

**RESOLUTION**  
**second Board of Appeal**  
**of 5 September 2018**

In Case R 2378/2017-2

**BISCUITS GULLÓN, S.A.**

Avenida Burgos 2  
34800 Aguilar de Campoo (Palencia)  
Spain

Applicant/Party

represented by Gomez-Acebo and Pombo, Paseo de la Castellana 216, 28046 Madrid,  
Spain

counter

**Intercontinental**

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The United States of America

Objector/Party complained against

represented by Baker & McKenzie Barcelona, Avenida. Diagonal 652 Edif. D, 8<sup>a</sup>  
Planta, 08034 Barcelona, Spain

Appeal against opposition No B 2 565 342 (application for EU trade mark No  
13 877 543)

THE SECOND BOARD OF APPEAL

integrated by S. StÜRMAN (Chairman), S. Martin (Rapporteur) and H. SALMI  
(Member)

Secretariat: H. Dijkema

gives the following

## Resolution

### Factual background

- 1 On 26 March 2015, GALLEAS Gullón, S.A. ('the applicant') applied for registration of the following figurative mark



in order to distinguish, the following products:

Class 30 — Biscuits

The applicant claimed colours:

green; yellow white; blue; dark brown.

- 2 The application was published on 11 May 2015.
- 3 On 7 August 2015 Intercontinental Great Brands LLC ('the opponent') lodged a opposition against all the products referred to in paragraph 1.
- 4 The pleas in law relied on in the opposition were Articles 8 (1) (b) and 8 (5) of the RUE.
- 5 The opposition was based on the following rights:
  - a) EU Trade Mark No 8 566 176



applied for on 22 September 2009 and registered on 22 February 2010 for, inter alia, the following products on which the opposition was based:

Class 30 — Preparations of cereals; confectionery and confectionery.

The territories in which the EU and Spain have been claiming the reputation of a product, namely ‘biscuits’.

b) Spanish mark 2 845 539, figurative or other, made:



applied for on 29 September 2008 and registered on 22 June 2009 for the following products:

Class 30 biscuits, crackers, crackers and crackers

Reputation has been claimed for all products.

6 By order of 7 September 2017 (‘the contested decision’), the Opposition Division accepted the opposition for all products provided on the basis of Article 8(5), RMUE and MEU No 8 566 176. In particular, its reasoning can be summarised as follows:

#### *Signs*

- Visually, the brands differ in particular from the names they contain (very particularly “dripping” and “GULLON”) and the appearance of colours. The marks overlap not only in the presence of a sandwich biscuit (which is found to be duplicated in the mark), but also in the fact that the same shape of the biscuit is very close, since black and white is the same and the top is perforated, and differences in this shape may not be received in full unless the aforementioned parts of the biscuit form are collected from a very close angle.
- In the light of the name “Twins” and two biscuits, part of the public, the meaning of the word may not exactly be described as “twinned or melises” which is the concept that communicates in English, but is just “double”, marked “twice” or “as a pair of partners”, etc. The names “cookie” and “sandwich” are fully descriptive for a relevant part of the public as they deal directly with the type of product and the way it appears.
- Phonetically, the marks do not have any similarity, since the terms are different, bearing in mind that the figurative elements cannot be made.
- The brands are conceptually identical in the perception by consumers of the sandwich biscuit, not bearing the terms ‘dripping’ and ‘GULON’ for a relevant part of the public (who do not know that a “dripping” is a “breath of air, which gives a slight difference” according to the dictionary of the Real Academia Española). The weight in the comparison both visual and the conceptual of the names “cookie” and “sandwich” is limited since they are descriptive for the products in dispute and for “Twins”, as explained above,

the image of two sandwich biscuits in the brand is conceptually intended to reflect conceptually.

- In view of the above, the brands are linked by the occurrence of the sandwich biscuit.

*The reputation of the earlier trade mark;*

- It is clear from the evidence provided that the earlier mark has been extensively and intensively used and enjoys a reputation in Spain widely known to constitute a relevant part of the relevant market, in which it occupies a consolidated position between the leading brands, as has been demonstrated by independent and diverse sources. Particularly important are the advertising documents which, because they were carried out in widely distributed media in widely held programmes, have clearly arrived at a large part of the population, as well as the surveys and market surveys provided in documents 23-25, where a large proportion of the public respondent associated the cracker in a single commercial origin, even when the latter is not identified by the word ‘dripping’.

*The “link” between the signs*

- The applicant refers in his observations repeatedly that the only similarity between the marks is the presence of the sandwich biscuit in both of which it is not possible for the consumer to have a link between brands on the consumer’s mind. The applicant has also submitted evidence of trade marks which indeed show a plurality of sandwich biscuits. In this regard the Opposition Division agrees that in principle and in general terms the element in itself is indistinctive; however, in the case at hand, the biscuits are very similar in nature as they share the same colour in black and white, as well as in the fact that the side chelated is prima facie also identical. Furthermore, with regard to the upper chelated, the Opposition Division is of the opinion that the individualisers of a biscuit and a cookie are not a prima facie case for the consumer or, if that happens, the cookies applied for would immediately result in the minds of the consumer.
- In this regard, the conclusions of the market study carried out by GfK in February 2016 on the distinctive features of the opponents (document 25) are very interesting. The sample refers to the fact that in view of the biscuit view contained in the sign of the contested brand by 53 % of respondents, they associate a single brand and 38 % from several brands and from the first 83 % of those marks spontaneously to dripping, while the percentage between the latter is 77 %.
- It is also revealing that, in the same market study, the sign contested as a whole and 71 % of the respondents stated spontaneously that they associate the photograph with any brand or manufacturer, and of these 73 % are associated with a ‘dripping’ even when the photograph is clearly marked ‘GULLON’, the main ground of association of the mark or the manufacturer for 72 % of the respondents ‘shape/design of the biscuit’.

