

Lookalike trademarks under scrutiny of Romanian IP Office

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- SOIT held there was a similarity and likelihood of confusion between JACKPOT SALA DE JOCURI and MAXBET SALA DE JOCURI
- Division held that even though their main verbal elements were not identical, both signs shared a similar structure that would give a lookalike impression
- Decision has been appealed and is subject to further review

On 11 April 2023, the Opposition Division of the Romanian State Office for Inventions and Trademarks (SOIT) rendered a decision in a case concerning a trademark dispute between opponents MAX BET SRL and MAX BET JOCURI ELECTRONICE SRL and applicant NGG IMPEX SRL. Although the decision is now under appeal, it offers insight into the relevant practices of the SOIT Opposition Division.

Background

The dispute relates to a conflict between an application for the figurative trademark JACKPOT SALA DE JOCURI, designating services included in Nice Class 41 (in essence, entertainment in the form of gaming and gambling services) and several earlier trademarks registered by the opponents in Romania and the European Union for identical services in Class 41.

Applicant's mark	Opponents' registered mark
 The applicant's mark is a circular logo. It features a central red circle with white diagonal stripes. The word "JACKPOT" is written in large, bold, red letters with a yellow outline across the top. Below it, "SALA DE JOCURI" is written in smaller, white letters on a red banner. The entire logo is surrounded by a grey border with small white dots and several blue diamonds.	 The opponents' registered mark is a similar circular logo. It features a central red circle with white diagonal stripes. The word "MAXBET" is written in large, bold, red letters with a yellow outline across the top. Below it, "SALA DE JOCURI" is written in smaller, white letters on a red banner. The entire logo is surrounded by a grey border with small white dots and several yellow and red stars.

Among other things, the opposition argued the cumulative fulfilment of the conditions provided under Article 6(1)(b) of the Romanian Trademarks Law, claiming:

- similarity between the signs in conflict;
- similarity between the identity of services; and
- a likelihood of confusion on the part of the public.

This was corroborated by the reputation enjoyed in Romania by the earlier MAXBET trademarks and their increased distinctive character as a consequence of such use.

Additionally, the opponents claimed that the applicant's use and registration of the contested application would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademarks, arguing that the registration was pursued in bad faith.

Opposition decision

While the Opposition Division rejected the opponents' grounds regarding the unfair advantage of the reputation of the earlier trademarks and bad faith, it allowed the opposition based on the similarity of the signs and the likelihood of confusion.

In doing so, the SOIT retained the opponents' arguments on the importance of the overall similarity of the signs, despite the fact that their central verbal elements were not identical nor similar (MAXBET versus JACKPOT), an aspect overturned by the high degree of visual similarity between the elements composing the signs, leading to the existence of an overall similarity.

Concluding on this, among other arguments, the SOIT's examiners noted that the signs in conflict were visually similar as they both reproduced, in a similar manner, the same figurative elements. More specifically, it was considered that both signs shared the pattern of a circle that was crossed by oblique hashed lines and, in both cases, the outline of the circles was decorated either with little dots or little stars. Furthermore, both signs shared the same predominant colours: red and burgundy.

Conceptually, the signs were found to be similar, as they both shared a similar structure and their main verbal elements (ie, JACKPOT SALA DE JOCURI (in English "JACKPOT GAME ROOM") and MAXBET SALA DE JOCURI (in English "MAXBET GAME ROOM")) were equally suggestive for gaming activities.

In what pertains to the phonetic comparison of the signs, it was held that the signs in conflict were different.

Following the above analysis and the conclusion on the identity and similarity of the services in conflict, the Opposition Division stated that there was a risk of confusion between the contested application and the earlier trademarks invoked in the case and, consequently, granted the opposition, rejecting the application for all the services applied for protection.

Comment

The judgment offers insight into the relevant practices of the SOIT Opposition Division in confirming that overall similarity can be found even in cases in which the central verbal elements are not identical, but when the overall visual impression conveyed by the marks is sufficiently close as to give a similar, 'lookalike' impression to consumers, when such designate identical goods or services.

Appeal

The decision has since been contested by the applicant and was recently overturned by the SOIT's Appeals Committee. However, the motivation thereof has not yet been made available to the parties.

As the case is still pending, with the decision rendered by the Appeals Committee subject to further appeal before the Bucharest Tribunal for a term of 30 days, starting from the date of communication of the decision to the parties, this case should be monitored further to ascertain whether, in the event of an appeal, the tribunal will take a similar position to the one previously adopted by the SOIT's Opposition Division in this conflict between so-called 'lookalikes'.

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