

**General Court finds likelihood of confusion between FRANCE.COM and French Republic's earlier FRANCE mark**  
European Union - Granrut Avocats

**Examination/opposition  
Confusion  
International procedures**

July 11 2018

- **French Republic opposed figurative mark FRANCE.COM based on earlier figurative mark FRANCE**
- **Board of Appeal and General Court found that there was likelihood of confusion due to high degree of phonetic and conceptual similarity**
- **Court dismissed applicant's argument that it had operated 'www.france.com' for 21 years**

In *France.com Inc v EU Intellectual Property Office* (EUIPO) (Case T-71/17, 26 June 2018), the General Court has upheld the decision of the First Board of Appeal of the EUIPO.

## Background

An individual applied for the registration of a figurative trademark consisting of an hexagon containing a stylised Eiffel tower and the word element 'FRANCE.com' in Classes 35, 39 and 41. The hexagon is the way French people represent the territory of metropolitan France. The mark was transferred to a company called France.com Inc, located in Florida, United States, before the decision of the Opposition Division.

The opponent was the French republic, on the basis of an international registration designating the European Union and consisting of a stylised Eiffel tower with the word 'France' below. This mark covered Classes 9, 35 and 41.

The opposition was rejected and the decision was appealed. The Board of Appeal overruled the Opposition Division's decision. The Board of Appeal considered that:

- the relevant public consisted of both consumers and professionals;
- the relevant public had a level of attention between average and high; and
- the likelihood of confusion should be assessed for the whole of the EU territory.

The board nevertheless agreed with the Opposition Division that the services were partly identical and partly similar.

Concerning the comparison of the signs, the board decided that they had an average degree of visual similarity due to their structure and common elements, even if the designs were different. Phonetically, the signs were identical since the word 'France' is the only word in the earlier mark and is central in the opposed mark. Conceptually, the signs were identical since both referred to France and included the Eiffel tower. Therefore, the signs were highly similar and a likelihood of confusion could not be excluded.

The decision was appealed.

## Decision

### **Procedural defences**

The applicant raised some imaginative procedural defences.

The first one was to request that the General Court refer certain questions to the Court of Justice of the European Union (CJEU) for a preliminary ruling. The General Court's answer was easy and harsh: the preliminary ruling system creates a cooperation between the national courts and the CJEU, and not between the various parts of the CJEU.

The second was to claim that the brief filed by the French republic was signed by individuals who were not authorised to act on behalf of the republic and was not in English, the language of the case. The court answered that the opponent, being a member state, was represented by its agents, who were recognised by the court as agents of that member state, and that a state is authorised to use its own language.

The procedural defences were thus rejected as inadmissible.

### **Substance**

The applicant's first claim was that the Board of Appeal had not taken into consideration the existence of

the applicant's prior rights. The court answered that the only rights to be taken into consideration were the mark applied for and the earlier mark. The court implicitly stated that the applicant could have tried to use its prior rights to oppose the filing made by the French Republic when this was possible.

The second - more classic - claim concerned the comparison between the signs. The applicant did not dispute the board's assessment of the relevant public or of the similarities of the services.

The applicant claimed that the word 'France' should not have been separated from the other elements. However, the court held that the board had found that, in the marks at issue, the stylised images of the Eiffel tower were as important as the word 'France'. In addition, the court recalled that, based on case law concerning the mark MONACO ([Case T-197/13](#), 15 January 2015), a mark corresponding to the abridged name of a state - here, 'France' was considered as the abridged name of the 'French Republic' - was descriptive of the products and services concerned. It further recalled that, when certain parts of a mark are descriptive of the products or services, they are only weakly distinctive. However, that did not mean that they were negligible and could not constitute the dominant part of a sign. The court also stressed that, generally, the average consumer will remember the word part of a sign more easily than the figurative part.

The court took all those points into consideration to carry out the visual, phonetic and conceptual comparison of the signs.

Concerning the visual comparison, the board had found that the overall impression conveyed by the signs was that of the word 'France' with a stylised Eiffel tower and the colours blue, white and red, and that, due to the size of the Eiffel tower and its positioning, this element was as important as the word element. The court recalled that the fact that the signs included similar verbal elements did not suffice to find that there were visually similar; further, when there is no clearly dominant element, it is the overall impression which must be taken into consideration. Having compared the verbal part of the signs, the court concluded that the visual similarity was weak.

Concerning the phonetic comparison, the board had decided that the signs were almost identical. The court recalled that this part of the comparison did not include the figurative elements and the earlier mark could not be read as 'Eiffel tower-France' or 'tour Eiffel-France'. Therefore, the court held that the signs were almost identical phonetically.

Concerning the conceptual comparison, the Board of Appeal had found that the signs were identical since they both referred to France and to the image of the Eiffel tower; the use of '.com' did not modify this conclusion. This was confirmed by the General Court, since 'France' refers to the French Republic, the Eiffel tower is associated with France and the hexagon refers to the shape of the country. The addition of '.com', which suggests that the products can be bought on the Internet, was not sufficient to have an impact on the conceptual identity.

With regard to the likelihood of confusion, the court recalled its general case law concerning the interdependence between the factors to be taken into account. Since the identity or similarity of the services was not discussed, and due to the high degree of phonetical and conceptual similarity, there was a likelihood of confusion, even if the earlier mark had a weak distinctive character.

Concerning the applicant's last argument that it had exploited the website 'france.com' for 21 years, the court recalled that the reputation of a mark is taken into consideration to examine the likelihood of confusion only as far as the earlier mark is concerned.

Therefore, there was a likelihood of confusion and the case was dismissed.

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