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General Court confirms lack of likelihood of confusion between MANDO and earlier MAN marks

European Union - [BOEHMERT & BOEHMERT Anwaltspartnerschaft mbB](#)

- **MAN Truck & Bus AG opposed the registration of MANDO in Classes 7, 9, 11, 12, 35, 37 and 39 based on earlier MAN marks in Classes 7, 9, 11, 12, 35 and 37**
- **The Board of Appeal found that there was no likelihood of confusion**
- **The General Court agreed with the board's conclusions, except with regard to one of the earlier registrations**

In [MAN Truck & Bus AG v European Union Intellectual Property Office](#) (EUIPO) (Case T-698/17, 12 July 2019), the Fourth Chamber of the General Court has partially upheld an action against the decision of the Board of Appeal in opposition proceedings against the application for the EU word mark MANDO.

Background

In October 2012 the intervener, South Korean company Halla Holdings Corp, applied for registration of the EU mark MANDO for various goods in Classes 7, 9, 11, 12, 35, 37 and 39. German truck manufacturer MAN Truck & Bus AG opposed the application based on Article 8(1)(b) of [Regulation 207/2009](#) (likelihood of confusion). The opposition was based on five earlier international registrations and national German marks, which were mainly figurative and covered various goods and services in Classes 7, 9, 11, 12, 35 and 37, including:

- International Registration No 542763 for the figurative mark depicted below, which covered mainly motors and engines for boats (Class 7), trucks, motor coaches and buses, street maintenance vehicles (Class 12), repair and maintenance of motor vehicles and of motors and engines (Class 37):



- International Registration No 542762 for the figurative mark depicted below, for the same goods and services as the previous mark:



- International Registration No 863418 for the figurative mark depicted below for advertising services (Class 35):



The Opposition Division dismissed the opposition. Upon appeal, the Board of Appeal dismissed the appeal as far as the infringement of Article 8(1)(b) was concerned on the following grounds, among others, especially as regards International Registrations No 542763 and No 542762:

- The relevant public was the professional or specialist public of specialist vehicles and engines and motors, as well as the vehicle-owning general public;
- The visual similarity of the marks was low and there was an average degree of phonetic similarity, with the marks being conceptually different and not comparable; and
- Due to the differences between the marks, the lesser importance of the phonetic similarity and the greater attention than average of the relevant public, the degree of similarity of the marks was insufficient to conclude that there was likelihood of confusion, even for goods that are identical, and even if the earlier mark enjoyed a reputation in Germany and Austria.

The same approach applied to International Registration No 863418.

In its action before the General Court, MAN Bus requested that the court annul the board's decision and put forward a single plea in law, alleging infringement of Article 8(1)(b). The company basically argued that the Board of Appeal had:

- incorrectly defined the relevant public and its level of attention;
- wrongly defined the visual and conceptual similarity of the marks; and
- failed to sufficiently take account of the exceptional distinctive character of the earlier marks.

General Court decision

The General Court confirmed the lack of likelihood of confusion as regards the earlier international registrations covering services in Classes 7, 12 and 37. In particular, the court found as follows:

- The Board of Appeal had correctly defined the relevant public; in particular, the goods concerned in Classes 7 and 12 were aimed at specialists and professionals, including mechanics and boat builders and undertakings transporting people or goods. The general public which takes the bus as a means of transport could at most be regarded as a consumer of transport services, since it is not called upon to choose its means of transport on the basis of its mark.
- This professional or specialist public and the vehicle-owning general public display a level of attention that is higher than average. The potentially lower level of attention of the relevant public in an after-sales context did not preclude the taking into account of the particularly high level of attention exhibited by the average consumer when making a choice between different goods in the category concerned.
- In contrast to MAN Truck's allegation, and in line with the Board of Appeal's finding, the visual similarity between MAN and MANDO was low. Both marks had the word element 'man' in common. However, the earlier marks comprised or contained a short term and MANDO formed a unique term which the relevant public would perceive as an indivisible whole. This was supported by the fact that MANDO is a fairly short word and that the two syllables of which it is composed are not separated by any space or typographic element. Moreover, even if MAN enjoyed a reputation in Germany and Austria, the reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks at issue. In any case, the element 'man' would not be the dominant element and the letters 'D' and 'O' could not be regarded as negligible, since they made up almost half of the MANDO mark.

- The Board of Appeal was right to exclude a likelihood of confusion. It was unlikely that the relevant public purchased the goods and services only after hearing the name of the mark; on the contrary, given the technical or expensive nature of the goods, these would be examined carefully, particularly visually, and sometimes with qualified sales personnel. In addition, even an enhanced distinctive character of the earlier marks owing to their reputation in Germany and Austria did not alter the finding that, for the relevant public that displays a high level of attention and that will perceive the mark applied for as a whole, the differences between the marks were clearly discernible.

On the other hand, the court annulled the contested decision due to a lack of reasoning with regard to the likelihood of confusion with International Registration No 863418 covering services in Class 35. The Board of Appeal had not carried out any specific analysis of the relevant public and its level of attention with regard to advertising services in Class 35, and had wrongfully referred to the reasoning in relation to the goods and services in Classes 7, 12 and 37 of the other registrations.

Comment

The court's conclusion that there is no likelihood of confusion - and especially the finding that MANDO will be perceived as a unique term, leading to a low degree of visual similarity, as well as the finding that the level of attention of the relevant public is above average - is convincing. Interestingly, the partial - and presumably temporary - success of MAN Truck due to the Board of Appeal's failure to comply with the duty to state reasons was based on a ground that had not been invoked by the German company, but raised by the General Court on its own motion.

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