- In view of the above, the Opposition Division considers that the relevant consumers, being faced with the contested mark, are likely to associate them with the previous sign, i.e. to establish a mental “link” between the signs.

### *Risk of injury*

- The opponent also refers to the fact that, in the event that the applicant uses the brand contested for biscuits, the distinctive character of the earlier trade mark will inevitably be impaired. The contested mark reveals an association in the minds of consumers with the same business origin of the well-known earlier trade mark, which will result in a reduction in the latter’s ability to encourage an immediate association with its business origin, which will ultimately result in the dispersal of its identity and of its retention in the consumer’s memory, which will lead to irreparable damage to the previous trade mark, or what the same is the same as ‘a death by THHOUSAND cuts’, as is stated in the case law of the United Kingdom. In other words, the opponent claims that the use of the contested mark would harm the distinctive character of the earlier mark. To test the plausibility of this risk and not its mere probability the opponent presented the survey found in Document 25.
  - On the basis of the proven reputation of the earlier trade mark, in the event that the opponent has established that the biscuit cookie that immediately brings to the mind of the consumer a link with the opponent mark and that the products are absolutely identical, the use of the contested mark would be an improper use of the earlier mark. The registration of the contested mark would allow the image of the earlier trade mark and the features which it plans, such as a long presence on the market and a high level of recognition among the public, to be transferred to the contested mark, and thus the contested mark would benefit from the attraction, reputation and prestige of the earlier trade mark for its own products, thus conferring a commercial advantage in relation to the products of its competitors and obtaining a financial advantage in order to exploit the efforts made by the opposing company to create the reputation and image of its earlier trade mark.
  - The applicant has claimed the coexistence of brands but has not proven that brands are in use on the market and that, if this is the case, consumers will not confuse them.
- 7 On 7 November 2017, the applicant brought an appeal against the contested decision and requested it to be annulled in its entirety. The application was lodged on 8 January 2018.
- 8 In its reply of 20 April 2018, the opponent requested a rejection of the appeal.

### **Claims and claims of the parties**

- 9 The arguments put forward by the applicant in the statement of grounds for the appeal can be summarised as follows:

*Lack of similarity to estimate the concurrence of the Article 8.5 RMUE*

- The Opposition Division bases its decision only on one of the constituent elements of the two brands, which it recognises in both cases, of entry, a distivity and leaves complete and inexplicably to the margin of its comparative judgment, the so-called ‘dripping’ (on the opponent mark) and ‘GULLON’, which hold the highest distinguishing load from among the elements making up the signs confronted, and not satisfying any other factors that may have, in addition, the other components of the mark applied for by Galletas Gullón, S.A. (graphic elements, colours and words — COOKIE, Sandwich, Twins).
- In the opposing trade mark the name ‘dripping’ is the one with the highest distinguishing load.
- In the opposite trade mark, the most distinctive component is the Gullón, which is the well-known one in the biscuit sector, as it is one of the main Spanish brands in the segment since the last century. The evidence on this reputation has been duly revealed at the opposition stage, even the opponent itself has given evidence of its renown through the exploratory nosure number of marks in the Galletero Sector carried out by Millward Brown in Spain in 2015 (which the opposing party has provided as Document No 7 of its statement of opposition).
- The Office’s own judgement of marks consisting of black and white sandwich biscuits and the doctrine that reflect the weight of signs and non-distinctive features on the comparison of signs for the effects of visual and phonetic similarity must be infringed, especially when marks that reproduce the form of a standard product or signs are analysed.

*No link between the markings required by the article 8.5 RMUE*

- The contested decision bases the existence of a link between those signs only on the basis of the common presence in both of a black-and-white biscuit in the common presence and the conclusions reached by GfK in the studies submitted by the opponent in the opposition phase as Documents No 25 and 26.
- No entry cannot be accepted for the purpose of establishing any link, the Study provided as Document No. 26 and which is exclusively displayed one of the components of the mark applied for by Galletas Gulon, S.A. and not the whole of the opposite mark as requested before the EUIPO.
- The study submitted by GfK shows important technical and methodological weaknesses that render it as proof as evidence in legal proceedings. Technical Note prepared by Prof. CERVIÑO of the Carlos III University of Madrid to discuss the approaches and conclusions of the GfK surveys.

*Lack of reputation/reputation*

- Indeed, the national courts and the Office have taken the view that the opposing sign could enjoy visibility but have always been given the task of demonstrating that its reputation as a result of the presence in that sign of the

term ‘dripping’, which is the only one of which it may have raised its reputation, is not such as that which can be extended or anticipated from the other common elements present on the sign in question.

- The opponent has never made use of the biscuit cookie by itself without the expression ‘dripping’ within its interior. The visibility tests put up in the opposition phase refer either to the called “dripping” mark or, to the three-dimensional trade mark consisting of a black sandwich with the word ‘oreo’ within its interior.
- It cannot be inferred that there is exploitation of the reputation which is outside the scope of that other than by coincidence in one of the constituent elements of the opposing trade mark, where the overlapping element corresponds to the standardised form of a product.
- The contested decision considers that it is being used exclusively because of the existence of a link between one of the many elements making up the signs in question and the reputation of the opponent’s mark.

