

European Union - Dr Helen G Papaconstantinou, John V Filias & Associates

In *Tifosi Optics Inc v Office for Harmonisation in the Internal Market* (OHIM) (Case T-531/12, October 7 2014), the General Court has upheld a decision of the Second Board of Appeal of OHIM in which the latter had found that there was a likelihood of confusion between the two figurative signs depicted below:



Mark applied for



Earlier mark

On September 11 2009 Tifosi Optics Inc filed a Community trademark application for the figurative sign T to cover “optical apparatus and instruments, spectacles, sunglasses frames, cases, hinges, arms and lenses for spectacles and sunglasses, parts and fittings therefor, visors, binoculars, ski masks, protective helmets and goggles, parts and fittings therefor, contact lenses and containers therefor” in Class 9 and “clothing, footwear, headgear” in Class 25 of the Nice Classification.

Tom Tailor GmbH opposed the application on the basis of, among other things, its earlier figurative Community trademark T (No 1 368 232), covering, among other goods, “optical apparatus and instruments, eyewear, eyeglasses, sunglasses, lenses, eyeglass cases and sunglass cases, parts and fittings for all the aforesaid goods” in Class 9 and “men’s and women’s clothing, t-shirts, shirts, jeans, pants, shorts, leather pants, chaps, sweaters, jackets, vests, skirts, dresses and footwear and articles of outer clothing” in Class 25.

The Opposition Division of OHIM rejected the opposition. This decision was reversed by the Second Board of Appeal of OHIM, which held that there was likelihood of confusion between the marks because:

- the goods covered by the marks were either similar or identical; and
- the marks were visually similar, and aurally and conceptually identical.

Tifosi filed an action against the decision of the Board of Appeal.

The General Court first looked at the similarity of the goods covered by the marks and found that many of the goods were identical, while the rest were similar. In its assessment, the General Court formed a different opinion to that of the Board of Appeal by finding that “protective... goggles” were not identical to the “optical apparatus and instruments” covered by the earlier mark. The court pointed out on the one hand that the latter category refers to goods which are far more technically complex than spectacles, such as microscopes, telescopes or cameras and, on the other hand, that “protective... goggles”, apart from protecting eyes from physical impact or from contact with harmful substances, also protect against intense sunlight. Accordingly, they were similar to “sunglasses”.

Moreover, the General Court observed that “visors, ... ski masks, protective helmets..., parts and fittings therefor” are similar to “articles of outerclothing”, despite the fact that they belong to different classes (Classes 9 and 25, respectively). In this respect, the court stressed that the classification of goods and services under the Nice Classification is intended to serve exclusively administrative purposes, the crucial criterion being whether, from the relevant public’s perspective, the goods in question may have a common commercial origin. In this case, according to the General Court, these two categories of goods were closely connected because of their producers, points of sale and purpose.

Turning to the comparison of the signs, the General Court found that the two signs in question were similar.

With regard to the visual similarity of the signs, the court agreed with the Board of Appeal that their overall impression was determined by the letter 'T' and the oval surrounding it, without one or the other element dominating the other. The court also mentioned that other differences between the signs, such as the way colour was applied or the length of the oval, were minor differences that could not outweigh the prevalent similarities. The court further pointed out that what would be remembered by consumers in this case would be the capital letter 'T' surrounded by an oval, to the detriment of the graphic stylisation. It stressed that the key issue is how the signs are perceived overall and not how the stylistic differences between the signs may be perceived by a particularly careful consumer who is in a position to examine and compare them.

With regard to aural similarity, the General Court agreed with the Board of Appeal that the marks would both be pronounced as 'T', and rejected the applicant's argument that consumers would inevitably make a connection between the signs and the names of the companies owning them. The court stressed that the names of the respective companies did not form part of the marks at issue.

With regard to conceptual similarity, the General Court concluded that the Board of Appeal had erred in finding that the marks were conceptually similar. The General Court pointed out that, although the court had not unambiguously established a clear position on whether an individual letter of the alphabet may convey a concept, it was not established that the capital letter 'T' had a particular meaning in one of the EU languages. It further emphasised that the stylistic differences highlighted by the applicant (the stout, static and simple nature of the earlier mark, compared to the sleek dynamic and complex nature of the mark applied for) were not adequate indicators of the marks having different conceptual content.

Taking all the above into account, in addition to the imperfect recollection which the relevant consumer would have of the marks at issue, the General Court agreed with the Board of Appeal that there was a likelihood of confusion between the marks, for all the goods covered by the mark applied for.

Consequently, the General Court rejected the action.

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