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# Conceptual dissimilarity cannot counteract visual/aural similarity if one mark has no clear meaning

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**European Union** - Dr Helen Papaconstantinou John Filias & Associates

In *Alpinestars Research Srl v Office for Harmonisation in the Internal Market* (OHIM) (Case T-521/13), the General Court has annulled a decision of the Fourth Board of Appeal of OHIM rejecting Alpinestars Research Srl's opposition against the registration of the stylised trademark A ASTER (depicted below).



The court held that, contrary to the findings of the Board of Appeal, there was a likelihood of confusion between the mark A ASTER and the earlier word mark A-STARs.

On July 23 2008 Mr Kean Tung Cho and Mr Ling-Yuan Wang Yu applied for the registration as a Community trademark of the stylised sign A ASTER for goods in Classes 18 and 25 of the Nice Classification. Alpinestars opposed the application based on its earlier Community word mark A-STARs, covering goods in the same classes.

The Opposition Division of OHIM rejected the opposition. This decision was upheld by the Fourth Board of Appeal of OHIM, which opined that there was no likelihood of confusion between the two marks based mainly on the following conclusions:

- The goods covered by the two marks were identical.
- There was a low degree of visual and aural similarity between the marks.
- It was not likely that consumers would perceive the two marks as conceptually similar, despite the fact that their common origin was the (ancient) Greek word 'αστήρ', meaning 'star'.
- The types of goods belonging to Classes 18 and 25 are normally chosen following a visual inspection, which implied that the visual comparison was the most important factor in the comparison of signs.

- The inherent distinctiveness of the A-STARs mark was normal and Alpinestars had not claimed that the mark had become particularly distinctive due to its intensive use or reputation.

Alpinestars filed an action against the decision of the Board of Appeal.

The General Court first proceeded to make a visual comparison of the two signs. The court, contrary to the findings of the Board of Appeal, concluded that there was at least a normal degree of similarity between the trademarks at issue. In particular, the court pointed out that the word element 'aster' of the opposed trademark was the dominant feature thereof and made an immediate impression on the relevant public - the decorative element in the form of an arrow on top of it being of lesser importance. The court thus compared the word elements 'aster' and 'A-STARs' and concluded that the slight differences between them could not outweigh their similarities, especially in the initial part of the two words - which, in accordance with established case law, is the part to which the public generally pays more attention.

Turning to the phonetic comparison of the marks, the court again disagreed with the Board of Appeal. The court concluded that there was a high degree of phonetical similarity between the two marks, taking the following into consideration:

- the vowel 'A' in the form of an arrow on top of the opposed mark was a stylised element that stood independently and, therefore, it was unlikely that consumers would pronounce it when referring to the mark;
- the presence of the hyphen at the beginning of the earlier mark could play a significant role, since although the English-speaking part of the public would pronounce A-STARs as two elements, this might not be the same for non-English-speaking consumers; and
- the difference between the endings of the two marks was not sufficient to affect the overall aural impression of the marks.

Turning to the assessment of the conceptual similarity, the General Court observed as follows:

- The Board of Appeal had erred in finding that at least non-English-speaking consumers would understand the element 'stars' in its secondary meaning of 'persons of brilliant reputation or talent', and not in its primary meaning of

'stars'. Even if the mark A-STARS were perceived either as a laudatory term emphasising the quality of the covered goods or as referring to a star or a famous person, it was incapable of directly conveying a clear meaning to consumers, given the very remote link between the possible meanings of the word 'stars' and the goods in Classes 18 and 25.

- The fact that, in most EU languages, the word used for 'star' derives from Greek or Latin does not mean that the related public, the majority of which does not have any knowledge of Greek or Latin, will perceive the mark at issue as meaning 'star' - especially as, in many EU languages, the word 'aster' refers to a kind of a plant.
- As regards the Greek public in particular, it was not likely that it would associate the modern word 'αστέρι' ('asteri' in transliteration) with the ancient Greek word 'αστήρ' ('astér' in transliteration) and thus attribute the specific meaning of 'star' to the element 'aster' of the mark applied for.

Consequently, the General Court concluded that there was no conceptual similarity between the two marks.

Finally, the court stressed that, when it comes to conceptual differences, it is necessary, for conceptual differences between two signs to be capable of counteracting phonetic and visual similarities between the marks at issue, for at least one of the signs to have a clear and specific meaning for the relevant public, so that that public is capable of grasping it immediately. In this case, however, the earlier mark was not capable of conveying a clear meaning to the relevant public and, therefore, the conceptual dissimilarity between the marks could not counteract the visual and aural similarity between them. As a result, these similarities prevailed and there was a likelihood of confusion between the two marks, contrary to the conclusions of the Board of Appeal.

Consequently, the General Court annulled the decision of the Board of Appeal.

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