

**Blow for Deutsche Post: General Court finds no likelihood of confusion between POST marks**  
European Union - **Boehmert & Boehmert**

**Examination/opposition  
International procedures**

March 13 2018

- **General Court confirmed that there was no likelihood of confusion between marks sharing word element 'post'**
- **Relevant public would not establish any link between the marks**
- **Consumers no longer necessarily associate 'post' exclusively with Deutsche Post given liberalisation of market**

In *Deutsche Post AG v European Union Intellectual Property Office* (EUIPO) (Case T-118/16, February 20 2018), the General Court has upheld a decision of the First Board of Appeal of the EUIPO in which the latter had found that there was no likelihood of confusion between marks which shared the word element 'post', and had ruled out the existence of a link between the signs in the mind of the relevant public.

On February 19 2010 Belgian company bpost NV filed an application for the registration as an EU trademark (EUTM) of the word mark BEPOST for goods and services in Classes 16, 35, 38 and 39, including paper goods, advertising and business management, and postal services.

German company Deutsche Post AG opposed the application on the basis of various marks, which all covered identical or highly similar services and goods, including:

- its German word mark POST;
- the EU word mark DEUTSCHE POST;
- the EU figurative mark ; and
- non-registered marks used in the course of trade.

The Opposition Division of the EUIPO rejected the opposition and the First Board of Appeal of the EUIPO dismissed the appeal. The board mainly argued that, despite the presence of the identical word element 'post', the signs "showed significant visual, aural and conceptual differences", thereby ruling out a likelihood of confusion under Article 8(1)(b) and Article 8(4) of [Regulation 207/2009](#). As regards the earlier national word mark POST, these differences were considered sufficient to rule out the possibility that the relevant public would establish an association or mental link in the sense of Article 8(5).

The General Court rejected the three pleas in law raised by Deutsche Post. From a formal point of view, the court first rejected as inadmissible a market survey presented by Deutsche Post for the first time before the court and intended to prove the enhanced distinctiveness of the German word mark POST.

Concerning the first plea (alleging infringement of Article 8(1)(b)), the court found that there was no likelihood of confusion between the EUTM application for BEPOST on the one hand, and the earlier national word mark POST and the earlier EU figurative mark EPOST on the other.

With respect to the comparison between the word marks BEPOST and POST, the General Court confirmed the Board of Appeal's finding that there were significant visual differences, despite the common element 'post', due to their different length and beginning. The court also agreed that the signs were aurally similar only to a low degree, as they differed in the pronunciation of the additional word element 'be'. As regards the conceptual comparison, Deutsche Post's argument that there was a high degree of conceptual similarity in the absence of elements establishing conceptual differences was rejected. The court confirmed that the degree of conceptual similarity was only low, as the word element 'be', unlike the term 'post', did not allude to the relevant goods and services, and was slightly dominant due to its place at the beginning of BEPOST. Finally, due to the grammatically unusual combination of the elements 'be' and 'post', the German consumer would not necessarily perceive the mark as a meaningful expression. In the context of the global assessment, the different overall impression produced by the marks in light of the additional word element 'be' in BEPOST - which is more distinctive than the word element 'post', which, in the mark applied for, is not likely to bring to mind an association with Deutsche Post - led to the conclusion that there was no likelihood of confusion.

The court also confirmed the Board of Appeal's conclusion that the earlier German word mark POST had a low degree of distinctiveness, as consumers no longer necessarily "associate the word 'post' exclusively

with [Deutsche Post], given the significant liberalisation of the market for postal services in the European Union". This conclusion would not have been put into question even if the German word mark POST had been found to have enhanced distinctiveness.

The General Court also found that the element 'post' did not have an independent distinctive role within the BEPOST mark, and did not apply the principles of the *Medion* judgment (Case C-120/04), as 'post' was "entirely descriptive" - compared to the more distinctive word element 'be' - and likely to be seen as a mere reference to postal services in the BEPOST mark.

With respect to the comparison between BEPOST and the earlier EU figurative mark EPOST, the court confirmed the Board of Appeal's conclusion that the marks were similar to a low degree due to significant visual, aural and conceptual differences. Regardless of the common element 'post', the General Court noted, from a visual point of view, the different colours and typefaces and, from an aural point of view, the different pronunciation of the first letter 'b' in the mark applied for. The element 'e' of the prior figurative mark was perceived as a reference to electronic services, which led to a conceptual difference, as the word element 'be' in BEPOST did not contain this concept.

Concerning the second plea, the General Court held that there was no infringement of Article 8(4) of Regulation 207/2009. Deutsche Post could not successfully invoke POST as a German prior sign used in the course of trade. Due to the weak distinctive character of that sign, which alluded to postal and related services, the differences with the EUTM application were sufficient to rule out a likelihood of confusion in the context of Article 8(4).

Concerning the third plea, the court found that there was no infringement of Article 8(5). Without being required to assess the alleged reputation of the earlier German mark for POST, the court again sided with the Board of Appeal and found that the relevant public would not make a link between BEPOST and the earlier national word mark POST, due to the weak distinctive character of the common element 'post'. Moreover, the registration of the German word mark POST, a term which is also used as a prefix meaning 'after', did not mean that that term has "such a high level of distinctiveness that it gives an unconditional right to oppose the registration of every later trademark containing that term".

The decision covers rather complex aspects concerning the assessment of the similarity - in its different forms - between signs containing an identical element and the evaluation of the distinctive character of that common element. EU case law in this field is hardly coherent, but it is most likely that such coherence is factually impossible. In any case, the result of the present trademark dispute was appropriate: the German word mark POST owes its reputation mainly to a decades-long state monopoly, as it is *per se* descriptive for postal services; thus, this mark could hardly have acquired enhanced distinctiveness. This is in line with the relevant case law of the German Federal Supreme Court on the distinctive character of the term 'post'.

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