

Müller-Boré & Partner Patentanwälte. Rechtsanwälte v OHIM (Eugen Popp, Wolf E. Sajda, Johannes Bohnenberger, Volkmar Krusic – intervening parties) 16 September 2013

The General Court has confirmed that there is a likelihood of confusion between a CTM application for **MBP** filed in respect of *Patent agent services; legal services; services of a representative registered at the European Patent Office (European Patent Attorney); consultancy, representation, providing of expertise and research (technical and legal), in particular in the field of protection of industrial property regarding patents, registered designs, registered effects, trademarks, topography, plant varieties protection, copyright, employed inventors' rights and protected privilege licences; administration of protected privileges including fee monitoring; legal research concerning the protection of industrial property, in particular research into international protected privileges; technical consultancy; technical and legal translations in Class 42 and an earlier CTM registration for **ip_law@mbp.**, registered in respect of *law firm services*.*

The claimant, Müller-Boré & Partner (Müller-Boré), filed a trade mark application for **MBP**, in classes 35 and 42, on 2 December 1999. This application was opposed by the intervening parties, on the basis of an earlier CTM registration for **ip_law@mbp.**, registered in respect of *law firm services*, on the grounds that there was a likelihood of confusion between the marks, under Art 8(1)(b) CTMR. In addition, the intervening party opposed Müller-Boré's application on the basis that the term **mbp.de** was considered to be a mark used in the course of trade in the sense of Art 8(4) CTMR, and, under the relevant provisions of German law, was liable to prevent use or registration of the mark applied for in Germany.

OHIM's opposition division rejected the opposition, on the basis that the services designated by the CTM registration for **ip_law@mbp** were far narrower than those designated by the mark applied for, and therefore were not sufficiently similar to cause a likelihood of confusion. Insofar as the opposition was based on Art 8(4) CTMR, the evidence of use was dated after the priority date of the contested CTM application, and therefore, the ground was rejected, as there was insufficient evidence that the intervener was the proprietor of such earlier rights, and that these rights pre-dated the priority date of Müller-Boré's application.

The intervener appealed to OHIM's fourth Board of Appeal (BoA), which overturned the decision of OHIM's opposition division, and refused registration of the mark applied for insofar as it covered services in class 42, on the basis of a likelihood of confusion with the intervener's earlier CTM registration.

Müller-Boré appealed to the General Court (GC), alleging that the BoA had made an error when finding that there was a likelihood of confusion between the marks. In particular, it argued that the BoA had erroneously found that the marks were similar. Müller-Boré advanced the following, to support its argument that the marks were not similar:

- As the average consumer of the services covered by the marks would have an elevated level of attention, it would distinguish between the marks and identify that the respective services originated from different undertakings.
- The common "mbp" denomination was located at the end of the earlier CTM registration, and therefore would not be memorable from the perspective of the average consumer, or interpreted as the sole distinctive aspect of the mark.
- The "ip_law" aspect of the earlier mark was distinctive in relation to the broad legal services covered by the mark applied for, as "ip" had meanings other than "intellectual property" or "industrial property", as it could also mean "internet protocol".
- The fact that the distinctiveness of some elements of a mark is low does not mean that one particular aspect of a mark is the sole distinctive element that stays in the mind of the average consumer.
- There was a clear difference in the length of marks, reducing the visual and phonetic similarity.
- The marks were conceptually different, and this neutralised any visual or phonetic similarity between the two.

The GC considered these arguments and found that there was visual and phonetic similarity between the marks, and that any conceptual dissimilarity was insufficient to neutralise this.

When making an overall assessment of the marks, taking into account all factors, the GC found that the marks were visually and phonetically similar because the distinctive element of both marks was "**MBP**". It found that the "**ip_law**" element of the earlier registration was of low distinctiveness, and that the "@" and "_" elements had no distinctive character at all, as the average consumer would view them as symbols commonly used within e-mail addresses.

In particular, the GC considered the marks from the perspective of the average consumer. The GC accepted that the average consumer of the legal services provided under the marks would have an elevated level of attention. However, contrary to the assertions of Müller-Boré, the effect of this would be to reduce the perceived distinctiveness of the “**ip_law**” element of the earlier registration, as the consumer would understand “**ip_law**” as designating “intellectual property law”, which would be considered descriptive of the legal services covered by the specification. Given the use of “law” in addition to “ip”, the GC held that the meaning of the term “**ip_law**” would clearly be interpreted by the average consumer as describing the specific legal services provided under the earlier trade mark registration. Therefore, it would be more likely that the marks would be considered similar.

The GC dismissed Müller-Boré’s argument that because the “**MBP**” element of the earlier CTM registration was placed towards the end of the mark, it would not be a particularly memorable element of the mark, and the average consumer would therefore not draw similarities between the two. The GC stated that the location of one particular element at the end of a mark may not always render it less memorable, especially when the other constituent elements of a mark are not particularly distinctive. Where the mark is interpreted by the average consumer as an electronic address, the indication of origin is expected to follow the “@” symbol. Given that the “**MBP**” element of the earlier mark followed the “@” symbol, it is more likely that the average consumer would view “**MBP**” as the origin of the services covered by the mark.

Equally, the GC did not accept the argument that the marks were dissimilar due to their difference in length, especially given that the earlier mark would be perceived as an e-mail address by the average consumer, and therefore, would be expected to be longer.

The GC confirmed that, merely because several constituent elements of a mark are of low distinctiveness, this does not mean that other elements are of greater distinctiveness. Nonetheless, the perception of the mark may favour the more distinctive elements in the mind of the consumer.

Therefore, the GC confirmed the BoA’s view that the most distinctive element of the earlier CTM registration was “**MBP**”, which was identical to the mark applied for, and that the marks were highly similar.

Likelihood of Confusion

In light of the similarity between the marks, the General Court assessed whether the BoA was correct in finding that there was a likelihood of confusion between the marks. Müller-Boré had argued that due to the differences between the marks, despite covering highly similar or identical services, there was not a likelihood of confusion.

The GC disagreed, making a global assessment of all of the relevant factors. In considering the interdependence of the similarity of the relevant marks and their specifications, it found that, given the similarities between the marks and the services that they both covered, there was a clear likelihood of confusion between the two. As such, the GC found that the BoA was correct in its assessment, and refused Müller-Boré’s appeal.

This case clearly reflects the fact that a trade mark is only enforceable insofar as it is distinctive in respect of its specification, the importance of the relative distinctiveness of each constituent part of a mark, and how it is viewed from the perspective of the average consumer of the goods and/or services. Whilst in this case, the relative distinctiveness of the constituent elements of the earlier trade mark was to the advantage of its proprietor, it is unlikely that a proprietor of an earlier mark could prevent use or registration of a mark that merely shares some of the aspects having a low distinctive character.

Authors

Amanda McDowall

T +44 20 7655 1344

E amanda.mcdowall@squiresanders.com

Chris McLeod

T +44 20 7655 1590

E chris.mcleod@squiresanders.com

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