



The General Court confirms that there exists a likelihood of confusion between the figurative and word sign SKYPE and the word mark SKY

In 2004 and 2005 Skype applied to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) for registration of the figurative and word signs SKYPE as a Community trade mark for audiovisual goods, telephony and photography goods and computer services relating to software or to the creation or hosting of websites.

In 2005 and 2006, British Sky Broadcasting Group, now Sky plc and Sky IP International, filed a notice of opposition, pleading the likelihood of confusion with its earlier Community word mark SKY, filed in 2003 for identical goods and services.

Figurative/word sign applied for

Word mark relied on in support of opposition



SKY

By decisions of 2012 and 2013, OHIM upheld the opposition, considering, in essence, that there existed a likelihood of confusion of the signs at issue on account, in particular, of their average degree of visual, phonetic and conceptual similarity and that the conditions for establishing a reduction of that likelihood had not been satisfied. Skype seeks annulment of those decisions before the General Court.

By today's judgments, **the Court has dismissed Skype's actions and by so doing confirmed that there exists a likelihood of confusion between the figurative and word sign SKYPE and the word mark SKY.**

As regards the visual, phonetic and conceptual similarity of the signs at issue, the Court has confirmed that the pronunciation of the vowel 'y' is no shorter in the word 'skype' than it is in the word 'sky'. In addition, the word 'sky', part of the basic vocabulary of the English language, remains clearly identifiable in the word 'skype', in spite of the fact that the latter is written as only one word. Last, the element 'sky' in the word 'skype' can perfectly well be identified by the relevant public, even if the remaining element 'pe' has no specific meaning.

Moreover, the fact that, in the figurative sign applied for, the word element 'skype' is surrounded by a jagged border in the shape of a cloud or a bubble does not affect the average degree of visual, phonetic and conceptual similarity. Visually, the figurative element does no more than highlight the word element and is, therefore, perceived as a mere border. Phonetically, the figurative element in the shape of a border cannot produce any phonetic impression, this latter remaining determined

solely by the word element. Conceptually, the figurative element conveys no concept, except perhaps that of a cloud, which would further increase the likelihood of the element 'sky' being recognised within the word element 'skype', for clouds are to be found 'in the sky' and thus may readily be associated with the word 'sky'.

So far as concerns the argument that the 'skype' signs are highly distinctive because they are known by the public, the Court declares that, even if the term 'skype' had acquired a meaning of its own for identifying the telecommunications services provided by the company Skype, it would be a generic, and consequently descriptive, term for services of that kind.

Lastly, the Court confirms that account cannot be taken of the peaceful coexistence of the signs at issue as a factor that could reduce the likelihood of confusion, the conditions in that connection not being satisfied. The peaceful coexistence of those signs in the United Kingdom concerns only one isolated, highly specific service (namely, peer-to-peer communications services) and cannot, therefore, lessen the likelihood of confusion in respect of the many other goods and services covered by the signs. In addition, that coexistence has not lasted long enough to give grounds for the assumption that it was based on the absence of any likelihood of confusion in the mind of the relevant public.

NOTE: An appeal, limited to points of law only, may be brought before the Court of Justice against the decision of the General Court within two months of notification of the decision.

NOTE: An action for annulment seeks the annulment of acts of the institutions of the EU that are contrary to EU law. The Member States, the European institutions and individuals may, under certain conditions, bring an action for annulment before the Court of Justice or the General Court. If the action is well founded, the act is annulled. The institution concerned must fill any legal vacuum created by the annulment of the act.

NOTE: Community trade marks are valid throughout the EU and co-exist with national trade marks. Applications for registration of a Community trade mark are sent to OHIM. Actions against its decisions may be brought before the General Court.

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The full texts of the judgments ([T-423/12](#), [T-183/13](#) and [T-184/13](#)) are published on the CURIA website on the day of delivery

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