*Fair cause of reproduction on the opposite brand of the sandwich black biscuit product type with cream filling*

- If the position of the Opposition Division is accepted, the competitors’ right of the objector to manufacture and place on the market, sandwich sandwich with cream-filled sandwich kits which, for sale, must be reproduced on the sales packages so that the consumer is aware that he is acquiring a certain type of product, would be unreasonably restrictive. Resolution of 26 February 2008, R 320/2007-2 Gullón mini O2 (3D)/Galleta (3D) was mentioned.
- 10 The arguments raised by the opponent in response to the appeal can be summarised as follows:
- The General Court, neither the General Court nor the Court of Justice of the European Union, has never called for an award criterion such as the one held by the appellant. In fact, in the first paragraph of this section of the appeal, the appellant does not quote a single resolution on the matter of the TG or the CJEU.
  - It is not the case in receipt of the artificial dissection of the opponent mark, discharge from the taking of any consideration to a very relevant part of the mark, such as the ornamentation of the surfaces that make up the shape of the three-dimensional shape, which is based on denying them free of charge and in contravention of the overriding principle that the marks must be assessed as a whole.
  - The references made by the appellant to a resolution of the 2006 Opposition Division and a decision of the Board of Appeal of 2008 do not call into question this conclusion. These decisions are not even so far as these decisions refer to the opponent mark, since those decisions predate the date on which the latter was applied for. Nor is the judgment cited by the Alicante Community Trademark Court of 5 July 2013 (or the subsequent judgment of the Spanish Supreme Court in connection with the appeal.), the conclusions

of which are distorted by the appellant, since those judgments give an opinion on a national mark (the Spanish trade mark 1.997.588) which is different to the mark which is the European Union's opponent, and, in addition, do so within an infringement and lapse process in the absence of use, with no effect as to the distinctiveness of the trade mark there.

- The signs of conflict have some degree of visual and conceptual similarity to satisfy the first of the requirements of Article 8(5) RMUE. **The reasons for this are basically that the graphic part of the opponent's mark is reproduced with an identity (and in duplicate) in the contested mark.**
- It is clear that the documents provided show that the opposition marks, and in particular No 8 566 176, have been extensively and extensively used in Spain for biscuits.
- The report on the renown of this three-dimensional trade mark without the name 'dripping' prepared by IPSOS Marketing raises a 76 % and suggested profile of 91 %.
- In order to fulfil the requirement of similarity, it is not necessary to show that there is, for the relevant public, a risk of confusion between the earlier trade mark having the reputation and the trade mark applied for. **It is sufficient that the degree of similarity between these marks has the effect of establishing a link between them** (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 31). Account should also be taken of the fact that the products are identical and are intended for the general public. As the case law has been pronounced on multiple occasions in relation to products of snacks, the level of attention will be low.
- It is extremely striking that GfK's market study (Document No 26) shows that 83 % of Spanish consumers associate with the origin of 'dripping' the three-dimensional shape of the biscuits showing the contested mark; and only 2 % successfully associates the Gullón.
- Particularly relevant is document 24 of this part, which consists of a market survey on the three-dimensional shape of the earlier trade mark No 8 566 176, without the so-called 'dripping' element, which shows that a very high percentage of the Spanish public (91 %) is able to indicate the trade origin of the earlier or earlier trade mark even without the expression of its name, which demonstrates the high distinctive character of the figurative component of the earlier sign.
- In this respect, it is very revealing that the other market study provided by this party, drawn up by the research company GfK in February 2016, relating to the distinctive character of the contested mark application (Document No 25). This study shows that 73 % of the Spanish public by seeing the contested brand application of Galletas Gullón is associated spontaneously with the business origin of 'dripping' and only 24 % from 'Gullón' or 'Twins', in spite of being able to read the symbol 'Gullón' and 'Twins' in the sign. When asking respondents why they link or relate to that sign with the entrepreneurial origin of "dripping", 72 % of the public responded spontaneously to the "shape/design of the biscuit", 20 % for "the design of the packaging" and only



12 % referred to “I have read, seen, on the package” (pages 17 and 19 of the study).

- To counter the technical note of Prof. Cerviño, technical note of GfK is provided on the methodology of the study and explanations on the calculation and conclusions.

- 11 On 17 July 2018, the applicant submitted comments informing that the Spanish Office of Patents and Trademarks had granted Spanish mark No 3 684 187 with a



sign identical to the mark challenged in this proceeding on 18 May 2018, after opposition on the basis of the same marks as those earlier than in the present proceeding. The applicant provided as Document 1 the publication in the BOPI of the total concession for class 30 and as Document No. 2 in the decision of the competition in which the AEOS considered that there is no risk of confusion between the signs.

- 12 On 17 August 2018, the opponent informed that on 22 June 2018 he lodged an appeal against the decision to grant the trade mark and to reject the opposition. Enclosed as Document No 1, evidence of a hierarchical submission and appeal and as Document No 2, extract from SITEX, in which publication in the BOPI was reported on 6 July 2018 of the appeal.

### Grounds

- 13 All references in this Decision to the RUE shall be construed as references to RUE (EU) 2017/1001 (OJ 2017 L 154, p. 1), which codifies Regulation (EC) No 207/2009, unless otherwise specifically indicated.
- 14 The appeal is in accordance with Articles 66, 67 and Article 68(1) of the RUE. Is admissible.

