

NJORD wins trademark opposition on behalf of Gucci in Sweden

NJORD's opposition, led by Partner Jeppe Brogaard Clausen and Assistant Attorney Emelie Svensson, resulted in an annulment of a trademark confusingly similar to Gucci's, and established that Gucci is well-known, leading to a larger protection area and less trademark registrations similar to Gucci's.

When assessing whether marks are confusingly similar, their visual, phonetic and conceptual similarities are taken into consideration, as well as the goods or services in relation to which protection of the marks has been applied for. The threshold for finding confusing similarity is lower when the older mark is well-known with respect to the specific goods or services in the geographical area in question.

The threshold for opposing a trademark in Sweden is considerably higher than in other countries, the reason being that the Swedish Patent and Registration Office takes into account both the absolute and the relative registration hinders prior to accepting a registration. Relative registration hinders may for example be an older mark similar to the mark applied. Once a mark is registered, but during the opposition period, the opposing part has to overturn the office's previous assessment of no existing similar marks.

In the present case, the challenges for NJORD's team were to prove the confusing similarity between the marks and to demonstrate Gucci's reputation, providing Gucci's trademarks with an extended protection.

Confusingly similar to Gucci

The office began its assessment by stating that the mark applied for was registered for identical goods in classes 3 and 8 and for identical services in class 44.

The office then assessed the similarities of the marks, starting with the visual similarities. Please find Gucci's trademark (registration no. 008967895) below to the right and Edge Cosmetics' (registration no. 526785) below to the left.



The office followed NJORD's argumentation and held that the figure mark applied for represented a figure that can be perceived as the letter G, and that the trademarks are similar due to being composed of the letters GG, turned against each other. It is essential to note that the applicant claimed that its logo was composed of 99, instead of GG.

Due to the office's acknowledgment of the visual similarity of the marks and composition of the same letter, which established conceptual similarity, the marks are thus also phonetically similar. Confusing similarity between the marks was hence proven.

The office established Gucci as a well-known trademark

In addition to having proved the similarity between the marks, NJORD managed to prove Gucci's reputation on the relevant market. In particular, the office held that:

- Gucci is well-known among the relevant public
- Gucci holds an extended protection due to its enhanced acquired distinctiveness
- Gucci's marks are inherently distinctive and have been used to such an extent that they have also acquired distinctiveness in relation to its perfumes in class 3

The extended protection includes protection against free-riding, taking advantage of Gucci's reputation, harming Gucci's brand, as well as extended protection in relation to similar marks.

Similar trademark registration annulled

The office concluded that the differences between the marks only appear when the marks are carefully studied. In a situation where the consumer is not able to make a direct comparison, but has to rely on his or her memory, the brands give an overall similar impression. Furthermore, taking into consideration Gucci's reputation and extended protection, and with respect to the similarities between the brands, the office concluded that the figure mark applied for is confusingly similar to Gucci's mark, constituting a ground for refusal of registration.

Accordingly, Edge Cosmetics' registration was annulled, and they will not be able to gain the benefits of a trademark registration in Sweden.

Remarks

Based on the above, the conclusion is first of all the result, although challenging, that the team managed to prove that Edge Cosmetics' mark was confusingly similar to Gucci's, which was the primary goal and led to the winning opposition that gained legal force on 8 April 2017.

Furthermore, Gucci's reputation and extended protection has now been established by the office, which is a great victory in relation to any future opposition in Sweden. A precedent has thus been confirmed, according to which marks similar to Gucci's cannot obtain trademark protection in Sweden, and Gucci can use its established extended reputation to oppose such registrations.



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