

Stylisation altercation

This decision leaves Luke Portnow pondering an important question

THIS DECISION COMES to us from an appeal to the Appointed Person of a UK IPO opposition. The Royal Academy of Arts had filed to register the plain word mark RA, claiming goods and services spanning 19 classes, and was opposed by Erreà Sport SpA (Erreà) based on a stylised Community Trade Mark (CTM) registration, shown below, for goods and services falling in classes 9, 14, 16, 18, 24, 25, 28 and 41.

The Hearing Officer's decision was that, while all of the contested goods and services were either identical (or at least highly similar), the Opposition was to be rejected in its entirety. Although the word elements were aurally identical, when taken as a whole, the marks were visually dissimilar under the "global appreciation" test.

It was held that the relatively high distinctiveness of the earlier Erreà mark was attributable only to its "heavy stylisation". Since this was absent from the later-filed mark, it

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did not increase any likelihood of confusion, particularly as the decision for purchasing was likely to be made on a visual basis for the goods and services at issue. No visual similarity was deemed to exist.

SUBJECTIVE TEST

The Opponent appealed this decision, based on the Hearing Officer's finding that there existed no visual similarity between the marks. The Appellant argued this was wrong, and that the Hearing Officer should have found a low degree of visual similarity and a resulting likelihood of confusion.

The Appointed Person held that the difference between "no" and "a low degree of" visual similarity is not only impossible to define, but quite subjective. He agreed with the Hearing Officer's decision, and held that, in the case of the heavily stylised earlier mark, taking aural similarities alone would ignore its real substance and distinctive character, and would likely lead to an erroneous result.

The Appointed Person also dismissed the Opponent's argument that, even if there had been no error in principle, the Hearing Officer had been "plainly wrong" and unreasonable under the Reef criteria. This was flatly rejected by the Appointed Person, who

also deemed it an unfair "wholesale re-arguing" of the case, and would not consider it, as it was not foreshadowed in the Appellant's Grounds of Appeal.

TAKE-HOME THOUGHTS

There are two main points to take away, along with an overriding question. First, significant stylisation in an earlier mark can lead to a finding of no likelihood of confusion, even when the later-filed mark comprises an identical word or letter element and claims identical goods and services. Second, any arguments submitted at such a hearing, however worthy, should always be set out in advance under the Appeal's supporting Statement of Grounds.

It is unclear whether a similar decision could be reached were the facts reversed: could a likelihood of confusion be found between an earlier plain word mark and a later-filed mark that is stylised but comprises the same word elements? From this decision the answer is unclear. However, based on its reasoning, it may well be "yes".

The Erreà Sport CTM



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