

***GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)***

Part C

Opposition

Section 2

Double identity and likelihood of confusion

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Chapter 1

General principles

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1 Introduction

This chapter provides an introduction to and overview of the concepts of (i) double identity and (ii) likelihood of confusion that are applied in situations of conflict between trade marks in opposition proceedings under Article 8(1) EUTMR.

The paragraphs below set out the nature of these concepts and their legal underpinning as determined by the relevant laws and as interpreted by the Court of Justice of the European Union (the ‘Court’)³⁴.

The legal concepts of double identity and likelihood of confusion are used to protect trade marks and, at the same time, to define their scope of protection. It is thus important to bear in mind what aspects or functions of trade marks merit protection. Trade marks have various functions. The most fundamental one is to act as ‘indicators of origin’ of the commercial provenance of goods/services. This is their ‘essential function’. In the *Canon* judgment the Court held that:

... according to the settled case-law of the Court, the **essential function of the trade mark is to guarantee the identity of the origin of the marked product** to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others that have another origin (emphasis added).

(29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 28).

The essential function of trade marks as indicating origin has been emphasised repeatedly and has become a precept of European Union trade mark law (18/06/2002, C-299/99, *Remington*, EU:C:2002:377, § 30; 06/10/2005, C-120/04, *Thomson Life*, EU:C:2005:594, § 23).

Whilst indicating origin is the essential function of trade marks, it is not the only one. Indeed, the term, ‘essential function’ implies other functions. The Court alluded to the other functions of trade marks several times (16/11/2004, C-245/02, *Budweiser*, EU:C:2004:717, § 59; 25/01/2007, C-48/05, *Opel*, EU:C:2007:55, § 21) but addressed them directly in the *L’Oréal* judgment, where it stated that the functions of trade marks include:

... **not only the essential function** of the trade mark, which is to guarantee to consumers the origin of the goods or services, **but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising** (emphasis added).

(18/06/2009, C-487/07, *L’Oréal*, EU:C:2009:378, § 58-59; 23/03/2010, C-236/08 – C-238/08, *Google-Louis Vuitton*, EU:C:2010:159).

In examining the concepts of double identity and likelihood of confusion, this chapter touches upon several themes that are explained comprehensively in the chapters of

³⁴ The Court was, in fact, often interpreting Articles 4 and 5 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, which for the purposes of interpretation are broadly comparable to Articles 8 and 9 EUTMR.

the Guidelines that follow. A summary of the key cases from the Court dealing with the core principles and concepts of likelihood of confusion is added in the Annex.

2 Article 8(1) EUTMR

Article 8 EUTMR enables the proprietor of an **earlier right** to oppose the registration of later EUTM applications in a range of situations. The present chapter will concentrate on the interpretation of double identity and likelihood of confusion within the meaning of Article 8(1) EUTMR.

An opposition pursuant to Article 8(1) EUTMR can be based on earlier trade mark registrations or applications (Article 8(2)(a) and (b) EUTMR) and earlier well-known marks (Article 8(2)(c) EUTMR) ³⁵.

2.1 Article 8(1)(a) EUTMR — double identity

Article 8(1)(a) EUTMR provides for oppositions based on identity. It provides that, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) EUTMR, an EUTM application will not be registered:

if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected.

The wording of Article 8(1)(a) EUTMR clearly requires identity between **both** the signs concerned **and** the goods/services in question. This situation is referred to as 'double identity'. Whether there is double identity is a **legal finding** to be established from a direct comparison of the two conflicting signs and the goods/services in question ³⁶. Where double identity is established, the opponent is not required to demonstrate likelihood of confusion in order to prevail; the protection conferred by Article 8(1)(a) EUTMR is absolute. Consequently, where there is double identity, there is no need to carry out an evaluation of likelihood of confusion, and the opposition will automatically be upheld.

2.2 Article 8(1)(b) EUTMR — likelihood of confusion

Article 8(1)(b) EUTMR states that, upon opposition, an EUTM application will not be registered:

...if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks **there exists a**

³⁵ Further guidance on earlier well-known trade marks is found in the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

³⁶ Comprehensive guidance on the criteria to find identity between goods and services and between signs can be found in the respective paragraphs of the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services, and Chapter 4, Comparison of Signs.

likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the **likelihood of confusion includes the likelihood of association** with the earlier trade mark (emphasis added).

Hence, in contrast to situations of double identity as seen above, in cases of mere similarity between the signs and the goods/services, or identity of only one of these two factors, an earlier trade mark may successfully oppose an EUTM application under Article 8(1)(b) EUTMR **only if** there is a likelihood of confusion.

2.3 Interrelation of Article 8(1)(a) and (b) EUTMR

Although the specific conditions under Article 8(1)(a) and (b) EUTMR differ, they are related. Consequently, in oppositions dealing with Article 8(1) EUTMR, if Article 8(1)(a) EUTMR is the only ground claimed but identity between the signs and/or the goods/services cannot be established, the Office will still examine the case under Article 8(1)(b) EUTMR, which requires at least similarity between signs and goods/services and likelihood of confusion. Similarity covers situations where both marks and goods/services are similar and also situations where the marks are identical and the goods/services are similar or vice versa.

Likewise, an opposition based only on Article 8(1)(b) EUTMR that meets the requirements of Article 8(1)(a) EUTMR will be dealt with under the latter provision without any examination under Article 8(1)(b) EUTMR.

3 The Notion of Likelihood of Confusion

3.1 Introduction

The assessment of likelihood of confusion is a calculus applied in situations of conflict between trade marks in proceedings before the Office, the General Court and the Court of Justice as well as in infringement proceedings before the courts of the Member States. However, neither the EUTMR nor Directive 2015/2436³⁷ contains a definition of likelihood of confusion or a statement as to precisely what ‘confusion’ refers to.

As shown below, it has been settled case-law for some time now that fundamentally the concept of likelihood of confusion refers to situations where:

1. the public directly confuses the conflicting trade marks, that is to say, mistakes the one for the other;
2. the public makes a connection between the conflicting trade marks and assumes that the goods/services in question are from the same or economically linked undertakings (likelihood of association).

³⁷ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

These two situations are further discussed below (see paragraph 3.2 below). The mere fact that the perception of a later trade mark brings to mind an earlier trade mark does not constitute likelihood of confusion.

The Court has also established the principle that ‘marks with a highly distinctive character enjoy broader protection than marks with a less distinctive character’ (see paragraph 3.3 below).

Finally, the concept of likelihood of confusion as developed by the Court must be regarded as a legal concept rather than purely an empirical or factual assessment despite the fact that its analysis requires taking into account certain aspects of consumer cognitive behaviour and purchasing habits (see paragraph 3.4 below).

3.2 Likelihood of confusion and likelihood of association

The Court considered likelihood of confusion comprehensively in *Sabèl* (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528). The Directive’s equivalents³⁸ of Article 8(1)(b) EUTMR and the recitals of the EUTMR clearly indicated that likelihood of confusion relates to confusion about the origin of goods/services, but the Court was required to consider what precisely this meant because there were opposing views on the meaning of, and the relationship between, ‘likelihood of confusion’ and ‘likelihood of association’, both of which are referred to in Article 8(1)(b) EUTMR.

This issue needed to be resolved because it was argued that likelihood of association was broader than likelihood of confusion as it could cover instances where a later trade mark brought an earlier trade mark to mind but the consumer did not consider that the goods/services had the same commercial origin³⁹. Ultimately, the issue in *Sabèl* was whether the wording ‘the likelihood of confusion includes the likelihood of association’ meant that ‘likelihood of confusion’ could cover a situation of association between trade marks that did not give rise to confusion as to origin.

The Court found that likelihood of association **is not an alternative** to likelihood of confusion, but that it merely serves to define its scope. Therefore, a finding of likelihood of confusion requires that there be confusion as to origin.

In *Canon* (paras 29-30), the Court clarified the scope of confusion as to origin when it held that:

... the risk that the public might believe that the goods and services in question come from the **same undertaking or, as the case may be, from economically linked undertakings**, constitutes a likelihood of confusion ... there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically linked undertakings (emphasis added).

