

Phonetic similarity, even to a high degree, is not enough to cause confusion, the General Court says

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In the assessment of the similarity of signs, visual, phonetic and conceptual similarity are evaluated and it is not necessary that similarity exist in all three aspects, one can suffice. Nonetheless, in the global assessment of likelihood of confusion, visual, phonetic and conceptual similarity do not actually carry the same weight, and often the balancing of these factors brings results which may be found surprising.



Case in point is the recent decision T-117/20, of 10 February 2021, where the General Court (GC) held that despite a high aural similarity among two signs, conceptual and visual differences might neutralize this and preclude confusion. Some aspects of this case are worth further reflection.

MKR Design Srl filed an EUTM application for the sign “PANTHÉ” (figurative)



for goods in class 25. El Corte Inglés, SA filed an opposition based, among others, on its Spanish and European Union figurative trademarks



“PANTHER”, namely  and , both also designating goods in class 25.

The EUIPO rejected the opposition and the Board of Appeal confirmed this, because, despite the high phonetic similarity between PANTHE and PANTER, the signs were visually and conceptually not similar.

El Corte Inglés filed an action to the GC arguing, among others, that the phonetic similarity, paired with the identity of the goods, should have been considered sufficient for likelihood of confusion, in light of the principle of interdependence. It also criticized the Board of Appeal’s finding that the visual aspect is preponderant, arguing instead that in the clothing sector, consumers tend to call a brand by its name. Moreover it countered the finding of conceptual dissimilarity arguing that the word ‘panthé’ could in fact be perceived by consumers as a misspelling of ‘panther’.

The GC dismissed the action. It held that it could not be inferred from the principle of interdependence that there was “necessarily” a likelihood of confusion each time that a mere phonetic similarity between two signs was established (at § 59). This is debatable, as the CG recognized that there was a “high [not ‘mere’] similarity”, and as the CJEU in *Lloyd* (C-342/97), which also concerned the fashion sector, had clearly stated that aural similarity alone may suffice.

True, the CG recognized that in the global assessment of likelihood of confusion, the visual, phonetic or conceptual aspects of the signs at issue did not always have the same weight and it was appropriate to examine the conditions under which the marks may be present on the market. Here, the GC relied on the fact (or: assumption) that clothes are purchased on sight and that therefore, the visual impression generally prevails in this sector. This theory is really an EU courts’ invention, but it has become a hard (and hardly disprovable) fact through endless reiteration in the case law. In any event, the GC did not explain why *even a high degree* of phonetic similarity is overridden by visual differences in the marks.

In addition to that, the GC emphasized the conceptual differences, namely, that the earlier marks were clearly associated with the concept of a black feline whereas the mark applied for had no meaning. It is recognised in case law that

conceptual differences can counteract other similarities if at least one of the marks has a clear and specific meaning.

Now it is interesting to note that, when the GC holds that *“the earlier figurative marks are clearly associated with the concept of a black feline”* at § 63, this finding is “clearly” predicated upon the visual evaluation, because at least in two EU languages, namely Finnish and Hungarian, PANTHER is, respectively PANTTERI. and PARDUC. Therefore, at least from a phonetical point of view, a good argument can be made that at least on Finnish and Hungarian consumers, the “clear and specific meaning” of PANTHER would be lost and thus the high aural similarity should be considered as carrying enough weight, if coupled with the identity of the goods and in light of the “interdependence principle”, to prevail over the visual differences.

Finally, and not to poke (too much) at the somewhat inconsistent application of the GC’s own principles, we cannot but notice that in a quite recent case (here commented “Should different meanings outweigh the similarities of non-distinctive elements?”), the GC had not given much relevance to the conceptual differences, finding confusion based on the visual and aural similarity of the (descriptive components of the) marks in conjunction with the identity between the goods. Judge Bridle goose, were those the little small dice or the large great ones?