



Getting Messe

Emily Scott reveals why a priority claim did not succeed

IN MAY 2008, Messe Friedrichshafen GmbH (Messe) filed an EU trade mark (EUTM) application for the mark shown on this page. The application was opposed by El Corte Inglés, SA (El Corte) on the basis of, *inter alia*, its earlier EUTM registration for the word mark OUTDOOR PRO. El Corte claimed there was a likelihood of confusion under Article 8(1)(b) of Council Regulation (EC) No 207/2009 (the Regulation).

The Opposition Division partially allowed the opposition, finding in favour of a likelihood of confusion in relation to the goods and services of Messe's application that were held to be identical and similar to those of El Corte's registration.

Messe appealed the decision, arguing against a likelihood of confusion on the following bases:

- El Corte's earlier mark was descriptive and lacked distinctive character within the meaning of Article 7(1) of the Regulation.
- At the very least, El Corte's mark had a low distinctive character, which was weakened by the number of similar third-party marks.
- The marks at issue would create different overall impressions on the relevant public due to their visual differences.
- The contested sign had been used over many years, to the extent that it has an above average level of distinctiveness. Messe also registered an EUTM for the mark (with a blue background, also shown on this page) prior to the registration of El Corte's mark and, therefore, it enjoyed priority over El Corte's mark.

The Board of Appeal (BoA) upheld the Opposition Division's decision, noting that Article 7(1) should not be taken into account when the legality of an opposition decision is assessed. In addition, the term "outdoor" in El Corte's mark would not have a meaning for the non-English speaking part of the EU public, and was distinctive, at least for that part of the public.

Decisions of the German and Spanish Registries provided as evidence of the

descriptiveness of OUTDOOR were dismissed, on the basis that EUIPO is not bound by a decision given in a Member State, as was a list supplied by Messe of earlier third-party marks it claimed coexisted on the market with El Corte's mark.

Messe's claim it had used the contested sign over many years was not relevant, as enhanced distinctive character is only important in respect of an earlier mark on which an opposition is based. Messe's claim to have priority from an earlier EUTM was also dismissed, as the earlier EUTM was not identical to the contested sign.

Messe appealed to the General Court, claiming infringement of Articles 76 and 8(1)(b) of the Regulation. The Court dismissed the appeal, agreeing with the conclusions of the BoA. It also noted that it cannot be entirely excluded that the coexistence of earlier marks could reduce the likelihood of confusion between two marks at issue. However, this possibility can only be considered if, at the very least, the applicant for the EUTM demonstrates that the coexistence is based on the absence of any likelihood of confusion between the earlier marks on which it relies and the earlier mark on which the opposition is based, and provided that the earlier marks concerned and marks at issue are identical. Messe's list of earlier marks was insufficient to show the absence of likelihood of confusion, and the earlier marks were not identical; therefore, the marks could not be deemed to coexist. Further, even if it were proved that Messe's earlier mark did have a high level of distinctiveness, this would not confer priority.

KEY POINTS

- ▶ In EUTM opposition proceedings, the validity of the registration of an earlier mark may not be called into question
- ▶ For an EUTM to be refused registration, it suffices that a relative ground for refusal for the purposes of Article 8(1)(b) of the Regulation exists in only part of the EU
- ▶ Evidence regarding the coexistence of trade marks is only persuasive in limited circumstances

- ▶ The Messe mark at issue



- ▶ The earlier Messe mark



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