

# European Court of Justice: ECJ Remands Golden Balls Case to Ohim for Correct Application of Article 8(5)

*Intra-Press SAS v Golden Balls (Joined Cases C-581/13P and C-582/13 P, November 20, 2014)*

The Court of Justice of the European Union (ECJ) recently ruled on the *Intra-Press SAS v Golden Balls* case, partially setting aside the judgments of the General Court allowing the registration of a CTM application for GOLDEN BALLS despite a prior CTM registration for BALLON D'OR (French for 'ball of gold'). [More](#)

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In 2007, Golden Balls Ltd ("Golden Balls") filed two CTM applications for GOLDEN BALLS, one in Classes 9, 28 and 41, and another in Classes 16, 21 and 24, both of which Intra-Press SAS ("Intra-Press") opposed based on its earlier 2006 CTM registration for BALLON D'OR in Classes 9, 14, 16, 18, 25, 28, 38 and 41. Intra-Press based its opposition on Article 8(1)(b) of the Community Trade Mark Regulation, arguing that the marks at issue were highly similar and likely to cause confusion among consumers. They also relied on Article 8(5), arguing that consumers would be likely to confuse the respective marks due to factors such as the reputation of the earlier trademark.

OHIM rejected Intra-Press's oppositions on the ground that while some of the goods and services covered by the marks were identical and there was a slight conceptual similarity (the manner in which the relevant public understands the signs at issue), the marks were visually and phonetically distinct

and overall dissimilar, and thus concluded that there was no likelihood of confusion. OHIM also decided that since the marks were different, the reputation of the Intra-Pressé mark was not relevant.

Intra-Pressé appealed the decision, and the First Board of Appeal reversed in part, concluding that there was a likelihood of confusion between the marks with respect to the identical or highly similar goods and services, namely, Classes 16, 28 and 41, and certain goods in Class 9.

Golden Balls then appealed to the General Court with respect to likelihood of confusion in Classes 9, 16, 28 and 41, and Intra-Pressé appealed the decisions to the extent that they dismissed its oppositions with respect to certain goods in Class 9 and Classes 21 and 24. On appeal, the General Court found only weak conceptual similarity between the marks (requiring translation), which was insufficient to create a likelihood of confusion, and reversed the Board of Appeal's decisions, ruling in favor of Golden Balls.

Intra-Pressé appealed to the ECJ and the ECJ dismissed the appeal with respect to the identical or similar goods and services because there was no likelihood of confusion under Article 8(1)(b). However, it noted that the General Court had erred in its application of Article 8(5) regarding the reputation of Intra-Pressé's mark. The ECJ explained that the degree of similarity between marks required for confusion is lower under Article 8(5). Since the General Court found that there was a low degree of conceptual similarity between the two marks and did not consider the reputation of Intra-Pressé's mark, the General Court therefore "did not, in those judgments, rule out all possibility that the marks at issue were similar" and failed to carry out a full assessment of the oppositions. Although the General Court was found to be correct in deciding that the similarity between the marks was insufficient for the purposes of Article 8(1)(b), the ECJ held that the General Court should have assessed whether consumers would nevertheless make a link between the marks due to factors such as the reputation of the earlier mark under Article 8(5). Therefore, with respect to the different goods covered by the marks, the General Court should have considered and ruled on whether the mark BALLON D'OR had a reputation in the EU or a member state, and whether the low degree of similarity was nevertheless sufficient for the public to associate the marks based on such reputation. The ECJ thus set aside the General Court judgments and annulled the OHIM decisions to the extent that they dismissed Intra-Pressé's oppositions for the different goods covered by the marks.

OHIM will now need to reconsider whether the low similarity between the marks is sufficient for the public to establish a link between the two marks under Article 8(5). This case highlights the importance of relying on the reputation of a mark under Article 8(5) in CTM oppositions as it requires a lower threshold for similarity.

### **Primary Contacts**

Amanda B. Agati