

Review

Intellectual Property

Meaning of Likelihood of Confusion

Case T-311/08 Fitoussi v OHIM (2 July 2009)

Paul Fitoussi, owned a French trade mark registration which comprised a white five-pointed star encompassed by a black circle for goods in class 25. Fitoussi opposed a CTM application, owned by Bernadette Loriot, comprising a black five-pointed star, bordered by white lines and in a grey circle with the words 'IBIZA REPUBLIC' placed horizontally across the front.

Fitoussi opposed on the ground that there was a likelihood of confusion between the marks. Three points formed the basis of Fitoussi's argument:

- i) that the earlier mark consisted of a representation of a five-pointed star surrounded by a circle and not only a star;
- ii) that the earlier mark was an intrinsically strong mark and not a mark with little distinctive character; and
- iii) that the graphic element of the earlier mark dominated the word element.

On this basis, Fitoussi also asked the CFI to overturn the OHIM decision which had been upheld by the Board of Appeal.

Since the earlier mark was registered in France, the CFI determined the likelihood of confusion from the point of view of the average, reasonably well-informed and circumspect French consumer.

The Court also made a number of references to existing case law interpreting a 'likelihood of confusion'. It noted that there would be a likelihood of confusion where the public thought that the products or services came from the same business or that the businesses were linked economically.

Comparison of the marks

The Court took the customary three-pronged approach to its comparison of the marks and focussed on the visual, phonetic and conceptual similarities of each in turn, considering, as the average consumer would, the marks as a whole.

The Court admitted that there was a low degree of similarity between the marks in that both incorporated a five-pointed star surrounded by a circle and distinguished between the visual impact of the marks.

The greatest protection is afforded to those marks which are highly distinctive and which incorporate a word or logo.

The Court highlighted several differences between the marks such as the fact that the applicant's mark incorporated the words IBIZA REPUBLIC. The size, legibility and positioning of the words seemed to be a defining factor in the decision because it reduced the contrast between the star and the circle. In particular, it noted that the word element was capitalised, easily readable, occupied a central position and covered about an eighth of the diameter of the circle.

In addition, the Court noted that the colours used in the marks were different and that grey hatchings had been used in the applicant's mark to reduce the contrast with the background image. As a result, the Court rejected point (iii) of Fitoussi's appeal; the star was not considered to be the dominant element of the applicant mark. The dominant element was in fact the word element, IBIZA REPUBLIC.

The Court also considered the phonetic and conceptual similarities between the marks. This was a simple assessment since the earlier mark could not be pronounced (since it did not contain a word element) and so the marks could not be said to be phonetically similar. Conceptually, the marks were also different since the applicant's mark invoked the idea of an imaginary Ibiza republic by virtue of the word element. This gave the earlier mark an additional and precise meaning, differentiating it from the earlier mark.

Global appreciation of likelihood of confusion

The Court referred to existing case law which stated that, despite a weak degree of similarity, there might still be a likelihood of confusion between the marks where the products and services covered were similar and the earlier mark was particularly distinctive. However, since Fitoussi had not provided any evidence that his mark had a particularly distinctive character and the word element clarified the origin of the goods bearing the later mark, the Court decided that the earlier mark had only a weak distinctive character, rejecting point (ii) of Fitoussi's appeal.

Conclusions

On the basis that there was a complete absence of phonetic or conceptual similarity and only a faint visual similarity between the marks, the Court held that the applicant's mark was neither identical nor sufficiently similar to breach Article 8(1)(b).

Further, the fact that the earlier mark was not particularly distinctive (indeed, the Court noted that national flags and hotels regularly used the symbol of a star) and the word element was the dominant element of the later mark meant that there could be no likelihood of confusion on the part of the consumer, even where the products were in the same class. The appeal was rejected.

This decision serves as a useful reminder (and perhaps also a warning) to trade mark owners in the EU that the greatest protection is afforded to those with marks which are highly distinctive and particularly to those which incorporate a word element in addition to a logo element.

FURTHER INFORMATION

For further information please contact:

Chris McLeod
Hammonds LLP
T: +44 (0)207 655 1590
E: chris.mcleod@hammonds.com

Ellen Forrest-Charde
Hammonds LLP
T: +44 (0)207 655 1290
E: ellen.forrest-charde@hammonds.com

WWW.HAMMONDS.COM

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