As seen above, likelihood of confusion relates to confusion as to commercial origin including economically linked undertakings. What matters is that the public believes

³⁸ Articles 4 and 5 of Directive 2008/95/EC and Articles 5 and 10 of Directive 2015/2436.

³⁹ The concept came from Benelux case-law and applied, inter alia, to non-reputed marks.

that the **control** of the goods or services in question is in the hands of a single undertaking. The Court has not interpreted **economically linked undertakings** in the context of likelihood of confusion, but it has done so with respect to the free movement of goods/services. In *Ideal Standard* the Court held:

... A number of situations are covered: products put into circulation by the same undertaking, by a licensee, by a parent company, by a subsidiary of the same group, or by an exclusive distributor.

... In all the cases mentioned, control [is] in the hands of a single body: the group of companies in the case of products put into circulation by a subsidiary; the manufacturer in the case of products marketed by the distributor; the licensor in the case of products marketed by a licensee. In the case of a licence, the licensor can control the quality of the licensee's products by including in the contract clauses requiring the licensee to comply with his instructions and giving him the possibility of verifying such compliance. The origin that the trade mark is intended to guarantee is the same: it is not defined by reference to the manufacturer but by reference to the point of control of manufacture.

(22/06/1994, C-9/93, *Ideal Standard*, EU:C:1994:261, § 34, 37).

Consequently, economic links will be presumed where the consumer assumes that the respective goods or services are marketed under the control of the trade mark proprietor. Such control can be assumed to exist in the case of enterprises belonging to the same group of companies and in the case of licensing, merchandising or distribution arrangements as well as in any other situation where the consumer assumes that the use of the trade mark is normally possible only with the agreement of the trade mark proprietor.

Therefore, the likelihood of confusion covers situations where:

1. the consumer directly confuses the trade marks themselves; or where
2. the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings.

Hence, if the perception of a later trade mark merely brings to mind an earlier trade mark, but the consumer does not assume the same commercial origin, then this link does not constitute likelihood of confusion despite the existence of a similarity between the signs ⁴⁰.

3.3 Likelihood of confusion and distinctiveness of the earlier mark

The distinctiveness of the earlier trade mark has been held by the Court to be an important consideration when assessing likelihood of confusion, since:

- the more distinctive the earlier trade mark, the greater will be the likelihood of confusion (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528, § 24);

⁴⁰ Although such a situation could take unfair advantage of, or be detrimental to, the distinctive character or the reputation of an earlier mark under Article 8(5) EUTMR, see the Guidelines Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

- trade marks with a highly distinctive character enjoy broader protection than trade marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18)
- however, the scope of protection of trade marks with low distinctive character will be narrower.

One consequence of these findings is that the enhanced distinctiveness of the earlier mark may be a decisive factor towards establishing a likelihood of confusion when the similarity between the signs and/or the goods and services is low (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22). When the distinctiveness of the earlier trade mark is low, this may be a factor weighing against likelihood of confusion.

3.4 Likelihood of confusion: questions of fact and questions of law

The concept of likelihood of confusion is a legal concept rather than a mere factual evaluation of the rational judgments and emotional preferences that inform the consumer's cognitive behaviour and purchasing habits. Therefore, assessment of likelihood of confusion depends on both legal questions **and** facts.

3.4.1 Fact and law — similarity of goods/services and of signs

Determining the relevant factors for establishing likelihood of confusion and whether they exist is a question of law, that is to say, these factors are established by the relevant legislation, namely, the EUTMR and case-law.

For instance, Article 8(1) EUTMR establishes that the identity/similarity of goods/services is a condition for likelihood of confusion. The identification of the relevant factors for evaluating whether this condition is met is also a question of law.

The Court has identified the following factors for determining whether goods/services are similar:

- their nature
- their intended purpose
- their method of use
- whether they are complementary or not
- whether they are in competition or interchangeable
- their distribution channels/points of sale
- their relevant public
- their usual origin.

(29/09/1998, C-39/97, Canon, EU:C:1998:442).

All these factors are legal concepts and determining the criteria to evaluate them is also a **question of law**. However, it is a **question of fact** whether, and to what degree, the legal criteria for determining, for instance, 'nature', are fulfilled in a particular case.

By way of example, *cooking fat* does not have the same nature as *petroleum lubricating oils and greases* even though both contain a fat base. *Cooking fat* is used in preparing food for human consumption, whereas *oils and greases* are used for lubricating machines. Considering ‘nature’ to be a relevant factor in the analysis of similarity of goods/services is a matter of **law**. However, it is a matter of **fact** to state that cooking fat is used in preparing food for human consumption and that oils and greases are used for machines.

Similarly, when it comes to the comparison of signs, Article 8(1) EUTMR establishes that the identity/similarity of signs is a condition for likelihood of confusion. It is a **question of law** that a conceptual coincidence between signs may render them similar for the purposes of the EUTMR, but it is a **question of fact**, for instance, that the word ‘fghryz’ does not have any meaning for the Spanish public.

3.4.2 Fact and law — evidence

In opposition proceedings, the parties must allege and, where necessary, prove the facts in support of their arguments. This follows from Article 95(1) EUTMR, according to which, in opposition proceedings, the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought.

Therefore, it is up to the opponent to state the facts on which the claim of similarity is based and to submit supporting evidence. For instance, where *wear-resistant cast iron* is to be compared with *medical implants*, it is not up to the Office to answer the question of whether *wear-resistant cast iron* is actually used for *medical implants*. This must be demonstrated by the opponent as it seems improbable (14/05/2002, R 684/2000-4, Tinox / TINOX).

An admission by the applicant of legal concepts is irrelevant. It does not discharge the Office from analysing and deciding on these concepts. This is not contrary to Article 95(1) EUTMR, which is binding on the Office **only** as regards the facts, evidence and arguments and does not extend to the legal evaluation of the same. Therefore, the parties may agree as to which facts have been proven or not, but they may not determine whether or not these facts are sufficient to establish the respective legal concepts, such as similarity of goods/services, similarity of the signs, and likelihood of confusion.

Article 95(1) EUTMR does not prevent the Office from taking into consideration, on its own initiative, facts that are already notorious or well known or that may be learnt from generally accessible sources, for example, that PICASSO will be recognised by EU consumers as a famous Spanish painter (22/06/2004, T-185/02, Picaro, EU:T:2004:189; 12/01/2006, C-361/04 P, Picaro, EU:C:2006:25). However, the Office cannot quote *ex officio* new facts or arguments (e.g. reputation or degree of knowledge of the earlier mark).

Moreover, even though certain trade marks are sometimes used in daily life as generic terms for the goods and services that they cover, this should never be taken as fact by the Office. In other words, trade marks should never be referred to (or interpreted) as if they were a generic term or a category of goods or services. For instance, the fact that

in daily life part of the public refers to 'X' when talking about *yoghurts* ('X' being a trade mark for *yoghurts*) should not lead to using 'X' as a generic term for *yoghurts*.

4 Evaluation of the Relevant Factors for Establishing a Likelihood of Confusion

4.1 The relevant point in time

The relevant moment in time for assessing a likelihood of confusion is the date the opposition decision is taken.

Where the opponent relies on **enhanced distinctiveness** of an earlier trade mark, the conditions for this must have been met on or before the filing date of the EUTM application (or any priority date) and must still be fulfilled at the point in time the decision is taken. Office practice is to assume that this is the case, unless there are indications to the contrary.

Where the EUTM applicant relies on a reduced scope of protection (weakness) of the earlier trade mark, only the date of the decision is relevant.

4.2 List of factors for assessing the likelihood of confusion

The likelihood of confusion is assessed in the following steps, taking into account multiple factors.

- Comparison of goods and services
- Relevant public and degree of attention
- Comparison of signs
- Distinctiveness of the earlier mark
- Any other factors
- Global assessment of likelihood of confusion.

A separate chapter of the Guidelines is dedicated to each of the above factors and its specifics.

Annex

General principles coming from case-law (these are not direct citations).

