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Registration of sound mark refused based on earlier word mark Examination/opposition
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In *Manpower Inc v PDV Beteiligung GmbH* (Case 31207-361/2006-20, March 25 2009), the **Slovenian Intellectual Property Office** (SIPO) has refused to register a sound mark consisting of a simple melody (three notes) and the term 'man-pow-er' on the grounds that it was confusingly similar to the earlier word and device marks MANPOWER.

In March 2006 Austrian company PDV Beteiligung GmbH applied for the registration of a sound mark which consisted of a three-note melody represented graphically on a musical stave, with 'man-pow-er' written below each note. The application covered, among others, services in Classes 35, 41 and 42 of the **Nice Classification**.

US company **Manpower Inc** filed an opposition against the registration of the mark based on two earlier word marks MANPOWER and a design mark comprising the word 'manpower' for services in Classes 35, 41 and 42. Manpower argued that even though the mark applied for was a sound mark, it was identical to its earlier marks from a phonetic and conceptual point of view. Moreover, Manpower claimed that the services covered by PDV's mark were identical and/or confusingly similar to those covered by its own marks.

In response, PDV argued that the dominant element of its mark was the melody, whereas the dominant element of the earlier marks was the word 'manpower'. Furthermore, PDV alleged that SIPO should not take into consideration the graphical representation of its mark, but should consider only its sound. PDV submitted that because its mark would always be used on the market with a melody, there was no likelihood of confusion with Manpower's marks.

SIPO upheld the opposition, stating that although the usual criteria for assessing the similarity of 'regular' marks cannot be applied to sound marks in their entirety (eg, visual analysis), PDV's sound mark comprised the word 'man-pow-er', which is sung following the melody. Consequently, the mark applied for was identical to the earlier marks from a conceptual point of view. In addition, SIPO found that the marks were similar from a phonetic point of view. It reasoned that the earlier marks have an aural dimension because they can

be advertised on radio and television, or can be pronounced by consumers. SIPO thus concluded that consumers would not be able to distinguish between PDV's and Manpower's marks.

This decision is significant in that it is the first time that SIPO has considered a conflict between a sound mark and a word mark. Therefore, the decision clarified the scope of protection of sound marks and 'regular' marks relative to one another.

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