

## KINDER Not Confusingly Similar to TiMi KINDERJOGHURT

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The **Court of Justice of the European Union (CJEU)** has upheld a decision of the **EU General Court** rejecting an invalidity action brought by the owner of trademarks for KINDER against a Community Trademark incorporating the words TiMi KINDERJOGHURT. *Ferrero SpA v. Office of Harmonisation in the Internal Market, Tirol Milch reg.Gen.mbH, Innsbruck*, Case C-552/09 (CJEU, March 24, 2011).

In 1998, Tirol Milch filed a figurative Community Trademark application for a sign incorporating the words TiMi KINDERJOGHURT covering yoghurt and related goods in class 29. Ferrero, which owns marks incorporating KINDER for a range of confectionary products, opposed the application. Ferrero's opposition failed on the grounds that the parties' marks were insufficiently similar.

After Tirol Milch registered TiMi KINDERJOGHURT, Ferrero brought cancellation proceedings against the mark before the Cancellation Division of the Office for Harmonisation in the Internal Market. Ferrero succeeded in its cancellation proceeding, but the Board of Appeal overturned the decision. Ferrero appealed to the EU General Court, arguing that the similarity of the marks and goods gave rise to a likelihood of confusion and infringement under Art 8(1)(b) of the CTM Regulation (40/94/EEC, now replaced by 2009/207/EC). Ferrero also argued that its KINDER mark was a well-known mark, and thus the registration of TiMi KINDERJOGHURT took unfair advantage of, or damaged, its reputation or distinctive character without due cause under Article 8(5).

The EU General Court held that notwithstanding the fact that the word "KINDER" was present in both parties' signs, a number of visual and phonetic differences existed that precluded the signs from being perceived as similar. The Court held that that even if the reputation of Ferrero's earlier marks and the similarity of the parties' goods could be considered in assessing the likelihood of confusion, it did not affect the assessment of the similarity of the signs. Ferrero appealed to the CJEU.

The CJEU rejected Ferrero's appeal, holding that the existence of a similarity between the earlier mark and the challenged mark was a precondition for the application of both Article 8(1)(b) and Article 8(5). The court explained that likelihood of confusion must be assessed globally, taking into account all of the relevant factors, which included not only the similarity between the conflicting marks but also the strength of the earlier mark's reputation. However, the reputation and distinctive character of the marks were not relevant for purposes of assessing whether the marks at issue were similar, but whether the relevant section of the public makes a link between the marks.

Although the global assessment of the existence of a link between the earlier mark and challenged mark under Art 8(5) implied some interdependence between the relevant factors, such that a low degree of similarity between the marks could be offset by the strong distinctiveness of the earlier mark, the court determined that the reputation of the KINDER mark and the fact that the parties' goods were identical or similar was not sufficient to establish a likelihood of confusion between the marks or that the public would make a link between them. In order for Article 8(1)(b) or Article 8(5) to apply, the court held that the marks must be identical or similar. Accordingly, those provisions did not apply because the court had ruled that the marks were not similar.

Further, the court acknowledged that it was settled case law that the existence of a "family" of marks was a relevant element to consider in assessing likelihood of confusion. However, that element was irrelevant for assessing similarity between the parties' marks, the court explained, and only became relevant once similarity between the marks had been found. Consequently, the CJEU held that the General Court did not err in its holding that the parties' marks are not similar based upon the existence of several visual and phonetic differences.

The moral of the story? No amount of fame and reputation can make two marks similar when they are not.

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