

World Trademark Review Daily

**Applicant's conduct irrelevant in opposition proceedings under Article 8 Examination/opposition
European Union - MAQS Law Firm International procedures**

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In *Calvin Klein Trademark Trust v Office for Harmonisation in the Internal Market (OHIM)* (Case C-254/09 P, September 2 2010), the Court of Justice of the European Union (ECJ) has considered whether the General Court had erred in law in finding that there was no likelihood of confusion between the marks CK and CK CREACIONES KENNYA.

On October 7 2003 Zafra Marroquinos SL filed an application for the registration of the word mark CK CREACIONES KENNYA as a Community trademark (CTM) in Classes 18 (including leather goods) and 25 ("clothing, footwear, headgear") of the [Nice Classification](#). *Calvin Klein Trademark Trust* lodged an opposition based on several earlier marks including the letters 'CK'. Calvin Klein alleged that:

- there was a likelihood of confusion between the marks under Article 8(1)(b) of the [Community Trademark Regulation](#) (40/94); and
- the CK marks had a reputation under Article 8(5).

It was not disputed that the goods covered by the parties' marks were identical.

The Opposition Division of OHIM rejected the opposition in its entirety, finding that there was no likelihood of confusion between the marks on the part of the relevant public. On appeal, the Second Board of Appeal of OHIM agreed with the Opposition Division, finding that the marks at issue were not sufficiently similar for it to be concluded that there was a likelihood of confusion on the part of the relevant public.

Calvin Klein appealed to the General Court, which rejected the appeal. The court pointed out that a compound trademark cannot be regarded as being similar to another mark which is identical or similar to one of the components of the compound mark, unless that component forms the dominant element within the overall impression created by the compound mark. The words 'creaciones kennya' occupied, because of their size, a much more significant position than the group of letters 'CK', and formed a syntactical and conceptual unit which dominated Zafra's mark.

As regards the visual similarity between the mark, the General Court found that the mere visual resemblance of the sole or dominant figurative element 'CK' in the earlier marks and the element 'CK' in the mark applied for did not serve to create a visual similarity between the marks, in light of the overall impression created by the CK CREACIONES KENNYA mark and the specific graphic representation which characterised the earlier marks. From a phonetic point of view, the General Court found that the marks at issue were not similar, as the mark applied for would be referred to by using the words 'creaciones kennya' alone or the whole expression 'CK creaciones kennya'. From a conceptual standpoint, the General Court agreed that the board had not erred in finding that the words 'creaciones kennya', from which the group of letters 'CK' is derived, created a conceptual difference with the earlier marks.

Calvin Klein introduced evidence that Zafra used its mark with the 'CK' element in isolation in large, highlighted letters, together with 'creaciones kennya' in very small letters. Calvin Klein urged the court to take into account Zafra's conduct, citing established case law under which the court must take into account all factors relevant to the case. However, the court did not give weight to Zafra's conduct.

Finally, the General Court ruled that the reputation of the earlier marks could not call into question the board's finding that there was no similarity between the marks (for further details please see "[Calvin Klein fails to prevent registration of CK CREACIONES KENNYA](#)").

On appeal to the ECJ, Calvin Klein reiterated the same arguments. As regards whether Zafra's conduct was relevant, the ECJ held that, while this is a factor which may be taken into account, it is not a factor which *must* be taken into account under Article 8. The two marks must be assessed from the point of view of the average consumer by referring to the intrinsic qualities of the marks, and not to the circumstances relating to Zafra's conduct. The ECJ reminded Calvin Klein that it was able to review only points of law. Because the facts had not been distorted, the General Court had correctly applied the law in finding that there was no visual, phonetic or conceptual similarity.

As regards reputation, the ECJ noted that, for Article 8(5) to apply, the marks at issue must be similar. Consequently, as the General Court had held that the marks were not similar, this provision was "manifestly inapplicable".

World Trademark Review *Daily*

This case demonstrates once again that the ECJ is reluctant to overturn a decision of the General Court on confusing similarity. It also demonstrates the extent of the appellate structure for CTMs - just under six years elapsed from the filing of the notice of opposition to the final decision of the ECJ.

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