

European Union - Dr Helen Papaconstantinou John Filias & Associates

In *Colgate-Palmolive Company v Office for Harmonisation in the Internal Market (OHIM)* (Case T-467/11, December 10 2013), the General Court has held that the trademarks 360° SONIC ENERGY and SONIC POWER, considered as a whole, were visually, phonetically and conceptually similar. These similarities overrode any visual and phonetic differences that might be due to the existence of the element '360°' at the beginning of the mark 360° SONIC ENERGY or to the differences between the last words ('energy' and 'power') of the two marks.

On August 29 2007 Colgate-Palmolive Company filed a Community trademark (CTM) application for the word sign 360° SONIC ENERGY to cover "toothbrushes" in Class 21 of the Nice Classification.

On April 4 2008 dm-drogerie markt GmbH & Co KG filed an opposition against the application, claiming that there was a likelihood of confusion with its earlier international trademark SONIC POWER, which was effective in the Czech Republic, Italy, Hungary, Austria, Slovenia and Slovakia, and covered, among other things, toothbrushes and electric toothbrushes in Class 21 and certain goods in Class 3.

The Opposition Division of OHIM upheld the opposition, finding that there was a likelihood of confusion between the two marks.

Colgate-Palmolive appealed the decision. The appeal was rejected by the Second Board of Appeal of OHIM, which found that there was a likelihood of confusion between the marks on the following grounds:

- The goods covered by the two trademarks were identical.
- Most of the consumers in the relevant territories would understand the word 'sonic' together with the other word elements of the marks under comparison. However, the contested mark was intended to cover toothbrushes in general and not just a particular type of toothbrush, whereas the word 'sonic' could be considered distinctive only for ordinary toothbrushes.

- The applicant had not shown that the public was familiar with an extensive use of the word 'sonic' in marks covering toothbrushes.
- The words 'power' and 'energy', as well as the element '360°', reinforced the distinctive character of a sign used in respect of simple toothbrushes and, because of these elements, there was a high degree of conceptual similarity between the marks under comparison, despite their phonetic and visual dissimilarity.

Colgate-Palmolive appealed, alleging that the conflicting marks were not similar and that there was no likelihood of confusion. More specifically, it argued as follows:

- The Board of Appeal had erred in disregarding the fact that the word 'sonic' has no distinctive character and, therefore, could not play a primary role in the comparison of the two conflicting marks. That word designated a very specific type of toothbrushes that intensify the cleaning process through the use of ultrasounds, which cause the water to vibrate at high speed. Further, the word 'sonic' was used as a generic term in many Community and national marks for various types of toothbrushes.
- The Board of Appeal had not sufficiently evaluated the importance of the element '360°', which had acquired increased distinctiveness through intensive use in several EU countries. Contrary to the board's argument, that element was not of a technical nature and did not imply any meaning of superiority or quality, but was a fanciful element that evoked various meanings in the minds of consumers.
- The marks under comparison were phonetically different.
- Contrary to the finding of the board, there was no visual similarity between the conflicting marks. The board had not sufficiently evaluated the importance of the element '360°', which did not imply any technical feature of the covered goods, and possessed distinctive character. Its position at the beginning of the mark reinforced the visual difference with the earlier mark.
- The board had erred in finding that there was a conceptual similarity between the conflicting marks. On the contrary, the word 'sonic' was descriptive for toothbrushes in general and implied a more intense and effective cleaning than normal. In line with established case law, the relevant public would not consider the descriptive element of a composite mark to be

the dominating feature thereof. Finally, the words 'power' and 'energy' were different conceptually, as they had different technical meanings. The word 'sonic' would be seen only as being descriptive of the words 'energy' and 'power'.

The General Court first referred to the Board of Appeal's finding that the word 'sonic', in combination with the other elements of the marks, was descriptive for the relevant public as far as electric toothbrushes were concerned, and was distinctive for simple toothbrushes that were not electrically operated. According to the Board of Appeal, the applicant had not proved that consumers were exposed to a widespread use of the word 'sonic' in connection with toothbrushes. The board had considered that the word 'sonic' was of paramount importance in both marks, since it caused a certain visual similarity between the marks, as well as a considerable conceptual similarity. The board had further stated that the expressions 'sonic energy' and 'sonic power', as well as the element '360°', would all be perceived as technical characteristics of the covered goods.

