

Third-party lions free to roam: General Court reverses decision on monopoly over trademarks depicting same animal species

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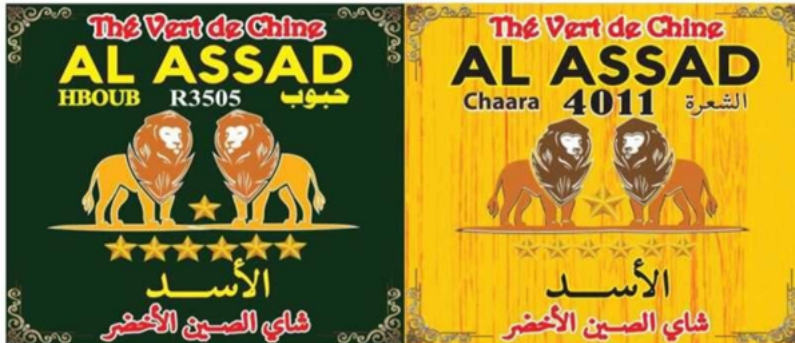
Legal updates: case law analysis and intelligence

- The General Court maintained that in complex trademarks, the main figurative element cannot *per se* provide monopoly over an entire species, regardless of its application to the packaging
- The Board of Appeal had identified an above-average degree of conceptual similarity between two figurative marks due to their representations of lions
- General Court disagreed, stating all components of a composite mark must be considered as a whole, and thus noting the difficulty in perceiving the lions in the earlier mark and the obscure meanings of associated terms for the relevant public

In re *Laura Food Srl v EUIPO, Bella Tawziaa II SLU* (T-541/23), the General Court First Chamber maintained that in complex trademarks, the main figurative element cannot *per se* provide monopoly over an entire species, regardless of its actual application to the packaging.

Background

On 14 May 2020, Laura Food Srl filed an application with the EUIPO seeking registration for the following figurative sign:



On 2 September 2021, Bella Tawziaa II SLU filed an opposition against the EU trademark based on its earlier EU figurative mark, depicted below, registered in January 2015, which also covered goods in Class 30.



The Opposition Division rejected the opposition on 20 September 2022. However, Bella Tawzia II SLU appealed, and the Board of Appeal upheld the appeal.

Board of Appeal decision

The board determined that the relevant public comprised EU consumers with a below-average level of attention. It found that, while the marks were visually and phonetically dissimilar, they were conceptually similar to an above-average degree for English, French and Arabic-speaking EU consumers. The board concluded that there was a likelihood of confusion between the two marks for the relevant public in the European Union.

At issue was the conceptual similarity, as the applicant contended that the only common element was the representation of lions, which were distinctively different. In contrast, the EUIPO argued that the Board of Appeal had correctly identified an above-average degree of conceptual similarity due to the lion representations.

General Court decision

The General Court disagreed, noting the difficulty in perceiving the lions in the earlier mark and the obscure meanings of associated terms for the relevant public. It concluded that the conceptual similarity was low.

In fact, the General Court found as follows:

“ The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see judgment of 12 June 2007, *OHIM v Shaker*, C 334/05 P, EU:C:2007:333, paragraph 41 and the case-law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (judgment of 12 June 2007, *OHIM v Shaker*, C 334/05 P, EU:C:2007:333, paragraph 42). That could be the case, in particular, where that component is capable on its own of dominating the image of that mark which members of the relevant public retain, with the result that all the other components are negligible in the overall impression created by that mark (judgment of 20 September 2007, *Nestlé v OHIM*, C 193/06 P, not published, EU:C:2007:539, paragraph 43).

[Also,] for the purposes of assessing the dominant character of one or more given components of a composite trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components... (see judgment of 8 February 2007, *Quelle v OHIM-Nars Cosmetics (NARS)*, T 88/05, not published, EU:T:2007:45, paragraph 58 and the case-law cited).

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In conclusion, as an established position on confusing similarity, especially when 'genus' or, in this case, animal species are to be taken into account, it is wiser not to compare the marks by abstractly mentioning the species (eg, "lion"). This is true when corporations need to weigh the nature of their monopoly, whereas obtaining registration for a lion as a figurative element does not necessarily mean that no other lions could graze in the open field of our shelves.



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