

The General Court has partially overturned a decision of OHIM's Fourth Board of Appeal (BoA) concerning a CTM application for the figurative mark below, filed in respect of "alcoholic beverages (except beers)" in Class 33 in the name of the Fédération Française de Rugby (FFR).



The Consorzio vino Chianti Classico (CCC) opposed this application on the grounds that under Art 8(1)(b) CTMR there would be a risk of consumer confusion between the marks, and under Art 8(5) CTMR there was a risk that registration of this mark would take unfair advantage of or be detrimental to the distinctive character and/or repute, of CCC's earlier collective trade mark registrations, covering "wine" or "chianti wine" in Class 33. The earlier rights that CCC relied upon are as follows:

- Italian collective trade mark registrations:



- UK collective trade mark registration:



- the following mark, alleged to be well-known trade mark in Germany and France:



Whilst OHIM's Opposition Division upheld CCC's opposition under Art 8(1)(b) CTMR, the BoA overturned this decision on the grounds that FFR's mark applied for was "sufficiently distant" from CCC's earlier rights for there not to be a risk of consumer confusion. In addition, the opposition was rejected in so far as it was based on Art 8(5) CTMR.

CCC appealed against this decision to the General Court, arguing that FFR's application should be rejected in respect of "wines" in Class 33. The appeal was based on two grounds:

### 1. Misapplication of Art 8(1)(b) CTMR

The General Court found that the BoA had erred when considering the likelihood of confusion between the marks from the viewpoint of only UK and Italian consumers, as the opposition was also based upon an earlier well known mark in France and Germany. OHIM explained that it had considered only this viewpoint for the sake of procedural economy, as it had only considered the opposition in relation to Italian collective TM Registration No. 856049, being the closest to FFR's mark. The General Court found that when assessing the likelihood of confusion between the marks, the BoA ought to have taken the relevant public to include the average consumers of the goods in all territories covered by the earlier rights in question, including France and Germany.

The General Court also considered CCC's argument that the marks were highly similar, in that they both contained images of roosters. The BoA had stated that the marks were "sufficiently distant" for there not to be a likelihood of consumer confusion between the marks. However, in its judgement, the BoA had also alluded to there being some similarity between the marks. The General Court found that, whilst both marks contained images of roosters, they exhibited a low degree of similarity, having given consideration to the visual, conceptual and aural similarity between the marks.

The General Court emphasised the importance of the other visual elements within both marks, besides the rooster images, such as the words, shapes and colours, which made them less similar. In particular, the General Court emphasised the importance of the word elements within each of the marks, and the higher attention that the average consumers of wine would pay to these elements.

The General Court found that the marks were not conceptually similar. First, the mark applied for was interpreted as being in the form of an armorial emblem associated with the nobility or guilds. In contrast, the earlier rights were considered as being more akin to a seal indicating particular sovereign authority or certification of quality or origin. Second, linguistically the marks were found to be conceptually neutral, or dissimilar in the case of a consumer who had an understanding of French and Italian, as the meanings of the words within the respective marks were different. Third, the General Court found that CCC's argument that both marks, by using the image of a Rooster, conveyed a concept of "pride" was not sufficiently immediate for consumers to identify conceptual similarity between the marks.

The marks were found to be aurally dissimilar.

Having found that the marks exhibited a low degree of similarity to each other, the General Court assessed whether this was enough for there to be a likelihood of confusion between the marks. Whilst it was accepted that CCC's earlier marks did have an enhanced earlier distinctive character, in that the single figure of a "black rooster" was associated with Chianti Classico wines, and that the contested goods in question were identical to those covered by FFR's trade mark application, this was not enough to compensate for the low degree of similarity between the marks. It was found that the similarity between the marks was not sufficient to give rise to a likelihood of confusion.

## 2. Misapplication of Art 8(5) CTMR

Having deemed the marks not similar enough to give rise to a likelihood of confusion, the BoA rejected the opposition on the basis of Art 8(5) CTMR, on the grounds that the initial requirement that marks must be similar had not been satisfied. However, within its decision, the BoA had indicated that there was a low degree of similarity between the marks. The General Court found that even a low degree of similarity between marks would be enough to satisfy the initial requirement of similarity under Art 8(5) CTMR and this ground should have been considered by the BoA. The General Court found that the BoA's decision should be annulled in so far as it rejected this as a ground of opposition.

Unfortunately, as the BoA had not substantively considered this ground, the General Court was unable to make any further assessment, other than to order that OHIM's decision to reject this ground of opposition was annulled.

This decision clearly emphasises the requirement to fully assess the overall nature of similarity between two marks, and not merely take into account their dominant and distinctive elements. In addition, it is clear that similarity between marks is the key factor in assessing likelihood of confusion. Even where the goods or services in question are identical and the earlier marks have an enhanced distinctive character, this is not necessarily enough to demonstrate that there is a likelihood that the average consumer of the goods would believe the products or services to which they were applied originated from an economically-linked undertaking.

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