

Strict conformity between signs as used and as registered unnecessary

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European Union - Dr. Helen G. Papaconstantinou and Partners Law Firm

The EU Intellectual Property Office (EUIPO) Board of Appeal has recently confirmed (Case R0109/2017-1) a decision of the EUIPO Cancellation Division (Decision 11300C) according to which, when examining the use of an earlier registration for the purpose of Article 15(1)(a) of the EU Trademark Regulation, the strict conformity between the signs as used and registered is unnecessary provided the difference is in negligible elements and that they are broadly equivalent.

In the case brought before the Cancellation Division the applicant sought to cancel the PORTOBELLO mark based on the earlier Greek trademark PORTOBELLO'S and device.



Earlier Greek trademark

PORTOBELLO

Challenged trademark

The trademark owner requested proof of use of the earlier Greek mark. The applicant submitted a considerable amount of evidence which the trademark owner accepted during the appeal proceedings as far as the place, date and extent of use were concerned, but not regarding the nature of use as the trademark owner argued that the evidence did not show use of the mark as registered. The evidence submitted showed various uses of the earlier mark, such as the use of PORTOBELLO'S without the figurative element which consisted of an inverted triangle and a pattern of six stars, or the use of PORTOBELLO'S accompanied by UOMO on a second line, in small characters as depicted below:



However, the Cancellation Division ruled that the figurative element of the earlier mark as registered (ie, an inverted triangle and a pattern of six stars), had less impact than PORTOBELLO'S. According to the Cancellation Division, unless the figurative elements are particularly striking, the relevant public perceives them as merely decorative or laudatory components. Therefore, the presence of the device does not divert attention from the word itself.

Further, the Cancellation Division stated that the use of PORTOBELLO'S without the figurative elements as well as the use of PORTOBELLO'S UOMO did not alter the distinctive character of PORTOBELLO'S since the stylisation of the word was minimal and the typeface and background used in all cases were commonplace. Moreover, the use of UOMO in the second line was illegible and in a secondary position.

Considering the relevant public, the Cancellation Division held that it could be considered that the contested sign was a modification of the earlier mark based on the same core element – PORTOBELLO'S.

The trademark owner appealed the decision. The EUIPO Board of Appeal upheld the Cancellation Division's decision based mainly on the findings outlined in that decision, namely, that PORTOBELLO'S was more distinctive than the figurative elements which would be considered as merely decorative.

The appeal board paid particular attention to the goods at issue and the field of relevant activity.

In the case at hand, the relevant sector was clothing where the common practice is the display of varying marks under the same owner as consumers are likely to assume that certain changes are the consequence of updating the mark according to fashion changes. Therefore, the same mark may be configured in different ways. Even the addition of UOMO on the earlier mark, which is Italian for 'man', is considered by average consumers as a mere reference to the sector of clothing for men covered by the earlier mark, taking into account the familiarity of consumers with the basic Italian word *uomo* as well as the significant international relevance of the Italian fashion industry.

In light of the above, the appeal board held that the mark as used constituted a revamp of the earlier mark in order to better adapt it to the marketing and promotional requirements for the clothing goods concerned which did not alter the distinctive character of the earlier trademark. It therefore met the requirements of Articles 15(1)(a) and 42(2) and (3) of the EU Trademark Regulation.

Comment

Based on the findings of both the Cancellation Division and the appeal board, trademark owners should always be careful regarding the use of a mark which differs from the registered mark for the purpose of Article 15(1)(a), as changes are accepted only if they are insignificant or in negligible elements and the marks as used and registered are broadly equivalent.

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