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Lost in translation? Board of Appeal should have considered Italian and Spanish-speaking public

European Union - [Bugnion SpA](#)

- An opposition was filed against the application for the mark MEATLOVE based on the earlier mark CARNILOVE
- The Board of Appeal found that it was not possible to compare the marks conceptually and that there was no likelihood of confusion between them
- The General Court held that the board should have examined whether the marks were conceptually similar, in particular for the Italian or Spanish-speaking publics

Background

In [Vafo Praha sro v European Union Intellectual Property Office](#) (EUIPO) (Case T-491/18, 3 October 2019), the General Court has held that the conceptual identity of the marks offset the visual and phonetic differences between them. In other words, the identical meaning of the main elements of the marks was sufficient to find that the marks were confusingly similar.

At issue in this case were the trademarks MEATLOVE and CARNILOVE. In the Italian and Spanish languages, 'carni' is the equivalent of 'meat'.

Decision

The decision mainly focuses on two issues: the complementarity of some of the goods and services, and the meaning of the marks in various EU languages.

Complementary of the goods and services

First, the General Court noted that, pursuant to Article 8(1)(b) of Regulation 207/2009:

[A] likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see judgment of 22 January 2009, Commercy v OHIM - easyGroup IP Licensing (easyHotel), T-316/07, EU:T:2009:14, Paragraph 42 and the case law cited).

In addition, the identity of the signs may offset the low degree of similarity of the goods and services.

The court further noted:

Complementary goods or services are those between which there is a close connection, in the sense that one is indispensable or important for the use of the other with the result that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services. By definition, goods or services intended for different publics cannot be complementary (see judgment of 22 January 2009, easyHotel, T-316/07, EU:T:2009:14, Paragraphs 57 and 58 and the case law cited).

In this particular case, the court found as follows:

[R]etail services in relation to dietary supplements [and] wholesale services in relation to dietary supplements' in Class 35, in respect of which registration of the mark applied for had been sought, are similar to an average degree to the 'vitamin and mineral supplements for pets' in Class 31 in respect of which the earlier mark is registered.

The General Court thus confirmed that, despite the different classification, the aforementioned goods in Class 31 were "complementary" to the services in Class 35.

Languages in the EU trademark system

The second matter - which was mainly disregarded by the Board of Appeal of the EUIPO - was the conceptual comparison. Although the elements 'meat' and 'carni' are completely different from a visual and phonetic point of view, they are identical conceptually.

The court found as follows:

[B]y not analysing that meaning of the word element 'carni' for the Italian or Spanish-speaking publics, even though it correctly found [...] that the relevant public in the present case was that in the whole of the European Union and that it was therefore not only the English-speaking public, but also the Italian or Spanish-speaking publics that had to be taken into account [...], the Board of Appeal disregarded a potentially relevant factor of conceptual similarity. Rather, it should have analysed that conceptual similarity, which the applicant had alleged existed for the Italian or Spanish-speaking publics.

The General Court further stated:

Since, first, the Board of Appeal incorrectly found that the earlier sign would not be broken down by the relevant public [...] and that there was no conceptual similarity between the signs at issue for the English-speaking public [...] and, secondly, it did not assess the conceptual similarity for the Italian or Spanish-speaking publics, that assessment is necessarily vitiated by errors.

Therefore, the conceptual identity of the marks, by itself, offset all the other factors. The court noted:

If the Board of Appeal had correctly examined whether the signs at issue were conceptually similar, in particular for the Italian or Spanish-speaking publics, it cannot be ruled out that it would have had to find that there is a likelihood of confusion in the present case.

Comment

In a system that uses many different languages and in which products must freely move through 28 countries, it is predictable that such an issue will commonly arise. However, almost all the decisions on the issue confirm that the language of each EU country is equally important.

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