

**DECISION**  
**of the Fourth Board of Appeal**  
**of 22 June 2017**

In Case R 1933/2016-4

**Bolton Cile España, S.A.**

Calle Ombu, 3 - Torre Urbis, Planta 13  
28045 Madrid  
Spain

Opponent / Appellant

represented by BARZANO' & ZANARDO MILANO S.P.A., Via Borgonuovo 10,  
20121 Milan, Italy

v

**P.P.H. PRIMART Marek Łukasiewicz**

Szosa Jadowska 70  
05-200 Wołomin-Duczki  
Poland

Applicant / Respondent

APPEAL relating to Opposition Proceedings No B 2 516 246 (European Union trade  
mark application No 13 682 299)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairperson), L. Marijnissen (Rapporteur) and C. Bartos  
(Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 27 January 2015, P.P.H. PRIMART Marek Łukasiewicz ('the applicant') sought to register the figurative as amended in the colours red, white and dark blue



for the following goods and services:

Class 30 - Sugars, natural sweeteners, sweet coatings and fillings, bee products; coffee, teas and cocoa and substitutes therefor; ice, ice creams, frozen yogurts and sorbets; salts, seasonings, flavourings and condiments; baked goods, confectionery, chocolate and desserts; processed grains, starches, and goods made thereof, baking preparations and yeasts; crackers.

- 2 On 29 April 2015, Bolton Cile España, S.A. ('the opponent') filed a notice of opposition based on the following earlier rights:
  - a) Spanish national registration No 2 578 815 for the word mark

### **PRIMA**

registered on 22 September 1973 and renewed on 9 April 2013 for, amongst other, the following goods:

Class 30 – Sauces and condiments; coffee; tea; cocoa; sugar; rice; tapioca; sago, artificial coffee; flour and preparations made from cereals; bread; biscuits; cakes; pastry and confectionary; edible ices; honey; treacle; yeast, baking-powder; salt; mustard; pepper; vinegar; ice.

- b) Portuguese national registration No 259 384 for the word mark

### **PRIMA**

registered on 26 October 1989 and renewed until 7 November 2022 for the following goods:

Class 30 – Food products of vegetable origin for consumption or conservation; adjuvants for foods.

- 3 The grounds of opposition were those laid down in Article 8(1)(b) EUTMR. The opposition was directed against all the goods of the application and based on the

goods for which the earlier marks were registered as indicated in the previous paragraph.

- 4 Within the period to substantiate its opposition, the opponent submitted extensive evidence supporting its claim of enhanced distinctiveness of the earlier marks.
- 5 By decision of 2 September 2016 ('the contested decision'), the Opposition Division rejected the opposition in its entirety and ordered the opponent to bear the costs.
- 6 It reasoned that the conflicting goods were identical, similar to a high degree or similar. They were directed at the public at large with an average degree of attention. The signs were visually and aurally similar to an average degree. They were not similar from a conceptual point of view. The earlier signs 'PRIMA' consisted of a laudatory expression and were therefore weak for the relevant goods. Enhanced distinctiveness of the earlier marks due to extensive use was assumed. It concluded that because of the differences between the marks there was no likelihood of confusion, even if the earlier marks were to be considered to have a high degree of distinctiveness.
- 7 On 24 October 2016, the opponent filed a notice of appeal followed by its statement of grounds on 30 December 2016. It requests that the Board annul the contested decision and order the applicant to bear the costs of the proceedings.
- 8 It argues that almost all the contested goods are identical or similar to a high degree to the earlier ones. None of the goods are different. The degree of attention of the relevant public at large is average. The element 'PRIMART' represents the dominant element of the contested sign. That element only differs in the last two letters 'RT' from the earlier marks. The first part of it, which catches the consumer's first attention, is identical. The conflicting signs are highly similar. The earlier Spanish mark has enhanced distinctiveness due to its extensive use in Spain. A likelihood of confusion would exist.
- 9 In its reply the applicant argues that the marks have enough differences from a visual, aural and conceptual point of view to avoid a likelihood of confusion also because the applied for mark contains the name of an entity present on the market since twenty years.

