World Trademark Review

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General Court confirms lack of likelihood of confusion between DECATHLON and ATHLON

European Union - Dr Helen G Papaconstantinou and Partners Law Firm

- **Decathlon opposed the registration of the mark ATHLON in Classes 25 and 28 based on the earlier mark DECATHLON in the same classes**
- **The court found that the visual differences arising from the figurative elements in the ATHLON mark counteracted the phonetic and conceptual similarity**
- **As the goods at issue are in a sector where visual perception generally takes place before purchase, the visual aspect was of greater importance in this case**

In opposition proceedings involving Decathlon and Athlon Custom Sportswear PB (Case T-349/19, 15 October 2020), the Sixth Chamber of the General Court has confirmed that there was no likelihood of confusion between the word mark DECATHLON and the figurative sign ATHLON. The conflicting signs are represented below:

Earlier trademark	Contested trademark
DECATHLON	athlon custom sportswear

Background

In 2016 Greek company Athlon applied to the European Union Intellectual Property Office (EUIPO) for the registration of the figurative sign ATHLON, to cover goods in Classes 25 and 28. French company Decathlon filed an opposition, claiming infringement of Article 8(1)(b) of Regulation 2017/1001. The opposition was based on the company's earlier EU word mark DECATHLON (Registration No 262931), which covered, among others, goods in Classes 25 and 28. The Opposition Division accepted the opposition.

The Greek company appealed this decision and subsequently withdrew its application as far as goods in Class 28 were concerned. It also limited the description of the goods in Class 25 to "athletic clothes and hats".

In essence, the Second Board of Appeal of the EUIPO found that, while the goods at issue were identical, there was a low degree of visual similarity and an average degree of phonetical similarity between the two marks; there was also a certain conceptual similarity, but only as regards the part of the public that would understand the relevant word elements of the signs. Finally, the Board of Appeal was not convinced that the earlier mark had acquired an enhanced distinctive character for the relevant goods. It therefore concluded that there was no likelihood of confusion between the mark applied for and the earlier mark and reversed the decision of the Opposition Division, thus rejecting the opposition.

Decathlon brought the case before the General Court.

General Court decision

The General Court confirmed the finding of the Board of Appeal that the figurative element of the contested mark, along with its stylised word element, played a greater role from a visual point of view in the overall impression given by the mark. Although the two marks had the word element 'athlon' in common, the additional letters of the earlier mark, as well as the figurative elements of the contested mark, were sufficient to visually differentiate the marks. The court also confirmed the phonetic difference between the marks, created by the sound of the letters 'D', 'E' and 'C' of the earlier mark.

Turning to the conceptual comparison of the marks, the General Court agreed with the Board of Appeal that, for the part of the public (including the English-speaking public) who would understand the word 'decathlon' as meaning 'a competition in which athletes compete in 10 different sporting events', and the word 'athlon' as meaning 'a contest' (in Greek), the marks did have a certain degree of conceptual similarity.

However, the court pointed out that the word ‘athlon’, from which this similarity originated, had a weak distinctive character for that part of the public and would not be perceived as an indication of commercial origin. According to the court, Decathlon had failed to prove the enhanced distinctiveness of its mark, showing merely that the mark was associated with its retail services, but not with the particular goods that it sold. On the contrary, Decathlon had showed that it sold several goods, especially clothes, under other brands, but did not demonstrate any link between DECATHLON and the marketed goods.

Based on established case law, the General Court stressed that, in the case of trademarks which have a weakly distinctive element in common, the impact of such similarity on the global assessment of the likelihood of confusion is low. The court thus concluded that the visual differences arising from the stylisation of the word ‘athlon’ and the lemniscate figure in the contested mark dominated the overall impression of the marks and counteracted the phonetic and conceptual similarity that existed for part of the public. With that in mind, along with the argument that the specific goods at issue (ie, athletic clothes and hats) are in a sector where visual perception generally takes place before purchase, the court came to the conclusion that, in this case, the visual aspect was of greater importance in the global assessment of the likelihood of confusion.

Consequently, the General Court dismissed the action, rejected the opposition and allowed the contested mark to proceed to registration.

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TAGS

Enforcement and Litigation, **Portfolio Management**, **Fashion & Luxury**, **Europe**, **European Union**