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LOST IN TRANSLATION: Translated terms in OHIM oppositions

Carolina Pina (Garrigues) · Thursday, February 4th, 2016

The CJEU had to decide whether “El Corte Inglés” was confusingly similar to “The English Cut”. It wasn’t – however it might just be similar enough for article 8(5) CTMR (dilution protection) to apply.

In its judgment of December 10, 2015 (case C-603/14 P, “**El Corte Inglés**” v. “**The English Cut**”), the CJEU overruled the judgment of the General Court (GC), following an appeal filed by “El Corte Inglés” (the famous Spanish department store).

Background: In 2010 the company The English Cut filed a CTM application for the word mark “The English Cut”. El Corte Inglés – famous Spanish chain of department stores – filed an opposition on Articles 8.1 (b) and 8.5 CTMR, based on its reputed CTM “El Corte Inglés” of which “The English Cut” is the literal translation.

The opposition was rejected by the OHIM considering that although there was a minimal degree of **conceptual similarity between the signs**, they were different overall from a visual or phonetic standpoint and therefore there was no likelihood of confusion. As for the application of article 8.5 CTMR, OHIM considered that El Corte Inglés had not provided sufficient evidence that there was actually or potentially any unfair advantage being taken of the reputation of the “El Corte Inglés” mark.

El Corte Inglés appealed to the GC, which rejected all of its pleas, holding that:

- The signs at issue were completely different from a visual and phonetic standpoint.
- There was a conceptual similarity between the two signs, however “slight”, because, although “El Corte Inglés” is the **literal translation** into Spanish of “The English Cut”, the connection between the two signs was not immediately obvious. The GC considered that the average Spanish consumer would have to first translate the sign in question into Spanish (we want to think that the members of the GC have not been in Spain recently...).
- On this basis, it considered that the signs were different overall.
- As for article 8.5, the GC held that, having found the marks dissimilar, this also precluded the protection of El Corte Inglés as a reputed mark.

The CJEU partially upheld the appeal and found that there had been an infringement of article 8.5, since the GC should have specifically examined whether the degree of slight conceptual similarity

was sufficient, because other pertinent factors were present—such as the reputation of the earlier mark—for the public to establish a link between the signs at issue for the purposes of article 8.5.

Conclusion: The CJEU held that, since a slight conceptual similarity had been found to exist between the signs, an **individual comparative analysis needed to be performed to determine whether articles 8.1 (b) and 8.5 applied**. The fact of declaring that the degree of similarity is not sufficient to apply article 8.1(b), does not mean that the application of 8.5 is necessarily precluded, since the degree of similarity required by each of the paragraphs is different.

CJEU reached the same conclusion in its judgment of November 20, 2014 (Joined Cases C?581/13 P and C?582/13 P, in *Golden Balls v OHIM — Intra-Press (GOLDEN BALLS)*, where it stated that the GC was wrong to rule out the application of article 8.5 without first undertaking an overall assessment of the marks at issue (“**Golden Balls**” v “**BALLON D’OR**”) in order to ascertain whether a low degree of conceptual similarity between the marks was nevertheless sufficient, on account of the presence of other relevant factors -such as the reputation or recognition enjoyed by the earlier mark **BALLON D’OR**-, for the relevant public to make a link between those marks.

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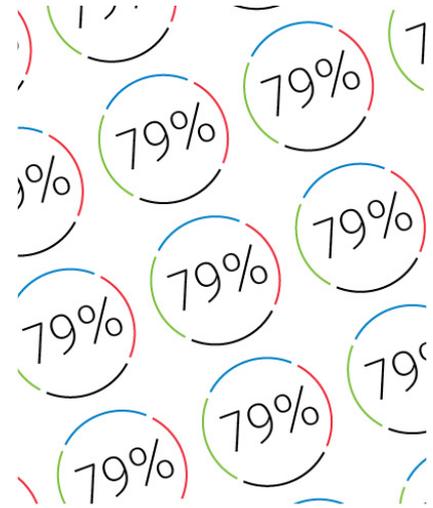
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