### **Reasons**

- 10 The appeal is well founded. A likelihood of confusion within the meaning of Article 8(1)(b) EUTMR exists for all the contested goods.
- 11 Pursuant to Article 8(1)(b) EUTMR, upon opposition of the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its identity with or similarity to the earlier trade mark and, cumulatively, the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

- 12 The opposition is based on an earlier Spanish and an earlier Portuguese trade mark registration, both for the word mark 'PRIMA'. The Board will first examine the opposition on the basis of the earlier Spanish trade mark. For this mark the relevant territory for analysing the likelihood of confusion is Spain and the relevant public consists of the public at large in that Member State.

*Comparison of the goods*

- 13 The Board agrees with the Opposition Division's reasoning that the contested goods 'sugars, natural sweeteners, bee products, coffee, teas and cocoa, ice, salts, condiments, baked goods, confectionery, yeasts' are identical with the earlier goods.
- 14 It further agrees with the Opposition Division's reasoning that the contested goods 'chocolate and desserts' are similar to a high degree to the earlier goods 'cakes and confectionery'; that the contested goods 'crackers' are similar to a high degree to the earlier goods 'biscuits'; and that the contested goods 'ice creams, frozen yoghurt and sorbets' are similar to a high degree to the earlier goods 'edible ices'. It further endorses the contested decision that the contested 'sweet coating and fillings' are similar, to an average degree, to the earlier goods 'sugar' and that the contested 'processed grains, starches, and goods made thereof, baking preparations' are similar, to an average degree as well, to the earlier goods 'flour and preparations made from cereals'.
- 15 As regards the contested goods 'substitutes for coffee, tea, cocoa' the Board finds, however, that these are not similar to an average degree, as decided by the Opposition Division, but to a high degree to the earlier goods 'coffee, tea; cocoa' like the contested goods 'seasonings, flavourings' which are highly similar, if not identical, to the earlier 'sauces and condiments; salt; mustard; pepper; vinegar'.
- 16 To conclude, the contested goods are all identical, highly similar or similar to an average degree to the earlier goods. No arguments were filed by the applicant to the contrary.

*Comparison of the signs*

- 17 The comparison of the conflicting marks shall assess the visual, aural or conceptual similarity of the signs in question, based on the overall impression given by the marks and bearing in mind, in particular, their distinctive and dominant elements (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28). The comparison must be based on the perception, pronunciation and meaning of the conflicting signs in the languages of the Member State where the earlier mark is protected, i.e. in Spain, and by reference to the target public of the goods at issue.

18 The marks to be compared are:

<i>Contested mark</i>	<i>Earlier mark</i>
	<p style="text-align: center;"><b>PRIMA</b></p>

- 19 The contested figurative mark consists of the word ‘PRIMART’ written in bold, white capital letters with a blue border. The word appears against a background of a red, blue bordered square. Underneath is a red band in which, in a very small white handwritten script, the words ‘Marek Lukasiewicz’ appear. Due to their size and presentation, they are hardly legible and thus of minor importance within the overall impression of the contested mark, in fact they may be even overlooked at all. As the consumer is used to focus on the textual elements of a mark and as the figurative elements of the mark at hand are merely decorative, also these only play a secondary role. It follows that the word ‘PRIMART’ forms the most distinctive and dominant part of the contested mark.
- 20 Visually, the earlier word mark ‘PRIMA’ is highly similar to the distinctive and dominant part ‘PRIMART’ of the contested mark as it reproduces the first five letters of that part in exactly the same order. The part ‘PRIMART’ only differs in the addition letters ‘RT’. The contested mark also differs in its figurative elements and the additional script underneath the word ‘PRIMART’ which have no counterpart in the earlier mark, but these elements only play a secondary role. It follows that the marks are visually similar to an average degree.
- 21 Aurally, the unclear and very small script underneath the word ‘PRIMART’ will not be pronounced. The contested mark will be pronounced as ‘PRI-MART’ the earlier mark as ‘PRI-MA’. From an aural point of view the marks are similar to an above average degree.
- 22 Conceptually, for the relevant Spanish consumer the word ‘prima’ means ‘female cousin’ or ‘bonus payment’. The contested sign lacks any meaning. The marks are not similar from a conceptual point of view (see also decisions of 18/09/2013, R-83/2012-4 and R 312/2012-4, PRIMAFLOR/PRIMA, § 56; 08/03/2016, R-28/2015-4, PRIMAWELL/PRIMA, § 49; 12/07/2016, R-1619/2015-4, Primal Food/PRIMA, § 48).

