

### Weak similarity of marks offset by strong similarity of goods European Union - *Hoogenraad & Haak*

### Examination/opposition International procedures

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In *Sherwin-Williams Sweden AB v Office for Harmonisation in the Internal Market* (OHIM) (Case T-12/13, December 11 2014), the General Court has confirmed a decision to refuse registration of the mark ARTI on the ground that there was a likelihood of confusion with earlier registrations for the word mark ARTITUDE.

On April 9 2010 Becker Acroma Group Aktiebolag (subsequently replaced by applicant [Sherwin-Williams Sweden Group AB](#)) filed an application for registration as a Community trademark of the figurative sign reproduced below with the indication of the colour 'Red HKS 23', for goods in Class 2 of the [Nice Classification](#):



[Akzo Nobel Coatings International BV](#) filed a notice of opposition based on earlier Benelux and international registrations for the word mark ARTITUDE for goods in Class 2.

The Opposition Division of OHIM upheld the opposition and the applicant filed an appeal. The First Board of Appeal of OHIM dismissed this appeal, finding that there was a likelihood of confusion between the marks at issue in the Benelux and in France.

Before the General Court, the applicant pleaded breach of Article 8(1)(b) of the [Community Trademark Regulation \(207/2009\)](#), arguing that, in finding a likelihood of confusion in France and the Benelux, the Board of Appeal had made three errors, regarding:

1. the relevant public's level of attention;
2. the relevant public's ability to recognise both the word element 'art' and the play on words on which the earlier trademarks are based; and
3. the similarity of the marks at issue, supported by a list of registered trademarks.

The applicant's argument relating to the public's level of attention was new. It is clear from Article 135(4) of the [Rules of Procedure of the General Court](#) that the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal. Moreover, under Article 65(2) of the regulation, the purpose of actions brought before the General Court is to review the legality of decisions of the Boards of Appeal of OHIM. In addition, Article 76 of the regulation requires the review to be carried out in the light of the factual and legal context of the dispute as it was brought before the Board of Appeal.

However, since the fact relied upon was a matter of common knowledge, the applicant was not required to adduce evidence in that regard. On the other hand, the list of registered trademarks and the items related thereto were produced for the first time before the court and, consequently, could not be taken into account. It was irrelevant that that information and evidence of that list are available for public consultation on the OHIM website.

The Board of Appeal had concluded that the level of attention of the relevant public was average. The territory (Benelux, France and Spain) was not in dispute. The court, however, found that, given the category of the goods at issue and the fact that the average consumer does not regularly buy those goods, the consumer's level of attention must be considered higher than average.

The court then turned to the comparison of the signs. First, it noted that, in the visual assessment of the marks, account should be taken of the length of the word elements. As the earlier trademarks consisted of eight letters and were therefore twice as long as the trademark applied for, there was a clear visual difference. The figurative nature of the mark applied for was further underscored by a distinctive typeface, bold letters and an unusually represented first letter. However, it is settled case law that the consumer normally attaches more importance to the first part of words, and the marks had the root 'arti' in common. Weighing all elements against each other, the court concluded that there is a weak visual similarity between the marks.

Phonetically, the trademark applied for shared its first two syllables with the earlier mark, but contained one syllable less, which constituted a not insignificant difference. In French, the stress is placed on the third syllable 'tude'. This was important as the suffix 'tude' is not present in the trademark applied for, so the

marks were only similar to an average degree for the relevant public in France and the French-speaking public in the Benelux.

Conceptually, the ARTI trademark could by no means be associated with the play on the words 'art' and 'attitude'. The idea created by the trademark applied for was therefore different. In addition, the root 'art' which is present in the marks could not be considered to be the distinctive and dominant element in the overall impression produced by those marks. This resulted in a weak conceptual similarity.

Consequently, the signs were only weakly similar visually and conceptually, and they were phonetically similar to an average degree. The comparison of the goods at issue was not disputed by the parties: the goods were in part identical and in part highly similar. The global assessment of the likelihood of confusion implies some interdependence of the factors taken into account and, in particular, of the similarity of the trademarks and that of the goods or services covered. Applying this rule, the court found that the weak similarity of the marks was offset by the strong similarity of the goods covered by those marks.

The Board of Appeal had thus correctly found that there is a likelihood of confusion between the mark applied for and the earlier trademarks in France and the Benelux. That finding was not called into question by the fact that the level of attention of the relevant public must be considered as higher than average. Given the strong similarity between the goods covered by the marks and the degree of similarity existing between them, the circumstance that the relevant public displays a greater than average degree of attention was not sufficient to make it inconceivable that the public could believe that the goods covered by the marks at issue have the same commercial origin.

The applicant's action was dismissed.

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