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All animals are equal, but some animals are more equal than others. Time to rethink the EUTM “unitary character”.

(<http://trademarkblog.kluweriplaw.com/2020/07/01/all-animals-are-equal-but-some-animals-are-more-equal-than-others-time-to-rethink-the-eutm-unitary-character/>)

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Should a registered EU trademark which consists of a descriptive term (in one of the EU languages) be capable to prevent registration of a later EUTM which is fanciful but happens to contain the same letter string, solely because in some EU countries knowledge of that language cannot be adequately proven? What if that language is English, the by far predominant language in the EU when it comes to number of people that speak it at least to a reasonable level of proficiency, even without counting the UK?

Yes and no. This is what the GC decided on 29 of April 2020 in case T-37/19 (Cimpress Schweiz GmbH vs EUIPO and Impress Media GmbH). The GC held that between the EUTM application “CIMPRESS” and the earlier EUTM registration “IMPRESS” (figurative) there was a likelihood of confusion for certain common goods and services in classes 16, 35 and 42, mainly because the applicant did not prove that the Polish-speaking public would understand what IMPRESS means in English.

Why the Polish public? Because there were EU trademarks involved on both sides, and if there is likelihood of confusion anywhere in the EU, the opponent prevails. It is not rare for the EUIPO to pick one or another country, rather randomly, to assess likelihood of confusion through the eyes of that country’s consumer. Usually those would be countries where the language(s) in which the marks in question are intelligible are not, or not widely, spoken.

The GC noted that understanding the meaning of a word which is not part of the mother tongue of the population of a territory cannot be presumed unless a sufficient knowledge of that language in that territory is a well-known fact. Since knowledge of English in Poland is not a well-known fact, Cimpress Schweiz should have demonstrated that the Polish public at large would be capable to perceive the meaning of the word IMPRESS.

However, this was held to be not proven. Firstly, the evidence showed good knowledge of English only among Polish people below 35 years of age. Secondly, in the GC’s view, the English term “IMPRESS” is not part of the basic English vocabulary; the English term usually used and better known is “to print”, so that even for the part of the public with a higher proficiency of English, the term “impress” would not necessarily be related to the products and services at issue. Therefore, the GC held that both marks were devoid of any meaning for the Polish public of reference. Therefore, CIMPRESS and IMPRESS were found to be highly similar both visually and aurally.

On the same day, the GC decided similarly in cases T-108/19 and T-109/19 (TasteSense / Multisense) finding a likelihood of confusion and holding that the knowledge of English on the part of the Polish and – in that case – Spanish public was not a well-known fact and must be demonstrated.

Both decisions are unsurprising because they are technically correct, given the unitary character of EUTM which dictates that a likelihood of confusion in only part of the EU is sufficient to refuse an EUTM in the entire EU. Nonetheless, the result is that Impress Media GmbH gets a monopoly on the word IMPRESS for, inter alia, print items (such as business cards etc.). That leaves a bit of a stale taste, especially bearing in mind that the word “print” derives from impression, and that either one or the other have many equivalent terms many EU languages. The aftertaste gets even staler when considering that it was recognised that the younger generations indeed do speak English.

The unitary character should be a factor which helps and fosters companies to exploit the benefits of the common market. However, granting monopoly rights over certain terms solely because for historical/political/economic reasons in certain EU countries, foreign languages and in particular English were not studied, seems to go against the spirit underlying the development of a Union where predictability and a level playing field for all companies should be the main objectives.

Thus, perhaps it might be that we have reached the time where instead of assuming that EU consumers do not generally understand English because it is not the mother tongue of the entire EU, we ought do the opposite. Let's switch the burden of proof and request that owners of earlier marks that are descriptive in English (or other languages) prove by a preponderance of evidence that their mark is not understood as a descriptive for the consumers of that EU country where they assert that a likelihood of confusion arises. After all, why should the unitary character not be used to strengthening the things we have in common, rather than those that divide us? "A house divided against itself cannot stand", said a truly remarkable man some time ago, and this still seems remarkably true now.

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