*Overall assessment of the likelihood of confusion*

- 23 According to the case-law of the Court of Justice, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion. It follows from the very wording of Article 8(1) (b) EUTMR that the concept of a likelihood of association is not an alternative to that of a likelihood of confusion, but serves to define its scope (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17).

- 24 A likelihood of confusion on the part of the public must be assessed globally. That global assessment implies some interdependence between the factors taken into account and in particular similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 19). The more distinctive the earlier mark, the greater the risk of confusion, and marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).
- 25 For the purpose of that global appreciation, the average consumer of the category of goods concerned is deemed to be reasonably well informed and reasonably observant and circumspect. The level of attention of the relevant consumer is likely to vary according to the category of goods or services in question and the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26; 30/06/2004, T-186/02, Dieselit, EU:T:2004:197, § 38).
- 26 The level of attention of the relevant public for the goods and services concerned is average or, taking into account the nature of the goods, even lower than average.
- 27 In the absence of any meaning of the earlier mark for the goods concerned, its inherent distinctive character is normal. In this respect, the Board notes that the Spanish consumer will understand the word 'prima' as indicated in paragraph 22 above and not as a qualification of something excellent as in some other languages of the European Union (see also decisions of 18/09/2013, R-283/2012-4 and R 312/2012-4, PRIMAFLOR/PRIMA, § 68; 08/03/2016, R-28/2015-4, PRIMAWELL/PRIMA, § 53; 12/07/ 2016, R-1619/2015-4, Primal Food/PRIMA, § 52).
- 28 Taking into account the identity and similarity of the conflicting goods, the average level of visual and above average level of aural similarity of the conflicting signs, the at most average level of attention of the relevant public and the normal level of inherent distinctiveness of the earlier mark, there exists a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR on the part of the relevant public.
- 29 The applicant claims that the contested mark includes the name of an entity present on the market since twenty years. Apart from the fact that this claim remains completely unsubstantiated, the Board notes that it is settled case law that only the reputation or high distinctiveness of the earlier mark will be taken into account in the assessment of the likelihood of confusion, but the applicant cannot rely on the reputation of its younger mark (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20; 16/09/2009, T-400/06, zerorh+, EU:T:2009:331, § 83; 19/04/2013, T-537/11, Snickers, EU:T:2013:207, § 55).

- 30 In view of the above considerations, there is no need to assess the evidence submitted by the opponent in order to show the enhanced distinctiveness of the earlier mark. Also, there is no need to examine the other earlier mark on which the opposition was based.
- 31 To conclude, the opponent is successful in its appeal. The opposition shall be upheld, the application rejected and the contested decision annulled.

### **Costs**

- 32 Since the applicant (respondent) is the losing party within the meaning of Article 85(1) EUTMR in this appeal, it must bear the costs incurred by the opponent (appellant) in the opposition and the appeal proceedings.

### **Fixing of costs**

- 33 In accordance with Article 85(6) EUTMR and Rules 94(3), (6) and 94(7)(d)(i) and (v) CTMIR, the Board fixes the amount of representation costs to be paid by the respondent to the appellant for the appeal proceedings at EUR 550 and for the opposition proceedings at EUR 300. In addition the respondent shall reimburse to the appellant the opposition fee of EUR 350 and the appeal fee of EUR 720. The total amount is EUR 1 920.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Upholds the opposition and rejects the European Union trade mark application No 13 682 299 for all the goods applied for;**
- 3. Orders the respondent to bear the costs of the opposition and the appeal proceedings;**
- 4. Fixes the amount of costs to be paid by the respondent to the appellant for the opposition and appeal proceedings at EUR 1 920.**

Signed

D. Schennen

Signed

L. Marijnissen

Signed

C. Bartos

Registrar:

Signed

H. Dijkema

