



Sporting goods company successfully relies on prior Slovenian company name in invalidation action against EUTM registration

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Legal updates: case law analysis and intelligence

- The applicant sought a declaration of invalidity of the EUTM PEACH BOOTY based on the earlier company name Peach Booty Plan DOO
- The Cancellation Division held that the applicant's company name had been used in the course of trade of more than local significance in Slovenia before the filing date of the contested EUTM
- There was a likelihood of confusion on the part of the public in Slovenia

In [Peach Booty Plan doo v Hassan](#) (Case C 52 590, 14 February 2023), the Cancellation Division of the European Union Intellectual Property Office (EUIPO) has held that the figurative EU trademark PEACH BOOTY was invalid in its entirety based on the prior Slovenian company name Peach Booty Plan DOO.

Background

Peach Booty Plan DOO ('the applicant') has been using in commerce since January 2020 an (unregistered) figurative sign (pictured below) designating mostly exercise bands:



On 19 October 2020 the applicant applied for the figurative EU trademark PEACH BOOTY PLAN (as pictured above), covering sports products in Classes 25 and 28 and sports services in Classes 35 and 41.

On 9 March 2021 Mr Islam Adel Hidar Soliman Hassan ('the EUTM proprietor') filed an opposition against the trademark application for PEACH BOOTY PLAN based on his earlier figurative EU trademark PEACH BOOTY (pictured below), which had a filing date of 8 April 2020 and covered products in Class 25:



The applicant tried to reach an amicable solution with the EUTM proprietor so that both trademarks could co-exist; however, the conditions proposed by the EUTM proprietor were not acceptable for the applicant, which had already been using the sign PEACH BOOTY PLAN extensively in Slovenia and elsewhere prior to the filing date of the earlier trademark PEACH BOOTY.

In order to obtain the trademark registration, the applicant filed an application for a declaration of invalidity of the earlier trademark PEACH BOOTY, invoking Article 60(1)(c) of [Regulation 2017/1001](#), in conjunction with Article 8(4). The application was based on the protection of the earlier company name Peach Booty Plan DOO and the earlier domain name 'peachbootyplan.com' under Slovenian law.

In the invalidation procedure, the applicant submitted evidence that:

- its company name Peach Booty Plan DOO and the domain name 'peachbootyplan.com' were protected under Slovenian law;
- they had been used in the course of trade of more than mere local significance;
- they were acquired before the contested EUTM was filed; and
- they provided the applicant with a right to prohibit the use of a subsequent trademark under Slovenian law.

Decision

When assessing the evidence, the Cancellation Division established that the applicant had been selling exercise bands under its registered company name Peach Booty Plan DOO since January 2020, and that the use was already significant on 8 April 2020 (ie, the date when the contested EUTM was filed). The evidence provided by the applicant demonstrated use of the company name Peach Booty Plan DOO, registered under Slovenian law on 15 January 2020. Such evidence consisted of:

- a list of over 6,000 invoices for exercise bands issued to customers between 28 January 2020 and 8 April 2020;
- PayPal payments;
- the company's credit rating; and
- documents with information on the applicant's presence on the Internet and social media.

Additionally, the invoices confirmed the geographic area of the use of the company name Peach Booty Plan DOO since they were issued to different clients located throughout the territory of Slovenia, which proved that the applicant's trade under the company name was of more than mere local significance.

Further, the Cancellation Division concluded that, according to Slovenian Law (ie, Articles 121(1)(a), 124(c), 47(1)(b) and 47(2) of the Industrial Property Act), the owner of an earlier company name enjoys protection against the use of a more recent, confusingly similar trademark. The conditions to be met are the following:

- identity or similarity of the signs;
- identity or similarity of the goods or services; and
- a likelihood of confusion among the public, including the possibility of association between the sign and the trademark.

Comparing the prior company name Peach Booty Plan DOO and the contested EUTM PEACH BOOTY, the Cancellation Division held that the signs were visually and phonetically similar to a high degree. With regard to the part of the relevant Slovenian public who understands the expression 'Peach Booty', the signs were also conceptually similar.

Turning to the comparison of the goods and services, the Cancellation Division compared exercise bands with the products in Class 25 covered by the contested EUTM (ie, "bathing costumes for women; crop tops; bikinis; maillots; bomber jackets; athletic tights; hooded pullovers; leggings [trousers]; sports bras; sportswear; sports pants; sports socks"), and concluded that there was a similarity between the goods with regard to their use in the context of physical exercise - namely, the compared products were sold together in sporting goods shops and could therefore have the same distribution channels. Additionally, the

compared products targeted the general public interested in physical exercise and, considering that many providers of sporting goods offer a wide product range, it was very likely that the relevant public would believe that the goods at issue came from the same source.

Comment

This decision is significant since it establishes that a prior company name registered under Slovenian law can be relied on in either invalidation or opposition proceedings before the EUIPO if all conditions under Article 8(4) of Regulation 2017/1001 are met.

ITEM doo represented the applicant in this case.

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