#### *Preliminary question — Requests for confidentiality in the statement of grounds for appeal and reply*

- 15 As regards the request for confidential treatment made by both parties, it should be noted that, pursuant to Article 114 (4) TEU, the party requesting anonymity and the omission of information from the public should give reasons for that request.
- 16 In this case, the discussion, inter alia, of the internal and external validity of the surveys carried out by the GfK company, was deemed necessary to refer to the methodology used by GfK for the surveys in the most general way in order not to spread the possible know-how of GfK, which could have been brought to the attention of the Board in order to illustrate the opinion on the preparation of the surveys. In addition, the technical note provided, together with the reply, was clearly marked as confidential.

- 17 Part of the previous consideration made by the Chamber, the parties have not indicated any reasons to support their requests.
- 18 The Chamber cannot, on its own, identify the reasons why these claims could be justified.
- 19 As a result, the Chamber rejects the application for confidential treatment of the statement of reasons and the reply in general, except for information relating to methodology used by GfK for the surveys (24/04/2018, T-831/16, ZOOM/ZOOM et al., EU:T:2018:218, § 21-24; 09/04/2014, T-623/11, Milanowek cream fdge, EU:T:2014:199, § 9-13).

*Article 8(5) RUE*

- 20 The Chamber agrees with the Opposition Division examining the opposition, first, on the basis of the earlier EU trade mark 8 566 176 and on the basis of Article 8.5 RMUE for which the objector has claimed its reputation for “cookies”.
- 21 Upon the opposition of the proprietor of an earlier registered trade mark, within the meaning of Article 8.5 (2), the registration of the trade mark applied for shall be refused, pursuant to Article:


if it is identical or similar to the earlier trade mark, irrespective of whether the goods and services in respect of which the earlier trade mark is registered are identical to, or not similar to, those for which the earlier mark is registered, if, in the case of an earlier European Union trade mark, the latter is well-known in the Union, or, in the case of an earlier national trade mark, the latter is well-known in the Member State concerned, and if the use of the earlier trade mark as a result of the trade mark applied for without due cause, or the fact that it is well-known, has been misused or is harmful to the latter.

- 22 The application of Article 8(5) of the Regulation (EU) of the EU requires that the following conditions are met (Judgment of 16/09/2010, in Joined Cases T-345/08 and T-357/08, *Boutolst v Bolocyl*, EU:T:2010:529, confirmed by the Court of Justice in its judgment in Case 10/05/2012 P, *Boitolst v Bolocyl*, EU:C:2012:285):
- the earlier registered trade mark must have a reputation in the reference territory;
  - there must be identity or similarity between the opposition to which object of the opposition and the earlier mark;
  - the use of the sign applied for must be such as to permit the misuse or prejudice the distinctive character or the renown of the earlier trade mark;
  - this use must be done without due cause.
- 23 As these conditions are cumulative, failure to comply with any of them will be sufficient for the above mentioned provision (judgments of 25/05/2005, T-67/04, *SPAQu-Finders*, EU:T:2005:179, paragraph 30; 22/03/2007, T-215/03, *VIPs*, EU:T:2007:93, § 34; 16/12/2010, T-345/08 and T-357/08, *Botolist/Bolocyl*, EU:T:2010:529, § 41).

*Reputation of the earlier trade mark*

- 24 It is not disputed by any of the parties that the earlier EU trade mark 8 566 176



tridimensional  has an exceptional reputation in Spain for biscuits for its long and intensive use and thus throughout the European Union.

*Comparison of brands*

- 25 Despite the same similarity criterion for signs in Article 8(1)(b) and Article 8(5), its underlying objectives are different: in the case of point (b) of paragraph 1, its purpose is to prevent the registration of a later trade mark which, if it were used, could confuse the intended public as to the commercial origin of the products or services concerned, whereas paragraph 5 is intended to prevent the registration of a later trade mark the use of which could be unduly exploited by the distinctive character or the repute of the earlier trade mark or is detrimental to them.
- 26 The link between the concept of “similarity” for each of these paragraphs was analysed by the Court in *Timi KINDEMUNGURT*: “The existence of a similarity between the earlier trade mark and the trade mark in question is a requirement of application which is common to Article 8(1)(b) [of the VVR] and Article 8(5) [of the EU RMRs]” (paragraph 51). Article 8(5) [of the RMFEU] such as Article 8(1) (b) of the VVR is manifestly not applicable if the General Court rules out any similarity between the marks concerned (judgment of 20/11/2014, C-581/13 P and C-582/13 P, *Golden Ballis*, EU:C:2014:2387, § 73).
- 27 However, these provisions differ with respect to the degree of similarity required. While the protection provided for by Article 8(1)(b) of the Regulation is made conditional on finding a degree of similarity between the trademarks in dispute that could create a risk of confusion, the presence of this risk is not necessary for the protection afforded by Article 8(5), RMUE. Therefore, the types of damage referred to in Article 8(5), RMUE can be derived from a degree of similarity between the brands in question which, although minor, is sufficient to enable the target public to perceive the connection, that is to say, to conclude that there is a link between them (23/10/2003, *Adidas*, EU:C:2003:582, § 27, 29 and 31; and of 27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 57, 58, 66).
- 28 Thus, for a successful competition based on Article 8(5), the EU needs to have “a certain degree of similarity” between the signs (judgment of 24/03/2011, C-552/09 P, *TimiKinderjoghurt*, EU:C:2011:177, § 53).
- 29 In the context of Article 8(1)(b) and Article 8(5), RUE, finding the similarity between the brands in question requires, in particular, the existence of similar graphical, ethical or conceptual traits (judgment of 23/10/2003, C-408/01, *Adidas*, EU:C:2003:582, § 28).
- 30 No case-law is required if these traits similar and present in both marks have a particular degree of inherent differentiation.

