

Athens Administrative Court of Appeal

Decision No. 2577/2009 (formally served on January 18th, 2010)

1. Reversal/Recourse
2. National Procedures

Likelihood of confusion with pre-existing similar trademark

The Athens Administrative Court of Appeal set aside an earlier decision after its referral by the Council of State, on the grounds that it was insufficiently reasoned.

Ferrero, the company that was the prior holder of a number of composite trademarks for class 30 products bearing the word FERRERO, opposed an application filed by Athinaiki Oikogeneiaki Artopoiia for a composite (figurative and word) trademark that included the word FERRO'. The opposition was rejected by the Trademark Committee, thence Ferrero filed a recourse that was, in turn, dismissed by the Athens Administrative Court of First Instance. Following this, an appeal was brought before the Athens Administrative Court of Appeal, where Ferrero claimed that the contested trademark was visually and phonetically similar to its own, prior existing trademarks that covered similar products. Ferrero argued that, given the circumstances, there was a risk of consumer confusion, adding that the application for the registration of this trademark was contrary to good faith. Athinaiki Oikogeneiakii Artopoiia, on the other hand, contended that the trademarks being compared were substantively different, both visually as well as phonetically, also adding that there was no evidence to support the argument regarding bad faith. The Court of Appeal upheld the decision of the Court of First Instance, stating that "based on the overall visual and aural impression of the trademarks in question, there is no risk of consumer confusion arising as to the origin of the products covered by the trademarks and the company that markets them, even though the products are similar". Thus, the application for registration of the contested trademark was sustained and the court found no evidence of bad faith.

On a further appeal before the Council of State, however, it was held that the bench had previously omitted to carry out the required examination of the presentation of some of the plaintiff's pre-existing trademarks, which was necessary in order to ensure the correct application of the law. Thus, upon extensive and detailed examination of the trademarks being compared (letters, shapes, frames, color, remaining illustrations, etc.), and with regard to the relevant case-law of the European Court of First Instance (CFI), the Court of Appeal reversed the earlier decision. In particular, the court noted the following:

- Notwithstanding the composite nature of both trademarks in question, their dominating features consisted of the word elements 'FERRERO' and 'FERRO' respectively, rather than their device elements that were seen as being mostly decorative in nature and not sufficiently distinctive; consequently, it was held that
- Overall, the word elements of the trademarks under scrutiny presented a considerable degree of visual similarity
- The prior existing trademarks and the one being contested were also aurally similar

- A conceptual comparison was not seen as being relevant, as neither the dominant element of the contested trademark, nor that of the prior existing trademark, had any meaning in Greek

Therefore, basing its findings on the words ‘FERRERO’ and ‘FERRO’” being the dominating features of both trademarks vis-à-vis their figurative elements; and given that there was a considerable degree of visual and phonetic similarity between the contested trademark and at least three of Ferrero’s prior existing trademarks, the court ruled that the registration of the contested trademark should not be accepted. This was particularly pertinent as the trademarks in question covered similar and identical products, hence creating a risk of confusion in consumers who might believe that the goods in question are produced by the same company or, as the case may be, from economically linked undertakings.

This decision forms part of an interesting string of cases initiated by Ferrero SpA, both at national as well as at Community level, exemplifying the importance of careful and detailed examination by the courts when assessing the overall effect of contested composite trademarks.

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