11/11/1997, C-251/95, Sabèl, EU:C:1997:528

- The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case (para. 22).
- The appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, on the association that the public might make between the two marks and on the degree of similarity between the signs and the goods (para. 22).
- The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components (para. 23).
- The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (para. 23).
- The more distinctive the earlier mark, the greater will be the likelihood of confusion (para. 24).
- It is not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character (para. 24).
- However, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion (para. 25).
- The concept of likelihood of association is not an alternative to likelihood of confusion, but serves to define its scope (para. 18).
- The mere association that the public might make between two marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion (para. 26).

29/09/1998, C-39/97, Canon, EU:C:1998:442

- The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion (para. 29).
- By contrast, there can be no such likelihood where the public does not think that the goods come from the same undertaking (or from economically linked undertakings) (para. 30).
- In assessing the similarity of the goods and services, all the relevant factors relating to those goods or services themselves should be taken into account (para. 23).
- Those factors include, inter alia, their nature, the purpose for which they are used (the translation 'end users' in the official English language version is not correct) and their method of use, and whether they are in competition with each other or are complementary (para. 23).
- A global assessment of the likelihood of confusion implies some interdependence between the relevant factors and in particular a similarity between the marks and between these goods or services. A lesser degree of similarity between the goods may be offset by a greater degree of similarities between the marks and vice versa (para. 17).
- Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (para. 18).
- Registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive (para. 19).
- The distinctive character of the earlier mark and in particular its reputation must be taken into account when determining whether the similarity between the goods and services is enough to give rise to the likelihood of confusion (para. 24).
- There may be a likelihood of confusion, even if the public thinks that these goods have different places of production (para. 30).

22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323

- The level of attention of the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, varies according to the category of the goods and services in question (para. 26).
- However, account should be taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks and must trust in their imperfect recollection of them (para. 26).
- When assessing the degree of visual, phonetic and conceptual similarity it can be appropriate to evaluate the importance attached to each by reference to the category of goods and the way they are marketed (para. 27).
- It is possible that mere aural similarity could lead to a likelihood of confusion (para. 28).
- In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, an overall assessment needs to be made of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking (para. 22).
- In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public who, because of the mark, identifies the goods and services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (para. 23).
- It is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character (para. 24).

22/06/2000, C-425/98, Marca, EU:C:2000:339

- The reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense (para. 41).
- Article 5(1)(b) of Directive 2008/95/EC cannot be interpreted as meaning that where:
 - a trade mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public, and
 - a third party, without the consent of the proprietor of the mark, uses, in the course of trade in goods or services that are identical with, or similar to, those for which the trade mark is registered, a sign that so closely corresponds to the mark as to give the possibility of its being associated with that mark,

the exclusive right enjoyed by the proprietor entitles him to prevent the use of the sign by that third party if the distinctive character of the mark is such that the possibility of such association giving rise to confusion cannot be ruled out (emphasis added) (para. 42).

06/10/2005, C-120/04, Thomson Life, EU:C:2005:594

- Where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark that has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (para. 37).

Obsolete

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EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 2

Comparison of goods and services

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1 Introduction

1.1 Relevance

The comparison of goods and services is primarily of relevance for the assessment of identity according to Article 8(1)(a) EUTMR and likelihood of confusion according to Article 8(1)(b) EUTMR. One of the main conditions for Article 8(1)(a) EUTMR is the identity of goods/services, while Article 8(1)(b) EUTMR requires the identity or similarity of goods/services. Consequently, if all goods/services are found to be dissimilar, one of the conditions contained in Article 8(1) EUTMR is not fulfilled and the opposition must be rejected without addressing the remaining sections of the decision ⁽⁴¹⁾.

The criteria for the assessment of identity or similarity might also play a role when proof of use has been requested and the evidence has to be assessed in order to conclude whether the opponent has proven use for the goods/services as registered. In particular, it is important to determine whether the goods and services for which the mark has been used belong to the category of goods and services for which the trade mark was registered. This is because, under Article 47(2) EUTMR, proof of use for a product or service that is merely similar to the one registered does not prove use for the registered product or service (see the Guidelines, Part C, Opposition, Section 6, Proof of Use).

Likewise, evidence of use of goods/services might also be relevant when examining a claim to enhanced distinctiveness. In such cases it is often necessary to examine whether the enhanced distinctiveness covers goods/services for which the earlier trade mark enjoys protection and that are relevant for the specific case, that is to say, that have been considered to be identical or similar to the goods/services of the contested EUTM (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

Furthermore, the outcome of the comparison of goods/services plays an important role in defining the part of the public for whom likelihood of confusion is analysed because the relevant public is that of the goods/services found to be identical or similar (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

The comparison of goods/services may also be relevant under Article 8(3) EUTMR, which requires the identity or close relation or equivalence in commercial terms of goods/services (see the Guidelines, Part C, Opposition, Section 3, Unauthorised Filing by Agents of the TM Proprietor (Article 8(3) EUTMR)), and under the applicable provisions of national law under Article 8(4) EUTMR, since identity or similarity of the goods/services is often a condition under which the use of a subsequent trade mark may be prohibited (see the Guidelines, Part C, Opposition, Section 4, Rights under

⁴¹ Equally, the comparison of goods and services is of relevance in invalidity proceedings, since pursuant to Article 60(1)(a) EUTMR, a registered European Union trade mark is declared invalid where the conditions set out in Article 8(1) EUTMR are fulfilled.

Article 8(4) and 8(6) EUTMR). Furthermore, under Article 8(5) EUTMR, the degree of similarity or dissimilarity between the goods or services is a factor that must be taken into account when establishing whether or not the consumer will perceive a link between the marks. For example, the goods or services may be so manifestly dissimilar that use of the later mark on the contested goods or services is unlikely to bring the earlier mark to the mind of the relevant public (see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR)).

1.2 Nice Classification: a starting point

Article 33(1) EUTMR requires that the goods/services to be compared are classified according to the Nice Classification. Currently the Nice Classification consists of 34 classes (1-34) for categorising goods and 11 classes (35-45) for categorising services.

1.2.1 Its nature as a classification tool

The Nice Classification was set up with the aim of harmonising national classification practices. Its first edition entered into force in 1961. Although it has undergone several revisions, it sometimes lags behind the rapid changes in product developments in the markets. Furthermore, the wording of the headings is at times unclear and imprecise.

The Nice Classification serves purely administrative purposes and, as such, does not in itself provide a basis for drawing conclusions as to the similarity of goods and services.

According to Article 33(7) EUTMR, the fact that goods or services are listed in the same class of the Nice Classification is not, in itself, an indication of similarity.

Examples

- *Live animals* are dissimilar to *flowers* (Class 31).
- *Advertising* is dissimilar to *office functions* (Class 35).

The fact that two specific goods/services fall under the same general indication of a class heading does not per se make them similar, let alone identical: *cars* and *bicycles* — although both fall under *vehicles* in Class 12 — are considered dissimilar.

Furthermore, goods/services listed in different classes are not necessarily considered dissimilar (16/12/2008, T-259/06, Manso de Velasco, EU:T:2008:575, § 30-31).

Examples

- *Meat extracts* (Class 29) are similar to *spices* (Class 30).
- *Travel arrangement* (Class 39) is similar to *providing temporary accommodation* (Class 43).

1.2.2 Its structure and methodology

Classification may serve as a tool to identify the common characteristics of certain goods/services.

Many classes of the Nice Classification are structured according to factors such as function, composition and/or purpose of use, which may be relevant in the comparison of goods/services. For example:

- Class 1 comprises chemical goods based primarily on their chemical properties (nature), rather than on their specific application. By contrast, Class 3 covers all items that are either cleaning preparations or for personal hygiene or beautification. Although they can by their nature also be classified as chemical products, it is their specific purpose that allows a distinction and thus a different classification.
- Equally, it is because of their nature that most items made of leather are classified in Class 18, whereas clothing made of leather falls under Class 25 since it serves a very specific purpose, namely that of being worn by people and as protection from the elements.