31 The signs to be compared are the following:



*Earlier trade mark*



*The contested mark*

32 The relevant territory is the European Union in its entirety.

33 The earlier trade mark is three-dimensional and consists of the shape of two black biscuits with white (or sandwich) cream. The black biscuit face is not smooth but has a cut-out edge, a inside filled with geometric items and an oval with the word “dripping”. The expression ‘dripping’ element is a difficult to perceive because of the decoration of the biscuit face in the absence of much space between the geometrical elements and the denominative element.

34 The contested mark is a figurative brand formed by the image of two sandwich biscuits, the face of which is not smooth, but also has an outer edge, embossed, with geometric figures and a circle. Next to one of the cookies written in small size the words at the dark blue standard font and the capital letters “COOKIE” and “Sandwich” of which arrows are taken to indicate the biscuits. The word “Twins” is written in a capital letter which is more relevant than the words “Twins” in the Figurative elements of the biscuits. On the upper right of the last letter of this word, which is hardly perceptible, the trademark symbol appears. This element is almost imperceptible and the examination will continue without it. The last denominative element is the word ‘Gulon’ written in the top left-hand corner on a green rectangle. The brand background is clear blue with white degradations along the side of the Figurative elements of the cookies. Because of its size and central position, the word ‘Twins’ and the Figurative elements of the cookies are to a greater extent stressed than the other elements.

35 Visually, when a brand is composed of denominative and figurative elements, the former should in principle be considered as more distinctive than the latter, since the average consumer would more readily refer to the product concerned by citing the brand name describing the figurative mark by describing its figurative element (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 49; 14/07/2005, T-312/03, SeleniumAce, EU:T:2005:289, § 37).

36 However, it should be borne in mind that this principle is derogated from under the circumstances. Thus, it has been stated that the foodstuffs in classes 29 and 30 are normally acquired through supermarkets or similar establishments and are therefore chosen directly by the consumer on the shelf and do not form a face-to-face choice. Also, in such establishments, the consumer loses a short period of

time between its successive purchases and often does not make a reading of all the indications given in the different products, but is further guided by the overall visual impact produced by its labels or packaging. In these circumstances, for the assessment of the existence of any risk of confusion or link between the signs at stake, the result of the analysis of visual similarity becomes more important than the result of the analysis of phonetic and conceptual similarity. In addition, in making that assessment, the graphic elements of a mark play a greater role than its elements entitled to the reference consumer's perception (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 50; 12/09/2007, T-363/04, Spain EU:T:2007:264, § 109, 02/12/2008, T-275/07, P, EU:T:2008:545, § 24).

- 37 In the present case, in the case of food products of class 30, and in particular biscuits, it is appropriate to consider, taking into account the exceptions case law, that the Figurative elements of the brands into conflict play a role, at least as important as their headings in the overall visual perception of the reference consumer.
- 38 The signs coincide with the reproduction of the biscuit in the form of sandwich, thick, thick, thick decoration, similar decoration, and a round element in the centre. In other words, the characteristics of the earlier mark are similarly reproduced in the central elements of the contested mark. As said the Opposition Division, the decoration on the sides of the cookies will not be analysed and received in detail by the consumers, but visually they will be perceived as a similar graphic decoration. They differ in the rest of its items, i.e. in the so-called "dripping" element of the earlier trade mark and the references "Twins", "Gullón", "cookie" and "sandwich" and in blue and green funds.
- 39 Therefore, conflicting signs, when viewed as a whole and not based on the analytical dissection of its figurative or figurative elements, present, in spite of their differences, some visual similarity to a similar representation of the sandwich biscuit.
- 40 Phonetically does not share similarities.
- 41 The brands conceptually agree on the perception of a sandwich biscuit. The distinction of this figurative element is low, as it reproduces the product being protected from both brands. The expression "obreo" presented in the earlier mark and "Gullón" of the contested mark shall not have a meaning for the relevant public and therefore its degree of differentiation is normal. The words "cookie" and "sandwich" are directly indicative of the type of the protected product. Part of the general public means 'Twins' as two, twins or double, in which case it is levied as repetitive of the drawing of two identical biscuits, and for part it has no meaning at all.
- 42 According to the case-law, for the purpose of assessing the degree of similarity between the marks in question it is appropriate to determine their degree of graphic, social and conceptual similarity and, where appropriate, to assess the importance to be attributed to these different factors, taking into account the category of products or services covered and the conditions under which they are marketed in the context of an overall assessment (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, paragraph 67; 24/03/2011, C-552/09 P,

TimiKinderjoghurt, EU:C:2011:177, § 85-86; 12/06/2007, C-334/05 P, limonlo, EU:C:2007:333, § 36 ).

