GNETWORK infringes Google marks: court finds bad faith

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Greece - Dr. Helen G. Papaconstantinou and Partners Law Firm
Mr G Koutsoumpidis, a Greek citizen, applied for and obtained registration at national level for the following trademark, covering goods and services in Classes 9, 35, 38, 41 and 42.

US company Google Inc filed a cancellation petition against the trademark before the Administrative Trademark Committee, on the basis of its Greek word trademark registration GOOGLE 147.997, covering goods and services in Classes 9, 38 and 42. Additionally, Google based its petition on its EU trademark registrations GOOGLE 000881006 and GMAIL 005685136, both with colour devices covering goods and services in the same classes. Finally, it invoked its series of international trademarks for GOOGLE.
In its petition Google argued the following:

- The trademark GNETWORK and colour device was similar to its earlier trademarks GOOGLE and GMAIL, because:
    - the first letter 'g' was the letter appearing in the middle of its own earlier EU mark;
    - the letter 'g' was blue in colour; and
    - the same font as well as the same colour order were used (blue, red, yellow, blue, green, red, yellow, blue), making a direct reference to the GOOGLE marks.
- The use of the word 'Network', which is common in the field of internet activities, does not add distinctive character to the mark, while it gives the impression that GNETWORK is a simple variation of its famous mark GOOGLE. Thus, it creates a risk of confusion as to the origin of the covered goods and services, which are identical and target the same group of consumers.
- The GOOGLE marks are famous and enjoy a higher level of establishment and recognition in transactions.
- The owner of the contested mark's effort to copy Google's earlier marks contravenes good faith and has the purpose of taking unfair advantage of its renown and reputation.

The Trademark Committee rejected the cancellation petition, finding no oral or visual similarity between the earlier GOOGLE and GMAIL marks and the contested trademark GNETWORK. In addition, the committee stressed that:

- the alleged reputation accompanies only the indication Google, known only as such and not as Gmail, whereas Google cannot monopolise the use of the letter 'g';
- the company can deprive its competitors neither of the use of the letter 'g' nor of the use and order of the particular colours of the Google letters; and
- everyday users of Google are not likely to remember the exact order of the colours of the Google letters.

Google appealed the decision before the Athens Administrative Court of First Instance, mainly arguing that the committee did not recognise the prime importance of the colour order in the

marks under comparison, arguing that:

- a specific colour order is an important characteristic of a trademark and gives it distinctive character; and
- this particular colour order has been protected since 2006 on the basis of EU Trademark 00881006 and has also been established in practice as a widely recognisable characteristic feature of its marks.

Further, Google complained that the Trademark Committee did not take into account the notoriety of its marks, on the basis of which it should enjoy additional protection against the registration of similar marks aiming to take advantage of its reputation. In support of this argument, Google stressed that the applicant had been systematically imitating its marks, by pursuing the registration of the mark ADWARDS NETWORKS which was similar to its prior EU mark ADWORDS and by trying to register the domain name 'googlenet.gr', which the applicant eventually withdrew.

Upon deciding the case, the court recognised that:

- Google was internationally renowned in the field of internet services and was the most popular search engine both at international and national level for more than 15 years;
- Google owned the Greek and European trademarks GOOGLE and GMAIL with the already mentioned colour order, which was also protected with an EU trademark;
- GOOGLE and GMAIL enjoyed international notoriety and had acquired a particularly good reputation among internet users, who are both numerous and diverse, due to the extensive use of its search engine and to the increased influence the Internet exercises on them; and
- GOOGLE and GMAIL – with the particular colour order of blue, red, yellow, blue, green, red – enjoy an additional degree of protection due to their notoriety.

The court further held that:

- There may not be a particular oral or visual resemblance between GNETWORK and Google's earlier marks, however, there is a certain similarity due to the use of the letter 'g' as well as of the same fonts and the same colour order.
- The visual impression that a certain colour order creates on the average consumer is critical and characteristic, irrespective of whether the consumer is capable of recalling it with exactness at any moment – the more so that this is anchored to his consciousness upon using Google's services through a computer screen where the colours are of particular importance.
- Even if not identical, there was a similarity between the covered goods and services. In particular, considering the large number of consumers of internet services and the strong distinctive character of the earlier trademarks, the court considered that there was a serious risk of association on part of the consumers, who are likely to associate the marks under comparison, even if they actually do not.

The court therefore held that GNETWORK was filed in bad faith – also taking into account that the applicant had filed another trademark and had been using a domain name showing awareness both of the renown of Google's earlier marks and of the use at international level – but intended to take advantage of Google's notoriety, thereby running the risk of weakening its distinctive power.

Consequently, the court reversed the decision of the Administrative Trademark Committee, accepted the recourse and ordered the cancellation of GNETWORK from the register (Decision 19616/2015).

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