1.2.3 Conclusions to be drawn from the structure of the Nice Classification

The structure of the class headings is not uniform and does not follow the same logic. Some classes consist of only one general indication that by definition already covers nearly all the goods/services included in this class (Class 15 *musical instruments*; Class 38 *telecommunications*). Others include many general indications — some very broad and others very specific. For example, the heading of Class 9 includes more than 30 terms, ranging from *scientific apparatus and instruments* to *fire-extinguishing apparatus*.

Exceptionally, there are class headings containing general indications that include another general indication and are thus identical.

Example: *materials for dressing* in Class 5 include *plasters* in Class 5.

Other specific indications in a class heading are only mentioned to clarify that they do not belong to another class.

Example: *adhesives used in industry* are included in *chemicals used in industry* in Class 1. Its mention is mainly thought to distinguish them from *adhesives* classified in Class 16, which are for stationery or household purposes.

To conclude, the Nice Classification gives indications that can be used in the assessment of identity or similarity of goods/services. However, its structure and content is not consistent. Therefore, each heading or specific term has to be analysed according to the specific class under which it is classified. As stated before, the Nice Classification mainly serves to categorise goods/services for administrative purposes and is not decisive for their comparison.

1.2.4 Changes in the classification of goods/services

Normally, each revision of the Nice Classification brings changes in the classification of goods/services (in particular transfers of goods/services between various classes) or in the wording of headings. In such cases the list of goods/services of both the earlier and

the contested mark must be interpreted according to the edition of the Nice Classification in force at the time of filing.

Example

- *Legal services* were transferred from Class 42 to Class 45 with the 8th edition of the Nice Classification. The nature of these services has not changed.
- *Vending machines* were transferred from Class 9 to Class 7 in the 10th edition of the Nice Classification, since a vending machine is basically a powered machine and as such was considered more appropriately classified in Class 7 with other machinery. However, since the nature of these goods has not changed, *vending machines* classified in different classes due to the different filing dates of the respective applications are regarded as identical.

1.3 The Similarity Tool (EUIPN) for the comparison of goods/ services

The [Similarity Tool](#) for the comparison of goods and services is a search tool to help and support examiners in assessing the similarity of goods and services. The Similarity Tool serves to harmonise practice on the assessment of similarity of goods and services and to guarantee the coherence of decisions. The Similarity Tool must be followed by examiners.

The Similarity Tool is based on comparing specific pairs of goods and services. A 'pair' compares two 'terms'. A 'term' consists of a class number from the Nice Classification (1-45) and a textual element, that is to say, a specific product or service (including general categories of goods and services, such as *clothing* or *education*). There are five possible results of the search: identity, high degree of similarity, similarity, low degree of similarity and dissimilarity. For each of the degrees of similarity, the tool indicates which criteria lead to each result.

The Similarity Tool is constantly updated and revised as necessary in order to create a comprehensive and reliable source of reference.

Since the tool gives, or will give, answers to specific comparisons, the Guidelines concentrate on defining the general principles and their application in practice.

1.4 Definition of goods and services (terminology)

1.4.1 Goods

The EUTMR does not give a definition of goods and services. Although the Nice Classification gives some general explanations to this effect in its introductory remarks, it refrains from clearly setting criteria for the distinction between goods and services.

In principle, the word 'goods' refers to any kind of item that may be traded. Goods comprise raw materials (unprocessed plastics in Class 1), semi-finished products

(plastics in extruded form for use in manufacture in Class 17) and finished products (plastic household containers in Class 21). They include natural and manufactured goods, such as agricultural products in Class 31 and machines and machine tools in Class 7.

However, sometimes it is not clear whether goods comprise only tangible physical products as opposed to services, which are intangible. The definition and thus the scope of protection are particularly relevant when it comes to 'goods', such as *electricity*, that are intangible. This question is already answered during the examination on classification and will not usually cause any problems in the comparison of goods and services.

1.4.2 Services

A service is any activity or benefit that one party can offer to another that is intangible and does not result in the transfer of ownership of any physical object. In contrast to goods, a service is **always** intangible.

Importantly, services comprise economic activities provided to **third parties**.

- Advertising one's own goods is not a service but running an advertising agency (designing advertising campaigns for third parties) is. Similarly *shop window dressing* is only a service when provided for third parties, not when done in one's own shop.
- Selling or distributing one's own goods is not a service. Retail services are meant to cover the services around the actual sale of goods, such as providing the customer with an opportunity to conveniently see, compare or test the goods. For more detailed information, see Annex II, paragraph 7, Retail Services.

One indication for an activity to be considered a service under trade mark law is its independent economic value, that is to say, it is usually provided in exchange for some form of (monetary) compensation. Otherwise, it could be a mere ancillary activity provided together with or after the purchase of a specific product.

Example

- Delivery, including the transport of furniture that has previously been purchased (either in a physical establishment or online), is not an independent service falling under *transport services* in Class 39.

However, the intention to make profit is not necessarily a criterion for defining whether an activity can qualify as a 'service' (09/12/2008, C-442/07, Radetzky, EU:C:2008:696, § 16-18). It is more a question of whether the service has an independent market area and targeted public rather than the way or form in which compensation is made for it.

1.4.3 Products

In common parlance the term 'products' is used for both goods and services, for example, 'financial products' instead of financial services. Whether terms in common

parlance are described as ‘products’ is immaterial to them being classified as goods or services.

1.5 Determining the goods/services

1.5.1 The correct wording

As a preliminary, the correct wording of the lists of goods/services under consideration must be identified.

1.5.1.1 European Union trade marks

An application for an EUTM will be published in all the official languages of the European Union (Article 147(1) EUTMR). Likewise, all entries in the Register of European Union trade marks (the Register) will be in all these languages (Article 147(2) EUTMR). Both applications and entries in the Register are published in the EUTM Bulletin (Article 116(1)(a) and Article 116(2) EUTMR).

In practice, occasional discrepancies may be found between:

- the translation of the wording of the list of goods and/or services of an EUTM (application or registration) published in the EUTM Bulletin, and
- the original wording as filed.

In cases of such discrepancy, the definitive version of the list of goods and services is:

- the text in the first language, if the first language is one of the five languages of the Office.
- the text in the second language indicated by the applicant (Article 147(3) EUTMR), if the first language of the application is not one of the five languages of the Office.

This applies regardless of whether the EUTM (or EUTM application) is the earlier right or the contested application.

Where an incorrect translation of the list of goods and services is detected in an EUTM application that prevents the Office from carrying out a comparison of the goods and services, the list will either be sent for translation again or, in clear-cut cases, changed directly in the Register. The Office will take its decisions on the basis of the correct translation. Where an incorrect translation is detected in a registered EUTM, the Office will explain which language version of the goods and services is the definitive version for the purposes of the comparison.

1.5.1.2 Earlier national marks and international registrations

The list of goods and services of the earlier marks on which the opposition is based must be submitted in the language of the opposition proceedings (Article 7(4) EUTMDR). The Office does not require any certified translation; it accepts simple translations, drawn up by the opponent or its representative. The Office normally does

not exercise the option available under Article 26 EUTMIR of requiring the translation to be certified by a sworn or official translator. Where the representative adds a declaration that the translation is true to the original, the Office will in principle not question this. The other party may, however, question the correctness of the translation during the adversarial part of the proceedings. (See the Guidelines, Part C, Opposition, Section 1, Opposition proceedings.)

For international registrations under the Madrid Agreement or Protocol, the language in which the international registration was registered is definitive (French, English or Spanish). However, where the language of the opposition procedure is not the language of the international registration, a translation must be supplied, as for earlier national marks.

Where a clearly incorrect translation is detected in the list of goods and services covered by the earlier national or international mark that prevents the Office from carrying out a comparison of goods and services, the opponent may be required under Article 26 EUTMIR to submit a certificate from a sworn or official translator confirming that the translation corresponds to the original. Alternatively, in clear-cut cases, the Office may, for the purposes of the decision, replace a clearly incorrect translation of a certain term by a correct translation, adding an explanation to that effect. For example, where the term '*bars*' in Class 43 is translated as *barras de cereales* (cereal bars), it is a clearly incorrect translation as this term could never fall within Class 43.