- 43 It should be pointed out in this connection that the graphic, phonetic or conceptual aspects of the conflicting signs do not always weigh the same. The importance of assimilating and differentiating elements between signs may depend, in particular, on their intrinsic characteristics or the conditions under which the products or services for which the trade marks are placed on the market are placed on the market. If the goods described by the marks concerned are normally sold in self services where the consumer chooses the product himself and, therefore, is principally based on the brand image affixed to the product, visual similarity of the signs must generally be more important. On the other hand, if the product is mainly offered for sale, it will normally be attributed to the phonetic similarity of the oral sale. Therefore, the degree of phonetic similarity between two marks is of minor importance when they refer to products placed on the market under conditions which normally allow the relevant public to perceive the brand visually at the time of buying-in (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 68; 21/02/2013, T-444/10, Kmix, EU:T:2013:89, § 36 and 37 and the case-law cited; see also, to that effect, 12/09/2007, T-363/04, EU:T:2007:264, § 109; 02/12/2008, T-275/07, Brillion's EU:T:2008:545, § 24).
- 44 In the present case, as class 30 products are normally sold in self-service, the elements of similarity and visual distinction between the conflicting signs therefore appear to be of greater importance than the elements of similarity and phordial and conceptual differentiation between those signs (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 69).
- 45 The poor visual and conceptual similarity of the brands is due to the fact that both brands reproduce sandwich biscuits with similar graphic characteristics on its sides.
- 46 The considerations of the applicant that the overlap relates to the representation of a standard biscuit type may only be relevant for the purposes of the overall analysis of a risk of confusion or a link by the reference consumer in accordance with paragraph 1 (b) or Article 8(5) of Regulation No 207/2009, but not for the purpose of the objective analysis of similarity between the signs. Thus, it is appropriate to consider that the public interest in which the representation of the sandwich biscuit is free to be used freely, cannot be opposed by itself as a similar element of similarity between the conflicting signs in the consumer's perception (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 61).
- 47 Whether or not the name 'Gullón' is renowned, this would have no influence on the existence of the above link between the marks at issue. Therefore, the claims in this regard of the applicant are rejected.

#### *Link between signs*

- 48 The Court notes that although it is correct that the degree of similarity between the conflicting signs is among the factors relevant to an overall assessment of the existence of a link between the conflicting signs within the meaning of Article 8(5) of Regulation No 207/2009 (see paragraph 27 above), the fact remains that the

very similarity between those signs, irrespective of the degree, is a requirement for the application of that Article even if it is of a low degree.

49 The Court has clearly expressed the view that, in order to determine whether the use of the mark being challenged may cause damage to the distinctive character or the repute of the earlier trade mark, or misuse thereof, it is **necessary to determine**, after verification of the similarity between the marks, if, **taking into account all relevant factors, the target audience may establish a link (or association) between the signs**. The subsequent case law has clearly established that an analysis of this nature should precede the final assessment of the existence of a risk of injury.

50 The link between the signs was addressed by the Court in its judgment in 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 30 (and the case-law cited therein), which, although it refers to the interpretation of Article 4(4)(a) of the Directive on Trademarks, is also applicable to Article 8(5) of the Directive, which is the equivalent provision of the EU VVR. In the context of the “Intel” case, the Court stated (paragraph 30):

‘The infringements referred to in Article 4(4)(a) of the Directive, when they occur, are the result of a certain degree of similarity between the marks before and after which, by virtue of which the relevant public establishes a relationship between the two brands, that is to say, establishes a link between the two, though not confounding’ (see, in connection with Article 5(2) of the Directive, ‘General Motors, paragraph 23; ‘Addidas-Salomon and Benelux Adidas’, paragraph 29, and the ‘Adidas and Benelux Adidas’, paragraph 41).

51 Other factors include the assessment of the link between signs first, the degree of similarity between the signs in conflict, and, second, the nature of the goods or services for which the signs in conflict were recorded, including the degree of proximity or differentiation between those products or services, and the relevant public, third, the intensity of the reputation of the earlier trade mark, fourth, the strength of the distinctive character of the earlier mark, either intrinsic or acquired by the use, and fifth, the existence of a risk of confusion on the part of the public ( 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42, 29/03/2012, T-369/10, Beatle, EU:T:2012:177, § 47).

52 The sign is in the figurative sign of sandwich biscuits which have a similar decoration. Contrary to what the applicant claims, the appreciation of a potential partnership between the brands by the public should be made taking into account all the factors of the case and the relevant public may involve two marks for the presence of both of the non-distinctive elements.

53 The earlier mark is renombrada for biscuits and the contested mark is rightly requested for this product. Overall, the latter has a degree of differentiation, in spite of its figurative component representing the protected product.

54 Although the figurative element that coincides with is the representation of biscuits, these representations are rather similar because of their similar decorations. The conflicting products are identical. These products are daily consumption by the general public. On the points of sale the objector’s and the applicant’s products are side by side in the same section and will be directly competitive and the public will not have a particularly high level of attention (15/12/2016, 112/13, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D),

EU:T:2016:735, § 57). In this respect, the average consumer normally perceives a trade mark as a whole, whose details do not stop at examining (11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 41).

