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# Review

Intellectual Property

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## CFI toys with ENERCON application

In Case T-472/07, Enercon GmbH v Office for Harmonisation in the Internal Market (OHIM) of 3 February 2010, the CFI has upheld a decision of OHIM's Board of Appeal that there is a likelihood of confusion between Enercon's mark, ENERCON and the mark, TRANSFORMERS ENERCON.

### The facts

In August 2003, Enercon filed an application to register ENERCON as a Community trade mark for goods in classes 16, 18, 24, 25, 28 and 32.

In November 2004, Hasbro Inc, proprietors of the mark TRANSFORMERS ENERCON opposed the registration under Article 8(1)(b). The mark was registered in the UK for goods in classes 16, 18, 24, 25, 28, 30 and 32. OHIM upheld Hasbro's opposition on the basis that there was a likelihood of confusion in respect of all the goods applied for. Enercon appealed to the Board of Appeal (the Board).

The Board rejected the appeal, agreeing that there was likelihood of confusion between the ENERCON and the TRANSFORMERS ENERCON marks. In arriving at this decision, the Board held that the goods covered by the marks were identified and that the marks themselves were similar enough to give rise to a likelihood of confusion.

### The CFI judgment

The CFI began by clarifying that for the purpose of assessing the likelihood of confusion, it is only earlier *registered* marks that can form the basis for the comparison. Hasbro's unregistered marks, TRANSFORMERS ENERCON and ENERCON were therefore irrelevant in this context because they did not fall within Article 8(1).

The CFI set out the established principle that the likelihood of confusion on the part of the public must be assessed globally which requires consideration of all the factors relevant to the case alongside the case law. It was necessary to consider the extent of the similarity of the goods covered by the marks (which in this case was not disputed by the parties) and the extent of the similarity between the marks themselves. The

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When assessing confusion the marks must be compared as a whole. The focus is not on merely one element of a mark

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latter requires an analysis of the visual, phonetic and conceptual similarity of the marks, bearing in mind any distinctive or dominant components.

As the earlier mark (the TRANSFORMERS ENERGON mark) was registered in the UK, for the purposes of assessing confusion, the relevant public was deemed to consist of the general public in the European Union.

The CFI held that the marks themselves were similar on the following grounds:

- there was a degree of visual similarity between the marks, taking into account the "energon" element of the earlier TRANSFORMERS ENERGON mark and the single "enercon" element of the ENERCON mark being applied for;
- there was a degree of phonetic similarity between the marks as the first two syllables, "e" and "ner" of the single element "enercon" of the ENERCON mark applied for were identical to the "energon" element of the earlier TRANSFORMERS ENERGON mark. Also, with regards to the same elements, there was a high degree of similarity between the third syllables "con" and "gon"; and
- there was a conceptual link between the marks as "energon" and "enercon" were likely to be perceived as "evoking the notion of energy".

The Court also looked at the distinctive and dominant elements of the marks and held that the Board was correct in finding that neither the "transformers" nor the "energon" element in the earlier TRANSFORMERS ENERGON mark was more dominant or distinctive than the other. Hasbro's attempts to argue that "transformers" was the dominant element of TRANSFORMERS ENERGON because of its font and larger size compared to the "energon" element was not accepted by the Court. The Court pointed out that the protection resulting from the registration of a word mark concerns the word in printed form in normal font and not the specific or stylised elements accompanying the word.

### Comment

The outcome in this case is not surprising. The CFI has taken the opportunity to reiterate that in assessing confusion, the comparison must be made by examining each of the marks as a whole, rather than just taking one element of a composite mark and comparing it with another mark.

### FURTHER INFORMATION

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