

**Decision Nos. 15347, 15348, 15349, 15350, 15351, 15352, 15353, 15354 of 2005 formally issued on 29 May 2006
Case Nos. 20180, 20182, 20183, 20186, 20187, 20188, 20189, 20190 of 2001**

1. Reversal/Recourse
2. National procedures

PRECIS: The Athens Administrative Court of First Instance reversed the eight Trademark Committee decisions, which had originally partially accepted four CITI+ marks filed by a Greek company, and granted all eight related Recourses filed by the CITIGROUP (CITIBANK N.A. and CITICORP, respectively).

The Court held that the four trademark applications brought before it for review, all of which contained the word CITI as their prefix, are confusingly similar to the well-known series of CITI+ marks owned by the CITIGROUP of companies and as such must be refused registration, despite the fact that the classes of goods and services covered by the respective marks do not coincide.

Upholding the fame of CITI+ marks owned by CITIGROUP despite non-coinciding classes

The Greek company CITISHOP – MERCHANDISE OF ELECTRONICS AND ELECTRICAL APPLIANCES, had filed, in 1999, a series of 4 new trademark applications all of which contained the word CITI as their prefix: CITIprice, CITIcheckup, CITIbills, CITIsmile. Each one of the four trademark applications included, in its verbal portion, some descriptive terms in Greek, depending on the type of goods or services intended for each mark. There were also some minor devices of cartoon-like mobile phones included with each application.

All the above trademark applications covered goods and services in classes 9, 14, 16 and 38. At first instance, the Trademark Committee, pursuant to related Oppositions filed by the CITIGROUP, had only partially rejected the four CITI+ trademark applications filed by the

Greek company, allowing them to proceed to registration for classes 14 and 38 and refusing them registration for classes 9 and 16.

The above was because, in the Trademark Committee's opinion, although the Greek company's CITI+ trademark applications were confusingly similar to the well-known CITI+ series of marks of the CITIGROUP, a risk of confusion was held to exist only with regard to the conflicting classes (9 and 16). Any potential risk of confusion for other, non-coinciding classes was, according to the Committee's view, mitigated by the fact that none of the CITI+ series of marks of the CITIGROUP actually covered classes 14 and 38, and there were no proximity of the goods and services actually covered by the Greek company's marks with those covered by the CITIGROUP CITI+ marks. Therefore consumers were not considered likely to be misled when it comes to telecommunications or watches, which were not covered by CITIGROUP's series of marks.

The CITIGROUP filed Recourses requesting the Court to dismiss the four trademark applications of the Greek company for the remaining classes 14 and 38 as well, primarily based on the fame of its CITI+ marks and notwithstanding the fact that the particular classes did not coincide with any of the classes covered by the CITIGROUP's numerous CITI+ marks. In substantiating this "claim to fame", the CITIGROUP argued, inter alia, that, based on submitted evidence, its CITIBANK mark is rated as one of the 75 most valuable marks worldwide and that in itself indicates the fame of its CITI+ marks aside of course from the endless list of CITI+ marks registered and used around the globe. Moreover, in today's business realities, the expansion of the CITIGROUP's activities in various fields gives leverage to consumers to assume that the particular goods and services (horological and chronometric instruments and watches & telecommunications) are also part and parcel of the CITIGROUP's activities. Therefore, the onus should be on the Greek company to

disprove any allegations of risk of confusion between its purported marks and the CITIGROUP's world famous CITI+ marks.

In examining the merits of the case, the Court momentarily went beyond the facts before it and drew a significant distinction between the direct and indirect risk of confusion.

In its important ruling, the Court held that direct risk is the obvious, evident resemblance towards a preceding mark, which, despite the existence of minor side-differences, is nonetheless capable of creating confusion to the average consumer as to the origin of the products involved.

On the other hand, the indirect risk of confusion primarily stems from the sub-conscious perception of the average Greek consumer, who may, in the circumstances, appreciate that the particular products or services do not, or cannot, originate from the same company that owns the preceding mark, but nonetheless, reasonably assume that there is some financial or legal nexus between the two companies.

Although Greek Trademark Law does not expressly mention the indirect risk of confusion as a factor for determining the admissibility of trademark applications, both the direct and indirect risk of confusion were deemed to be of equal importance by the Court. This finding followed from the Court's interpretation of a combination of relevant provisions of Greek Trademark Law and upheld related precedent from the Greek Supreme Administrative Court (Council of State), as well as the European Court of Justice.

In applying the above legal principle to the facts before it, the Court was satisfied that indeed the dispute under review involved a real, albeit indirect, risk of confusion, given the fact that the classes of goods and services respectively covered did not entirely coincide.

The Court went on to examine the fame and good will associated with the CITI+ series of trademarks owned by CITIGROUP. By re-tracking on the longstanding history of CITIGROUP, which was founded nearly 2 centuries ago, in 1812, and the start of its operation in Greece dated back from 1964, the Court was convinced that the CITI+ series of marks owned by CITIGROUP enjoy extended fame and notoriety in Greek jurisdiction and are therefore subject to special protection, deriving also from the CITIGROUP's famous company name, itself containing the CITI prefix.

Notwithstanding the fact that the purported trademark applications were filed by an applicant whose own company name contained the prefix CITI (CITISHOP), the Court was satisfied that the CITIGROUP was sufficiently shielded by its world-famous preceding company name, fortified as well by its globally famous CITI+ series of marks, including, but not limited to, CITIBANK, CITICORP, CITIGOLD, CITIFREEDOM, CITICASH, CITIDIRECT, CITIPHONE, CITIBUSINESS, CITIPAY, CITIFUND, etc.

After examining the trademark applications under review, it was obvious to the Court that their dominant element was the prefix CITI while the remaining word and device elements of each one were not sufficiently distinct in order to differentiate them, to a satisfactory extent, from the famous preceding CITI+ marks.

In light of all the above, a real risk of confusion, albeit indirect, given the non-coinciding classes respectively involved, was held to exist and be sufficiently detrimental, given the extended goodwill associated with the CITI+ marks of the CITIGROUP. As such, the Court refused the registration of the particular trademark applications and granted the related Recourses filed by CITIBANK and CITICORP of the CITI Group of companies.

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