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General Court: Board of Appeal erred in assessing distinctive and dominant character of first name and surname making up trademark

European Union - [Bugnion SpA](#)

- Higicol opposed registration of ANDREA INCONTRI in Class 3 based on earlier ANDREIA marks also in Class 3
- Board of Appeal found that 'Andrea' and 'Incontri' elements are co-dominant in overall impression of mark applied for, irrespective of whether they are perceived as first name and surname
- General Court held, among other things, that board had failed to consider whether first name 'Andrea' and surname 'Incontri' were common or rare

In [Andrea Incontri Srl v European Union Intellectual Property Office](#) (EUIPO) (Case T-197/16), the General Court has annulled the decision of the Fourth Board of Appeal of the EUIPO of 25 February 2016 in opposition proceedings between Higicol SA and Andrea Incontri Srl.

Background

On 3 April 2013 Higicol filed an opposition against the EU trademark application for ANDREA INCONTRI claiming protection for goods in Class 3, based on a likelihood of confusion with its earlier ANDREIA marks for goods in Class 3. The Opposition Division of the EUIPO upheld the opposition for nearly all the contested goods.

Applicant Andrea Incontri filed an appeal. On 25 February 2016 the Fourth Board of Appeal of the EUIPO dismissed the appeal on the ground that the goods were identical and that:

the words of which the mark applied for was comprised, irrespective of whether or not they were perceived as a first name and a surname, had no meaning in relation to the contested goods and were co-dominant in the overall impression produced by the mark applied for.

The applicant headed to the General Court, claiming that the Board of Appeal had erred in confirming that there was a likelihood of confusion between the marks at issue.

General Court decision

In its decision, the General Court focused mainly on the comparison of the signs and on the relevance of each element of a trademark that is composed of a first name and a surname.

The court first recalled that, according to the relevant case law, account must be taken of whether the name and surname at issue are common or rare, since this factor will be relevant in the assessment of the distinctive character of each element of the mark.

In addition, the court held that the Board of Appeal had only envisaged two opposite hypotheses (ie, 1) the relevant public perceives the words 'Andrea' and 'Incontri' as a first name and a surname; and 2) the relevant public does not perceive these elements as a first name and a surname), without making a decision on

which of these hypotheses was correct. The board had merely stated that, in both cases, the word elements at issue were co-dominant, on the ground that they had no meaning in relation to the goods concerned.

In particular, the court stated in Paragraph 47:

[The Board of Appeal] failed to have regard to whether the first name 'Andrea' and the surname 'Incontri' were common or, on the contrary, rare, even though the applicant had claimed in the administrative proceedings that the 'andrea' element was a common first name and the 'incontri' element was rather a rare surname.

Had the Board of Appeal conducted such assessment, it might have correctly considered the distinctive and dominant character of the word elements 'Andrea' and 'Incontri' in the hypothesis under which they are perceived as a name and surname by the relevant consumers, concluding that the word 'Andrea' was of lesser distinctiveness than 'Incontri'.

As a consequence, as stated in Paragraph 58:

[A] finding that the 'andrea' element was less distinctive than the 'incontri' element could have had an effect on the visual, phonetic and conceptual comparisons of the marks at issue and, consequently, altered the global assessment of likelihood of confusion.

The General Court thus sent the case back to the Board of Appeal, recommending that the latter make a decision relating to the hypothesis under which the word elements would be perceived as a first name and surname by the relevant consumers, taking into account all the relevant factors highlighted in the decision.

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