



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

14 July 2021 *

(EU trade mark – Opposition proceedings – Application for EU figurative mark Ø – Earlier international figurative mark φ – Relative ground for refusal – Likelihood of confusion – Similarity of the signs – Article 8(1)(b) of Regulation (EU) 2017/1001)

In Case T-399/20,

Cole Haan LLC, established in Greenland, New Hampshire (United States), represented by G. Vos, lawyer

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by T. Frydendahl and A. Folliard-Monguiral, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

Samsøe & Samsøe Holding A/S, established in Copenhagen (Denmark), represented by C. Jardorf, lawyer,

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 15 April 2020 (Case R 1375/2019-4) relating to opposition proceedings between Samsøe & Samsøe Holding and Cole Haan,

THE GENERAL COURT (Fifth Chamber),

composed of D. Spielmann (Rapporteur), President, U. Öberg and R. Mastroianni, Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 26 June 2020,

having regard to the response of EUIPO lodged at the Court Registry on 7 December 2020,

* Language of the case: English.

having regard to the response of the intervener lodged at the Court Registry on 19 November 2020,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment¹

Background to the dispute

- 1 On 1 November 2017, the applicant, Cole Haan LLC, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Regulation (EU) 2017/2001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2009 L 154, p. 1).
- 2 Registration as a mark was sought for the following figurative sign:



- 3 The goods in respect of which registration was sought are in Classes 18 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:
 - Class 18: ‘Briefcases, wallets, suitcases, trunks, travelling bags, rucksacks, leather bags, handbags, purses, leather shopping bags, leather key cases, business card holders, credit card holders, shoulder bags, luggage, clutches, all-purpose athletic bags, sports-bags, beach bags, shoulder bags; pocket wallets; umbrellas’;
 - Class 25: ‘Clothing for men, women and children; jeans, pants, bottoms, shirts, t-shirts, tops, tank tops, skirts, socks, jackets, coats, shorts, blouses, sweaters, vests, dresses, scarves, gloves, shawls, jumpsuits, capes, rainwear, ski-wear, swimwear, undergarments, singlets, hosiery; neckties; footwear; boots, shoes, sneakers, pumps, sandals and slippers; headwear, caps, hats’.
- 4 On 23 February 2018, the intervener, Samsøe & Samsøe Holding A/S, filed a notice of opposition pursuant to Article 46 of Regulation 2017/1001 to registration of the mark applied for in respect of the goods referred to in paragraph 3 above.

¹ Only the paragraphs of the present judgment which the Court considers it appropriate to publish are reproduced here.

5 The opposition was based, inter alia, on the international registration designating the European Union of the figurative mark registered on 22 November 2013 under number 1193789 and reproduced below:



6 The earlier mark had been registered for goods in, inter alia, Classes 18 and 25 corresponding, for each of those classes, to the following description:

- Class 18: ‘Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; bags, purses, trunks and travelling bags; umbrellas and parasols’;
- Class 25: ‘Clothing, footwear, headgear’.

7 The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation 2017/1001.

8 On 29 April 2019, the Opposition Division upheld the opposition and refused registration of the mark applied for in respect of all of the goods referred to in paragraph 3 above, on the basis of Article 8(1)(b) of Regulation 2017/1001.

9 The applicant filed a notice of appeal with EUIPO, pursuant to Articles 66 to 71 of Regulation 2017/1001, against the Opposition Division’s decision.

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Forms of order sought

11 The applicant claims that the Court should:

- annul the contested decision;
- order EUIPO to pay the costs of the proceedings before the General Court;
- order the intervener to pay the costs of the proceedings before the Opposition Division and the Board of Appeal.

12 EUIPO contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

13 The intervener claims that the Court should dismiss the action.

Law

...

18 In the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of goods concerned, who is reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see judgment of 13 February 2007, *Mundipharma v OHIM – Altana Pharma (RESPICUR)*, T-256/04, EU:T:2007:46, paragraph 42 and the case-law cited).

19 In the present case, the applicant does not dispute the validity of the definition of the public on the part of which the Board of Appeal assessed whether there is a likelihood of confusion, namely the French-speaking public with no command of Danish, Bulgarian or Greek and displaying an average level of attention.

20 Nor does it dispute the Board of Appeal's finding that the goods at issue are identical or similar.

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22 It should be borne in mind that the global assessment of the likelihood of confusion must, so far as concerns the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant elements. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (see judgment of 12 June 2007, *OHIM v Shaker*, C-334/05 P, EU:C:2007:333, paragraph 35 and the case-law cited).

23 It is common ground between the parties that the mark applied for is a representation of the letter 'Ø', which is part of the alphabet used in Danish, whereas the earlier mark is a representation of the Greek letter 'φ' or the letter 'Φ', from the Cyrillic alphabet, used, inter alia, in Bulgarian.

...