1.5.2 The relevant scope

Comparison of the goods and services must be based on the wording indicated in the respective lists of goods/services. Any actual or intended use not stipulated in the list of goods/services is not relevant for this comparison since it is part of the assessment of likelihood of confusion in relation to the goods/services on which the opposition is based and against which it is directed; it is not an assessment of actual confusion or infringement (16/06/2010, T-487/08, Kremezin, EU:T:2010:237, § 71).

However, if proof of use of the earlier mark is validly requested and the submitted evidence is sufficient for only part of the goods/services listed, the earlier mark is deemed to be registered for only those goods/services (Article 47(2) EUTMR); consequently, the examination is restricted to those goods/services (see the Guidelines, Part C, Opposition, Section 6, Proof of Use).

Moreover, in the case of the earlier mark, only the goods and services on which the opposition is validly based are pertinent. Hence, no account will be taken of goods/services:

- that cannot be taken into account for reasons of admissibility;
- that have not been properly substantiated (e.g. only a partial translation of the list of goods/services was filed); or
- on which the opposition is not, or is no longer, based.

Similarly, only those goods and services of the contested application against which the opposition is directed are taken into consideration. Consequently, restrictions applied

during the proceedings to either the list of goods/services of the application or the goods/services on which the opposition is based, or both, will limit the goods and services to be compared.

Furthermore, an analysis of the wording of the list of goods/services might be required to determine the scope of protection of those goods and services. This is especially true where terms such as **in particular**, **namely**, or equivalents are used in order to show the relationship of an individual product with a broader category.

The term **in particular** (or **for example**, **such as**, **including** or other equivalent) indicates that the specific goods/services are only examples of items included in the category, and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (on the use of **in particular**, see the reference in 09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107).

However, the term **namely** (or **exclusively** or other equivalent) is exclusive and restricts the scope of the registration to only the specifically listed goods.

For example, in the case of *chemicals used in industry, namely raw materials for plastics* only the *raw materials for plastics* need to be compared with the goods of the other mark.

The use of commas in the list of goods/services serves to separate items within the same or a similar category. The use of a semicolon means a separation between terms. The separation of terms by different punctuation can lead to changes in their meaning and may lead to a different assessment when comparing the goods/services. For more information on punctuation in lists of goods and services, see the Guidelines, Part B, Examination, Section 3, Classification.

For example, in *computer software for use with industrial machines; fire extinguishers* in Class 9, the inclusion of a semicolon means that the term *fire extinguishers* must be considered as an independent category of goods, regardless of whether the intention was to protect computer software to be used in the field of industrial machines and fire extinguishers.

An analysis of the wording of the list of goods/services is also required where the wording used is **not sufficiently clear and precise** to enable the competent authorities and economic operators, on that sole basis, to determine the scope of protection, and, consequently, to enable the Office to carry out a proper comparison of those goods and services.

In such cases the Office will first verify whether goods or services are considered to be unclear or imprecise due to an incorrect translation of the original list. If so, the Office will take different steps depending on whether the unclear or imprecise term is contained in the specification of the EUTM (regardless of whether the EUTM (or EUTM application) is the earlier right or the contested application) or of the national or international mark on which the opposition is based. The provisions contained in paragraphs 1.5.1.1 and 1.5.1.2 apply.

If the lack of clarity and precision is not the result of an incorrect translation but the term is unclear or imprecise in itself, and it prevents the Office from carrying out a

proper comparison of the goods and services, then, in the absence of a limitation enabling the Office to clearly determine the exact scope of protection of the unclear or imprecise term, different steps must be taken depending on whether the unclear or imprecise term is contained in the contested mark or the earlier mark.

Unclear or imprecise term(s) in the list of goods/services covered by the contested mark

Where the contested mark contains an unclear or imprecise term that prevents the Office from carrying out a comparison of goods and services, the Office will reopen examination of the classification of the mark under Article 33 EUTMR and suspend the opposition proceedings accordingly (27/02/2014, T-229/12, *Vogue*, EU:T:2014:95, § 55).

Unclear or imprecise term(s) in the list of goods and services covered by the earlier mark

Where the Office is unable to clearly determine the exact scope of protection of unclear or imprecise terms, the vagueness of the wording is not a sufficient basis in itself for arguing in support of identity or similarity. Unclear or imprecise terms may only be taken into account in their most natural and literal meaning and may not be construed as relating to goods, qualities, properties, methods of use, etc. to which that term is not expressly limited (14/07/2003, R 559/2002-4, *MOBILIX / OBELIX*, §17; 02/02/2015, R 391/2014-4 *POWERMATIC / POWRMATIC et al.*, § 29, 33). Nor may the unclear or imprecise term be interpreted in relation to other goods or services within the same class or different classes.

For example, when comparing the unclear or imprecise term *machines* to *dual combustion machines for use in agriculture*, the lack of clarity and precision of the term cannot be used on its own for arguing similarity; nor can the term be construed as relating to 'dual combustion' machines or to machines 'for use in agriculture' when such qualities and methods of use have not been expressly identified in the specification.

Likewise, when comparing an unclear or imprecise term such as *giftware of all kinds*, such a wide formulation cannot be used by the opponent to argue that the retail of these goods is similar to all kinds of goods in the contested mark, when the opponent could have easily specified the kind of giftware offered for sale. In these cases, the comparison will be done on a case-by-case basis.

Further examples of general indications and terms and expressions lacking clarity and precision can be found in the Guidelines, Part B, Examination, Section 3, Classification, paragraph 4.2.

1.5.3 The meaning of goods/services

Once the wording of the goods and services to be considered has been identified, its meaning must be determined.

In some cases, the exact meaning is immediately obvious from the list of goods and/or services of the marks, where a more or less detailed description of the goods and

services will often be given. For example, the wording *belts, being articles of clothing* excludes by definition safety or industrial belts.

In cases of doubt about the exact meaning of the terms used in the list of goods and/or services, the terms have to be interpreted both in the light of the Nice Classification and from a commercial perspective.

Therefore, *belts* in Class 25 are, due to their classification, *articles of clothing*.

Where the meanings of terms in a semantic context, a commercial context and/or under the Nice Classification are ambiguous or leave doubts, the meaning they have under the Nice Classification prevails.

Clothing, for instance, refers to ‘clothes collectively’ (*Oxford Dictionaries* online edition) and thus to items worn to cover the body, such as shirts, dresses, pants, etc. Although the definition found in standard dictionaries does not explicitly exclude *footwear*, the fact that it appears in the Nice Classification as a separate item in the same class, Class 25, leads to the conclusion that *clothing* and *footwear* are not identical but similar (confirmed 13/07/2004, T-115/02, ‘a’ in a black ellipse, EU:T:2004:234, § 26).

However, this does not mean that two general indications in one class heading can never be considered identical. As mentioned above, the structure of the class headings is not uniform. Some general indications included in the class headings may encompass others.

Example

- *Meat* and *poultry* are identical (Class 29).

1.6 Objective approach

The comparison of the goods/services in question must be made **without** taking into account the degree of similarity of the conflicting signs or the distinctiveness of the earlier mark. It is only in the overall assessment of a decision that the examiners will take into account all the relevant factors.

The classification of the goods or services is not conclusive, because similar goods/services may be classified in different classes, whereas dissimilar goods/services may fall within the same class.

Identity or similarity of the goods/services in question must be determined on an objective basis.

It is necessary to base the findings on the realities of the marketplace, such as established customs in the relevant field of industry or commerce. These customs, especially trade practices, are dynamic and constantly changing. For instance, mobile phones nowadays combine many functions, such as being communication tools as well as photographic apparatus.