- 55 For the sake of completeness, account should be taken of the purchasing method for self-services, where the products in conflict will be one beside the other and visual overlaps are therefore of greater relevance.
- 56 taking into account the fact that the trademark in the shop is one beside the other and the purchasing method, the reputation of the earlier mark considered in its entirety and the consumer's relatively low degree of attention for a daily consumer product, because of the similar decoration of the biscuits present in both brands the relevant public, at least in Spain, will associate the contested mark to the earlier trade mark.
- 57 In addition, the opponent during the opposition proceedings has presented as Document No 25 study on the association of the earlier trade mark which confirms the previous findings of the Chamber.
- 58 With reference to document No 25, it should be pointed out that both technical notes, both the technical memorandum of Prof. Cerviño attached to the statement of reasons and the technical note of GfK presented together with the comments in response, are taken into consideration under the Article. 95.2 RMUE because they have been submitted following the findings of the contested decision which has taken special account of document No 25. In addition, both parties have submitted technical notes within the first deadlines.
- 59 This study (Document No 25, submitted on 23 February 2016 during the objection procedure) was drawn up by the long path company and acknowledged in this field by its experience GfK. Among other objective accreditations (see technical note provided by GfK on 20 April 2018), the company has ISO 9001 certificates for quality management systems and ISO 20252 specific for the 'Market, Social and Opinion' sector of opinion. The approach and field work has been carried out by a team (i.e. the director, technical and interviewers) and within the structure of an international company. In addition, those responsible for the study, the director and the technician, who sign the study declare that they have acted as objectively as possible, taking into consideration both what can be encouraged and what is likely to be detrimental to any party and who are aware of the criminal sanctions which they may incur if they fail to comply with the duty of an expert as an expert, indicating their willingness to carry out the study professionally and to respond to the consequences of the contrary.
- 60 As regards the study itself, the sample is sufficiently representative for the whole of the Spanish population taking into account the fact that the products are intended for the general public. The survey is based on a sufficient number of people, population of different age, gender and geographical location. The study was prepared in January and February 2016, when the contested mark was requested on 26 March 2015. Therefore, the study has been carried out at a time sufficiently close to the date of application for the contested mark in order to be able to prove the risk of a public association, as the reputation of the trade marks is understood and is not abruptly created and abolished.



- 61 In addition, the methodology used for the survey and further described in the GfK Technical Note is the personal interview at the Hoar, as described in the Technical Note, the Chamber considers a very reliable method for the respondent to identify visually the respondent and to corroborate several of the necessary parameters (age, gender, etc.).
- 62 Considerations regarding the unreliability of the online surveys carried out in the technical note developed by Professor. CERVIÑO and supplied by the applicant are irrelevant because the methodology is not online and shows, inter alia, the absence of rigour and the unreliability of the technical note prepared by the teacher. CERVIÑO.
- 63 The issues raised in the surveys are appropriate and the inconsistencies in the results in the technical note are clarified in the technical note provided by the opponent.
- 64 The result of the study is that of the population that would associate the contested



mark with any brand, 73 % would be spontaneously attached, with 72 % being the main ground of association of the shape/design of the biscuit with the contested mark.

- 65 That is to say, the public associates both brands in spite of the references in the contested mark and there is, or not, the reputation of the 'Gullón' description element.

#### *Misuse*

- 66 In its judgment in 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, the Court noted that there is unfair advantage in the event of a transfer of the brand image or the features it envisages towards the products designated with an identical or similar sign. By attempting to place himself in the wake of the renombade mark, the applicant benefits from his/her attractiveness, reputation and prestige. It also operates, without payment of any financial compensation, for the trade effort developed by the proprietor of the earlier trade mark in order to create and maintain the image of the earlier trade mark.
- 67 The concept of **misuse of the distinctive character or reputation** covers cases where the applicant benefits from the attractiveness of the earlier trade mark by subscribing to a similar (or identical) sign on the market to one which enjoys a strong reputation on the market, thereby unduly appropriate either as to its attractiveness and to the advertising investment of the latter, or to exploit its reputation, reputation and prestige. Such a scenario may lead to unacceptable trade free-riding where the applicant "is used for free" thanks to the opponent's investment to promote its brand and to create goodwill for it, from the moment it can serve to stimulate sales of the applicant's products in a high proportion of its own investment in promotion.

- 68 The examination of injury or misuse shall be based on an overall assessment of all relevant factors of the case (including, in particular, the similarity of the marks, the reputation of the earlier trade mark, the groups of consumers and the respective market sectors) in order to determine whether trade marks may be associated in a way that could adversely affect the earlier trade mark.
- 69 The existence of an unfair advantage based on the distinctive or reputation character of the earlier trade mark should thus be examined in relation to the normal consumers for the goods and services for which the later trade mark is being applied (judgments of 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 35-36; 12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146, § 46-48; de 07/12/2010, T-59/08, Nimei La Perla Modern Classic, EU:T:2010:500, § 35).
- 70 In the present case, in the light of the reputation of the earlier trade mark, as the identical products, daily consumption by the general public and sold one close to the other in the supermarkets, the product bearing the contested mark will more easily attract the consumer, since the contested mark will remind you of the earlier mark which is well known. Although the consumer does not confuse both marks, the similarity of the matched part, it will see the applicant's identical product as a possible replacement of the product offered by the opponent on the grounds that the applicant's product will have similar quality characteristics, taste, etc. The applicant is thus taking advantage of the reputation and investment in advertising the earlier trade mark in order to sell its product.

