

In a relatively rare scenario, Case T-64/11 Run2Day Franchise BV v OHIM (7 February 2012) the General Court has overturned a decision of OHIM's First Board of Appeal overturning a decision of the Opposition Division which had upheld an opposition to a CTM application for the following mark:

Run²

The application was filed by Runners Point Warenhandels GmbH in December 2007 for sportswear and related goods and services in classes 18, 25 and 35 of the Nice Classification. In August 2008, Run2Day opposed the application under Article 8(1)(b) of the Community Trademark Regulation (40/94) on the basis of the word mark RUN2DAY and the following figurative CTM registration of RUN2DAY in classes 25 and 35 and Benelux figurative registration of RUN2DATE in class 25:



In January 2010 the Opposition Division upheld the opposition, but in November 2010 the Board of Appeal overturned the decision and rejected the opposition on the following grounds:

- the relevant public was the public at large for the goods as well as professionals for the services, and the level of attention of the relevant public was not particularly high;
- the class 18 goods covered by the application had a low degree of similarity with the class 25 goods covered by the earlier marks, and the respective class 25 goods and class 35 services were identical to the first two syllables of the earlier word mark;
- the marks were visually relatively similar, were phonetically similar and lacked conceptual similarity despite the presence of the elements RUN and 2 in the respective marks;
- the marks had a low level of distinctiveness in view of the descriptiveness of the word RUN;
- in the context of global appreciation, the differences between the marks and the low level of distinctiveness of the word RUN eliminated any likelihood of confusion;

- the earlier figurative marks had more differences from the mark applied for than the earlier word mark.

The General Court held that the board's examination of visual similarity was incorrect and contradictory because on the one hand it held that the word RUN in the respective marks should be considered identical, and on the other that the use of capital and lower case letters in the mark applied for should be taken into consideration.

With regard to phonetic similarity, the court noted that the board had held that the mark applied for was identical to the first two syllables of the earlier word mark, but that the element 2 would be perceived by the relevant public as meaning "squared", and again concluded that the board's examination was incorrect.

Turning to conceptual similarity, the court again found that the board had concluded in error that the marks were not similar because it had refused to consider any such similarity arising from the word RUN. According to the court, the concept of "run" or "running" would not be negligible in the overall impression created by the earlier word mark registration.

Having disagreed with the board on each count, the court concluded that the board had made errors in assessing the degree of similarity between the marks and its global appreciation of the likelihood of confusion, and overturned the board's decision.

Reading this judgment, it is tempting to conclude that the board of appeal erred alarmingly. However, it is on balance relatively easy to follow the board's lines of argument and concur with them, in view of the arguably low distinctiveness of all the marks in question. Perhaps the most compelling impression left by the judgment is the comprehensive manner in which the court dismantled the board's decision.

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