25 The applicant alleges that the Board of Appeal erred in finding that the signs at issue both consist of a circle bisected by a straight vertical line when the line bisecting the circle in the mark applied for is diagonal. In addition, it submits that, in the earlier mark, the line bisecting the circle extends beyond the circle further than in the mark applied for, which the Board of Appeal did not take into account.

...

30 Furthermore, contrary to the applicant's submission, it is apparent from paragraph 23 above that the Board of Appeal took account of the visual difference resulting from the fact that the line bisecting the circle in the earlier mark extends beyond the circle further than in the mark applied for.

- 31 As regards the applicant's assertions concerning consumers' ability to distinguish certain letters or symbols with visual similarities, it is clear that those assertions relate to letters or symbols in the language or languages spoken by the relevant consumers, namely, in the present case, French-speaking consumers who do not speak Danish, Bulgarian or Greek.
- 32 None of the letters 'Ø', 'Φ' or 'φ' is used in French, which is spoken by the relevant public.
- ...
- 34 Lastly, it is also clear that the applicant's assertion that the signs at issue are visually dissimilar is the consequence of the arguments rejected in paragraphs 28 and 29 above, respectively, and is, moreover, not substantiated. Accordingly, it is not such as to call in question the Board of Appeal's finding that the signs at issue are visually similar to a high degree and therefore must be rejected.
- 35 Consequently, the Board of Appeal did not make an error of assessment in finding that the signs at issue are visually similar to a high degree.
- 36 As regards the phonetic comparison of the signs at issue, the Board of Appeal found that no such comparison is possible because, since neither sign has any meaning for the majority of the French-speaking public, they will not be verbalised. It added that, if they were to be verbalised by describing their appearance, the signs at issue would be pronounced as '*cercle bissecté*', with the result that they would, in that scenario, be phonetically identical.
- 37 The applicant takes issue with the Board of Appeal for finding that the phonetic aspect of the signs at issue has no bearing on the assessment of the similarity between the signs. In particular, the Board of Appeal was wrong to consider that the French-speaking public has no knowledge of Danish, Bulgarian or Greek. Consumers, even without understanding those languages, know that, first, the mark applied for has a meaning in the 'Scandinavian languages', represents a letter in the Danish alphabet and means 'island' in that language and, secondly, the earlier mark represents a letter in the Greek and Bulgarian alphabets. In support of those claims, the applicant submits that the intervener uses the letter 'ø' in its name to show its Scandinavian identity and that it has a shop in France, which indicates that French-speaking consumers understand the Scandinavian, or even Danish, origin of the letter 'ø'. In their respective languages, the letters represented by the signs at issue are pronounced differently, with the result that the signs are not phonetically similar.
- 38 As is apparent from paragraphs 22 and 31 above, the letters 'Ø', 'Φ' and 'φ' are not used in French, which is spoken by the relevant public, with the result that, from the point of view of that public, those letters belong to foreign languages.
- 39 It should be borne in mind that, according to case-law, knowledge of a foreign language cannot, in general, be assumed (see, to that effect, judgment of 13 September 2020, *Inditex v OHIM – Marín Díaz de Cerio (OFTEN)*, T-292/08, EU:T:2010:399, paragraph 83).
- 40 In that regard, it must be held that, in principle, the correct pronunciation of the letters of the alphabet in a foreign language and knowledge of the existence of a letter of the alphabet specific to that language come under knowledge of that language and likewise cannot, therefore, be assumed.

- 41 As regards the pronunciation by the relevant public of a word belonging to a foreign language, the Court has held that it is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in his own language. First, it is far from certain that the word will be recognised as being foreign. Secondly, even when the word is recognised as being foreign, it may not be pronounced in the same manner as in the original language. A correct pronunciation as in the original language presupposes not only knowledge of that pronunciation, but also the ability to pronounce the word in question correctly. Thirdly, in the assessment of the likelihood of confusion, it will still be necessary to establish that a majority of the relevant public has that ability (see, to that effect, judgment of 1 February 2005, *SPAG v OHIM – Dann and Backer (HOOLIGAN)*, T-57/03, EU:T:2005:29, paragraph 58).
- 42 Those considerations are also relevant so far as concerns the pronunciation of letters which do not exist in the languages understood by the relevant public.
- 43 In the present case, the applicant accepts that it is ‘most likely true’ that the relevant public defined by the Board of Appeal does not understand Danish, Bulgarian or Greek. However, it has adduced no evidence establishing that the relevant public would verbalise the signs at issue, let alone how.
- 44 Therefore, the applicant’s argument relating to the different pronunciation of the signs at issue by the relevant public with no knowledge of Bulgarian, Danish or Greek must be rejected.
- 45 It is also necessary to reject the applicant’s argument that the relevant public identifies, first, the letter represented by the mark applied for as appearing in the Danish alphabet, as meaning ‘island’ in that language and as having a meaning in the ‘Scandinavian languages’ and, second, the earlier mark as representing a letter used in Greek and Bulgarian. That argument seeks to establish the existence of a conceptual difference between the signs at issue, but is irrelevant as regards the phonetic comparison of the signs.
- 46 It follows that the Board of Appeal did not make an error of assessment in finding that, having regard to the perception of the relevant public, no phonetic comparison of the signs at issue is possible.
- 47 As regards the conceptual comparison of the signs at issue, the applicant disputes the Board of Appeal’s conclusion that such a comparison is not possible. In that regard, it infers from the argument referred to in paragraph 44 above that the relevant public will recognise the signs at issue as being two letters from different foreign languages. It adds that the letter ‘Ø’, represented by the mark applied for, has other meanings understood by consumers across the European Union. First, that letter is understood as a mathematical symbol for the number 0. In that regard, it submits that it uses the letter ‘Ø’ in its marketing strategy and in other trade marks of which it is the proprietor, such as ZERØGRAND, ØRIGINALGRAND, GRANDPRØ and GRAND.ØS, to replace both the letter ‘o’ and the number 0. It would not use the letter ‘Ø’ in that way if it considered that the relevant public could not recognise it as replacing the letter ‘o’ or the number 0. Secondly, that letter is understood as a symbol for the diameter of an object. In support of that claim, the applicant has produced screenshots of extracts from a furniture manufacturer’s catalogue, of which more than 200 million copies are published each year and which contains numerous examples of the letter ‘Ø’ being used to designate the diameter of an object. It infers from this that the signs at issue are conceptually different.

