

In **Case T-353/09 mtronix OHG v OHIM** (1 February 2012), the General Court has rejected an appeal against the Fourth Board of Appeal's decision to refuse in part a CTM application.

In January 2005, mtronix OHG, a German electronics company, applied to register the word mtronix as a CTM for the following goods in class 9:

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus; apparatus for performance, distribution, transformation, heating, adjusting or managing electrical currents; apparatus for recording, transmission or reproduction of sound or images; ATMs and prepayment machines; magnetic data carriers, recording discs, cash registers, calculators, data processing equipment and computers; fire extinguishers.

In November 2005, Growth Finance AG opposed the application on the basis of Article 8(1)(b) of Trade Mark Regulation No 40/94 (now 207/2009) due to its earlier CTM registration of the word **Montronix** for the following class 9 goods:

Scientific, nautical, surveying, photographic, cinematographic, optical, measuring, signalling, checking, life-saving, apparatus for teaching, surveillance and methods of surveillance of machine tools, electrical apparatus, apparatus for recording, transmission and reproduction of sound and image, data processing equipment and apparatus, IT equipment to process information, computers; apparatus for checking machine tools, sensors, hardware and software for checking, analysing and documenting the activity of machine tools.

The Opposition Division upheld the opposition, except in relation to fire extinguishers. mtronix appealed to the Board of Appeal.

In June 2009, the Board of Appeal overturned the Opposition Division's decision for ATMs and pre-payment machines. It rejected the appeal for all other goods in the application due to a likelihood of confusion between the marks for those goods.

mtronix filed an appeal to the General Court.

Preliminary Points

The General Court acknowledged that mtronix had requested the entire decision of the Board of Appeal to be overturned but the Board of Appeal had in fact accepted the application for certain goods, namely ATMs and prepayment machines, which, in the Board's view, were different to the goods for which the earlier mark was registered.

With this in mind, the General Court held that the appeal to overturn the entire decision was not fully admissible. It explained that a

person wishing to appeal against a decision must have a real interest in overturning it. There was no such interest for mtronix in respect of the entire decision since part of the decision did not prejudice mtronix at all.

The Relevant Public

The General Court emphasised that, whilst the Board of Appeal had not expressly defined the relevant public, it had defined the relevant public by implication, because it had stated in its decision that the whole of the EU had to be taken into consideration and it had considered that its interpretation of the likelihood of confusion also applied to the specialist public who would pay a greater level of attention to the goods.

The General Court agreed that the relevant public was the average EU consumer and comprised both specialists (for goods such as scientific and surveying apparatus) and the general public (for goods such as photographic apparatus, recording discs, calculating machines and computers).

Comparison of The Goods

The General Court took the customary approach of referring to several factors to compare the goods in the application and registration including their nature, purpose, use and distribution channels. It relied on the established principle that, where a category of goods includes all goods in another category, the goods in the sub-category are to be considered as identical to the broader category.

mtronix conceded that the following goods were identical in both the application and the registration: *scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus; apparatus for recording, transmission or reproduction of sound or images; data processing equipment and computers* but disagreed that other goods in the application were the same or similar as follows: *weighing apparatus, apparatus for performance, distribution, transformation, heating, adjusting or managing electrical currents; ATMs and prepayment machines; magnetic data carriers, recording discs, cash registers, calculators.*

The General Court examined each of the goods in the application in detail, concluding as follows:

- *Weighing apparatus* would be included in the general category of "apparatus for measuring or checking" covered by the earlier registration since they had the same purpose, user, distribution channels and manufacturers and were generally related. Therefore, weighing apparatus was identical to those goods;

- *Apparatus for performance, distribution, transformation, heating, adjusting or managing electrical currents* would be included in the category of “electrical apparatus” covered by the earlier registration and accordingly were identical to those goods;
- *Magnetic data carriers and recorded discs* would be similar to “apparatus for recording, transmission or reproduction of sound or image” covered by the pre-existing registration since they were related goods and had the same user and distribution channels;
- *Cash registers and calculators* would be incorporated in, and are therefore similar to, “computers” covered by the earlier registration, since computers often incorporated a calculator or processed information and had the same function, manufacturer and distribution channels. Moreover, such goods would be likely to be in competition with each other.

Comparison of The Marks

The General Court took the same approach as the Board of Appeal by comparing the marks visually, phonetically and conceptually.

First, the General Court agreed with the Board of Appeal that the marks had strong visual similarity because they shared the same first letter and suffix and comprised letters in the same order. mtronix argued that there were visual differences due to the upper case M in the registered mark and lower case m in the applicant mark but the General Court dismissed this on the basis that stylisation had no significance for a word mark application as the legal protection was derived from the word itself, regardless of stylisation.

Second, the General Court agreed with the Board of Appeal that the marks had at least average phonetic similarity. It emphasised that the “m” and “tronix” element would sound identical and would dominate the sound of the marks and up to 2, 3 or 4 syllables would be pronounced identically.

Finally, the General Court considered the conceptual similarity of the marks. The Board of Appeal had held that the words had no meaning at all but the General Court took a different approach. It accepted that the words mtronix and Montronix were invented words, but also accepted that the “tronix” element of the mark alluded to electronics in English, *electronique* in French, *elektronik* in German and *electronica* in Spanish. The General Court also acknowledged mtronix’s submission that the letters “ks” were often abbreviated to an “x”. Therefore, the General Court concluded that the marks were conceptually similar despite their differences in form.

Likelihood of Confusion

The Board of Appeal had considered that the earlier mark had average distinctiveness and, as a result of a high level of visual similarity and at least average phonetic similarity, there would be a likelihood of confusion for the identical or similar goods. However, there would be no likelihood of confusion for dissimilar goods such as fire extinguishers (as reflected in the Opposition Division’s decision) or ATMs and prepayment machines.

mtronix submitted arguments relating to the range of its goods and sales techniques in an attempt to prove that there was no likelihood of confusion, but the General Court dismissed such arguments and explained that the analysis of the likelihood of confusion between two marks should not rely on the subjective commercial intentions of the mark owners and that OHIM can only consider the specification of goods in the application.

Accordingly, the General Court held that the two marks were visually, phonetically and conceptually similar and the relevant goods were either identical or similar so there would be a likelihood of confusion between the marks for the relevant public (both specialists and the general public).

Comment

This case illustrates the propensity of the General Court to scrutinize the specification of goods or services for which a CTM application is filed in detail when comparing them with those covered by an earlier registration. It is a useful reminder that it is crucial to ensure that specifications are properly reviewed and drafted.

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