The degree of similarity of the goods and services is a matter of law, which must be assessed *ex officio* by the Office even if the parties do not comment on it (16/01/2007, T-53/05, Calvo, EU:T:2007:7, § 59). However, the Office’s *ex officio* examination is

restricted to well-known facts, that is to say, ‘facts which are likely to be known by anyone or which may be learned from generally accessible sources’, which excludes facts of a highly technical nature (03/07/2013, T-106/12, Alpharen, EU:T:2013:340, § 51). Consequently, what does not follow from the evidence/arguments submitted by the parties or is not commonly known should not be speculated on or extensively investigated *ex officio* (09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 31-32). This follows from Article 95(1) EUTMR, according to which, in opposition proceedings, the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. (See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 1, General Principles).

1.7 Statement of reasons

The examiner is required to state reasons for the outcome of the comparison (identity, similarity or dissimilarity) for each of the individual goods and services specified in the application for registration. However, the examiner may use only general reasoning for groups of the goods or services concerned as long as the goods or services present analogous characteristics (see, by analogy, 18/03/2010, C-282/09 P, P@yweb card / Payweb card, EU:C:2010:153, § 37-38; 12/04/2011, T-28/10, Euro automatic Payment, EU:T:2011:158, § 54; 17/10/2013, C-597/12 P, Zebexir, EU:C:2013:672, § 26-27).

2 Identity

2.1 General principles

Identity is generally defined as ‘the quality or condition of being the same in substance, composition, nature, properties, or in particular qualities under consideration’ (*Oxford Dictionaries* online edition).

Identity exists not only when the goods and services completely coincide (the same terms or synonyms are used), but also when and insofar as the contested mark’s goods/services fall within the earlier mark’s broader category, or when and insofar as — conversely — a broader term of the contested mark includes the more specific goods/services of the earlier mark. There might also be identity when two broad categories under comparison coincide partially (‘overlap’). Hence a distinction can be made between cases of ‘full identity’ and ‘partial identity’.

Identity should not be established on the basis of similarity factors (see paragraph 3.1.1).

2.2 Identical terms or synonyms

Identity between the goods/services in dispute must be established on the basis of the wording of the relevant parts of the lists of goods and/or services of the two marks that have been identified in accordance with the general principles set out in paragraph 2.1. Identity is obvious where the goods/services to be compared are listed in exactly the same terms.

Example

- *Vehicles* are identical to *vehicles*.

Where this is not the case, the terms of the respective lists of goods and/or services must be interpreted in order to show that they are in fact synonyms, that is to say, that their meaning is the same. The interpretation can be made based on dictionary definitions, expressions from the Nice Classification and, in particular, by taking into account the commercial perspective.

Examples

- *Bicycle* is a synonym for *bike*. The goods are identical.
- The meaning of the words *smokers' articles* in Class 34 refers to individual objects that are used in close connection with tobacco or tobacco products. In former editions of the Nice Classification these products were called *smokers' requisites*. Therefore, despite a different term used in the current heading, these goods are identical.
- From a commercial perspective, *health spa services* and *wellness services* are the same and are therefore identical.

However, if identical wording is used but the goods are classified in different classes, this generally means that these goods are not identical.

Examples

- *Drills* (machine tools) in Class 7 are not identical to *drills* (hand tools) in Class 8.
- *Lasers* (not for medical treatment) in Class 9 are not identical to *lasers* (for curative purposes) in Class 10.

Even though they might be similar, the classification in different classes indicates that they have a different nature, purpose or method of use, etc.

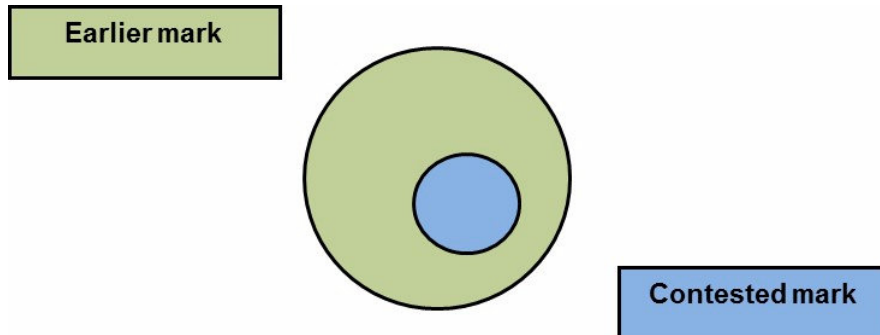
The same reasoning does not apply if the different classification is only due to a revision of the Nice Classification or where it is clear that the goods/services are wrongly 'classified' due to an obvious mistake.

Examples

- *Playing cards* (Class 16 — 7th edition) are identical to *playing cards* (Class 28 — 10th edition).
- *Pharmaceutical preparations* (Class 15) — an obvious typing error — are identical to *pharmaceutical preparations* (Class 5).

2.3 Terms included in the general indication or broad category

2.3.1 The earlier mark includes the goods/services of the contested mark

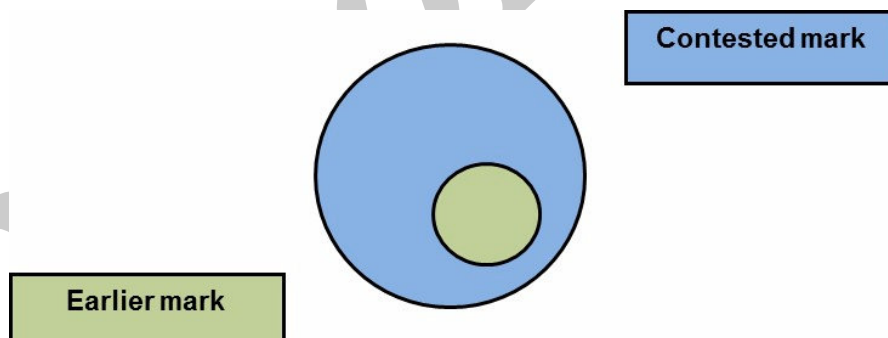


Where the list of goods/services of the earlier right includes a general indication or a broad category that covers the goods/services of the contested mark in their entirety, the goods/services will be identical (17/01/2012, T-522/10, Hell, EU:T:2012:9, § 36).

Examples

- *Temporary accommodation* (earlier right, Class 43) includes *youth hostel services* (contested mark, Class 43). Therefore, the services are identical.
- *Pasta* (earlier right, Class 30) includes *spaghetti* (contested mark, Class 30). The conflicting goods are considered identical.

2.3.2 The contested mark includes the goods/services of the earlier mark



If the goods/services designated in the earlier mark are covered by a general indication or broad category used in the contested mark, these goods/services must be considered identical since the Office cannot dissect *ex officio* the broad category of the applicant's/holder's goods/services (07/09/2006, T-133/05, Pam-Pim's Baby-Prop, EU:T:2006:247, § 29).

Examples

- The earlier mark's *jeans* (Class 25) are included in *articles of clothing* (contested mark, Class 25). The goods are considered identical.
- The earlier mark's *bicycles* (Class 12) are included in *vehicles* (contested mark, Class 12). The goods are considered identical.

The applicant/holder may, however, restrict the list of goods/services in a way that excludes identity, but could still lead to similarity (24/05/2011, T-161/10, E-Plex, EU:T:2011:244, § 22).

- The earlier mark's *jeans* (Class 25) are included in *articles of clothing* (Class 25). The applicant/holder restricts the specification to *articles of clothing, excluding jeans*. The goods are no longer identical but remain similar.
- The earlier mark's *bicycles* (Class 12) are included in *vehicles* (contested mark, Class 12). The applicant/holder restricts the specification to *vehicles, namely automobiles*. The goods are no longer identical or similar.

If the applicant/holder does not restrict the list of goods/services, or does not do so sufficiently, the Office will treat the contested mark's general indication or broad term/category as a single unit and find identity.

If the contested mark covers a general indication or a broad term/category as well as specific items that fall under that general indication or broad term/category, all of these will need to be compared with the specific earlier goods/services. The result of identity found with the general indication or broad term/category does not automatically extend to the specific items.

Example

- The contested mark covers *vehicles* (general indication) as well as *bicycles, aircraft, trains* (included in vehicles). Where the earlier mark is protected for *bicycles*, identity will be found with respect to *vehicles* and to *bicycles* but not for *aircraft or trains*.

