

World Trademark Review Daily

Word mark held to be confusingly similar to earlier figurative mark
European Union - MAQS Law Firm

Examination/opposition
International procedures

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In *Schuhhaus Dielmann GmbH & Co KG v Office for Harmonisation in the Internal Market* (OHIM) (Case T-600/11, January 28 2014), the General Court has upheld a ruling of the First Board of Appeal of OHIM in which the latter had found that the word mark CARRERA PANAMERICANA was confusingly similar to the figurative mark CARRERA.

Schuhhaus Dielmann GmbH & Co KG sought registration of the word mark CARRERA PANAMERICANA as a Community trademark (CTM) for:

- “beach bags, bags for sports, bags for campers, shopping bags, handbags, bum bags, rucksacks, particularly carry-bags, valises, travelling trunks, vanity cases, school bags, parasols, umbrellas” in Class 18; and
- “clothing, footwear, headgear, belts” in Class 25 of the [Nice Classification](#).

Carrera SpA filed a notice of opposition based on the earlier figurative CTM CARRERA, registered for “clothing, including belts and footwear” in Class 25:



The Opposition Division delivered a split decision, primarily in favour of the opponent, refusing protection of the applicant’s mark for “beach bags, bags for sports, bags for campers, shopping bags, handbags, bum bags, rucksacks, particularly carry-bags, school bags” in Class 18 and all goods in Class 25. The Opposition Division reasoned that these goods were identical (as far as Class 25 was concerned) or similar (as far as Class 18 was concerned) to the goods covered by the opponent’s registration.

Further, the Opposition Division found that the marks had a medium degree of visual and aural similarity, as well as a certain degree of conceptual similarity since both signs evoked the notion of ‘race’ (*‘carrera’* in Spanish). As the opponent’s mark was not descriptive of the goods, it had an average degree of distinctiveness. The Opposition Division found that the presence of the same word in the two marks could mislead consumers into believing that the signs had the same commercial origin; therefore, there was a likelihood of confusion with regard to the similar and identical goods.

The applicant appealed. The First Board of Appeal of OHIM dismissed the appeal and upheld the Opposition Division’s decision. Among other things, the board held as follows:

- The parties’ goods were in part identical and in part similar.
- The assessment made by the Opposition Division as regards the visual and aural similarity was correct. The applicant’s mark fully incorporated the word element ‘*carrera*’, which was the dominant element in the opponent’s mark, as the figurative elements were clearly subordinate and designed to highlight the word element. Thus, there was a medium degree of visual and aural similarity.
- The presence of the word ‘*panamericana*’ in the mark applied for did not exclude aural and visual similarity, but only reduced it. The applicant’s mark begins with the word element ‘*carrera*’, which is thus the part of the mark that consumers will see first.
- The marks were also conceptually similar for those consumers in the European Union who understand the Spanish word ‘*carrera*’ (race). For most Spanish-speaking consumers, the two marks were built around the notion of a race. The adjective ‘*panamericana*’ added a geographical connotation to that notion, but did not eliminate the notion itself. For those consumers who understand Spanish, therefore, the marks were conceptually highly similar. The rest of the consumers in the European Union would perceive the word ‘*carrera*’ as purely fanciful.
- The argument that the word ‘*carrera*’ was no longer distinctive because the CTM register contains numerous marks based on that word was not well founded. What matters, for the purpose of assessing the distinctive character of a sign, is the exposure of consumers to that sign in the marketplace. In this case, to support its argument, the applicant should have submitted pictures of products that can be found on the market, and not citations from the trademark registers.
- The opponent’s mark is based on a word that is distinctive in the context of clothing and the

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presence of the same word at the beginning of the applicant's mark was likely to mislead most consumers into believing that there was a connection between the two brand names. The geographical connotation of the applicant's mark might make this connection even more likely - for example, consumers might reasonably believe that CARRERA PANAMERICANA designates the opponent's business operations on the American continent.

On appeal to the General Court, the applicant presented additional evidence of third-party CARRERA marks. This evidence was not admitted, as it had been presented for the first time before the court. The court then considered the applicant's claim that the Board of Appeal had failed to state reasons in contravention of Article 75 of the [Community Trademark Regulation](#) (207/2009). The court rejected this claim, holding that:

- the board's statement of reasons allowed both the applicant and the court to understand that the board's findings as regards the visual and phonetic similarity were based on the presence of the same word in the marks at issue;
- the board's finding that the word '*carrera*' was the dominant element of the earlier mark was clearly based on the graphic presentation of that mark, and the board was not required to substantiate the finding that the figurative elements of that mark were subordinate and designed to highlight the word element; and
- the board had explained the reasons which led it to find that consumers were likely to be misled regarding the existence of a connection between the two marks, as that finding was based, among other things, on the presence of the word '*carrera*' in both marks and on the position which it occupies in each of those marks.

The court then considered whether the board had infringed Article 8(1)(b) of the regulation by finding that there was a likelihood of confusion between the marks. It was not disputed that there was identity/similarity of the goods at issue. The court held as follows:

- The board was right to find that the word '*carrera*' constituted the dominant element of the earlier mark, both visually and phonetically. The applicant's argument that '*carrera*' was descriptive of running shoes was rejected by the court because the board had correctly pointed out the confusion between the Spanish words '*carrera*' ('race') and '*correr*' ('to run'). The expression 'footwear for running' translates into Spanish as '*calzado para correr*', and not as '*calzado de carrera*'. Therefore, the word '*carrera*' was not descriptive of shoes.
- While it was true that the mark applied for consisted of two words and nine syllables, in light of the fact that the word '*carrera*' was used in both marks, the differences were not sufficient to alter the relevant consumer's impression that those marks, when assessed globally, were visually and phonetically similar.
- The board was correct in rejecting, in its conceptual comparison, the argument that the applicant's mark referred to a Mexican car from the 1950s.

Accordingly, the court upheld the board's conclusion that there was a likelihood of confusion, including a likelihood of association, and rejected the appeal.

This case is a text-book illustration of how OHIM typically works, from the split decision as regards the similarity of the goods, to the conflict between mark [A] and mark [A][B], where [A] typically wins, even if [A] is a figurative mark. It also shows the importance of presenting the relevant evidence, at the latest, before the Board of Appeal.

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