

It takes two

Rebecca O’Kelly reviews a case that highlights the interdependence of similarity of goods and similarity of marks

Schuhhaus Dielmann GmbH & Co KG (“Schuhhaus”) appealed against the Board of Appeal of OHIM’s decision to partially uphold an opposition to its application for the word mark CARRERA PANAMERICANA on the basis that the Board of Appeal had failed to give reasons for its finding and that it erred in finding a likelihood of confusion between Schuhhaus’ application and an earlier mark, shown below right.

The General Court rejected the argument that the Board of Appeal had failed to give reasoning, stating reasoning is sufficient as long as it states (T-304/06, Reber v OHIM – Chocoladefabriken Lindt & Sprüngli (Mozart) [2008] ECR II 1927, paragraph 46):

- the grounds for refusing the mark;
- the corresponding legislative provision; and
- the facts that were proved which justified the finding.

The General Court found each of those elements had been provided by the Board of Appeal.

Schuhhaus also alleged infringement of Article 8(1)(b) of Regulation 40/94 (now Article 8(1)(b) of Council Regulation (EC) 207/2009) in finding a likelihood of confusion between the earlier mark and the application.

The General Court also considered how likelihood of confusion should be assessed, finding it must be assessed globally considering the perception the relevant public has of the signs and of the goods (T-162/01, Laboratorios RTB v OHIM), including the interdependence of any similarities (C-39/97, Canon).

The General Court confirmed that the earlier mark and the application had to be compared based on the

overall impression given by each, including having regard to any distinctive and dominant components. Therefore, while marks were to be looked at as a whole, the average consumer might still perceive a component of one of the marks to be dominant (C-334/05, OHIM v Shaker). The General Court upheld the Board of Appeal’s finding that the word “Carrera” was the dominant part of the earlier mark as the background highlighted that word and it was how the average consumer would refer to the mark. Given that “Carrera” was also the first word of the mark applied for, it could also catch the public’s eye first (T-183/02 and T-184/02, El Corte Ingles v OHIM). Therefore, despite the second word in the application, the Board of Appeal was correct in finding a degree of visual and aural similarity between the marks. In addition, Spanish-speaking consumers would find the two conceptually similar.

The General Court found inadmissible new evidence that Schuhhaus produced regarding a classic car race in Mexico called the Carrera Panamericana because it was not produced at the Board of Appeal.

The Applicant did not dispute that the Board of Appeal was correct to determine that certain of the goods were found to be identical and others were found to be similar.

Having regard to the similarity/identicalness of the goods, the marks were found to be sufficiently similar to warrant the partial refusal of the application

Therefore, having regard to the similarity/identicalness of the goods, the marks were found to be sufficiently similar to warrant the partial refusal of the application.

This case highlights that, even where a figurative mark is being compared to a word mark that includes additional words, the two can still be sufficiently similar to cause a likelihood of confusion, particularly where the goods to which they relate are very similar or identical. This emphasises the need to consider the interdependence of similarity of goods and similarity of marks.



Rebecca O’Kelly
is an Associate at Bird & Bird LLP
rebecca.okelly@twobirds.com

