

**'Bonus' decision highlights General Court's tendency to protect relatively weak marks** **Examination/opposition International procedures**  
**European Union - NJORD**

February 13 2015

In *Türkiye Garanti Bankası AS v Office for Harmonisation in the Internal Market* (OHIM) (Case T-33/13, February 5 2015), the General Court has annulled a decision of the Fourth Board of Appeal of OHIM in which the latter had partially upheld a decision of the Opposition Division finding that earlier rights in BONUSNET could prevent the registration of BONUS&MORE as a Community trademark (CTM).

Card & Finance Consulting GmbH applied for the registration of the following figurative mark as a CTM:



The application covered a broad list of services in Classes 35, 36 and 42 of the [Nice Classification](#):

- Class 35: "Advertising; business management services; business administration; office functions; operating bonus systems; advertising by means of customer loyalty schemes; devising and handling of bonus schemes; dissemination of advertisements; computerised file managing; systematic ordering of data in computer databases; collating of data in computer databases; online advertising in computer networks; sales promotion (for others); storecard services";
- Class 36: "Insurance; financial affairs; monetary affairs; real estate affairs";
- Class 42: "Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; upgrading of computer software; computer software consulting; consultancy in the field of computers; provision of search engines for the Internet; restoration of computer dates".

Türkiye Garanti Bankası AS lodged an opposition based on its rights in the following international trademark, which designated numerous European countries and covered a very broad list of services in Classes 35, 36 and 42:



The Opposition Division of OHIM partially upheld the opposition, finding that there was a likelihood of confusion for the following services:

- Class 35: "Office functions; business management services; systematic ordering of data in computer databases; collating of data in computer databases; business administration; computerised file managing; operating bonus schemes; devising and handling of bonus schemes; storecard services";
- Class 36: "Insurance; financial affairs; monetary affairs; real estate affairs";
- Class 42: "Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; upgrading of computer software; computer software consulting; consultancy in the field of computers; provision of search engines for the Internet; restoration of computer dates".

The applicant appealed. The Fourth Board of Appeal of OHIM rejected the opposition in its entirety in a decision of November 12 2015, finding that, given the differences between the signs at issue, there was no likelihood of confusion.

The opponent appealed to the General Court, which agreed with the opponent that there was a likelihood of confusion for all services.

Firstly, while the Board of Appeal had correctly stated that the services at issue were directed at both the general public and business customers, it went on to limit its analysis to only part of the relevant public merely by stating that the target public consisted of professionals who will devote an elevated degree of attention to the signs in question for the purposes of assessing the similarity of the signs at issue. The board should have taken into account both the general public and business customers.

Secondly, noting that the common word 'bonus' was placed at the beginning of both signs and was the longest of the word elements, the court held that, even if the word element 'bonus' were not regarded as the dominant element in the overall impression of the signs at issue, it could not be described as a negligible element.

Finally, the court disagreed with the board's assessment of the visual, phonetic and conceptual similarities and differences. While the board had found that the marks were visually different overall, the court held that they had, at the very least, a certain degree of visual similarity. While the board had held that, phonetically, the marks were different due to the different pronunciation of their latter syllables, the court stated that they had at least an average degree of phonetic similarity due to the identical pronunciation of their first two syllables. As regards conceptual similarity, the court held that the marks could not be held to be conceptually dissimilar (Paragraph 41):

*"It is true that the word 'more' preceded by the ampersand representing the word 'and' in the case of the mark applied for and the element 'net', in the case of the earlier mark, convey, at least for the English-speaking part of the relevant public, meanings which refer respectively to the concepts of 'and more' and 'network'. However, the signs will be perceived by the relevant public in their entirety, without the different elements being analysed separately. Accordingly, the elements following the word 'bonus', to the extent that each one of them will convey a different meaning, will supplement without completely counteracting the meaning of the element 'bonus', to which both signs refer, even if that element has only a weak distinctive character with respect to the services covered by the signs in question."*

Thus, while the board had carried out a more substantive analysis of the elements of the marks and their meanings, the court applied a more objective test focused on the quantitative elements of the marks, and found that the marks were sufficiently similar overall for there to be a likelihood of confusion.

This case reinforces a general tendency of the General Court to provide relatively weak trademark elements with exclusive rights. However, the fact that the application was first partially rejected, then completely restored and then completely rejected, shows that legal certainty as regards weak elements is still lacking. Trademark owners and practitioners who prefer legal certainty may hope that this decision is appealed, so that the Court of Justice of the European Union can weigh in on the issue.

The dates in this case also are noteworthy: an appeal from a simple opposition decision from the Board of Appeals to the General Court, without a hearing at the General Court, took nearly 26 months.

*Peter Gustav Olson, NJORD Law Firm, Copenhagen*

---

**World Trademark Review ([www.worldtrademarkreview.com](http://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.**