

LIKELIHOOD OF CONFUSION UNDER TRADE MARK LAW FOR COMPOSITE WORD MARKS - FCJ I ZB 80/19 - YOOFOOD/YO

How is the likelihood of confusion assessed if one of the opposing trademarks is a composite trademark consisting of a distinctive and a purely descriptive word element? This was recently decided by the Federal Court of Justice in its decision of 9 July 2020 (Case No. I ZB 80/19).

The dispute started with the trademark application "YOOFOOD" in 2005. A retailer filed the application with the German Patent and Trademark Office (GPTO) for various foodstuffs in classes 29, 30, 31 and 32. The owner of the wordmark "YO", registered for goods in classes 29 and 30, filed an opposition. The GPTO rejected this opposition because it denied a likelihood of confusion.

The appeal against this decision filed with the Federal Patent Court (FPC, decision of 10.8.2019, ref. 28 W (pat) 591/17) was also unsuccessful. In its decision, the FPC stated that the younger trademark "YOOFOOD" in its entirety was clearly distinguishable from the opposing trademark in every direction of perception. There were also no sufficient indications that the public would regard the word syllable "YO" of the contested trademark as a separable element that would characterize the overall impression because of the descriptive content of the other syllable "FOOD".

The FPC had assumed a phonetic approximation. The domestic public would pronounce the word syllable "YOO" primarily like "JOO". The additional syllable "FOOD", however, clearly distinguished the contested mark from the short word "YO", according to the FPC. There were no sufficient indications that the public would regard the word syllable "YOO" as a separable element – at least theoretically – which would characterize its overall impression because of the descriptive content of the additional syllable "FOOD". Such a special circumstance could not be seen in the fact that the word syllable "FOOD" was merely descriptive in the present case. The word syllable "FOOD" appears to be a dependent part of an overall term due to its concrete integration into the contested trademark. The external unity of a one-word sign would create a considerable bracket effect. An independent character within a one-word mark is only accorded to descriptive terms which merely express an already obvious circumstance, for example which specifically designate the product designated by the mark (such as "rice" or "juice"). However, in the case of a generic term such as the term "FOOD", an intellectual division is more likely. The specific design of the mark also argued against a separate selection of the two word syllables "YOO" and "FOOD". Due to the vowel pairs "OO", they had a symmetrical structure, which would remain the same even if they were written in lower case.

DECISION OF THE FCJ

The Federal Court of Justice concluded that there was a likelihood of confusion between the signs "YOOFOOD" and "YO" under trademark law and opposed the assessment of the FPC insofar as it considered the assumption that the mark was not characterized by the first syllable "YOO" to be erroneous in law. The Federal Court of Justice decided that there was a lack of findings with regard to the assessment of the overall impression of the trademark in the present case.

In the opinion of the FCJ, it does not appear excluded that in the case of a one-word sign composed of a distinctive ("YOO") and a purely descriptive ("FOOD") word element, which does not form an overall concept with a recognisable (new) meaning, the distinctive word element characterizes the sign because the other

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sign element can be neglected in the specific case as a mere factual reference.

The Federal Court of Justice considers the FPC's finding that the assumed bracket effect due to the vowel pairs "OO" is only given from a visual point of view to be erroneous in law. It points out that when the trademark is perceived acoustically, neither the vowel pairs of the challenged trademark can be perceived, nor the symmetry of the sign emphasized by the FPC is recognizable to the public. The phonetic perception due to the different pronunciation of the first word syllable ("YOO") compared to the second word syllable ("FOOD") speaks against a bracketing symmetry which can exclude the independence of the first word syllable within the one-word sign. Furthermore, it was not recognisable from a phonetic point of view whether the contested mark "YOOFOOD" was a one-word sign with a resulting bracket effect or whether the sign consisted of two words, possibly connected by a hyphen.

Furthermore, the Federal Court of Justice pointed out that, when examining whether the word element "YOO" characterizes the challenged trademark, the Federal Patent Court did not consider the empirical principle that the beginning of a word may be more relevant than the subsequent word elements because the public generally pays more attention to the beginning of a word sign. Ultimately, the Federal Court of Justice thus found a likelihood of confusion under trademark law between the dominant element "YOO" of the challenged trademark and the earlier trademark "YO".

The decision of the Federal Court of Justice once again puts the focus on the principle that in the assessment of the likelihood of confusion of composite word marks, the distinctive and dominant word elements are of particular importance. It shows once again that the assessment of whether an element within a composite sign has a dominant meaning always remains a case-by-case decision despite established principles of experience and case law and can also always be assessed differently.

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