

Mobilix smashes Obelix

Vivien Terrien and David Reingewirtz of WilmerHale analyse the recent development concerning the likelihood of confusion of trademarks

The case

Les Editions Albert René/OHIM;
Case T-336/03
European Court of First Instance
27 October 2005

Has the magic potion lost its effect on Obelix? Undoubtedly successful on the bookstores' shelves, Asterix's publisher, the Editions Albert René, was also quite triumphant in lawsuits to protect its trademarks such as 'Obelix'.

Recently, a German Court of Appeal prohibited the use of the term 'Mobilix' by an Internet website, dedicated to an open source project providing information on Linux and mobile computers, because of the similarities of this word with the 'Obelix' trademark. However, on 27 October 2005, "the sky fell on the publisher's head" when

the Court of First Instance of the European Communities (CFI) rejected the appeal introduced by the Editions Albert René seeking the prohibition of the use of the 'Mobilix' trademark by Orange A/S, a mobile phone company owned by TeliaSonera in Denmark. Although adopted in two different jurisdictions, these contrasted decisions allow some parallels to be drawn in order to shed new light on how a likelihood of confusion between two trademarks can be avoided.

No confusion between 'Mobilix' and 'Obelix'

In 1997, Orange A/S, at that time a Danish subsidiary of France Télécom, filed an application to register the 'Mobilix' sign at the Office for Harmonization in the Internal Market (OHIM). Although the OHIM refused this request for a series of products (inter alia,

signaling and teaching apparatus and instruments), it accepted to register 'Mobilix' for other products such as for data processing and telephony. The Editions Albert René appealed this decision before the CFI, considering that a likelihood of confusion between 'Mobilix' and 'Obelix' could still exist in the mind of the public.

The Court first noted that such a risk "must be assessed globally by reference (...) in particular to the interdependence between the similarity of the signs and that of the goods or services designated." It analyzed then the similarity between the products and services for which the trademark 'Mobilix' was registered and those already protected by the trademark 'Obelix'. Only certain products and services concerning data processing were considered as possibly presenting a similarity. The CFI then looked at the resemblance of the two signs, 'Mobilix' and 'Obelix', from three points of view: visual, aural and conceptual. Finding only a very slight visual similarity at most and a certain aural similarities⁴, it more importantly underlined that "conceptual differences can in certain circumstances counteract the visual and aural similarities between the signs concerned." Noting that the words 'Mobilix' and 'Obelix' have no meaning in any of the official languages of the European Union, the Court found that whilst the term 'Mobilix' may readily be perceived as referring to something mobile or to mobility, the term 'Obelix' will readily be identified by the average consumer with the corpulent character from the comic strip series, widely known throughout the European Union. As this makes the conceptual confusion unlikely in the public mind, the Court concluded that the conceptual differences between the signs 'Mobilix' and 'Obelix' prevented any risk of confusion in the public mind. By doing so, the Court confirmed that the global appreciation of the visual, aural or conceptual similarities of the marks at stake must be based on the "overall impression given by the marks, bearing in mind, in particular their distinctive and dominant components."⁵

Also, the Court, unsurprisingly, rejected the publisher's argument that because of the 'ix' suffix, it is entirely conceivable that the term 'Mobilix' would insinuate itself into the family of trademarks made up of the characters from the Asterix series and that it would be understood as a derivation of the term 'Obelix'. The Court stated that the Editions Albert René could not enjoy an exclusive right of the use of the 'ix' suffix.



However, on 27 October 2005, "the sky fell on the publisher's head" when the Court of First Instance of the European Communities rejected the appeal introduced by the Editions Albert René seeking the prohibition of the use of the 'Mobilix' trademark by Orange A/S, a mobile phone company owned by TeliaSonera in Denmark.



An opposite conclusion would have endangered the registration of new trademarks with the 'ix' suffix.

Cultivating the conceptual differences

This judgment confirms that the mere association that the public might make between two trademarks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion.⁴ The consequences of visual and aural similarities of a sign with an existing trademark are already well known. For instance, the OHIM refused the registration of the sign Idelix because of its strong visual and aural similarities with the trademark Idelix.⁵

The present case puts the emphasis on another similarity that should be avoided, the conceptual one,⁶ and implicitly invites trademarks registrants to take into account the importance of the concept borne by the sign that they propose for registration. However, the conceptual differences between their signs and the earlier trademarks will offset the other similarities, i.e. visual and aural, only if "at least one of the signs at issue [has], from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately." This balanced appreciation is the cornerstone, both at the European and national level, of the courts' reasoning regarding the assessment of the likelihood of confusion between two words signs.

