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SHA v SHAPERFECTION: Opposition Division erred in finding that coinciding element played independent distinctive role

European Union - [ITEM doo](#)

- Herbamedis' application for SHAPERFECTION was opposed by Albir Hills Resort based on its earlier SHA marks
- In contrast to the Opposition Division, the Board of Appeal found that the element 'sha' did not play an independent distinctive role in the contested mark
- There was no reason to believe that 'sha' would be dissected from the rest of the word element in the mark

In [Herbamedis Ltd v Albir Hills Resort SAU](#) (Case R 2405/2020, 15 June 2021), the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) has held that trademarks coinciding merely in their first part were not confusingly similar. The interest of the decision lies in the determination of the distinctive element of the contested trademark.

Background

In 2019 Herbamedis Ltd applied for the registration of the mark depicted below as an EUTM (Application No 018048969) for goods in Class 3:



Herbamedis' application was opposed by Albir Hills Resort SAU based on its earlier EUTMs - namely:

- EUTM No 006115761 for the word mark SHA, covering services in Classes 43 and 44;
- EUTM No 009090572 for the combined mark SHA, covering services in Class 44:



- EUTM No 014837991 for the word mark SHA SKIN CARE, covering goods and services in Classes 3, 35 and 44.

The Opposition Division (Case B 3 089 622, 20 October 2020) upheld the opposition on the basis of the earlier EUTM No 009090572, and rejected the application in its entirety. It reasoned that the contested trademark would be perceived as a combination of the elements 'sha' and 'perfection'. It concluded that there was a likelihood of confusion because:

- the goods and services in Classes 3 and 44 were similar; and
- the signs were similar as the coinciding element 'sha' played an independent distinctive role in both signs, and they both conveyed the similar concept of a flower.

Herbamedis filed an appeal against the Opposition Division's decision. It requested that the Board of Appeal annul the contested decision and allow its EUTM to proceed to registration.

Board of Appeal decision

The board held that the appeal was well founded and that the opposition failed on the basis of all grounds and earlier rights invoked.

Incorrect assessment of the distinctive element of the contested trademark

In contrast to the Opposition Division's decision, the board found that the element 'sha' did not play an independent distinctive role in the contested trademark. It reasoned that the word 'sha', as such, has no meaning, so there was no reason to believe that it would be dissected from the rest of the word element in the mark. The board held that 'sha' forms an integrated part of the word element as a whole, also being presented in exactly the same size and letter-type as the rest of the letters of which the word is composed. The board concluded that the word element 'shaperfection', as a whole, represented the dominant and most distinctive element of the contested trademark.

Dissimilarities between the signs

In comparing the signs, the board pointed out several differences between them:

- Visually, the trademarks gave a very different overall impression:
 - the mere fact that the three letters of which the earlier trademarks are composed are the same as the first three - out of 13 - letters of the contested trademark (in which they do not form an independent distinctive part) could not render the marks similar; and
 - although the earlier trademark includes a device of a flower, this did not change the conclusion that the marks were visually dissimilar.
- Aurally, the compared signs differed in the number of syllables, which created a very different rhythm and intonation.
- The figurative element of the contested mark played a secondary role due to its position, size and weak distinctive character. The mere fact that the earlier trademark also includes a flower could not create any relevant conceptual similarity, since the variety of flowers are innumerable and the trademarks do not represent the same one.

The board thus concluded that the trademarks under comparison were dissimilar.

Unproven reputation of the earlier trademarks

The board opined that the conditions under Article 8(5) of [Regulation 2017/1001](#) had not been fulfilled, not only because the conflicting trademarks were found to be dissimilar, but also because the reputation of the earlier trademarks had not been proven.

Comment

This decision serves as a reminder that the determination of the dominant and distinctive element of a trademark plays an important role in the global assessment of the likelihood of confusion. The Opposition Division erred in its assessment when determining that the coinciding word element was an independent distinctive element of the contested trademark. The board emphasised that such element did not form a meaningful word, so there was no reason to believe that it would be perceived separately from the rest of the mark.

ITEM doo represented Herbamedis Ltd in this case

Maša Osredkar

ITEM doo

TAGS

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