

Court recognizes similarity in annulment case

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Pure Fishing, Inc., a US company, the owner of world-wide known fishing tackle brands, represented by *Andra Musatescu Law & Industrial Property Offices*, has just obtained a positive decision in an annulment action brought against a local company SC CHEN YANG 2000 SRL.

SPIDER vs. SPIDER YOYO

The facts of the case:

The Romanian company has registered with the Romanian Trademark Office a 'SPIDER YOYO'



SPIDER YOYO

for all the products in 'sport and fishing articles, fishing rods, fishing reels, fishing line, hooks and artificial baits Class 28.

Pure Fishing is the owner of the following trademarks:

- SPIDER 833738 word mark, an international trademark with Romania as a designating country, being registered for "fishing rods; fishing reels; fishing line; artificial baits for fishing; terminal fishing tackle; and fishing accessories, namely, fishing floats, bobbers, fishing hooks, hand-held fishing dip nets, hand-held fishing landing nets, hand-held bait capture nets, in ground and mounted fishing rod holders, fishing hook removers, fish stringers, fish strike indicators, and fishing tackle boxes" in Class 28;

- SPIDER 005142070 Community word trademark, being registered for "fishing rods; reels for fishing; gut for fishing; artificial baits for fishing; fishing tackle and fishing equipment; fishing accessories, namely floats, bobbers, fish hooks, weights for fishing in the form of balls and lead; portable fishing nets, portable landing nets, portable bait traps (nets), rod rests, fish hook removers, fish stringers, bite indicators, scales (weighing devices) for fish, fishing buoys and fishing cases" in Class 28

Pure Fishing considered that the registered SPIDER YOYO is similar as to create confusion among the consumers with its trademarks, its prior trademark rights are infringed by such registration and, therefore, decided to file an annulment action against the registration of the SPIDER YOYO trademark.

Arguments:

Pure Fishing's arguments in court were extensive, *including but not limited to*, similarity of the trademarks compared, the higher level of distinctiveness of the IR and CTM trademarks acquired through use, the beginning of the trademark being of a high importance, adding 'yoyo' not being of the nature to differentiate the trademarks, the identity of the products which the analyzed trademarks were registered, risk of confusion and association.

Findings of the court:

In judgment 1939/2012, the High Court of Bucharest decided that (1) the trademarks are similar as the principal element of the trademarks is 'spider', 'yoyo' and the figurative element (including the writing of the words) which represents the falling in the water of an object are not of the nature to differentiate; (2) the products are identical; (3) the risk of association is clear as there is the possibility that the consumers to consider that there is a link between the previous trademark and the contested mark.

Comments:

We consider the decision of the court as of high importance, not only for Pure Fishing as there is no risk that now their SPIDER trademarks to be diluted, but also as a precedent to be followed by the courts in similar cases.

The decision of the High Court of Bucharest is not yet final.

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Andra Musatescu Law & Industrial Property Offices acted for Pure Fishing in this case

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