

# World Trademark Review Daily

Word element of figurative mark given broad protection  
European Union - MAQS Law Firm

Examination/opposition  
International procedures

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In *IBSolution GmbH v Office for Harmonisation in the Internal Market* (OHIM), the General Court has affirmed a decision of the Second Board of Appeal of OHIM in which the latter had found that there was a likelihood of confusion between the figurative mark IBS and the word mark IBSOLUTION. This case confirms that, in certain circumstances, the word elements of figurative marks will be given significant weight.

IBSolution GmbH filed an application for the word mark IBSOLUTION (written 'IBSolution') for a broad range of services in Classes 35, 41 and 42 of the [Nice Classification](#). IBS AB lodged an opposition on the basis of the earlier figurative mark IBS:



The earlier mark was registered for a rather narrow list of services in the same classes as those covered in the application, namely:

- Class 35: "commercial management assistance, in particular computer aid in connection with administrative routines";
- Class 41: "teaching and educational services in the computer field"; and
- Class 42: "computer programming, computer software design, consultancy in the field of computer hardware and product development, in particular in the computer field".

The opponent was successful. The applicant appealed, but the Second Board of Appeal of OHIM affirmed, taking the view that the marks were similar, in particular from a visual and phonetic point of view. Finding that the most distinctive element in each mark was the element 'IBS', the board held there was a likelihood of confusion, despite the relevant public's high degree of attention.

On further appeal to the General Court, the applicant was again unsuccessful. The court agreed with the board that the relevant public consisted mainly of professionals with a high level of attention, and noted that these consumers would not dissect a complex mark, but would view it as a whole. The court further reiterated that a complex mark may be considered similar to another trademark which is identical to one of the components of the complex mark, where that component forms the dominant element within the overall impression created by the complex mark.

The court then found that the dominant element of the opponent's mark was not the figurative ornamentation, but rather the word element 'IBS'. Therefore, the figurative elements would not have a significant effect on the overall impression made by the opponent's mark. The court refused to accept that the relevant public would necessarily dissociate the word 'solution' in the applied-for mark from the first two letters, because the first letter in 'solution' was a capital letter, which was likely to be perceived as being part of the group 'IBS', as well as being part of the word 'solution'. The court further held that the only difference between the marks "lies in the addition, at the end of the mark applied for, of the seven letters 'o', 'l', 'u', 't', 'i', 'o' and 'n' after the capital letters 'I', 'B' and 'S', the 'S' being part of the word 'solution'" (Paragraph 37). The court acknowledged that these seven letters added three syllables to the applied-for mark compared to the opponent's mark, but because these were situated in the second part of the mark, they would not have the effect of dominating the overall impression of the applied-for mark.

The court then criticised, directly and indirectly, the analysis of Second Board of Appeal, holding that:

- the board might have erred in finding that a section of the relevant public would pronounce the applied-for mark 'i-b-s-solution'; and
- the board had erred in finding that there was a degree, albeit low, of conceptual similarity between the marks.

However, the court held that:

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- there was a certain phonetic similarity between the marks, regardless of the pronunciation; and
- the board's erroneous finding as to conceptual similarity could not invalidate the finding that there was an overall likelihood of confusion, in light of the visual and phonetic similarities.

Consequently, the court upheld the board's decision.

This case confirms that OHIM is rather opponent-friendly, and will, in certain circumstances, grant broad protection to the word elements of figurative marks, similar to that afforded to word marks. However, one might question whether the board and the General Court were correct in dividing the applied-for mark into 'IBS' and 'olution' rather than 'IB' and 'Solution', particularly considering the sophistication of the relevant consumers. It is also interesting to note that, apparently, the applicant did not challenge the finding that the services were similar, considering the narrow list of services covered by the opponent's mark.

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