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General Court: Board of Appeal wrongly assessed dominant element of composite sign

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

- El Corte Inglés opposed registration of figurative mark K9 UNIT based on earlier figurative mark UNIT
- Board of Appeal found that there was likelihood of confusion for goods in Classes 16, 18 and 25
- General Court disagreed, finding that word element 'k9' and figurative elements were clearly dominant compared to word element 'unit' in mark applied for

In [Julius-K9 Zrt v EUIPO](#) (Case T-276/18), the General Court has annulled the decision of the Second Board of Appeal of the EUIPO. The General Court clarified how to assess the dominant and distinctive character of one or more elements that make up a composite trademark in the context of an opposition procedure based on Article 8(1)(b) of [Regulation 207/2009](#) (now Article 8(1)(b) of [Regulation 2017/1001](#)).

Background

Julius-K9 (hereafter 'the applicant') sought the registration of the following figurative sign in Classes 9, 10, 16, 18, 20, 25 and 28:



Hipercor, which later merged with El Corte Inglés, filed an opposition directed at the goods in Classes 16, 18, 25 and 28 based on the grounds laid down in Article 8(1)(b). The opposition was based on its earlier EU figurative mark No 9182718:



The Opposition Division upheld the opposition for all the contested goods in Classes 16, 18 and 25, but rejected it in respect of the goods in Class 28. An appeal against this decision was unsuccessful, as the Board of Appeal confirmed the decision of the Opposition Division. This led to an appeal before the General Court. The applicant made one plea in law, consisting of three complaints:

- The first complaint was aimed at the exclusion of significant graphic elements, such as the silhouette of a man and the leaping dog, and the word element 'K9' from the comparison. According to the applicant, the board had compared only the word 'unit' to the earlier sign, instead of examining the signs as a whole.
- The second complaint concerned the phonetic comparison of the contested sign and earlier mark. According to the applicant, instead of comparing 'unit' and 'unit', the board should have compared the sign as a whole - namely, the elements 'k9 unit' and 'unit'.
- The last complaint referred to the assessment of the likelihood of confusion. According to the applicant, the board had merely stated that the contested sign contained the word 'unit' and found that this element had an independent role, even though it was not dominant.

In short, the complaints concerned the board's assessment that the word element 'unit' was the dominant element of the contested sign and, thus, its disregard of the other elements of the composite sign. According to the applicant, a fair comparison between the contested sign and the earlier trademark had not taken place.

General Court decision

Contrary to the board, the court believed that there was no reason to regard the word element 'unit', due to its positioning and legibility, as an element of particular importance in the sign applied for. The court pointed out that the other elements (the silhouette of a man with a cap pointing his finger to the star in the centre of the number 9 of the 'k9' element and the leaping dog) occupied a clearly central position in the sign. The size of these elements added to the conclusion that they were more likely to attract the attention of the consumer than the word 'unit'. The board was wrong to 'grab' only the element 'unit' instead of perceiving the applicant's sign as a whole (ie, the element 'unit', as well as the figurative elements and their dominant position in the composite sign).

Due to the board's clear misconception of the dominant elements in the composite sign, the court found reason to reject the board's assessment of the comparison of the goods and likelihood of confusion. Had the board applied the correct assessment by comparing the applicant's sign as a whole, it would have found a significantly lower degree of visual and phonetic similarity. This was supported by the fact that the element 'k9' is part of the applicant's name, Julius-K9 and, therefore, the element 'unit' could not be perceived independently from the element 'k9'. The erroneous comparison gravely affected the overall analysis of the likelihood of confusion.

Therefore, unsurprisingly, the court upheld the applicant's plea and annulled the decision of the board that there was a likelihood of confusion on the part of the relevant public with regard to the goods at issue.

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