However, if the contested mark covers a general indication or broad term/category and specific terms that are not listed independently but only as examples, the comparison differs insofar as only the general indication or broad term/category has to be compared.

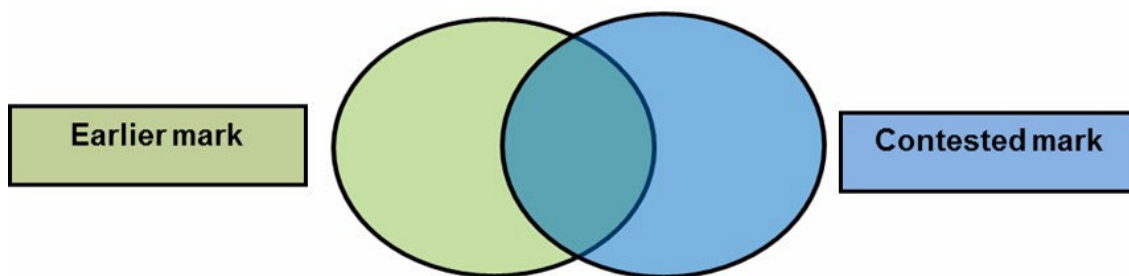
Example

- The contested mark covers *vehicles, in particular bicycles, aircraft, trains*. The earlier mark is protected for *bicycles*. The goods in conflict are considered identical.

The applicant/holder can avoid this result by deleting the general indication *vehicles*, the expression *in particular*, and the specific category *bicycles*.

Where the list of goods and/or services of the contested mark reads: *vehicles, namely bicycles, aircraft, trains*, the comparison differs insofar as only the specific items have to be compared. In this case only the contested *bicycles* are identical to the earlier goods.

2.4 Overlap



If two categories of goods/services coincide partially ('overlap') there might be identity if:

1. they are classified in the same class; and
2. it is impossible to clearly separate the two goods/services.

Examples

Earlier goods	Contested goods	Coinciding part
<i>Outdoor clothing for women</i> (Class 25)	<i>Clothing made of leather</i> (Class 25)	Outdoor clothing made of leather for women
<i>Components and spare parts for land vehicles</i> (Class 12)	<i>Vehicle seats</i> (*) (Class 12)	Seats for land vehicles
<i>Bread</i> (Class 30)	<i>Long-life bakery products</i> (Class 30)	Long-life bread
<i>Soap</i> (Class 3)	<i>Cleaning preparations</i> (Class 3)	Soaps for cleaning purposes
<i>Scientific instruments</i> (Class 9)	<i>Optical instruments</i> (Class 9)	Scientific optical instruments, e.g. microscopes
<i>Online banking services</i> (Class 36)	<i>Commercial banking services</i> (Class 36)	Online commercial banking services
(*) 09/09/2008, T-363/06, Magic seat, EU:T:2008:319, § 22.		

In such cases, it is impossible for the Office to filter these goods from the abovementioned categories. Since the Office cannot dissect *ex officio* the broad category of the applicant's/holder's goods, they are considered to be identical.

In the fourth example given above, the outcome changes, of course, if *soap* is limited to *soaps for personal use*. In this case the goods are no longer included in the heading *cleaning preparations* in Class 3 since the latter are only for household use.

2.5 Practice on the use of general indications of the class headings

According to Article 33(3) EUTMR, the Office does not object to the use of any of the general indications of the class headings provided that this identification is sufficiently clear and precise ⁽⁴²⁾.

According to Article 33(5) EUTMR, the use of general terms or general indications of the class headings will be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms will not be interpreted as comprising a claim to goods or services that cannot be so understood.

Under Article 33(8) EUTMR, during the 6-month period ending on 24/09/2016, proprietors of European Union trade marks filed before 22/06/2012 and registered for the entire heading of a Nice class had the opportunity to declare that their intention at the time of filing had been to cover goods and services going beyond the literal meaning of that class heading, provided that the goods or services declared were included in the alphabetical list for the class of the edition of the Nice Classification in force on the date of filing.

During that 6-month period, Communication of the President No 2/12 of 20/06/2012 remained in force and therefore trade marks filed before 22/06/2012 and registered for an entire class heading were considered to cover the literal meaning of the general indications, as well as the goods and services of the alphabetical list of that class, in the edition of the Nice Classification in force at the time of filing.

According to Article 33(8) EUTMR, last sentence, from the expiry of the 6-month period following the entry into force of the Amending Regulation, all European Union trade marks registered in respect of the entire heading of a Nice class for which no declaration has been filed, will be deemed to extend only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.

Declarations for European Union trade marks filed within the relevant period will take effect from the moment of their entry in the Register.

Where the declaration is accepted and the Register is amended, Article 33(9) EUTMR will apply.

According to Article 33(9) EUTMR, the amendment of a list of goods or services recorded in the Register following a declaration under Article 33(8) EUTMR made during the 6-month period after the entry into force of the Regulation, cannot give the proprietor of a European Union trade mark the right to oppose or to apply for a declaration of invalidity in respect of a later mark where and to the extent that (i) the later trade mark was in use for, or an application had been made to register the later trade mark for, goods or services before the Register was amended for the earlier mark

⁴² See the 'Common Communication on the Common Practice on the General Indications of the Nice Class Headings'.

and (ii) the use in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the record of the goods or services in the Register at that time.

In practice, this means that, where the earlier mark is a European Union trade mark and the contested mark was filed, or was in use, before the Register was amended under Article 33(8) EUTMR for the earlier European Union trade mark, the goods and services identified as going beyond the literal meaning of the class heading will not be taken into account in oppositions or declarations of invalidity filed after the entry into force of the Amending Regulation.

As regards the scope of protection of national marks, the Office and all national trade mark offices of the European Union issued a Common Communication on the implementation of the *IP Translator* judgment. According to that Communication, the Office interprets the scope of protection of national marks containing class headings as follows:

- **Earlier national trade marks filed before the *IP Translator* judgment:** in principle, the Office accepts the filing practice of all national trade mark offices in the European Union. National trade marks filed before the *IP Translator* judgment have the scope of protection awarded by the national office(s) concerned. The majority of the national offices interpret the class headings of their marks literally. For those marks, the Office also interprets the class headings on the basis of the natural and usual meaning of each general indication.
- Only **eight** national trade mark offices do **not** interpret the class headings of their own marks filed before the *IP Translator* judgment on the basis of their natural and usual meaning: **Bulgaria, Greece, Italy, Lithuania, Hungary, Malta, Romania and Finland** (see Table 1 of the Common Communication). The Office interprets those national marks as covering the class headings plus the alphabetical list of the Nice edition at the time of filing (even if the national office interprets the class heading as covering all goods and services in the class).
- **Earlier national marks filed after the *IP Translator* judgment:** the Office interprets all goods and services covered by the national marks on the basis of their natural and usual meaning (see Table 5 of the Common Communication).

In order to determine the scope of protection the abovementioned principles have to be applied. Only those goods or services deemed to be covered following these principles will be considered when comparing the goods/services.

3 Similarity of Goods and Services

3.1 General principles

3.1.1 Similarity factors

Generally speaking, two items are defined as being similar when they have some characteristics in common. The similarity of goods and services does not depend on any specific number of criteria that could be determined in advance and applied in all cases.

The similarity of goods and services has been addressed in the case-law of the Court of Justice in *Canon* (29/09/1998, C-39/97, Canon, EU:C:1998:442). The Court of Justice held that in assessing the similarity of goods **all** the relevant factors relating to those goods themselves should be taken into account. Those factors include, inter alia, their nature, their end users [**should read 'intended purpose'**], their method of use and whether they are in competition with each other or are complementary (para. 23).

The term **inter alia** shows that the enumeration of the above factors by the Court is only indicative. There may be other factors in addition to or instead of those mentioned by the Court that may be pertinent, depending on the particular case.

This leads to the conclusion that the following factors should be taken into account:

Canon factors

- nature
- intended purpose
- method of use
- complementarity
- competition.

Additional factors

- distribution channels
- relevant public
- the usual origin of the goods/services.

