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OHIM decision annulled for failure to take account of all relevant consumers

European Union - Bureau DA Casalonga-Josse

**Examination/opposition
International procedures**

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In *Coin SpA v Office for Harmonization in the Internal Market (OHIM)* (Case T-249/08, April 21 2010), the General Court has annulled a decision of the Board of Appeal of OHIM in which the latter had found that there was no likelihood of confusion between the word mark FITCOIN and earlier figurative marks containing the word 'coin'.

Coin SpA opposed an application for the registration of the word mark FITCOIN as a Community trademark (CTM) in Classes 16, 25, 28, 35, 36 and 41 of the [Nice Classification](#). The opposition was based on a number of earlier figurative marks all containing the word element 'coin', including:

- a CTM registration;
- several Italian registrations; and
- an international registration that was valid in a number of EU member states.

The Opposition Division of OHIM rejected the opposition, restricting its analysis to the likelihood of confusion between the FITCOIN mark and the earlier international registration. It took the view that, even if the goods and services covered by the mark applied for were identical, or similar, to those covered by the prior mark, the marks were dissimilar visually and phonetically, and had no meaning conceptually. Therefore, any risk of confusion was excluded.

Coin appealed to the Board of Appeal of OHIM, which dismissed the appeal. For its analysis of the similarity between the marks and the likelihood of confusion, the board took into account only the Italian figurative marks as earlier rights. With regard to the comparison of the marks, the board found that there was a low degree of visual similarity and a manifest phonetic difference. Further, it held that a conceptual comparison between the marks was not possible, since the words 'coin' and 'fit' have no meaning for the majority of Italian consumers. The board concluded that, based on a global assessment, the marks were dissimilar and, therefore, there was no likelihood of confusion within the meaning of Article 8(1)(b) of the [Community Trademark Regulation](#) (40/94). Coin appealed.

The General Court annulled the board's decision. The court first held that the board had erred in concluding that there was no likelihood of confusion between the marks by confining itself to an analysis of the similarity of the signs and likelihood of confusion in relation solely to the Italian public, without taking into account:

- the average consumer of the European Union with respect to the goods and services protected by the earlier CTM; and
- the average German, Spanish, Hungarian and Slovenian consumers with respect to the goods and services covered by the earlier international registration.

The court considered that, by taking into account only the Italian marks, and by finding that there was no likelihood of confusion on this basis alone (even though Coin had, in support of its opposition, also invoked earlier marks protected outside of Italy for goods and services which were essentially identical to those covered by the earlier Italian marks), the board had breached Article 8(1)(b) of the regulation.

The court further held that this conclusion could not be brought into question by OHIM's argument that the approach taken by the board (ie, assessing the likelihood of confusion in relation only to Italian consumers) should be upheld on the grounds that a comparison of the marks from the point of view of the other relevant consumers would not alter the conclusion regarding the similarity of the marks and the likelihood of confusion. According to the court, it could not be ruled out that a full examination in relation to all the relevant consumers might alter that conclusion.

The decision of the General Court should be welcomed, as it supports the rights of trademark owners. The decision requires that OHIM take into consideration all the prior rights upon which an opposition is based and, consequently, analyze the likelihood of confusion in all relevant territories.

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