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In OHIM v riha WeserGold Getränke C-558/12 P, the Court of Justice of the European Union (CJEU) has held that the enhanced distinctiveness of an earlier mark is irrelevant where no similarity between marks has been found.

Background

Lidl filed a Community trade mark (CTM) application for the word mark WESTERN GOLD in Class 33 for “spirits, in particular whiskey”. WeserGold filed an opposition alleging likelihood of confusion under Article 8(1)(b) of the CTM Regulation (40/94/EC, now 207/2009/EC) with several of its earlier Community, national and international registrations for the word mark WESERGOLD covering goods in Classes 29, 31 and 32, including non-alcoholic beverages.

The Opposition Division of the Office of Harmonization for the Internal Market (OHIM) upheld the opposition. The First Board of Appeal overturned that decision, finding there was no likelihood of confusion.

On appeal, the EU General Court held the Board of Appeal had erred in its application of Article 8(1)(b) by failing to uphold its duty to perform a new and comprehensive examination of the merits of the opposition. Even though WeserGold had not submitted arguments regarding enhanced distinctiveness before the Board of Appeal, it had referred to this in its written submissions before the Opposition Division, which indicated that the earlier marks had acquired enhanced distinctiveness through use. In the General Court’s view, the Board of Appeal had failed to examine a relevant factor in the global assessment of whether or not there was a likelihood of confusion and the decision had to be annulled for breaching essential procedural requirements. WeserGold appealed to the CJEU.

Decision

Allowing the appeal, the CJEU stressed that the likelihood of confusion under Article 8(1)(b) presupposed that the mark applied for and the earlier mark were identical or similar, and that the goods or services applied for were identical or similar to those goods or services for which the earlier mark was registered. These conditions were cumulative. Where there was no similarity between the marks, the enhanced distinctiveness of the earlier mark and the identity and similarity of the relevant goods and services could not result in a finding of a likelihood of confusion. The enhanced distinctiveness of a mark that was acquired through use, however, had to be considered when deciding whether or not the similarity between the signs and between the goods or services created a likelihood of confusion. The CJEU held the General Court had misinterpreted Article 8(1)(b). Since the General Court had found the relevant marks were dissimilar, it was unnecessary to consider enhanced distinctiveness. The General Court had, therefore, erred in law by finding that the Board of Appeal had failed to uphold its duty to examine the enhanced distinctiveness of the earlier mark, acquired through use. Where there was no similarity between the marks, there could not be a likelihood of confusion, and enhanced distinctiveness of the earlier mark could not offset the lack of similarity between the respective marks.
Comment

A finding of a likelihood of confusion under Article 8(1)(b) presupposes identity or similarity between the marks and identity or similarity between the goods and/or services. Once it is established that the marks in question are dissimilar, a likelihood of confusion becomes impossible. It is, therefore, unnecessary to consider the enhanced distinctiveness of the earlier mark.

Conversely, where the marks are found to be similar and the goods and/or services are identical or similar, enhanced distinctiveness of the earlier mark is one factor to examine in the global assessment for determining whether or not there is a likelihood of confusion.

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