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Lego successfully prevents registration of LEGNOLAND in Class 28

European Union - [Bugnion SpA](#)

- **The Fourth Board of Appeal of the EUIPO has confirmed that there was a likelihood of confusion between LEGNOLAND and LEGO/LEGOLAND in Class 28**
- **The argument concerning the peaceful co-existence of the mark was held to be manifestly unfounded**
- **The Danish-speaking and English-speaking public would not perceive 'legno' as the Italian word for 'wood'**

In [Globo SpA Servizi Commerciali v Lego Juris A/S](#) (Case R 29/2019-4), the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) has dismissed the appeal filed against the decision of the Opposition Division of the EUIPO of 12 November 2018 in opposition proceedings against the mark LEGNOLAND.

Background

On 21 April 2017 Lego Juris A/S filed an opposition against the EU trademark (EUTM) application (No 016125197) for LEGNOLAND and device, claiming protection for goods in Class 28. The opposition was based on a likelihood of confusion with Lego's EUTMs LEGO and LEGOLAND, relied upon for some of the goods protected in Class 28, for which reputation of the earlier marks in the European Union was claimed under Article 8(5) of the Trademark Regulation.

The Opposition Division of the EUIPO upheld the opposition for all the contested goods based on the reputation of the earlier LEGO mark.

On 7 January 2019 the applicant appealed the decision of the Opposition Division.

Board of Appeal decision

The Board of Appeal focused, in the first place, on the alleged peaceful co-existence of the marks and on the admissibility of the related evidence, which had been raised by the appellant **for the first time at the appeal stage**.

The board found that the argument concerning the peaceful co-existence of the marks was manifestly unfounded and that the evidence filed was inadmissible, as it did not meet the requirements set forth in Article 27(4) of the EU Trademark Delegated Regulation.

To demonstrate the alleged co-existence, the appellant had filed screenshots showing a few products for sale on Amazon websites in Italy, Germany and France. In the board's opinion, the fact that some of the products might have been offered for sale on Amazon websites in Italy, France and Germany did not show co-existence in the remaining member states of the European Union.

The board recalled that, according to the relevant case law, "it is a prerequisite for a claim of co-existence to show that the relevant public has encountered both the contested EUTM and the earlier trademark on the market". In the absence of evidence to prove the extent of sales, it could not be assessed, in the board's view, that a substantial part of the relevant public knew that the contested sign was used in relation to the contested goods. In this regard, the board stated:

[O]n Amazon websites there are countless products, and merely selling goods there certainly does not constitute proof that any substantial part of the relevant public even knew about any such offers or sales. Also, regardless as to when products were first made available, it is entirely possible that for intervening periods they were not available, so the arguments do not even show constant uninterrupted sales of products. [...] In the absence of knowledge, any co-existence on a given marketplace cannot be said to be peaceful in any relevant sense.

Further, the fact that Lego opposed the corresponding Italian trademark application for LEGNOLAND constituted a clear sign that tolerance or peaceful co-existence of the marks could not be recognised.

The appellant did not contest the reputation of the earlier mark LEGO, recognised by the Opposition Division, and the board confirmed such reputation. As to the comparison of the signs LEGO and LEGNOLAND, the board found that the similarity and identity of the goods, as well as the visual and aural average similarities of the signs, led to the existence of a likelihood of confusion for all the contested goods at least for the Danish-speaking and English-speaking public, who would not perceive 'legno' - as claimed by the appellant - as the Italian word for 'wood', but as a fanciful word being the most distinctive element in the contested sign.

The board thus dismissed the appeal.

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