

## Kinder: Sweet victory with the European Court of First Instance

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On 16 May 2012, the European Court of First Instance (CFI) issued its judgment on a dispute involving the well-known mark Kinder and its registered holder, the Italian confectionary company Ferrero (case T 580/10).

The dispute arose in 2002 when a German individual filed an application for the Community trade mark "Kindertraum" in classes 15, 16, 20, 21 and 28. Ferrero challenged the registration by filing a notice of opposition on the grounds of its earlier mark "Kinder" in classes 16 and 28.

In 2009, the OHIM upheld Ferrero's opposition against the registration and that was confirmed by the OHIM's Appeals Commission in 2010. The German applicant had appealed with the CFI on the basis that the sign "Kinder" was merely descriptive for the Italian population, thus could be afforded a narrower scope of protection.

The CFI found in favour of Ferrero and ruled against the registration of the community trade mark. Moreover, the CFI held that the sign Kinder, which is used by Ferrero to distinguish well-known chocolate confectionary worldwide (especially in Italy), has a distinctive character (in Italy at least), which rules out the registration of similar signs that could create a likelihood of confusion.

This decision is in line with the principles consistently established by Italian and European case law in relation to signs with word elements that have a common meaning in a foreign language<sup>1</sup>. The court stated that although "Kinder" is a common word in the German language (meaning 'children'), it nonetheless does not have a descriptive character for the Italian public on the assumption that the majority of Italian consumers do not know what the word means in German.

### **In essence, the grounds for the CFI's decision were twofold:**

- (i) that Kinder has no descriptive value in Italy given that only a limited percentage of the population understands German;
- (ii) that the signs are very similar visually and phonetically so even if the sign were found to be descriptive (thus enjoying a lesser scope of protection), there would have been a likelihood of confusion between the two.

This judgment sheds an interesting light on the CFI's approach regarding the extent to which a foreign word can be afforded trade mark protection. Although it could be argued that the meaning of "kinder" is understandable to non German-speaking people as well, with trade mark matters, it is useful to remember that the benchmark is not an informed user, but the *average consumer*.

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<sup>1</sup> See Court of Justice of the European Union, 9 March 2006, C-421/04.

In a similar case, the Italian Court of Venice (5 July 2007) upheld the validity of an Italian trade mark registration for the word “book” used for a bookcase, on the grounds that the mark had been registered in 1977 and at that time, the use of the English language was limited so the average Italian consumer would unlikely have known the meaning of such a common English word. In this regard, the Italian Courts have consistently taken the view that words commonly used in a foreign language can be lawfully registered as a trade mark if it can be reasonably assumed that they will not be recognised by consumers.

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