



General Court highlights proximity between goods in Classes 32 and 33

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- The EUIPO upheld an opposition against the registration of COPALLI in Class 33 based on the earlier Portuguese mark COMPAL in Class 32
- The court found that the Board of Appeal had correctly established the elements of similarity between the marks
- There was a certain “proximity” between the goods, which was one of the factors which must be taken into consideration under Article 8(5)

On 30 March 2022 the General Court issued its decision in [Case T-445/21](#) between Copal Tree Brands Inc (‘the applicant’), the European Union Intellectual Property Office (EUIPO) and Sumol + Compal Marcas SA (‘the intervener’).

Background

On 13 September 2018 the applicant filed an application for registration of an EU trademark with the EUIPO. Registration was sought for the word sign COPALLI for goods in Class 33.

The intervener filed a notice of opposition in respect of all the goods covered by the application in Class 33. The opposition was based on, among other rights, the Portuguese word mark COMPAL, which was registered in 1998 and covers goods in Class 32 (in particular, fruit drinks).

The Opposition Division of the EUIPO upheld the opposition, and the Second Board of Appeal dismissed the appeal.

General Court Decision

Before the General Court, the applicant raised one plea in law, which was divided in two parts. The applicant contested:

1. the existence of similarity between the earlier mark and the mark applied for; and
2. the existence of a risk that the use without due care of the mark applied for would take unfair advantage of the repute of the Portuguese earlier mark under Article 8(5) of Regulation 2017/1001.

First part of the plea

The court recognised that the Board of Appeal had correctly established the elements of similarity between the marks. First, considering the visual similarity, almost all of the letters contained in the words 'copalli' and 'compal' were the same and in the same order; there were only irrelevant differences between them.

Turning to the phonetical comparison, it followed from the case law that, where the signs to be compared are invented terms that do not correspond to any existing word in an EU language, the likely pronunciation thereof by the relevant public should be taken into account. For this reason, the Board of Appeal found a probable syllabic division of the pronunciation of the marks - that is, 'co-pal-li' for the mark applied for and 'com-pal' for the earlier mark. The pronunciation of the first two syllables of the marks was very similar. Even though the mark applied for has a third syllable, this difference was not capable of offsetting the similarities found.

Second part of the plea

The court noted that there was a "proximity" between the Compal fruit drinks and the Copalli alcoholic beverages, which could allow the application of Article 8(5) of Regulation 2017/1001. A "proximity" should not be confused with the concept of "similarity", which is one of the cumulative conditions for the application of Article 8(1) of the regulation.

Here, there was a certain "proximity" between the goods covered by the marks as a very large number of non-alcoholic beverages in Class 32 and alcoholic beverages in Class 33 are generally consumed or marketed together. Taking into account the very strong reputation of the earlier mark for "fruit drinks and fruit juices", the proximity between these goods and those covered by the mark applied for, the degree of similarity between the marks at issue, and the inherent distinctive character of the earlier mark, the court concluded that there was a strong probability that the use without due cause of the mark applied for would take unfair advantage of the distinctive character or the repute of the earlier mark.

Conclusion

The General Court dismissed the action, upholding the Board of Appeal's decision. Therefore, the applicant's trademark cannot be registered as an EU trademark for goods in Class 33.

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