*Just cause*

- 71 In this respect, it is necessary to reject the applicant's claim that the representation of sandwich biscuits for cookies is intended to monopolise the representation of sandwich biscuits but, because of the similarity between the representations of biscuits in the conflicting brands, consumers will establish a link or a connection between the marks at issue when they are used to market the products bearing the mark applied for, in particular biscuits. The applicant is therefore wrong to argue that a decision that permits the existence of a similarity or a link between the brands compared means not only that the opponent is proceeding to exploit the image of the sandwich biscuits, thus preventing any other operator to use it to indicate the sandwich biscuit product (11/12/2014, T-480/12, MASTER, EU:T:2014:1062).
- 72 Thus, there is no fair cause for it to use a similar element to that of the earlier trade mark.
- 73 Other trade marks or designs for sandwich biscuits, the use of which together with the earlier marks is referred to in the Community trade mark judgment of 5 July 2013, are as follows:



- MUE No 3 285 418:

- Registered Community design No 58 334-0001 and expired on 30 July 2008:



- Spanish mark No 2 837 603, whose validity is unknown today.

74 Thus, these rights are a clear indication that the opponent is not monopolising the use of the representation of a sandwich biscuit, but is the applicant that has chosen a representation of the sandwich biscuit of, one or both of, the opponent's mark.

75 Therefore, the applicant does not have a justification to imitate and to approach both the biscuit picture of the previous old mark.

### *Conclusion*

76 In view of the above, the trade mark application is misuse of the reputation of the earlier trade mark and must therefore be rejected in full pursuant to Article 8(5) of the EC Treaty.

77 The applicant cites previous national decisions to substantiate its arguments. It should be noted, however, that decisions of national courts and offices regarding identical or similar conflicts at national level do not have a binding effect on the Office, since the EU trade mark is an autonomous system which applies independently of any national system (13/09/2010, T 292/08, often, EU:T:2010:399).

78 Even if the above national decisions are not binding, their reasoning and outcome must be properly taken into account when deciding on a particular case, especially when the decision has been taken in a Member State relevant to the proceedings.

79 In 2015, the Spanish Supreme Court, even though he stated the reputation of the



earlier marks and , rejected both the action for infringement of the renombrated brand and the action for unfair



competition against the Gullón brand , because it considered that the relevant elements in the conflicting brands were the so-called

“dripping” and “moratoria” respectively, meaning that the public does not mean that there is no trade mark.

- 80 Each case must be examined on the basis of merit in the light of the circumstances and documentation at the case-file. Firstly, the surface and decoration of the cookies in the sign used by Gullón in the case heard by the Spanish Supreme Court are different from those of the earlier trade mark in the present case. Secondly, in the present case the opponent has submitted a solid report which supports its claims on the effective association between the trade marks. In view of the above, the above mentioned above refers to signs more far away than in the present case and the circumstances and documentation of the present case, followed by a different conclusion.
- 81 With regard to the decision of the ESO of 18 May 2018 to grant Spanish brand No 3 684 187 with a sign identical to that given here for products of class 30, it is not a valid precedent because, firstly, it is not firm and, secondly, the decision is solely based on the risk of confusion between the marks at issue, where this decision is based on the reputation of the earlier mark.
- 82 The applicant also refers to previous decisions of the Office to support its allegations. These decisions have been analysed. However, their reasoning and failures do not modify the conclusion reached in the present case after the examination of the circumstances and documentation of the case, for the reasons set out below:

- With regard to the Office’s decision of 6 April 2016 to refuse the registration on the territory of the European Union of the international trade mark No 1 282 903 which reproduces the Roman biscuit’s name (without the oreo’s



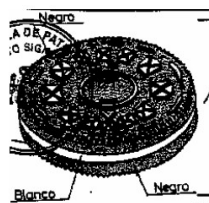
name), it has to be recalled once again that the opposition to succeed on the basis of Article 8.5 RUE is not a sine qua non requirement for the traits to be distinguished to a minimum, but relevant and that, together with other circumstances, the public due to these issues involve conflicting brands. In addition, in that case, there was no identification of the acquired advantage that would have to be tested across the EU.

- Resolution of the EUIPO Opposition Division of 15 December 2006: The



application by MUE No 3 285 418 is very different from the one requested in the present case since due to the decoration of the case it appears to be a button, i.e. decoration it modifies the conceptual perception of the public. It is not a valid precedent.

- Resolution of 26 February 2008, R 320/2007-2 Gullón mini O2



(3D)/Galleta (3D)

the graphics of the marks are different to those in this case. For the sake of completeness, the Court found that the sample of the population of the survey submitted by the opponent was limited in order to extend its conclusions to the entire Spanish population, which is not the case in the present case where a different study was submitted.

- 83 The appeal is dismissed in its entirety and the contested decision is confirmed.

### Costs

- 84 Pursuant to Article 109(1) of the Treaty, the applicant, as an unsuccessful party, has to pay the costs of the opponent relating to the opposition and appeal proceedings.
- 85 As regards the procedure for appeal, these costs consist of the costs of professional representation of the objector of EUR 550.
- 86 As regards the opposition procedure, the Opposition Division condemned the applicant to pay the opposition fee of EUR 350 and the costs of representation of the opponent fixed at EUR 300. This resolution is not affected. The total amount for both procedures is therefore EUR 1 200.

**Failure**

On those grounds,

THE CHAMBER

resolves as follows:

- 1. Dismisses the action.**
- 2. Orders the applicant to pay the costs of which the opponent has made in the appeal procedure, which are set at EUR 550. The total amount to be paid by the applicant in the opposition and appeal proceedings is EUR 1 200.**

Signed

S. StÜRMAN

Signed

S. Martin

Signed

H. SALMI

Secretariat:

Signed

Damascus P. 2-Naphthz

