**General Court finds 'CHIARA FERRAGNI' not confusingly similar to 'CHIARA'**

General Court, *Serendipity Srl and Others v EUIPO*, T-647/17, EU:T:2019:73, 8 February 2019

In this decision the General Court (GC) reversed the earlier decisions of the EUIPO Opposition Division and the Fourth Board of Appeal, and held that the sign ‘CHIARA FERRAGNI’ that the applicant wished to register as an EU trade mark (EUTM) was not confusingly similar to the opponent’s ‘CHIARA’ Benelux trade mark.

**Legal context and facts**

In 2015, Serendipity Srl, a company of which fashion blogger and entrepreneur Chiara Ferragniis a member, filed an application with the EUIPO to register the sign below as an EUTM for a variety of goods in classes 18 and 25:



The application was opposed in accordance with Article 8(1)(b) of the EU Trade Mark Regulation 207/2009 (EUTMR; now Article 8(1)(b) of EUTrade Mark Regulation 2017/1001) by a Dutch company that holds an earlier Benelux word trade mark, 'CHIARA', also registered in Class 25.

The EUIPO Opposition Division decided in favour of the opponent in respect of certain goods in Class 18 and for all goods claimed in Class 25, on grounds that likelihood of confusion would subsist between the 'CHIARA' and 'CHIARA FERRAGNI' signs.

The applicants unsuccessfully appealed the decision to the EUIPO Fourth Board of Appeal, but without success. The Board found in fact that the signs were visually similar to an average extent and phonetically similar above average. The conceptual similarity was ‘neutral’. The Board also found that ‘CHIARA’ possessed a ‘normal’ intrinsic distinctiveness.

A further appeal to the GC naturally followed.

**Analysis**

Having noted that no issues subsisted as regards the identification of the reference public and the fact that the goods covered by the marks were identical, the GC recalled the general approach that needs to be adopted when assessing similarities between two signs.

With specific regard to the trade mark applied for, the GC held that the figurative element of ‘CHIARA FERRAGNI’ represents an eye that has a peculiar stylization. As such, consumers would perceive it as an elaborate and original element, which may be easily memorized. Hence, it cannot be regarded as merely an ornamental element. In addition, as it does not have any connection with the goods claimed, the figurative element also possesses an intrinsic distinctive character. Furthermore, it being placed above the word element and having a much bigger size than that, it has at least a position of relevance equal to that of the word element. In light of all this, it would be incorrect to conduct the assessment of similarity based only on the word elements of the two signs.
 ***Visual similarity***

Having recalled that word and figurative signs may be compared for a finding of similarity and that the fact that an earlier trade mark is included in its entirety in a later mark hints towards a finding of similarity, the GC stated that the issue was to determine whether any such similarity would be average (as the Board held) or, rather, weak (as the applicants claimed).

The GC found that the figurative element in the ‘CHIARA FERRAGNI’ sign is as important as the word element, and contributes to the overall visual impression thereof. In addition, the element ‘FERRAGNI’ is visually more important than ‘CHIARA’. It follows that the earlier trade mark ‘CHIARA’ and the sign ‘CHIARA FERRAGNI’ should have been considered similar to a low extent.

At this point the GC warned against an ‘automatic’ application of certain criteria established in case law. So, for instance, whilst it is true that in principle the initial part of a sign is more relevant than the final part, this is not always the case. What matters is the overall impression conveyed by the signs at issue, since the average consumer normally perceives a sign as a whole and does not examine the individual elements thereof. In this case, the fact that the element ‘CHIARA’ is placed before ‘FERRAGNI’ cannot exclude that the overall impression conveyed by this sign and the earlier trade mark is similar to a limited extent. Also the idea that the name ‘Chiara’ would sound somewhat “exotic” to the reference public (Benelux) does not make up for the fact that the visual similarity between the signs at issue is weak.
 ***Aural similarity***

Turning to the assessment of the aural similarity, the GC noted that: ‘FERRAGNI’, given its length, is more relevant – aurally – than the element ‘CHIARA’; it cannot be presumed that the element ‘FERRAGNI’ would not be pronounced; one should avoid – once again – any automatism and think that just because ‘CHIARA’ comes before ‘FERRAGNI’, it is more important than this. As such, also the aural similarity between the signs ‘CHIARA’ and ‘CHIARA FERRAGNI’ should be regarded as average if not even low.
 ***Conceptual similarity***

Turning to the final type of similarity, the applicant submitted that ‘CHIARA FERRAGNI’ enjoys a repute that ‘CHIARA’ does not possess, in that it is the name and surname of “fashion blogger Chiara Ferragni, known all around the world as an influential person in the fashion field and already well-known at the time of filing the application to register” (para 63; the translation from Italian is by the author). In support of this, the applicant provided an extract from Wikipedia, a copy of Chiara Ferragni’s Instagram profile and several extracts of publications in the fashion sector in different countries. According to the opponent, this evidence would be insufficient to prove knowledge within the reference public in the Benelux.

To this, the GC responded that, first to those who would not think of ‘Chiara’ as a female name, the word elements of either mark would be devoid of any conceptual meaning; as such, said elements could not be considered similar on a conceptual level. Second, those, who would instead think of ‘Chiara’ as a female name, would also think of ‘Chiara Ferragni’ as a name and surname. Either way, just because the marks contain the same female name, this does not mean that the marks are conceptually similar:“indeed, the trade mark applied for identifies and distinguishes a certain person, that is a person belonging to the Ferragni family, while the earlier trade mark only refers to a name without also identify a certain person” (para 68; again the translation is by the author). In the case at issue, the relevant consumer who was to recognize the term ‘Chiara’ as a name would not think that the earlier trade mark relates to products with the same commercial origin as Chiara Ferragni’s.

It follows that no conceptual similarity would subsist between ‘CHIARA’ and ‘CHIARA FERRAGNI’. This conclusion is further reinforced by the presence, in the latter sign, of a figurative element (the eye) with a very precise semantic content. As such, the Board had erred in considering that the conceptual similarity between the signs would be ‘neutral’.

***Likelihood of confusion***

Coming to the assessment of likelihood of confusion, the GC found that the erroneous conclusion - by the Board - concerning the visual similarity between the signs had also led to an erroneous finding concerning the subsistence of a likelihood of confusion.

The GC concluded that: “despite the existence of an identity or similarity between the products at issue, the differences between the signs, in particular from a visual standpoint, are sufficient to exclude the subsistence of any risk of confusion in the perception of the relevant public.”(para 86, again the translation is by the author)

**Practical significance**

This decision is a useful reminder of how, on the one hand, undertaking the assessment of similarities between signs is not an easy exercise and, on the other hand, one should really avoid applying automatically criteria and principles established in case law and office practice. From reading the judgment, the latter seems to be the main message of the GC: the criteria and principles established to assess similarities should not be intended as a checklist of points to 'tick', but rather as guidance that needs to be tailored and applied carefully in any given case, based on the relevant circumstances at issue.

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