

## Evidence of Co-Existence of Limited Use in Trade Mark Opposition Proceedings

The GC ruled that while the peaceful co-existence of the marks in dispute in the European marketplace might be considered as one of the relevant factors in an assessment of the likelihood of confusion, the applicant would need to demonstrate convincing evidence of such co-existence. To the extent that it will be almost impossible for an applicant to demonstrate a negative, namely an absence of confusion between the marks in conflict, evidence of co-existence is unlikely to be of any real assistance as a defence to a claim of confusing similarity in proceedings before OHIM.

### Background

The Cartoon Network Inc. (CN) filed a Community Trade Mark (CTM) application for the plain word mark BOOMERANG in respect of “Cable and television broadcasting services; broadcasting programmes directed to children and young adults via a global computer network” in Class 38 and “Entertainment services, namely a series of television and cable television programmes targeted primarily to children and young adults” in Class 41. The application was opposed on the basis of the figurative CTM BOOMERANG, an image of which is set out below and which was protected in respect of “film and recording studios, rent of videos, concourse (scattering), installation of television and radio programmes; production of films” in Class 41.



The opposition was grounded on a risk of confusion under Article 8(1)(b) of the CTM Regulation No 207/2009 and was upheld by the Opposition Division.

On appeal, CN filed, for the first time, a Witness Statement from one of its directors, stating that its BOOMERANG word mark had been used extensively in the European Union since 2000 without ever having been confused with the earlier mark in the marketplace. This evidence included details of advertising expenditure in some member states from 2001, examples of advertising materials from 2003 and viewing figures in several member states for the BOOMERANG television channel from 2008. CN also attested to trade mark registrations for its BOOMERANG word mark in France and Monaco which had safely co-existed with registrations for the earlier mark. The Board of Appeal dismissed

CN’s appeal, ruling as follows:

“24 In certain circumstances, the peaceful coexistence of the marks in dispute may be considered as one of the relevant factors in the assessment of the likelihood of confusion [citation omitted]. However, coexistence must be on the market and not just in the register. It is essential that the party presenting such argument adduces convincing evidence of the peaceful coexistence of the marks.

25 As regards the ‘peaceful coexistence’ requirement, it suffices to state that there is no evidence on file to demonstrate how the marks have been encountered by the consumer in the market place and in relation to which services. The evidence does not show that confusion did not occur during the time in which the trade marks were marketed.

26 Only under special circumstances may the Board consider evidence of the coexistence of the marks in the market. This has to be assessed on a case-by-case basis and such an indicative value should be treated with caution as there may be different reasons as to why similar signs coexist, e.g. different legal or factual situations in the past, or prior rights agreements between the parties involved. No such additional information exists in this case and the evidence of coexistence in the trade mark registers is irrelevant.”

The GC agreed with this assessment and added that while the co-existence of earlier marks on the market might reduce the likelihood of confusion between two later conflicting marks, that possibility could only be taken into consideration if the applicant demonstrated that such co-existence was based on the absence of any likelihood of confusion on the part of the relevant public between the earlier marks on the marketplace on which it relies and the opponent’s earlier mark and provided that all of these earlier marks are identical to the application.

Where the evidence filed by CN had related solely to its use of the BOOMERANG mark under application, the GC found that it gave no indication of the way in which the relevant public encountered the conflicting marks on the market in connection with the services for which they were used. Furthermore, the CG found that the use of the marks in the marketplace could not be inferred from trade mark registrations alone and that the evidence provided by CN was disputable where it was not corroborated by independent sources. The Board of Appeal had therefore been correct to find that the evidence was insufficient to demonstrate the co-existence of the conflicting marks.

### Comment

It is difficult to anticipate what type of evidence would be

accepted by OHIM to demonstrate an absence of confusion between two identical marks co-existing on the market on the part of the relevant public. In addition, at paragraph 26 of its judgment, the Board of Appeal indicated that such evidence would only be considered in “special circumstances” and would be treated with caution since there may be different reasons as to why signs coexist. Where OHIM chooses not to examine trade mark applications on relative grounds, it is left to individual traders to determine whether and under what circumstances brands can peacefully co-exist in the market place. In these circumstances, it appears to be very onerous to expect brand owners to demonstrate, as a matter of fact, that marks co-exist as a result of an absence of confusion between them rather than for any other reason.

The GC has left a bigger question mark over whether co-existence is of any relevance in any event, where it states that “it [CN] was required to demonstrate that the co-existence of the marks on which it relied was based on the absence of a likelihood of

confusion on the part of the relevant public.” This statement appears to suggest that the applicant needs to establish that the marks are not confusingly similar before the Court will consider any evidence relating to co-existence. However, if there is no confusion, then there is no need to consider co-existence. An applicant would only seek to demonstrate peaceful co-existence in order to support a claim of non-confusion rather than simply to confirm an absence thereof.

This ruling suggests that evidence of co-existence is only likely to be of any assistance in opposition proceedings in support of an argument that a shared element of the marks in dispute is in common usage and thereby of low distinctive character. To the extent that the applicant can demonstrate that consumers have been exposed to the widespread use of, and have become accustomed to, trade marks which include the shared element in question, they should be in a position to argue that the existence of this element in the mark under application will not give rise to a risk of confusion with the earlier mark.

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