- 48 The Board of Appeal stated that, for the majority of the French-speaking public, which does not understand Bulgarian, Danish or Greek, the earlier sign has no meaning, from which it concluded that no conceptual comparison of the signs at issue is possible. It added that the fact that part of that public would perceive the signs at issue as being letters from the Danish, Bulgarian or Greek alphabets was irrelevant and that the mark applied for would not be perceived by the majority of the French-speaking public as the mathematical symbol ‘zero’ or as the symbol for the diameter of an object.
- 49 As was pointed out in paragraph 39 above, knowledge of the existence of a letter of the alphabet specific to a foreign language cannot be assumed.
- 50 It is clear that the applicant has produced no evidence capable of showing that the French-speaking public with no knowledge of Danish, Bulgarian or Greek would recognise the mark applied for as a representation of a letter used in Danish and the earlier mark as representing a letter used in Greek and Bulgarian. In that regard, the spelling of the intervener’s name coupled with the use of that name as a shop sign in France does not prove that the letter ‘Ø’ is understood in the way alleged by the applicant. Moreover, it is clear that, as EUIPO correctly states, the claim of that use is substantiated by a screenshot of a website, submitted as Annex A.5 to the application, which the applicant produced for the first time before the Court. However, such evidence must be rejected as inadmissible and there is no need to examine it (see, to that effect, judgment of 14 May 2009, *Fiorucci v OHIM – Edwin (ELIO FIORUCCI)*, T-165/06, EU:T:2009:157, paragraph 22 and the case-law cited).
- 51 In addition, the applicant has likewise not proved that the relevant public would understand the mark applied for as meaning ‘island’ in Danish.
- 52 As regards the relevant public’s supposed understanding of the letter ‘Ø’ as designating the number 0 in mathematics, that claim is substantiated only by the applicant’s assertions relating to its use of that letter in trade marks of which it is the proprietor. Since those assertions do not relate to the letter ‘Ø’ in isolation, they are irrelevant for the purposes of establishing the meaning of that letter for the public, even if such use were proved.
- 53 As regards the relevant public’s supposed understanding of the letter ‘Ø’ as designating the diameter of an object, that claim is, as EUIPO correctly states, substantiated in the present action only by evidence produced for the first time before the Court, namely Annexes A.7, A.8 and A.9 to the application. In accordance with the case-law referred to in paragraph 50 above, such evidence is inadmissible.

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Costs

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- 63 Since the intervener has not applied for costs against the applicant, it must be ordered to bear its own costs, in accordance with Article 138(3) of the Rules of Procedure.

64 As regards the applicant's claim that the intervener should be ordered to pay the costs relating to the proceedings before the Opposition Division and the Board of Appeal, it is sufficient to note that, since the present judgment dismisses the action brought against the contested decision, paragraph 2 of the operative part of that decision continues to govern the costs incurred in the opposition proceedings and in the appeal proceedings before EUIPO (see, to that effect, judgment of 19 October 2017, *Aldi v EUIPO – Sky (SKYLITe)*, T-736/15, not published, EU:T:2017:729, paragraph 131).

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Cole Haan LLC to bear its own costs and to pay those incurred by the European Union Intellectual Property Office (EUIPO);**
- 3. Orders Samsøe & Samsøe Holding A/S to bear its own costs.**

Spielmann

Öberg

Mastroianni

Delivered in open court in Luxembourg on 14 July 2021.

[Signatures]