and concluded that the board had correctly determined that there was a likelihood of confusion.

The General Court thus dismissed the appeal in its entirety.

Maria Athanassiadou

Partner

Dr Helen G Papaconstantinou and Partners Law Firm

m.athanassiadou@hplaw.biz

[View full biography](#)