

Summary

The General Court has upheld an OHIM Board of Appeal decision confirming that there was a likelihood of confusion between a figurative Community trade mark application incorporating the word “Snickers” and an earlier Italian registration of KICKERS, both for goods in class 25, mainly clothing, footwear and headgear.

Background

In March 2004, Hultafors Group AB (HG) filed a Community trade mark application for the following mark in classes 8, 9 and 25:



In April 2005 Società Italiana Calzature SpA (SIC) opposed the application under Article 8(1)(b) and (5) of Regulation No 207/2009. The opposition was based on an Italian registration of KICKERS, which covered ‘clothing items, shoes, headgear’ in Class 25. In October 2010 the Opposition Division upheld the opposition for all of the contested goods.

HG appealed against the decision but the Fourth Board of Appeal dismissed the appeal. It found that as the earlier mark was an Italian registration, the relevant territory was Italy, and that the average consumer concerned was a member of the public at large with a normal level of attentiveness. It also found that the goods were identical and the marks were similar overall, therefore confusion was likely. As such, arguments relating to the enhanced distinctiveness of the earlier mark and based on Article 8(5) were not examined.

HG appealed to the General Court alleging infringement of Article 8(1)(b) of Regulation No 207/2009. The Court first considered the relevant public. HG argued that, as consumers paid particular attention both to the mark and to the goods, they would be able to remember every minor difference between two similar marks for identical products. As a result, HG claimed that the relevant consumers had a higher level of attention. The Court took the view that even if part of the relevant public showed a higher level of attention when buying the goods, HG did not demonstrate that this applied to all of the relevant public or that the part of the relevant public whose level of attention is normal was insignificant. Therefore, the Court found that only the public with the lowest attention level must be considered.

There was no dispute in relation to the goods at issue, as both parties agreed that they were identical.

Regarding comparison of the marks, HG claimed that the marks were visually and phonetically dissimilar. It claimed that the suffix ‘ickers’ was common in the English language, that the consumer’s attention was directed more towards the beginning of the words rather than their end, and that the figurative mark was visually distinctive. HG also argued that the intonation and stress of the earlier mark differed from that of its mark, the latter being pronounced with a distinctly voiced ‘s’ and clear stress on the initial letter of the first syllable. Furthermore, HG claimed that the verb ‘to kick’ was a common term, and that the average Italian consumer would be aware of the term ‘kicker’ and its plural form ‘kickers’, or would be able to deduce instantly the conceptual meaning. Finally, it claimed the mark applied for was highly distinctive and overall that the marks were dissimilar.

The Court disagreed, citing Case T 312/03 *Wassen International v OHIM – Stroschein Gesundkost (SELENIUM-ACE)* [2005] ECR II 2897, paragraph 37. It stated that when a mark is composed of word elements and figurative elements, the former should, as a rule, be considered more distinctive than the latter, since the average consumer will more easily refer to the goods in question by citing the word elements than by describing the figurative element of the mark.

In addition, the Court did not share HG’s opinion regarding the comparison of the marks, but instead agreed with the Board of Appeal that the word element ‘Snickers’ was the dominant element of the mark applied for and that the figurative element had a low degree of distinctiveness and would be perceived as decorative.

The Court noted that the marks KICKERS and Snickers contained seven and eight letters respectively, had the same number of syllables and that their last six letters were identical. Overall the word elements of the marks had several common characteristics and were differentiated only by their initial letters, ‘k’ and ‘sn’ respectively. As a result, the Court agreed with the Board of Appeal, that there was an average degree of visual similarity between the marks.

The Court also found that HG’s argument that the attention of the consumer is drawn more towards the beginning of the words than their end did not apply in this case. This was because the average consumer would consider not just the first letter of a mark, but at least the first syllable and, as the following letter was ‘i’ in both marks, the first syllables were similar. The second syllables were identical. Taking into account the overall impression of the marks, the Court held that there was an average degree of visual similarity. The Court reiterated the Board of Appeal’s view that the marks were phonetically similar and that the consonants ‘k’ and ‘sn’ were insignificant in the overall pronunciation.

Regarding the conceptual comparison of the marks, OHIM argued that although many consumers had a sufficiently good knowledge of English, the suffix ‘ickers’ did not exist in Italian and hence would be unfamiliar to the majority of relevant consumers. OHIM also pointed out that in Italian the words ‘snickers’ and ‘kickers’ are pronounced with two syllables and that in both cases, the stress falls on the first syllable.

Both parties agreed that the term 'Snickers' was unknown by the relevant public and therefore had no conceptual meaning.

Regarding 'KICKERS' HG claimed, but did not prove, that the relevant Italian consumers understood the meaning of the word 'kickers', the plural form of 'kicker', meaning 'someone who kicks something'. However, the Court found that this English term was uncommon and that although a section of the relevant public may understand it, others would not. Although HG claimed that SIC's website stated that the relevant consumers had an adequate command of English to understand the meaning of the term 'kickers'. The Court found that this was insufficient to establish that all of the relevant Italian public understood the meaning of the term 'kickers'. Overall, the Court found that, for the limited part of the relevant public which understood the word 'kickers', it was inconsequential, as the marks at issue were not conceptually similar. With respect to the remaining public the conceptual comparison was not possible as the words were meaningless to them. The Board of Appeal had held that the marks at issue did not have any meaning for the Italian consumers concerned, with which the Court agreed.

The Court concluded that as the marks had an average degree of similarity both visually and phonetically and the goods were identical, the Board of Appeal was correct to find that there was a likelihood of confusion between the marks.

Furthermore, HG's argument concerning the highly distinctive character of the 'Snickers' mark was dismissed by the Court, as it is only the distinctiveness of the earlier mark which is considered in the assessment of the likelihood of confusion.

HG's single plea of infringement of Article 8(1)(b) of Regulation No 207/2009 was rejected and its second claim, seeking annulment of the decision of the Opposition Division, was also dismissed.

Comment

This case reiterates the fact that figurative marks may not be deemed dissimilar to earlier word marks which are visually and phonetically similar, unless the figurative element of the later mark is substantial and distinctive in its own right.

**Triona Desmond and Chris McLeod, Squire Sanders (UK) LLP,
London**

This article first appeared on WTR Daily, part of World Trademark Review, in May 2013. For further information, please go to www.worldtrademarkreview.com

Contacts

Chris McLeod

Director of Trade Marks
T +44 20 7655 1590
E chris.mcleod@squiresanders.com

Triona Desmond

Trade Mark Attorney
T +44 20 7655 1326
E triona.desmond@squiresanders.com

The contents of this update are not intended to serve as legal advice related to individual situations or as legal opinions concerning such situations nor should they be considered a substitute for taking legal advice.

© Squire Sanders.