The court referred to *Medion* (Case C-120/04), in which it was held that, where the goods or services are identical, there might be a likelihood of confusion if the contested sign is composed by juxtaposing the company name of another party and a registered trademark with normal distinctiveness and which, although it does not determine by itself the overall impression conveyed by the composite sign, still has an independent distinctive role therein. However, in the present case, the court found that the mark 360° SONIC ENERGY did not contain the earlier mark, but only the word 'sonic'.

The General Court further agreed with the finding of the Board of Appeal that the word 'sonic', particularly when associated with the words 'energy' and 'power', could be considered descriptive of the characteristics of a specific electric toothbrush, a fact that was confirmed by the advertisements and evidence of online offers submitted by Colgate-Palmolive. However, the court disagreed with the board's finding that the fact that the mark 360° SONIC ENERGY was intended to cover toothbrushes in general had the consequence that the term 'sonic' could not be considered to be descriptive when comparing the two marks in question. The court stressed that the term 'sonic' was descriptive of one essential characteristic of electric toothbrushes, which allowed the public to distinguish such toothbrushes from ordinary ones or other electric toothbrushes. Therefore,

the fact that the contested trademark was intended for all kinds of toothbrushes did not alter the descriptive character of the word 'sonic' in the two marks under comparison.

The court then pointed out that challenges to the validity of national trademarks fell outside its jurisdiction and, therefore, it could not examine the distinctive character of a protected earlier international trademark. A certain degree of distinctiveness of the earlier word mark thus had to be acknowledged, despite the court's above findings.

Further, the court disagreed with Colgate-Palmolive's argument that the element 360° was dominant in its mark. Although it accepted that it was evident from the material submitted by Colgate-Palmolive that '360°' was used in connection with the marketing of toothbrushes, it stressed that, in almost all of the cases, it appeared in connection with other elements, especially Colgate-Palmolive's trade name. Thus, the court confirmed the Board of Appeal's conclusion that consumers would perceive this element as a technical feature, rather than as a significant distinctive element of the contested mark - especially as, in line with established case law, the public would not, as a general rule, consider a descriptive element of a composite mark to be the distinctive and dominant element in the overall impression given by the mark. Therefore, the dissimilarity resulting from the presence of the element '360°' in the trademark applied for could not be decisive for the purpose of counteracting the similarity existing between those signs, resulting in particular from the common element 'sonic'.

In assessing the conceptual similarity of the marks, the court rejected Colgate-Palmolive's claim that the element '360°' introduced a conceptual difference between the marks and confirmed that it would be considered by consumers as a technical feature of the covered goods. Moreover, in agreement with the Board of Appeal, it stressed that the words 'energy' and 'power' implied the idea of mechanical or electrical force. However, since the average consumer does not usually make a direct comparison between the marks, but relies on the imperfect image he/she has in his/her mind, and since the average consumer usually has a low level of attention when purchasing the goods at issue, the court concluded that the words 'energy' and 'power' could not be considered as introducing a conceptual difference. Thus, the Board of Appeal had not erred in finding that consumers would associate the marks conceptually.

Finally, turning to the likelihood of confusion, the court agreed with the board that the common element 'sonic' gave rise to similarity between the marks, which was strengthened by the words 'energy' and 'power' from a conceptual point of view. The court noted that the coexistence of earlier marks on the market could reduce the likelihood of confusion; however, in such cases, the CTM applicant must show that such coexistence was based on the absence of any likelihood of confusion on the part of consumers between the coexisting marks and the mark on which the opposition is based, and provided that the earlier marks and the marks at issue are identical. However, in the present case, the coexisting marks to which Colgate-Palmolive had referred were not identical.

The court also stressed that, although the distinctive character of the earlier mark should be taken into account upon assessment of the likelihood of confusion, it is only one factor among others. Accordingly, even in a case involving a mark with weak distinctive character, there may be a likelihood of confusion due to the similarity of the marks and the goods concerned.

Consequently, the court rejected the appeal.

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