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Is 'safari' distinctive for goods in Classes 18 and 25? The General Court decides

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- Owner of WS WALK SAFARI in Classes 18 and 25 opposed registration of SAFARI CLUB in same classes
- Board of Appeal found that there was likelihood of confusion for all of goods concerned
- Court disagreed, finding that 'safari' had weak distinctive character at least for certain goods

In [Eduard Meier GmbH v European Union Intellectual Property Office](#) (EUIPO) (Case T-418/17, 13 September 2018), the General Court has partially annulled the decision of the Fourth Board of Appeal of the EUIPO.

Background

On 19 August 2014 the applicant, Eduard Meier GmbH, filed an application for registration of an EU trademark consisting of the words 'safari club' for goods and services in various classes of the Nice Classification, including goods in Classes 18 and 25.

On 31 March 2015 Calzaturificio Elisabet Srl filed a notice of opposition based on Article 8(1)(b) of [Regulation 207/2009](#) (now [Regulation 2017/1001](#)) in respect of all the goods in Classes 18 and 25. The applicant invoked its earlier figurative Italian trademark WS WALK SAFARI (No 1454232), registered for similar and identical goods in Classes 18 and 25:



On 27 April 2016 the Opposition Division upheld the opposition in respect of all of the contested goods. On 27 June 2016 the applicant filed an appeal against the Opposition Division's decision before the EUIPO's Board of Appeal.

With regard to the similarity of the signs, the Board of Appeal considered that the word element 'safari' in both signs had a normal level of distinctive character. The Board of Appeal therefore considered that the signs were visually and aurally similar to various degrees, and conceptually identical. The goods were found to be similar and identical and the consumers' level of attention was found to be average. Given

those findings, the Board of Appeal concluded that there was a likelihood of confusion between the signs for all of the goods concerned.

General Court decision

The applicant filed an appeal before the General Court alleging, in essence, infringement of Article 8(1) (b) of the regulation, particularly with regard to the assessment of the similarity of the signs. Specifically, the applicant argued that the Board of Appeal had erroneously stated that the word 'safari' was distinctive with regard to all the goods in Classes 18 and 25.

Even though the Board of Appeal had recognised that the word 'safari' was understood by the relevant public as meaning "an expedition to observe or hunt animals in their natural habitat, especially in East Africa", and that there are certain types of hats and items of clothing that can be associated with a safari, it considered that this word was not descriptive of any of the goods at issue.

The applicant claimed that the word 'safari' was a common term used in the fashion industry for clothing and, in particular, that 'safari style' referred to casual clothing featuring strong materials and certain details such as epaulettes, patch pockets and metal buttons. In support of its claim, the applicant submitted extracts from the search engine Google, showing that the expression 'safari style' was used in relation to clothes, shoes and bags.

The General Court considered that these documents were not inadmissible, as they were adduced for the first time by the applicant before the court. The General Court based its findings on the fact that the purpose of actions before the court is to review the legality of decisions of the Board of Appeal, and not to review the facts in light of new documents submitted by the parties.

Nevertheless, the General Court found that the Board of Appeal had erroneously stated that the word 'safari' was distinctive for all the goods in Classes 18 and 25. The applicant was right to claim that the element 'safari' had weak distinctive character at least for "game bags" in Class 18 and "clothing for hunting, clothing and hunting boots" in Class 25.

Therefore, with regard to these goods, the consumers' attention would be focused on the differences between the signs at issue, and such differences would counteract the phonetic and conceptual similarities deriving from the presence of 'safari' in both signs.

The applicant also claimed that 'WS' was the most dominant and eye-catching element of the earlier mark. However, the General Court disagreed and upheld the board's findings, finding that 'WS' would be perceived merely as an abbreviation of the element 'walk safari'.

Consequently, the General Court annulled the board's decision to the extent that it had found a likelihood of confusion with regard to "game bags" and "clothing for hunting, clothing and hunting boots".

Marcella Florio

Bugnion SpA

TAGS

[Portfolio Management](#), [Fashion & Luxury](#), [European Union](#), [Europe](#)

