General Court upholds Louis Vuitton's opposition in CALIFORNIA DREAMING case

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- **The EUIPO found that there was a likelihood of confusion between a figurative mark including the words 'California dreaming' and Louis Vuitton's earlier mark CALIFORNIA DREAM**
- **The General Court confirmed that the stylisation of the words and their presentation on three lines in the contested sign were unlikely to hold the relevant public's attention**
- **The signs were conceptually similar to a high degree as they referred to the same concept of 'dream' or 'dreaming of California'**

On 11 October 2023 the General Court (First Chamber) issued its decision in ***Martin Rodrigo v European Union Intellectual Property Office*** (EUIPO) (Case T-542/22).

Background

On 13 April 2020 Andres Carlos Martin Rodrigo('the applicant') filed an EU trademark application for the following sign in Classes 3, 14, 18, 25, 35, 43 and 44:

CALIFORNIA
Dreaming
by Made in California

On 10 September 2020 Louis Vuitton Malletier filed a partial opposition against the goods and services in Classes 3, 35 and 44 pursuant to Article 8(1)(b) of **Regulation 2017/1001** based on the earlier Benelux mark CALIFORNIA DREAM (No 1412180) for goods in Class 3. The opposition was partially accepted.

The applicant appealed. The Board of Appeal of the EUIPO dismissed the appeal in its entirety, considering that there was a likelihood of confusion since the signs in question were visually and phonetically similar to an average degree, were conceptually similar to a high degree, and covered goods and services that were similar or identical to varying degrees.

The applicant appealed to the General Court, which upheld the Board of Appeal's decision.

General Court decision

The court reviewed the Board of Appeal's findings regarding the similarity of the goods and services and the similarity of the signs, which served as a basis for concluding that there was a likelihood of confusion.

Comparison of the goods and services

With respect to the contested goods in Class 3, the court held that they were either identical or similar to various degrees to those protected by Louis Vuitton's earlier mark, which was not contested by the applicant.

Regarding the contested retail and wholesale services in Class 35, the court, applying established case law, concluded that such services were similar at least to a low degree to the goods in Class 3 protected by the earlier mark, since they were indispensable to, or at the very least, important for the provision of such services.

Finally, with respect to the Class 44 services, the court considered that they were similar to a low degree to the Class 3 goods protected by the earlier mark, as they have the same purpose, end users and distribution channels.

Comparison of the signs

First, the court considered that the dominant and distinctive elements of both signs were the words 'California dream' in the earlier mark and 'California dreaming' in the contested mark, since the terms 'by Made in California' were presented on a third line in small characters and, thus, occupied a secondary position.

In respect of the visual comparison, the court considered that the stylisation of the words and the presentation on three lines in the contested sign were unlikely to hold the attention of the relevant public. Indeed, it considered that the graphic aspect of the contested sign was purely ornamental and, therefore, could not have a significant impact on its overall impression. Thus, the court confirmed that the signs were visually similar to an average degree.

In respect of the phonetic comparison, the court considered that the signs were very similar for the public omitting the expression 'by Made in California', or similar to an average degree for the public pronouncing this expression.

Finally, in respect of the conceptual comparison, the court confirmed that the signs were conceptually similar to a high degree as they referred to the same concept of 'dream' or to the fact of 'dreaming of California', even though the word element 'by Made in California' in the contested sign might refer to an additional concept of an indication of business origin.

Likelihood of confusion

Based on the above, the court confirmed the Board of Appeal's holding that there was a likelihood of confusion on the part of the relevant public pursuant to Article 8(1)(b) and dismissed the appeal.

Comment

The decision confirms that a figurative trademark consisting of stylised words with a multi-line presentation is not sufficient to give an overall different impression and distinguish it from a word mark consisting of identical and similar terms. It also emphasises the importance of the conceptual similarity between signs, which, in this case, outweighed the average degree of visual and phonetic similarity.

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