

World Trademark Review Daily

Marks in different languages may be conceptually identical
European Union - MAQS Law Firm

Examination/opposition
International procedures

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In *The Hut.com Ltd v Office for Harmonisation in the Internal Market* (OHIM) (Case T-330/12, June 24 2014), the General Court has upheld a decision of the Second Board of Appeal of OHIM in which the latter had found a likelihood of confusion between THE HUT in Class 35 and LA HUTTE in Classes 3, 5, 18, 22, 25 and 28 of the [Nice Classification](#).

In 2009 *The Hut.com Ltd* filed an application for the word mark THE HUT. The services in respect of which registration was sought were in Class 35, among others: "Procurement of goods on behalf of others; retail services in connection with the sale of electronic products, cosmetics products, perfumes, clothing, footwear, headgear, toys, games, foodstuffs, drinks; advice and consultancy services in connection with all the aforesaid services; provision of the aforementioned services by a customer care unit". On February 15 2010 *Intersport France* filed a notice of opposition pursuant to Article 41 of the [Community Trademark Regulation](#) (207/2009) against registration of the mark in respect of the aforementioned services. The opponent's mark LA HUTTE was filed and registered in France in 2003 in respect of goods in Classes 3, 5, 18, 22, 25 and 28, corresponding to a relatively broad list of goods in each class. The ground relied on in support of the opposition was that referred to in Article 8(1)(b) of the regulation.

The Opposition Division ruled in favour of the applicant and rejected the opposition in its entirety. The applicant appealed. By decision of April 27 2012, the Second Board of Appeal of OHIM annulled the Opposition Division's decision in part insofar as it had rejected the opposition in respect of "retail services in connection with the sale of cosmetics products, perfumes, clothing, footwear, headgear, toys, games, advice and consultancy services in connection with all the aforesaid services; provision of the aforementioned services by a customer care unit" in Class 35 - that is, the board allowed the opposition for the services related to the goods registered by the opponent.

Among other things, the board held as follows:

- The likelihood of confusion between the signs at issue must be assessed with regard to French consumers, as the earlier mark was registered in France. Having regard to the nature of the goods and services covered by the signs at issue, that consumer's level of attention must be considered to be average.
- The "retail" and "advice and consultancy" services or the services of "provision of the aforementioned services by a customer care unit", in respect of which registration of the mark THE HUT was sought, related to goods which were identical to those covered by the earlier mark, namely "perfumes, essential oils, cosmetics" (Class 3), "clothing, footwear, headgear" (Class 25) and "games and playthings" (Class 28). The relationship between those services and goods was close in the sense that the goods are indispensable to - or, at the very least, important for - the provision of the services covered by the mark applied for, which are specifically provided when those goods are sold. Consequently, the services and goods covered by the signs at issue were complementary. In those circumstances, there was a certain degree of similarity between the goods and services covered by the signs.
- There was a lower degree of similarity between the signs from a strictly visual point of view. Although the word 'hut' was included in the earlier mark, the first two elements and the endings of the signs at issue were, in contrast, different. Thus, assessed as a whole, the signs at issue are visually similar, albeit to a low degree.
- Even though the word 'hutte' in the earlier mark and the word 'hut' in the mark applied for were phonetically identical, the signs at issue, however, are phonetically similar only when assessed as a whole. The board also pointed out that knowledge of the vocabulary of a foreign language, other than the basic vocabulary, could not be assumed.
- The average consumer must rely on his/her imperfect recollection of the marks and the differences in the mark applied for may be perceived by the relevant public as reflecting a kind of anglicisation, modernisation or internationalisation of the earlier mark.
- In view of the similarity of the goods and services covered by the signs at issue and the similarity between those signs, a likelihood of confusion on the part of the French general public could not be excluded.

The applicant appealed to the General Court, arguing that the Board of Appeal had come to the wrong conclusion in finding that there was a likelihood of confusion, and requesting that the court annul the board's decision. The General Court dismissed the action.

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The General Court agreed, in essence, with the findings of the Board of Appeal concerning the comparison of goods and services, the similarity between the marks in question and the likelihood of confusion. Thus, in its decision the court quoted the findings of the Board of Appeal, adding only a few additional remarks.

Concerning the visual similarity of the marks, the court added that the signs at issue, taken as a whole, were of different lengths and were asymmetrical in their structures. The mark applied for consisted of two words of three letters each, while the earlier mark consisted of one word of two letters followed by a word of five letters. Secondly, the initial elements of the signs at issue, namely 'the' in the mark applied for and 'la' in the earlier mark, consisted of different letters. Lastly, the second element of the earlier mark contained the letters 'T' and 'E' added to the syllable 'hut', which was the second word in the mark applied for. However, the court held that those differences were not sufficient to rule out any visual similarity between the signs at issue.

The General Court then repeated the Board of Appeal's arguments concerning the phonetic and conceptual similarity of the signs, and ruled that the signs were phonetically similar and conceptually identical. Hence, the court ruled that the Board of Appeal had been right to find that the signs at issue, taken as whole, were similar. Finally, responding to the applicant's argument that the Board of Appeal should have attached greater importance to the lack of visual similarity between the signs at issue, the General Court said that, even if the board had paid greater attention to the visual aspects of the signs, that would not be capable of altering the finding that, taken as whole, those signs were similar, given that the lower degree of visual similarity was offset by the phonetic similarity and the conceptual identity. The court also stated that it was for the applicant to substantiate, by means of evidence, its argument that the relevant French public had sufficient knowledge of English to pronounce the English word 'hut' and the French word '*hutte*' differently.

Concerning the likelihood of confusion, the court again confirmed that the findings of the Board of Appeal were correct. Considering that there was a certain degree of similarity between the services in respect of which registration of the mark was sought and the goods covered by the earlier mark and that the signs at issue were similar, it could not be called into question that there was a likelihood of confusion between those signs when assessed globally. Furthermore, the General Court rejected as unfounded the applicant's argument that the Board of Appeal had erred in taking into consideration a not insignificant part of the relevant public, and not the relevant public as a whole. The court held that the board had compared the signs with regard to the average French consumer's perception of the signs. Furthermore, the court confirmed that the Board of Appeal had not erred in taking into consideration a "substantial part" or "not insignificant part" of the relevant public, and not the whole of that public. It was apparent from the case law that a finding that there is a likelihood of confusion for a not insignificant part of the relevant public is sufficient to uphold an opposition brought against an application for registration of a mark.

Finally, the General Court concluded that the Board of Appeal, in the present case, had carried out a comparison of the signs at issue and of the goods and services in question which was capable of substantiating the conclusion that there was a likelihood of confusion between those signs.

This decision is interesting for two reasons. First, it accepts that marks in different languages can be conceptually identical. Second, it confirms that the retail sale of goods (Class 35) is similar to the goods themselves, and that there can be a likelihood of confusion even when the marks are "visually similar, albeit to a low degree".

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