

World Trademark Review Daily

**Word element with low level of distinctiveness not necessarily negligible Examination/opposition
European Union - Bureau DA Casalanga-Josse International procedures**

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In *Lan Airlines SA v Office for Harmonisation in the Internal Market* (OHIM) (Case T-194/09, February 8 2011), the General Court has upheld a decision of the Fourth Board of Appeal of OHIM in which the latter had held that there was no likelihood of confusion between the word mark LINEAS AEREAS DEL MEDITERRANEO LAM for transportation services in Class 39 of the [Nice Classification](#) and the following earlier Community trademarks:

- the word mark LAN for services in Classes 35, 39 and 43; and
- the figurative mark LAN for services in Class 39.



The Fourth Board of Appeal had concluded that there was no likelihood of confusion between the marks on the part of the average European consumer, who constitutes the relevant public, since, despite the identity of the services, the marks assessed as a whole were not similar.

The court, contrary to the opponent's argument, considered that the element 'LAM' in the mark applied for was not dominant. In this respect, the court held that although, as a general rule, the public will not consider a descriptive element forming part of a mark as the distinctive and dominant element in the overall impression produced by that mark, the fact remains that the low level of distinctiveness of an element does not necessarily mean, when its size or position is taken into account, that this element is negligible in the overall impression produced by the mark.

In this respect, the Board of Appeal had considered that the element '*lineas aéreas del mediterraneo*' was likely to hold the attention of all the relevant consumers, whether or not they were Spanish speakers, due to the fact that:

- firstly, such element is significantly larger than the element 'LAM'; and
- secondly, it was immediately perceptible because of its position at the beginning of the sign.

In this respect, the opponent maintained that it was apparent from case law that there were exceptions to the principle that the attention of the average consumer is drawn to the beginning of the mark. However, this argument was rejected, since the opponent did not put forward any specific evidence to support the view that the board's assessment was erroneous in this case.

Therefore, the court concluded that the element '*lineas aéreas del mediterraneo*' could not be considered to be negligible in the overall impression produced by the mark applied for in the minds of the consumers, regardless of whether they were Spanish speakers.

The court noted that, while the earlier marks were made up of a single word element comprising three letters, and the earlier figurative mark also included a stylised star, the mark applied for was made up of the word elements '*lineas aéreas del mediterraneo*' and 'LAM', comprising a total of 30 letters. Consequently, as the board had rightly noted, the marks at issue, assessed overall, differed not only in the number of words they comprised, in their structure and in their length, but also in their sound. Hence, the opponent's argument that the marks were visually and phonetically similar was rejected.

As a result, the General Court dismissed the action and confirmed the board's decision that the marks, assessed overall, were different in view of:

- first, their visual and phonetic differences; and
- second, their conceptual difference for that section of the relevant public which is Spanish speaking,

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or of their lack of meaning for that section of the public which is not Spanish speaking.

The above conclusion was not affected by the opponent's argument that the board had failed to examine the reputation of the earlier marks - the reputation of an earlier mark must be taken into account in the assessment of the likelihood of confusion once the similarity between the marks has been established, and not in order to establish such similarity.

The decision is in line with the general criteria applied by the Court of Justice of the European Union in order to establish the existence of a likelihood of confusion between two marks.

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