In Germany, a similar case between the two signs 'Mobilix' and 'Obelix' led to the exact opposite conclusion than the present case. Both, the Lower Court and the Appeal Court, found these trademarks as highly similar. However, the judges of the Lower District Court ruled that the conceptual idea of mobility attached to the sign 'Mobilix' counteracted the visual and aural similarities justifying that, before any risk of confusion would occur, the average consumer would understand the differences between both signs. By contrast, the Munich Court of Appeal, which also recognised the existence of the concept of mobility associated with 'Mobilix', considered that the "ix" suffix in 'Mobilix' had emptied the word of its mobility concept. Therefore, it prevented the conceptual differences to counteract the aural and visual similarities since only one concept, the one attached to 'Obelix', remained. Consequently, the German Appeal Court ruled in favour of the famous Gaul's publisher due to the likelihood of confusion prompted by the visual and aural similarities.

This judgment confirms that the mere association that the public might make between two trademarks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion..

On the contrary, the CFI’s judgment clearly recognised the explicit existence of the two respective concepts included in ‘Mobilix’ and ‘Obelix’. Moreover, it found that ‘Obelix’ had such a clear and specific meaning that it was capable of being immediately grasped by the average consumer. As a result, the CFI found that the conceptual differences did counteract the aural and visual similarities and therefore concluded that there was no risk of confusion within the meaning defined by the Court as being “the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings”.⁷

This decision follows the trend observed in the Court’s case law towards the acknowledgement of the better awareness of the European consumer with regard to the signification of marks. If, in an always more consumption-oriented society, the risk of confusion is increased, it is counterbalanced by the faculty of the consumer to be more alert. In the Picasso case, although some aural and visual similarities were found between the words signs Picasso and Picaro, the Court clearly noted that: “the reputation of the painter Pablo Picasso is such that it is not plausible to consider (...) that the sign Picasso as a mark for motor vehicles may, in the perception of the average consumer, override the name of the painter (...).”

Lastly, the Mobilix judgment offers more legal certainty to companies willing to register a sign as a trademark since, by its decision, the Court implies that the clearer and more tailor-made the concept of a brand will be, the easier it will be to justify and defend the absence of confusion with an existing trademark. ☺

- 2 It is worth noting that the beginning of a word sign bears a particular importance in the assessment of the visual as well as the aural comparison. The OHIM and the Court regularly recall that the consumer normally attaches more importance to the first part of words (judgment of the Court of First Instance of 17 March 2004, T-183/02, El Corte Inglés, para. 81: “the attention of the average and normally attentive consumer would firstly and essentially be caught by the initial element.”; CFI decision, 16 March 2005, L’Oréal, T-112/03, para. 70: “as concerns phonetic comparison (...) the beginning of a sign plays an essential part in that regard (...)”).
- 3 European Court of Justice (ECJ) decision, 11 November 1997, Sabel, C-251/95, para. 23.
- 4 CFI decision, 23 October 2002, Oberhauser/OHIM, T-104/01, para. 25.
- 5 OHIM decision 257/2004, 2 February 2004, Les Editions Albert René v. Idelix Software Inc.
- 6 See also, CFI decision, 22 June 2004, Ruiz-Picasso/OHIM (the Picasso case), T-185/02, para. 56: “Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned.”
- 7 ECJ decision, 11 November 1997, Sabel, C-251/95, para. 26.

Notes

- 1 Decision of the Munich Court of Appeal (Oberlandesgericht) of 23 January 2003 (29 U 4096/02), reversing the judgment of the Munich Lower District Court (Landgericht) of 17 July 2002 (21 O 17363/01).

About the author

Vivien Terrien is an associate in the Brussels office of WilmerHale. He graduated from Harvard Law School and practices in European IP law as well as in European and French competition law.



About the author

David Reingewirtz is an associate in the Brussels office of WilmerHale. He graduated from Columbia Law School and practices in European IP law as well as in European and French competition law.



**ATTORNEOS DE LEY
INTELLECTUAL PROPERTY
CORPORATE
AND COMMERCIAL LAW**

VALUE ADDED SERVICES IN ALL ASPECTS OF I.P.

IP and Litigation contacts:

Sergio L. Olivares, Sr.	so@olivares.com.mx
Antonio Belamantán	ab@olivares.com.mx
Luis Schmidt	ls@olivares.com.mx
Sergio L. Olivares, Jr.	sjo@olivares.com.mx
Javier Saucedo	js@olivares.com.mx
César Ramos	cr@olivares.com.mx
José I. De Santiago	jsd@olivares.com.mx
Alejandro Lina	al@olivares.com.mx

Corporate and Commercial Law contact:

Gustavo A. Alcocer	ga@olivares.com.mx
Pablo Luis Ogilvie Jr.	PO (502) 22 22 20 00
Cd. San Ángel	F: (502) 22 22 20 00
Condes, México, D.F.	olivares@olivares.com.mx
México	www.olivares.com.mx