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Is the CJEU finally reconsidering LOC for weak marks? PRIMA v. PRIMART

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How many times in the course of a trademark clearance have you discovered that clearly, descriptive trademarks - usually registered because of some tiny stylization or unremarkable imagery - have been relied upon as bases for oppositions (often successfully) against other marks?

These “kind” of trademarks was, quite appropriately by a long time friend, named “TMD” or “Trademarks of Mass Destruction”, given their capability to become almost unsurpassable obstacles to adoption and registration of later trademarks. While, theoretically, their descriptive nature should have played a greater role because the distinctive character of the earlier trademark is one of the factors to be taken into consideration for the assessment of the likelihood of confusion.

However, as we already observed [here](#) and [here](#), this is not always the case, and still way too often, TM Offices and Courts continue to pay an unreasonable deference to trade marks which, per se, and without any hint of acquired distinctiveness, are barely worth the paper their certificates are printed on.

The CJEU of 18 June 2020 decision in case C-702/18 P, might therefore be welcomed as perhaps signalling a reconsideration of the role of descriptive trademarks, and should in any case stimulate a debate on whether or not “TMD” (in the above sense, not to be confused with “Trademark Directive”) should become a thing of the past.

Bolton Cile España, owner of a Spanish wordmark “PRIMA”, filed an opposition



against the EUTM application “PRIMART”
30.

for various goods in class

The EUIPO rejected the opposition. The Fourth BOA reversed (which is odd as they used to be the champions of the freedom to register despite earlier weak marks). The GC dismissed the action, declaring the arguments concerning the weakness of the earlier mark inadmissible, because they had been put forward before the GC for the first time.

The Applicant appealed to the CJEU, arguing that the descriptive/laudatory character of the word “prima” (as it evokes the concept of premium quality, also in Spanish, as shown in various dictionaries), should have been considered a well-known fact which the BOA and the GC should have taken into account of their own motion. Thus, according to the Applicant, had the low distinctive character of PRIMA been considered, the BOA/GC might have come to a different conclusion with regard to likelihood of confusion.

The CJEU confirmed that in relative grounds proceedings, the EUIPO shall decide only on the basis of the facts, evidence and arguments provided by the parties. Nonetheless, the EUIPO must consider all issues necessary to ensure a correct application of the law - including the assessment of the distinctive character of the earlier right - even if such argument has not been made by the parties. The CJEU therefore held that the GC had erred in declaring inadmissible PRIMART’s arguments in this respect.

Interestingly, the EUIPO argued that even if the GC *“had declared the arguments relating to the weak distinctive character of the earlier mark admissible and well founded, that circumstance would not have affected the conclusion reached in the judgment under appeal regarding the likelihood of confusion”*, citing case law that had not precluded a likelihood of confusion where the distinctive character of the earlier mark was weak (the same case law that created the TMD in the first place!).

This time, however, the CJEU did not buy EUIPO’s assertions. With an unusually terse, but unequivocal language, the CJEU said that *“where the earlier trade mark and the sign whose registration is sought coincide in an element that is weakly distinctive with regard to the goods at issue, the global assessment of the likelihood of confusion [...] does not often lead to a finding that such likelihood exists”* (§53).

Although the CJEU has not reversed its prior case law on descriptive/weak trademarks (like C-171/06, T.I.M.E. ART v OHIM, and C-196/11, Formula One Licensing v OHIM; see also the judgment of 12 June 2020, C-705/17, Hansson), the CJEU has sent a clear message about the “value” of these marks to trademark offices and courts, and there is room for hope that weak marks will stop being TMDs in future assessments of likelihood of confusion under EU trademark law....

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