

Court of Cassation decision offers guidance for assessing confusing similarity



By Rachel Cosgrove (with Yana Komsitsky)

The Dubai Court of Cassation has reversed a Court of Appeal ruling which upheld the dismissal of a cancellation action because the ruling was based on an inappropriate comparison of two trade marks by the court appointed expert. The Court has directed the Court of Appeal to reassess the marks for confusing similarity by looking at each mark as a whole and in succession, instead of comparing individual elements of the marks side by side.

The Court has confirmed that what determines whether consumers are misled is the image of each trade mark imprinted in the mind of the consumer. This image is the *combination* of all the images, symbols, letters and colours used together in the mark, as seen when applied to goods.

Background of the case

The Lacoste crocodile is registered in the UAE and numerous other countries and is globally recognised by consumers. Lacoste has established a significant presence in the UAE using the crocodile device.

Lacoste had sought the cancellation of the Cartelo mark on the basis it is confusingly similar to the Lacoste crocodile device, and thus likely to confuse consumers as to the origin and interrelationship of both marks in violation of the UAE's Federal Trademark Law.

The lower court had appointed an expert who compared the trade mark registration certificates side by side. The expert found that based on the way the trade marks were represented in black and white on the registration certificates and the use of the word 'Cartelo', the marks were distinguishable.

The significance of colours

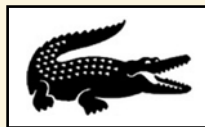
According to the Court, the consumer is in reality unlikely to view the trade marks side by side to enable him to undertake a detailed compare and contrast analysis of the different elements.

The consumer is much more likely to see them in succession and is therefore more likely to find them confusing because the second mark he sees may invoke the imprint on his mind of the first. He is also not going to view them in black and white, as they appear on the certificates, but in the colours in which they are reproduced on the products, as both marks were registered to be reproduced in multiple colours.

How is confusion created?

Once on the products, the trade marks might actually be represented in identical colours. The word 'Cartelo' might be camouflaged by the background colour of the product, effectively making

the crocodile stand out as the prominent element. If the colours used on both products create more similarity between the crocodiles, there is the possibility consumers will be misled to believe the products are linked.



Trade marks in the UAE

The Court noted that images are more prominent in the consumer's mind than words. Further, the typical UAE consumer is an Arabic or Asian language speaker and will not necessarily attach any significance to the word 'Cartelo'.

Also, whereas Lacoste has an established presence in the UAE, the proprietor of the second mark has none. UAE consumers will naturally associate the second crocodile device with the Lacoste brand.

Although the UAE is a civil jurisdiction, this decision should be welcomed by brand owners as it is likely to have persuasive weight in both trade mark cancellation and infringement proceedings.

Clyde & Co

Dubai Office: PO Box 7001

City Tower 2, Sheikh Zayed Road

Dubai United Arab Emirates

Tel: (971) 4 331 1102

Fax: (971) 4 331 9920

Email: rachel.cosgrove@clydeco.ae

yana.komsitsky@clydeco.ae

www.clydeco.com