

Philip Morris successfully opposes figurative mark containing abstract MARLBORO mark

Peter Gustav Olson

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- Philip Morris opposed the registration of a figurative mark containing a polygonal shape in Class 34 based on an earlier figurative MARLBORO mark
- The EUIPO upheld the opposition on the basis of Article 8(5)

- The General Court confirmed, holding, among other things, that the goods marketed under the mark applied for could be perceived as being linked to Philip Morris

In *International Masis Tabak LLC v European Union Intellectual Property Office* (EUIPO) (Case T- 44/22, 21 December 2022), the General Court has confirmed the decision of the Fifth Board of Appeal of the EUIPO of 15 November 2021, which declared that International Registration No 1 434 506 should be refused protection in its entirety in respect of the European Union due to a likelihood of confusion with the well-known MARLBORO trade dress.

Background

International Masis Tabak LLC ('the applicant') obtained an international registration designating the European Union for a broad list of goods in Class 34 pursuant to an application published on 16 November 2018. The trademark that was the subject of the international registration was the following figurative mark:



Philip Morris Brands Sàrl ('the opponent') filed a notice of opposition based on the figurative mark MARLBORO SELECTED PREMIUM TOBACCOS (depicted below), which also covered a broad list of goods in Class 34:



This registration was not more than five years old at the time of the opposition and was thus not subject to the use requirement. The opponent claimed that this mark was well known, relying on Article 8(5) of [Regulation 2017/1001](#).

The Opposition Division of the EUIPO upheld the opposition. The applicant appealed, but the Fifth Board of Appeal of the EUIPO dismissed the appeal, since all the conditions laid down in Article 8(5) of Regulation 2017/1001 were fulfilled as regards the earlier mark.

The applicant further appealed to the General Court, but did not fare better there.

Decision

Before the General Court, the applicant did not dispute that the opponent's mark was well known or that there was identity of the goods. The applicant argued solely that there was no similarity between the marks.

The General Court held that the Board of Appeal was correct in finding the following:

- the sign applied for was purely figurative in view of the lack of visible word elements; the word elements 'marlboro' and 'selected premium tobaccos' were "printed in the background in very light grey, thus making them hardly visible" to the relevant public;
- the signs at issue had a common dominant element in the form of coloured polygons in the upper part which, despite their differences, produced a similar visual impression;
- a phonetic comparison was not possible due to the fact that the mark applied for had been regarded as purely figurative;
- a conceptual comparison was not possible, because the sign applied for did not convey any particular concept, since it represented only an abstract triangular geometric shape;
- the relevant public would establish a link between the marks at issue, despite there only being a low degree of similarity between them, because "the visual aspects are significant, since the goods at issue are not only named aloud, but also need to be

inspected visually during a purchase, which the applicant does not dispute”;

- there was a risk that the mark applied for would take unfair advantage of the enhanced distinctive character and the repute of the earlier mark; and
- by choosing a similar shape, the applicant clearly attempted to align itself with the opponent, without due cause.

The court emphasised that, in view of the evidence produced by the opponent before the Board of Appeal, the latter was entitled to find that the rooftop-shaped polygonal element of the earlier mark had been widely used, so that consumers could be led to believe that the polygonal element of the mark applied for was merely a variant of that element. Therefore, the goods marketed under the mark applied for could be perceived as being linked to the opponent, thus facilitating their promotion and marketing, without any financial compensation for the marketing effort expended by the opponent to create and maintain the image of its mark.

The decision of the Board of Appeal was thus affirmed.

Comment

This decision is interesting for several reasons. Although the opponent had many relevant trademark registrations on which to base the opposition, it elected to use a single, abstract figurative registration which was less than five years old and not subject to the use requirement. The applicant did not dispute that this abstract registration was well known. The Board of Appeal and the General Court, on the other hand, basically ignored the “barely perceptible” word elements of the opponent’s abstract mark.

Peter Gustav Olson

Author | Partner

pgo@njordlaw.com

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