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Success for Apple as General Court finds certain degree of similarity between APO and APPLE marks

European Union - [Hoogenraad & Haak, Advertising + IP Advocaten](#)

- Apple opposed registration of figurative APO mark based on earlier figurative and word marks
- EUIPO found that marks were not similar
- General Court disagreed, finding certain degree of visual, phonetic and conceptual similarity

Facts

Apo International Co Ltd sought registration of the figurative sign depicted below as an EU trademark in 2012:



Apple Inc filed a notice of opposition based on the figurative trademark depicted below, as well as two APPLE word marks:



The grounds relied on in support of the opposition were those set out in Articles 8(1)(b), (4) and (5) of [Regulation 207/2009](#) (now Article 8(1)(b), (4) and (5) of [Regulation 2017/1001](#)). In February 2016 the Opposition Division rejected the opposition (Paragraphs 1 to 8).

In April 2016 Apple filed a notice of appeal against this rejection, which was dismissed by the Fourth Board of Appeal of European Union Intellectual Property Office (EUIPO). The board stated that, visually, the APO mark distinguished itself (i) from Apple's figurative mark due to the word 'apo' being prominently visible and (ii) from the earlier word marks by reason of its graphic features and due to the fact that the word 'apo' is shorter than 'apple'. Phonetically, the mark would be pronounced 'apo' or 'capo', which was different from 'apple' due to their respective endings ('o' and 'ple') leading to very different pronunciations. Finally, the board noted that the marks were different on a conceptual level because the earlier marks clearly designated an apple, whereas the word element 'apo' did not have such a meaning and the representation of a fruit in the APO mark could be another fruit, such as an orange (Paragraphs 9 to 11 and 65).

General Court decision

Apple successfully sought the annulment of that decision at the General Court ([Apple Inc v EUIPO](#) (Case T-104/17)).

The court noted that both Articles 8(1)(b) and 8(5) are inapplicable only where any similarity between the marks at issue is ruled out. If there is some similarity, however faint, it will be necessary to carry out an overall assessment in order to ascertain whether there is a likelihood of confusion or a link made between the marks by the relevant public (Paragraph 20). According to settled case law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical visually, phonetically or conceptually (Paragraph 22).

The court held that, from a visual point of view, the figurative element of the APO mark would be perceived, at least by a significant part of the relevant public, as being the representation of a part of an apple (Paragraph 35). The court concluded that the signs, considered as a whole, showed a certain degree of visual similarity (Paragraph 41). Regarding the comparison with Apple's word marks, the court noted that, although there was a similarity between the two initial letters 'ap', it was not sufficient to counterbalance the clear differences in length as well as in their endings (Paragraphs 42 to 50).

The court further noted that a figurative mark without word elements cannot, by definition, be pronounced. For the comparison with Apple's word marks, it noted that the word elements coincided in that they consisted of two syllables and by the fact that the first syllable would be stressed, whereas the second syllable would be swallowed. The result was a comparable rhythm and sound. The slight difference in ending of the words could not counterbalance the phonetic similarity so that there would be, at least for a significant part of the public, a certain degree of similarity (Paragraphs 52 to 64).

On a conceptual level, the court held that the element 'apo' does not have a meaning, in most languages, for the relevant public. It also noted that the graphic particularities of the figurative element of the APO mark contradicted the proposition that the figurative element would be perceived as a letter 'c' by a significant part of the public. It was therefore appropriate to hold that there was a conceptual similarity between the marks at issue, to the extent that all the marks evoke the concept of an apple (Paragraphs 71 to 75).

The court concluded that the board had erred in taking the view that the marks at issue were different and in rejecting the opposition without conducting an assessment of the other conditions laid down in Article 8(1)(b) and (5) of the regulation. Therefore, the court annulled the board's decision in its entirety, ruling in favour of Apple.

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