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GOLDEN BALLS are true to their name – they’re back before the General Court

Verena von Bomhard (BomhardIP) · Wednesday, January 25th, 2017

The GOLDEN BALLS saga continues: after losing in the last round before the Board of Appeal of the EUIPO, Golden Balls Limited has once again taken its case (or cause?) to the General Court in Luxembourg (“GC”) (pending case T?8/17).

For recollection: in 2007, two applications for registration of GOLDEN BALLS as EU trademarks were filed, one in classes 9, 28, 41, and the other in classes 16, 21, 24. These are word mark applications, the device mark shown here for illustration that these are truly golden balls had already been registered since 2003.

Intra-Pressé opposed the applications based on BALLON D’OR. The Opposition Division saw no likelihood of confusion and rejected both oppositions. The applicants rejoiced – report in The Telegraph from July 2010 [here](#) – but too early: the Board of Appeal did find that there was a likelihood of confusion with respect to at least some of the goods and services due to the conceptual (almost) identity of the marks and granted the oppositions in part. That did not go down well with Golden Balls Limited, who took both cases to the GC. The GC granted these actions in September 2013 (T-437/11 and T-448/11), annulled the Board of Appeal’s decisions, holding that there was no likelihood of confusion. The fact that one mark was essentially the translation of the other did not suffice, in the GC’s opinion, to make the marks similar – or similar enough for confusion to arise. Given the assumed dissimilarity of the marks, the GC did not assess the matter under the aspects of dilution or misappropriation.

This time, Intra-Pressé appealed, and on 20 November 2014, the CJEU ruled in its favour (C-581/13 P and C-582/13 P). While it agreed with the GC on the absence of likelihood of confusion, it confirmed its statements from *TiMi KiNDERJOGHURT* (Ferrero v. OHIM, C-552/09 P) whereby the degree of similarity required under Article 8(1)(b) EUTMR, on the one hand, and Article 8(5), on the other, is different. The types of injury from which marks with a reputation are protected “may be the consequence of a lesser degree of similarity” between the marks (GOLDEN BALLS, para. 72). As the GC had failed to even assess Article 8(5), its judgments were annulled. What is more – the CJEU also set aside the Board of Appeal’s decisions to the extent that they had confirmed the first instance decisions. The cases were therefore back before the EUIPO Opposition Division.

On 28 July 2015, the Opposition Division found that, with respect to some of the goods and services in both applications, Article 8(5) EUTMR applied, as the trademark GOLDEN BALLS

took unfair advantage of the earlier mark BALLON D'OR. Following this, one of the applications was registered in class 16. However, the applicant did not accept the partial rejection of the other application in classes 9, 28, 41, and appealed again. It is that application that is back on the "career path" through the instances for EUTMs: on 30 September 2016, the Board of Appeal rejected the appeal, agreeing with the Opposition Division that there was misappropriation of the reputation of BALLON D'OR, and Golden Balls have challenged this decision before the GC. The application to the GC is not publicly available and so we will all have to wait for the GC's decision, not to be expected before 2018, to find out more about the merits of this case.

Without commenting on this specific case, or questioning the merits of Golden Balls' further action to the GC, generally it does not seem far-fetched that a trademark with a reputation may suffer harm if it is translated into another language and used for the same goods or services. That, in these "translation cases", likelihood of confusion is denied is now set in stone and needs to be accepted (see also ROTKÄPPCHEN v. RED RIDING HOOD, T-128/15). However, to assume dilution or misappropriation in such cases in accordance with Article 8(5) does seem reasonable.

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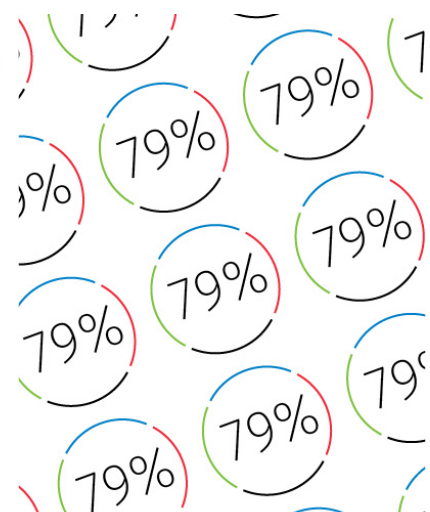
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