

**European Union** - Dr Helen Papaconstantinou John Filias & Associates

In *Bimbo SA v Office for Harmonisation in the Internal Market* (OHIM) (Case C-591/12, May 8 2014), the Court of Justice of the European Union has rejected an appeal by Bimbo SA requesting the annulment of the decision of the General Court in Case T-569/10.

In Case T-569/10, the General Court had held that the word 'doughnuts' was not devoid of distinctive character for those consumers who were not familiar with the English language; therefore, the mark BIMBO DOUGHNUTS did not form a unitary whole or a logical unit on its own, with the consequence that the relevant public would not be able to understand that the covered goods were doughnuts produced by the company Bimbo or the owner of the BIMBO mark.

In December 2012 Bimbo appealed the aforementioned decision, basing its appeal on a single ground (infringement of Article 8(1)(b) of Community Trademark Regulation (207/2009)), which was in two parts:

1. The General Court had erred in law by confusing the legal concepts of 'distinctiveness' and 'wholly meaningless element' on the one hand, and 'independent distinctive role' on the other. Moreover, it had disregarded the rule that one component of a composite mark may be considered as having an independent distinctive role only in exceptional cases, and had used terminology ('unitary whole' and 'logical unit') which was extraneous to the relevant case law.
2. The General Court had concluded that there was a likelihood of confusion based on the assumption that the word 'doughnuts' had an independent distinctive role, and had not taken into account the characteristic role of the element 'bimbo', which enjoyed a high degree of reputation in Spain for the goods in question, or the low degree of distinctiveness of the earlier mark, as well as the fact that the word 'doughnuts' was reproduced in a different manner. Bimbo also alleged that the reputation of the first element of a composite mark prevents the public from believing that the overall impression given by the mark indicates that the covered goods originate

from the owner of the earlier mark. Accordingly, Bimbo alleged that the court should have substantiated the reasons why, exceptionally in this case, it was considered that there was a likelihood of confusion.

In assessing the first part of the single ground of the appeal, the ECJ held that, in the contested decision, the General Court had found that the word element 'doughnuts' in the BIMBO DOUGHNUTS mark was not negligible in the overall impression given by that mark and that it should be taken into account when comparing said mark with the earlier DOUGHNUTS marks, even if the word 'bimbo' was considered as the dominant element in the mark applied for. The General Court had found that, due to the fact that the word 'doughnuts' had no particular meaning for the relevant Spanish-speaking public, it did not form a unit with the element 'bimbo'; it had an independent distinctive role in the trademark and therefore it should be taken into account in the global assessment of the trademark. In this respect, the ECJ concluded that the General Court had not erred, because it had based its conclusion on a global assessment including the different stages of examination required by the relevant case law, and not merely on its finding of the independent distinctive role of the word 'doughnuts'.

Regarding Bimbo's allegation that the General Court had confused certain legal concepts, the ECJ stressed that, in the paragraph at issue, the General Court had merely rejected Bimbo's arguments, thereby supplementing its assessment that the 'doughnuts' element had significant importance in the overall impression produced by the mark applied for and that it should thus have been taken into account in the assessment of the likelihood of confusion. Therefore, the General Court had not confused the aforementioned terms.

The ECJ further pointed out that the examination of whether any of the components of a composite mark has an independent distinctive role has the purpose of determining which of the components will be perceived by the relevant public. In this respect, the General Court had stressed that the determination of which components contribute to the overall impression given by the mark must be performed before the assessment of the likelihood of confusion, which must be based on the assessment of the overall impression given by the marks at issue. Thus, the ECJ concluded that this did not involve an

exception, as alleged by Bimbo, and added that the particular circumstances of each case should be taken into consideration, the individual assessment of each sign not being subject to general presumptions.

Finally, the ECJ held that, contrary to Bimbo's allegations, the expressions 'unitary whole' and 'logical unit' used by the General Court corresponded to the expression "unit having a different meaning" used in the case law of the ECJ. The ECJ thus rejected the first part of the single ground of Bimbo's appeal.

Regarding the second part of the appeal, the ECJ held that the General Court had performed a global assessment of the likelihood of confusion and had also taken into account the particular factors of the case. The ECJ concluded that Bimbo's arguments were based on an incorrect reading of the contested judgment and also rejected the second part of the appeal.

Consequently, the ECJ dismissed the appeal in its entirety.

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