


There is not likelihood of confusion between CITI and CITY according to new OHIM ruling Inés Cantero Clivillé

In November 2012, four Decisions from the Opposition Divisions of the OHIM (Office for Harmonization in the Internal Market) rejected the oppositions filed by the multinational financial services corporation Citigroup Inc. and its consumer banking arm Citibank, N.A.

Both companies filed four oppositions contesting the applications of figurative mark “**CITY TRADING**” (no 8 631 871) and word marks “**CITY INDEX**” (no 7 458 094), “**CITY INDEX THE NEXT WAY OF TRADE**” (no 7 518 475) and “**CITY WISE**” (no 8 645 301), filed by City Index Limited, a leading provider of trading services to individuals, which seat in London, making a total of two oppositions per application. Since two oppositions had been entered against each one of the applications and the opponents were economically linked, the Office decided to treat the two oppositions against each one of the cases in one set of proceedings, according to Rule 21(1) of the Commission Regulation (EC) No 2868/95 of 13 December 1995.

Relying on the family of marks CITIBANK, , CITIMONEY, etc, registered both as Community trade marks or as National trade marks, the opponents had claimed basically the existence of Likelihood of Confusion and that the use without due cause of the contested trade marks would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark, which are the grounds set forth in Articles 8(1)(b) and 8(5) respectively, of the Council Regulation (EC) No 207/2009 of 26 February on the Community trade mark.

In spite of the phonetic coincidence between the word “CITY” included in all the applications and the earlier marks (“CITI”), which leads into a phonetic identity and also into a certain degree of visual similarity due to the coincidence in the first three letters of the signs, the oppositions were not upheld, following the practice established by the Second Board of Appeal in the Decision of 25/01/2012 in Case R 467/2011-2, which rejected the appeal filed by Citibank, N.A. and Citigroup Inc. against the ruling on joined oppositions B 1 334 962 and B 1 334 970 of the Opposition Division of 23/12/2010, which refused the opposition against the Community trade mark application.



Decisions from the Boards of Appeal are not binding for the Opposition Division. However, it is clear that for reasons of consistency, the four Divisions of the OHIM decided not to enter into contradictions with the Board's previous Decision.

Without entering into the comparison between the goods and services at stake, whose identity and/or similarity plays an essential role for the purposes of establishing Likelihood of Confusion, the Opposition Division considers in each one of the rulings, that the main point at issue was to establish whether the matching first three letters of the signs under comparison (CIT-) are enough to create confusion in the marketplace, taking into account also the particular layout of the earlier mark that was chosen in the examination of the opposition, because of reasons of procedural economy.

The cornerstone argument in the section of the Global Assessment of the four cases is based on the importance of the different ending letters (“I” and “Y”) of the word “CITI” in the earlier mark and “CITY” in the contested applications, since not only from the conceptual point of view but also visually, the similarities between these terms are not sufficient to conclude that there is a Likelihood of Confusion between the relevant public.

As established by the General Court in the Judgement of 16/04/2008, T-181/05, “CITI”, paragraph 69, the term “CITI” of the earlier mark has no meaning; whereas the English word “CITY” will be understood as a large town (Cambridge Dictionaries Online) by the relevant public, leading to a conceptual dissimilarity between the signs. Furthermore, although the

applications include more words apart from the term "CITY", the Opposition Divisions underline that:

Even in the fictitious case in which the marks to be compared were only "CITI" (being CITI a word mark) and "CITY" (being the contested mark deprived of all the remaining terms included in the same), the difference ascribable to the last letter 'I' of the earlier mark and 'Y' would not make them "almost identical".

The fact that three letters out of four are identical (CITI/CITY) does not automatically result in a 75% degree of similarity, since the Opposition Division considers that the difference in the last letters of the two signs "I" and "Y" does not produce a 25% dissimilarity.

In the light of the Board's Decision, the inexistence of Likelihood of Confusion is established on the difference in the last letter of "CITI" and "CITY", which has a visual impact within the signs, since these terms are relatively short and therefore, the difference in one letter, even if it is located at the end of the word, is a relevant factor to bear in mind, since it is precisely because they are short terms, that the public will more easily perceive all its single elements.

This difference has also been the reason why the ground on Reputation mentioned above was not assessed in its entirety in the four cases and also in the Board's decision, since all the rulings conclude that *the partial aural similarity is not enough to justify a finding that consumers will make an immediate mental link between the signs in question.*

Until now, the oppositions that had been filed by the opponents against Community trade mark applications had been upheld due to the fact that the applications included the word "CITI". However, unless the Boards of Appeal say the contrary a year after the "CITY VIRTUAL" case, this practice will probably avoid the filing of more opposition on behalf of the opponents.

The truth is that some of the services applied for by City Index Limited are services in class 36 which are obviously identical to the services protected under the opponent's earlier marks and for which the earlier marks have a reputation. Therefore, is the difference in one letter which is phonetically identical going to exclude the possibility of likelihood of confusion among the relevant public? And what is more, can the ground of reputation be discarded on the account of a different letter at the end of the signs, despite having the same pronunciation?