

Case in point: C-317/10, Union Investment Privatfonds v UniCredito Italiano and OHIM, The Court (Fourth Chamber), 16 June 2011

ABOUT THE AUTHOR



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A family affair

This banking word mark underlines the sensitivity of series decisions. Sharon Daboul of MW Trade Marks reports

The European Court of Justice (ECJ) has ruled that the General Court failed to consider evidence properly in a case concerning word marks with the prefix UNI- for Class 36 services. The case was referred back to the General Court for judgment.

Background

The Respondent, UniCredito Italiano, applied to register Community Trade Marks (CTMs) for UNIWEB and UNICREDIT WEALTH MANAGEMENT for banking business, financial affairs, insurance and real estate services. The Appellant, Union Investment Privatfonds, opposed on the basis of earlier German registrations for UNIFONDS, UNIRAK and UNIZINS (stylised) also in Class 36.

The Opposition Division and the Office for Harmonization in the Internal Market (OHIM) Board of Appeal upheld the oppositions, finding that Privatfond's UNI- prefixed marks constituted a series, and held there to be a likelihood of confusion between the earlier and later marks.

The General Court overturned these decisions primarily on the basis that evidence filed by Privatfonds was

insufficient to demonstrate that use of the common UNI- element would lead to an association between the marks.

The Appellant and OHIM alleged that the General Court had erred in its analysis of the factual background and in applying the law, by neglecting to take into account all the relevant circumstances of the case.

Automatic answer

The General Court's decision was set aside for failing to consider the evidence correctly and for distorting the content of the Board of Appeal's reasoning.

The General Court had criticised the Appeal Board for concluding "almost automatically" and without "thorough examination" that the relevant public associated UNI- prefixed marks on financial services with the Appellant. The ECJ found that the General Court had failed to properly examine aspects of the Appeal Board's findings, where it had made assessments relating to the identical structure of the UNI- marks, the common prefix element, the relevant public's perception and the lack of distinctive character in the terms WEALTH MANAGEMENT.

When the General Court stated that UNI- did not have the inherent capacity

to bring about an association between the marks, they had failed to properly consider the Appeal Board's conclusions on the influence of the UNI- element on the relevant public's perception of the marks.

For oppositions based on a series or family of marks, confusion may result from the fact that consumers could mistakenly believe later marks to be part of that earlier family. The global assessment of the likelihood of confusion requires complex analysis of fact to decide whether there is a risk that the relevant public might believe the later trade marks to be part of the series. The ECJ found that the General Court had not taken into account all the relevant factors.

Series issue

This case reminds us that while the ECJ is reluctant to interfere with the General Court's findings of fact, it will intervene where the General Court's findings amount to an error of law. The ECJ gave much attention to the fact that the opposition was based on several marks. The risk that consumers might consider later marks to be part of an earlier family should be sufficient to establish a likelihood of confusion. ■