

**Hug wins opposition case against GULLON DARVIDA mark  
European Union - Granrut Avocats**

**Examination/opposition  
International procedures**

January 22 2018

- **General Court has upheld a decision finding that there was a likelihood of confusion between the mark GULLON DARVIDA and earlier DAR VIDA marks**
- **The goods designated by the marks were found to be identical**
- **This increased the likelihood of confusion, despite the fact that the signs had an average degree of visual and phonetic similarity**

## Background

In *Gallettas Gullon v EU Intellectual Property Office (EUIPO)* (T-456/16), Spanish company Gallettas Gullon applied to register the word mark GULLON DARVIDA in Class 30. The application was opposed by Hug AG on the basis of its prior DAR VIDA international mark covering a number of EU countries and its DAR VIDA national marks. The opposition was rejected as Hug failed to prove that it owned the prior international mark. The mark had been registered under the name Hug AG Zwieback & Biscuits and there was insufficient evidence to prove use of the various prior national marks.

This decision was cancelled by the EUIPO Board of Appeal, which held that the fact that the international World Intellectual Property Organisation (WIPO) Romarin database listed Hug AG Zwieback & Biscuits did not mean that Hug AG could not file an opposition and that the small differences between the mark as filed and its use were not enough to refuse it as evidence of use. It also found that the relevant territory to examine the likelihood of confusion was Germany and that the products and signs were similar. The opposition was therefore accepted on the basis of the international mark. This decision was then appealed.

## Facts

As is often the case, new evidence was produced for the first time before the EU General Court and under the procedural rules it was rejected.

The first plea was based on Article 76 of Regulation 207/2009 and Rule 19 of the Regulation 2868/95. According to settled case law concerning Article 76(2), the EUIPO has discretion to accept facts and evidence even if filed late.

The EU General Court re-examined Rules 19, 20 and 50 of Regulation 2868/95 to decide on the extent of the power of the board of appeal to examine evidence filed after a delay. The court distinguished between new and complementary evidence since Rule 50 does not allow the board of appeal to examine new evidence – this can be done only if the evidence is complementary.

In the case at hand, Hug presented to the EUIPO Opposition Division an excerpt from the Romarin database and to the board of appeal an excerpt from the commercial register to prove its ownership of the prior mark, despite two slightly different names appeared according to which document was taken into consideration. It also filed a request for a change of company name for the international mark and a letter proving that this change was going to be published in the WIPO official review.

The documents were judged as complementary and, according to case law, the board of appeal had the power to accept them even if they were produced before it for the first time. The court then examined whether the board of appeal had correctly used its power, since the board had to justify that the evidence was relevant and did not impede the proceedings. In addition, it had to explain the basis for its decision and whether it accepts the new evidence.

The board of appeal explained that the document provided had verified the issue concerning the name and explained why the decision had been taken. This was sufficient for the court to decide that the board of appeal had correctly exercised its power to allow the new evidence.

The next issue for the court was to decide whether the board of appeal had correctly examined the evidence by taking into consideration Part C, Section 1 of the EUIPO examination guidelines concerning the company name. The court stated that the directives are non-binding but that the EUIPO imposes on itself a limitation to which it must abide.

It appeared from the evidence submitted that the change of name did not modify the legal form of the company, since the AG form (meaning company per share in German and Swiss law) did not change as a result of the name change. This was accepted by WIPO, which notified that the change would be published. Therefore, the change of name had not resulted in a change of ownership and the board of appeal had not incorrectly examined the evidence.

The second plea was based on Article 42(2) and (3) of Regulation 207/2009 and Rule 22(2) of Regulation 2868/95. The court found that, contrary to what was submitted by Hug, the appeal was admissible as the factual and legal elements could be understood when reading the appellant's brief. Since the board of appeal had correctly taken into consideration the international registration as the basis of its decision, it was unnecessary to examine the serious use of the other prior national marks. The second plea was therefore rejected.

The third plea was more common, based on Article 8(1)(b) of Regulation 207/2009. The court recalled its settled case law concerning the likelihood of confusion. It held that where the goods or services are identical there may be a likelihood of confusion on the part of the public when the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness, without determining the overall impression conveyed by the composite sign which has an independent distinctive role (see *Medion* (Case C-120/04) at 37). This principle requires that an individual examination must be made.

It was decided that the German territory was relevant since proof of use of the international mark had been provided for that territory and there was no discussion concerning the relevant public (the average consumer who is reasonably well informed, observant and circumspect). There was also no discussion about the fact that the products of both marks were identical.

Concerning the signs, the visual analysis suggested that 'Dar vida' had no meaning for the German consumer. However, it was found that 'Dar vida' and 'Darvida' were relatively similar. Regarding whether Gullon's mark was well known, the court held that this concerned the prior mark and not the opposed mark.

It was then argued that the public would focus on the beginning of the mark rather than the end. However, the court held that the fact that each of the marks contained several letters in the same order may be of some importance in assessing the visual similarity between the signs at issue (see *Clover Canyon v EUIPO – Kaipa Sportswear* (Case T-693/15)). Further, the fact that a mark consists exclusively of an earlier mark, to which another word has been added, is an indication that the two marks are similar.

The court added that the consumer normally attaches more importance to the first part of a word mark than the subsequent parts, but this is not true in all cases. Therefore, this argument could not be assessed independently of the facts of the case, in particular the specific characteristics of the signs at issue (see *United States Polo Association v OHIM – Textiles CMG* (Case T-228/09) at 37). Taking into consideration the overall impression created by the sign at issue, the board of appeal was correct in finding a visual similarity.

The phonetic comparison was not discussed and was found to be average. It was held that the signs had no conceptual meaning and that their comparison was neutral.

Finally, concerning the likelihood of confusion, the board of appeal found that, taking into account the identity of the relevant goods, the average level of visual and phonetic similarity of the signs at issue, the normal level of attention of the relevant public and the normal degree of inherent distinctiveness of the earlier mark, there was a likelihood of confusion.

The court concluded that there was no sufficiently direct and specific link between the goods referred to by the applied-for mark and those covered by the earlier international mark, namely biscuits, nor the Spanish word '*darvida*' (which means 'giving life') and the Spanish expression '*dar vida*' (which has no meaning for the public at large in Germany). Therefore, the board of appeal was entitled to find that the earlier trademark had a normal degree of intrinsic distinctiveness for the relevant public. Further, it found that the signs had an average degree of visual and phonetic similarity, the level of attention of the relevant public was normal and the earlier mark had a normal degree of distinctiveness. The goods covered by the earlier international trademark and those that were the subject of the mark applied for were identical.

There may be a likelihood of confusion, despite a low degree of similarity between the marks, where the similarity of the goods or services covered by the marks is considerable (see *Emram v OHIM – Guccio Gucci* (Case T-187/10)).

In the case at hand, as previously stated, the goods designated by the applied-for mark and those covered by the earlier marks were identical. This therefore increased the likelihood of confusion between the signs, despite the fact that the signs had an average degree of visual and phonetic similarity, the level of attention of the relevant public was normal and the earlier trademark had a normal degree of distinctiveness.

The board of appeal was therefore entitled to find that there was a likelihood of confusion and the action was dismissed.

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