

The General Court (GC) has confirmed a decision of OHIM's First Board of Appeal (BoA), partially invalidating David Mayer Naman's (DMN) CTM registration for

David Mayer

covering leather and imitations of leather, products made from these materials not included in other classes; animal skins; trunks; suitcases; umbrellas; canes; whips and saddlery in Class 18 and clothing, footwear and headgear in class 25.

The CTM was registered in April 2001, and in October 2007 the intervener filed an application for a declaration of invalidity in respect of the goods covered in classes 18 and 25.

The intervener's application for a declaration of invalidity was based on its earlier Italian trade mark registration for DANIEL & MAYER MADE IN ITALY, covering "under garments and garments in mesh, ready to wear clothing for men, women and children, haberdashery", on the grounds of Article 53(1)(a) CTMR, in conjunction with Article 8(1)(b) CTMR and Article 53(1)(c) CTMR in conjunction with Article 8(4) CTMR. OHIM's Cancellation Division declared that the CTM was invalid under Art 52(1)(a) CTMR in respect of leather and imitations of leather not included in other classes in class 18 and clothing, footwear and headgear in class 25. This decision was confirmed by OHIM's First Board of Appeal (BoA).

The BoA rejected DMN's request, which was made for the first time before the BoA, that the intervener provide proof of use of its earlier marks. The BoA concluded that the marks were visually, aurally and conceptually similar, giving a similar overall impression to the relevant public, the average purchaser of clothing in Italy, and that the products in question, in classes 18 and 25, were also similar. In light of this, there was a risk of confusion between the marks. The BoA rejected the arguments that the contested mark had a reputation, that the marks were positioned in different commercial markets, and that they had been peacefully co-existing.

In particular, this case reinforces the importance of making requests within the relevant deadlines set by OHIM.

DMN unsuccessfully appealed against the decision of the BoA to the General Court on the following grounds:

1) Violation of Article 54(2) CTMR – the intervener had acquiesced to the use and registration of DMN's mark for over five years and therefore could not invalidate DMN's registration

As the first time that DMN had raised this ground was before the GC, it was deemed inadmissible, as accepting the ground would enlarge the dispute beyond the remit of the GC. The role of the GC is to assess the validity of the decisions of the BoA, and not law or facts that have not already been raised. Therefore, this ground was rejected by the GC.

2) Violation of Art 57(2) and (3) CTMR – by not allowing DMN's request that the intervener demonstrate real and effective use of its earlier trade mark

DMN had requested that the intervener present proof of use of its earlier mark before the BoA, this was deemed too late to be accepted.

A request that a party provides proof of use of a mark must be made within the specific deadlines set by OHIM. If a request is not made within these deadlines, the mark in question is presumed to have been put to proper use. As the request had not been made at the right time, the BoA was correct to reject a request that the intervener provide proof of use of its earlier mark.

3) Violation of Art 8 (1)(b) that the marks in question and the designated goods were not similar enough for there to be a likelihood of confusion and that DMN's registration was valid

The GC followed the standard application of an assessment of consumer confusion. When carrying this out, the following considerations were discussed:

a) The Relevant Public

The GC confirmed the view of the BoA that the assessment of confusion must be made from the perspective of the average Italian consumer.

b) The Comparison of the Goods

First, DMN argued that the BoA had only provided brief reasons to support its assessment of similarity and identity between the goods in question. Whilst case law states that there is an obligation to provide clear reasons for a decision, in the context of these proceedings, whereby the BoA was merely endorsing the decision of OHIM's Cancellation Division, no further analysis was necessary.

Second, DMN alleged that when comparing the products covered by the marks in class 25, account must be made of the fact that the goods covered by the earlier mark were aimed at female consumers, whilst those covered by the contested mark were aimed at male consumers. The GC confirmed the view of the BoA that the comparison of the products must be made in light of the goods covered by the marks, and not those for which the mark has effectively been used, given that an assessment of actual use was not relevant to this case. The GC confirmed that the products covered by the contested mark included those covered by the earlier mark, and, following case law, these products would be considered identical.

