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EUROPEAN UNION: KRISPY KREME DOUGHNUTS CTM Upheld

Contributors: Ingrida Karina-Berzina and Krisjanis Buss, Raidla Lejins & Norcoux, Riga, Latvia

Verifier: Ursula Stelzenmüller, Lichtenstein, Körner & Partners, Stuttgart, Germany

Ms. Karina-Berzina serves on the *INTA Bulletin* Law & Practice—Europe & Central Asia Subcommittee.

On October 7, 2015, the General Court of the European Union adopted a judgment in the long-running dispute among Panrico SA, the Office for Harmonization in the Internal Market (OHIM) and HDN Development Corp. The outcome is that the KRISPY KREME DOUGHNUTS figurative mark is registered as a Community trade mark (CTM). (*Panrico, SA v. OHIM—HDN Development Corp.*, Case T-534/13, GC, Oct. 7, 2015).



The case has a long history. In 1999, HDN, an American company, applied to register the figurative mark KRISPY KREME DOUGHNUTS as a CTM in Classes 30 and 42. The application was opposed by Panrico, the holder of earlier Spanish registrations for DOUGHNUTS [note: the standard English spelling would be “doughnut”] and DONUT in Class 30. In 2005, the OHIM Opposition Division dismissed the opposition on the basis of no likelihood of confusion. Similarly, the OHIM First Board of Appeal dismissed Panrico’s appeal. Panrico appealed to the General Court in 2006, but soon withdrew its appeal. The KRISPY KREME DOUGHNUTS mark was registered in 2007.

In January 2008, Panrico filed to invalidate the registration, relying not only on its two earlier verbal marks, DOUGHNUTS and DONUT, but also on the figurative mark DONUTS. The OHIM Cancellation Division rejected the invalidation, finding there was no likelihood of confusion and that the contested mark did not take unfair advantage of the earlier marks. Panrico appealed, but the OHIM Fourth Board of Appeal dismissed on the basis that the conflicted trade marks were visually dissimilar and the slight phonetic similarity between the signs could not create likelihood of confusion. Similarly, the Board of Appeal held that the signs at issue did not have a sufficient similarity for Article 8(5) of Regulation No. 40/94, concerning a mark with reputation, to apply.

Panrico appealed to the General Court, requesting annulment of the decision and invalidation of the HDN mark. In an earlier “doughnut” case, the Court of Justice of the European Union had found that BIMBO DOUGHNUTS was confusingly similar to Panrico’s earlier DOUGHNUTS mark (*Bimbo SA v. OHIM—Panrico SA*, Case C-591/12 P, 8 May 2014; reported in the *INTA Trademark Reporter*). Here, however, the General Court found that, when analyzed as a whole, the marks were dissimilar visually and conceptually, were only slightly similar phonetically and that the KRISPY KREME DOUGHNUTS mark did not take unfair advantage of the earlier marks, notwithstanding the reputation of these earlier marks. In reaching this conclusion, the court particularly took into account the additional elements KRISPY KREME at the beginning of the contested mark and that, where Class 30 products were concerned, the public would usually perceive the mark visually before making the purchase decision.

The General Court upheld the Board of Appeal’s decision and dismissed the appeal.

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