

World Trademark Review Daily

Seniority: identity of marks must be interpreted strictly
European Union - MAQS Law Firm

Examination/opposition
International procedures

March 11 2013

In *Franz Wilhelm Langguth Erben GmbH & Co KG v Office for Harmonisation in the Internal Market* (OHIM) (Case T-378/11, February 20 2013), the General Court has upheld a decision of the Fourth Board of Appeal of OHIM finding that the seniority of a mark in colour could not be claimed in an application to register the mark in black and white.

Applicant Franz Wilhelm Langguth Erben GmbH & Co KG filed an application for registration of a figurative mark containing the word element 'MEDINET' as a Community trademark (CTM):



At the same time, the applicant claimed the seniority of earlier national and international figurative marks - which were, respectively, the subject of a German registration and of an international registration with effect in nine European countries - consisting of a cross with the word element 'MEDINET'. Visually, the marks were identical to the application, except that they were golden in colour:



The OHIM examiner refused the claim of seniority of the earlier marks on the basis that the application and the marks were not identical. The Board of Appeal of OHIM came to the same conclusion and dismissed the appeal, holding, among other things, that the requirement set out in Article 34(1) of the [Community Trademark Regulation \(207/2009\)](#) - ie, there must be 'identity' of the marks for seniority to be claimed - was not satisfied inasmuch as the CTM applied for did not designate any specific colour, while the earlier national and international marks were golden in colour.

The applicant appealed to the General Court, claiming that because the black-and-white CTM covers all colour combinations, at least a claim of partial seniority should have been allowed.

The General Court dismissed the appeal and upheld the Board of Appeal's decision, holding, among other things:

- In order to uphold a claim of seniority of an earlier national mark for the purposes of an application for registration of a CTM, three cumulative conditions must be fulfilled: 1) the earlier mark and the CTM applied for must be identical; 2) the goods or services covered by the CTM applied for must be identical to, or contained within, those covered by the earlier mark; and 3) the proprietor of the marks at issue must be the same. A sign is identical to a trademark only where it reproduces, without any modification or addition, all the elements constituting the trademark or where, viewed as a whole, it contains differences which are so insignificant that they may go unnoticed by an average consumer (*Shang v OHIM (justing)* (Case T-103/11), Paragraphs 14 and 16).
- The condition that the sign and mark must be identical must be interpreted restrictively because of the consequences attaching to such identity. The proprietor of the CTM for which the seniority of the earlier mark has been recognised will, if it surrenders the earlier mark or allows it to lapse, be able to continue to have the same rights as it would have had if the earlier trademark had continued to be registered.
- As for the scope of protection of the marks at issue, this was not a factor to be taken into consideration in examining the claim of seniority of the earlier marks. One of the conditions examined by OHIM in order to uphold or refuse such a claim is that of whether the marks at issue

World Trademark Review *Daily*

are identical. An examination of whether such marks are identical involves a comparison of the elements comprising the marks and not an assessment or comparison of the scope of protection which those marks have or might have. The scope of protection of a CTM designating a colour is different from that of a CTM which does not designate any specific colour.

- The fact that a mark is registered in colour or, on the contrary, does not designate any specific colour, cannot be regarded as a negligible element in the eyes of a consumer. The impression left by a mark is different according to whether that mark is in colour or does not designate any specific colour.

Accordingly, the General Court held that the Board of Appeal was right to find that the marks at issue were not identical and that seniority could not be claimed.

This case confirms the General Court's prior case law that the identity of marks must be interpreted strictly in relation to a claim of seniority. There is no such thing as 'partial seniority' as regards the identity of marks. The decision also shows that marks in black and white cannot always be considered to cover all colours. As a corollary, trademark owners with distinctive colour logos may consider filing for colour marks if all their existing registrations are in black and white.

Peter Gustav Olson, MAQS Law Firm, Copenhagen

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.