Third, the GC maintained the view of the BoA that *products in leather and imitations of leather* were similar to *clothing, footwear and headgear* in class 25. In particular, the court indicated that these goods would be sold at the same point of sale, they all contribute to an outward appearance, and are often worn to complement each other.

Clearly, certain consumers would perceive a link between these particular goods in classes 18 and 25 and believe that they originated from the same economic undertaking.

The GC confirmed that the goods in question were identical or similar.

c) Comparison of the Signs

The GC confirmed the view of the BoA that the marks were similar. It considered the following in particular:

• The Reputation of the Surname **MAYER** in Italy

DMN alleged that the surname **MAYER** was commonly used in Italy, and that this should have been taken into consideration when the BoA made its global appreciation of the risk of consumer confusion. DMN presented eight trade marks registered in Italy, containing “Mayer”. This was found insufficient, as the pertinent factor was the actual existence of the surname Mayer in the Italian fashion industry. However, only one mark relating to fashion was included. The internet extracts that DMN presented were not sufficient to demonstrate that the name Mayer was of low distinctiveness.

The GC confirmed the BoA’s assessment that the intrinsically distinctive characteristic of Mayer should be taken into account when making a global appreciation of consumer confusion.

• Visual Comparison

The second verbal element of both marks, **MAYER**, is identical. This was deemed even more notable given the varieties in which the name could be spelt. The first words within the signs **David** and **Daniel** both start with “**DA**”. The differences between the marks were found insufficient to render the marks visually dissimilar. The marks were found similar, in particular due to the inclusion of **MAYER**, being a distinctive and unusual surname in Italy. The GC confirmed that the marks were visually similar.

• Phonetic Comparison

The GC found that the marks were composed of two words both consisting of two syllables; the second, identical, word was the distinctive and dominant element of both marks. In addition, the first element of the two words was deemed to be pronounced in a relatively similar manner, the “**DA**” syllable being accentuated in Italian. The inclusion of “made in Italy” and “e” was insufficient to reduce the similarity between the marks, this phrase being of low distinctiveness.

• Conceptual Comparison

DMN argued that the BoA had not accounted for the conceptual differences between the marks; the earlier mark designating two people associated with the sale of products made in Italy, and the contested registration denoting one physical person. The GC rejected this argument.

The GC emphasised the importance of the “Mayer” element within the marks, being a recognisable surname, with Jewish origins. Given that the marks both consist of a first name

followed by a surname, the simple presence of “made in Italy” was deemed insufficient to exclude conceptual similarity, given that the term “made in Italy” is conceptually descriptive and negligible.

• Global Appreciation of a Risk of Confusion

The GC confirmed that in light of the similarity of the marks and the designated goods, there was a risk of consumer confusion between the marks, even in light of the arguments advanced by DMN:

- The contested mark had enjoyed a significant reputation in respect of male clothing for decades. This was dismissed, the General Court emphasising that only the reputation of the earlier mark at issue could be taken into account.
- The products designated by each of the marks were sold from separate retail outlets, between which the average consumer would not be confused. However, the existence of a risk of confusion between the marks should only be viewed from the perspective of notional and fair use, where no actual use has been taken into account.
- The marks in conflict co-existed peacefully. Given that the parties were engaged in additional litigation in Italy concerning the marks, this was not a valid argument.
- As the marks both contained surnames, which were commonly used in fashion, the average consumer would not confuse the two marks. Whilst this argument may be more acceptable for common surnames, given the distinctive nature of Mayer, the risk of confusion was elevated.
- As Mayer is a foreign surname, the risk of confusion would be reduced, as the average consumer would be more attentive to a foreign name than one in its native language. The GC found that the converse would be true, as the average consumer would be more easily confused between unfamiliar foreign names.

In light of the above, the GC confirmed that there was a likelihood of confusion between the marks, and that the contested CTM registration was invalid.

This case confirms the importance of submitting full arguments and requests at the correctly allotted times. Clearly, the fact that the intervener was not obliged to submit proof of use of its earlier mark significantly disadvantaged DMN’s case, and meant that certain issues could not be considered. In addition, a defence of acquiescence, if submitted at the correct time, could have been another consideration that may have meant that proceedings went more favourably for DMN. Following procedural timetables is clearly important.

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