These factors will be further explained in paragraph 3.2; they are also used in the Office's database on the comparison of goods and services. It should be noted, however, that even though the database is restricted to these eight factors, there might be specific cases where other criteria are relevant.

3.1.2 Defining relevant factors

The comparison should focus on identifying the relevant factors that specifically characterise the goods/services to be compared. Therefore, the relevance of a particular factor depends on the respective goods/services to be compared.

Example

- When comparing *skis* and *ski-boots*, it is evident that they do not coincide in their nature or method of use and are not in competition. Therefore, the comparison should focus on their purpose, their complementary character, their distribution channels, their usual origin and/or the relevant public.

Therefore, the relevant factors and features characterising a product or a service may be different depending on the goods and services with which they have to be compared.

It is not necessary to list all possible factors. What does matter, however, is whether the connections between the relevant factors are sufficiently close to find similarity.

The following questions could be asked:

- How will the goods/services be used?
- What is their purpose?
- How likely is it that they coincide in producers?
- Are they usually found in the same outlet or department store, or in the same section of a supermarket?

If the factors cannot already be defined from the wording of the goods/services, information may be derived from dictionary entries. However, dictionary entries have to be analysed against commercial realities and in particular taking into account the Nice Classification.

Example

- According to the dictionary, *ice* is the singular of *ices* and means inter alia '(an) ice cream' or 'water ice' (*Oxford Dictionaries* online edition). If the comparison of *ices* and *ice* in Class 30 were made on the basis of the definition from the dictionary alone, it would lead to the erroneous conclusion that *ice* is identical to *ices*. However, since both *ices* and *ice* are mentioned in the list of goods in Class 30, *ices* are to be understood as 'edible ices', whereas *ice* is to be understood as 'cooling ice'. Although they coincide in the composition to the extent that both consist (partly) of frozen water, their commercial nature is different: while one is a foodstuff, the other is an auxiliary good for preserving and/or cooling foodstuffs. This shows that the Nice Classification, in conjunction with the commercial perspective, prevails over the dictionary definition.

Once the relevant factors have been identified, the examiner must determine the relation between and the weight attributed to the relevant factors (see paragraph 3.3).

3.2 The specific similarity factors

The following paragraphs define and illustrate the various factors for similarity of goods and services.

3.2.1 Nature

The nature of a product/service can be defined as the essential qualities or characteristics by which this product/service is recognised. Nature often corresponds to the particular type or sort of product/service or the specific category to which this product/service belongs and which is usually used to define it. In other words, it is the answer to the question ‘What is it?’

Examples

- *Yoghurt* is a milk product;
- *Car* is a vehicle;
- *Body lotion* is a cosmetic product.

3.2.1.1 Indicative value of class headings and categories

The fact that goods/services to be compared fall under the same general indication of a class heading or broad category does not automatically mean that they are of the same nature. An example of such a broad category is *foodstuffs for human consumption*.

Examples

- *Fresh fruit* (Class 31) on the one hand and *coffee, flour, and bread* (Class 30) on the other hand are of a different nature despite being foodstuffs.
- *Meat, fish, poultry and game* (Class 29) are foodstuffs of animal origin. *Fruits and vegetables* (Class 31) are foodstuffs of plant origin. This slight connection, namely all being foodstuffs, does not preclude that their nature is different.

The fact that goods/services to be compared fall under a sufficiently narrow general indication of a class heading favours an identical or similar nature.

Example

- *Condensed milk* and *cheese* (both in Class 29) share the same nature because they belong to the same product category, namely milk products, which are a subcategory of foodstuffs (4/11/2003, T-85/02, Castillo, EU:T:2003:288, § 33).

3.2.1.2 Features of the goods defining their nature

A variety of features of the goods in question may be useful for defining their nature. These include the following:

Composition: for example, ingredients, materials of which the goods are made.

Example

- *Yoghurt* (Class 29) is a milk product (the nature of yoghurt may be defined by its basic ingredient).

Composition may be the most relevant criterion for defining nature. However, an identical or similar composition of the goods is not per se an indicator of the same nature.

Example

- A *chair* (Class 20) and a *doll* (Class 28) can both be made of plastic, but they are not of the same nature since one is a piece of furniture and the other is a toy. They belong to different categories.

Functioning principle: for example, mechanical functioning, with or without engine/motor; optical, electrical, biological, or chemical functioning.

Example

- *Telescope* (Class 9) is an optical device (the nature of a telescope may be defined by its functioning principle, which is optical).

Although the functioning principle may help to define the nature of some goods, it is not always conclusive. There are cases where goods, in particular technology-related ones, with the same functioning principle are of a different nature.

Example

- A *blender* and an *electric toothbrush* have the same functioning principle of rotation, but they are not of the same nature.

In contrast, there are goods with different functioning principles but the same nature.

Example

- The functioning principle of *washing machines using washing powder* is chemical, which is not the same as the functioning principle of *washing machines using magnetic waves*. However, these goods are of the same nature as they are both washing machines.

Physical condition: for example, liquid/solid, hard/soft, flexible/rigid.

The physical condition is another feature of the goods that may be used to define nature but, like the functioning principle, it is not conclusive.

Examples

- All drinks are liquid. Their nature is different from the nature of solid foodstuffs. However, when comparing two different drinks, their physical condition should not be conclusive: *milk* (Class 29) is not of the same nature as an *alcoholic beverage* (Class 33).
- *Yoghurt* is marketed both in solid and liquid form. However, the nature of this good is not defined by its physical condition, but — as mentioned above — by its basic ingredient (milk). In both cases, the nature of a solid yogurt and of a liquid yogurt is the same (a milk product).

3.2.1.3 Nature of services

When defining the nature of services, the composition of features, functioning principle and physical condition cannot be used since services are intangible.

The nature of services can be defined, in particular, by the kind of activity provided to third parties. In most cases, it is the category under which the service falls that defines its nature.

Example

- *Taxi services* (Class 39) have the same nature as *bus services* (Class 39) as they are both transport services.

3.2.1.4 Nature of goods versus nature of services

By their **nature**, goods are generally dissimilar to services. This is because goods are articles of trade, wares or merchandise. Their sale usually entails the transfer in title of something physical. Services, however, consist of the provision of intangible activities.

3.2.2 Intended purpose

‘Purpose’ is generally defined as ‘the reason for which something is done or made, or for which it exists’ (*Oxford Dictionaries* online edition).

As a Canon factor, purpose means the intended use of the goods or services and not any other possible use.

Example

- A *plastic bag* can be used as protection against the rain. However, its intended purpose is to carry items.

The purpose is defined by the function of the goods/services. In other words, it answers the questions: What need do these goods/services satisfy? What problem do they solve?

It is sometimes difficult to determine the proper level of abstraction in order to determine the purpose. As in the case of defining the nature, the purpose must be defined in a sufficiently narrow way.

Example

- In the case of *vinegar*, the intended purpose should not be defined as ‘human consumption’, which is the general purpose that all foodstuffs share, but as ‘everyday seasoning’.

3.2.3 Method of use

The method of use determines the way in which the goods/services are used to achieve their purpose.

The question to be asked is: How are these goods/services used?

Method of use often follows directly from the nature and/or intended purpose of the goods/services and therefore has little or no significance of its own in the similarity analysis.

Example

- The method of use of newspapers and books is the same in the sense that they are both read. However, similarity can already be concluded from the facts that they are both printed matter (same nature) and that they both serve to entertain or to inform (same purpose).

Notwithstanding the explanation above, the method of use may be important, independent of nature and purpose, where it characterises the goods.

Example

- *Pharmaceutical preparations for treating skin diseases* in Class 5 can take the form of creams. They have the same method of use as *cosmetic creams* in Class 3.

However, even where the method of use characterises the goods under comparison and where it is identical for both goods, this fact alone will not be sufficient to establish similarity.

Example

- *Chewing gum* (Class 30) and *chewing tobacco* (Class 34) have an identical method of use. However, this fact alone does not make them similar.

3.2.4 Complementarity

Goods (or services) are complementary if there is a close connection between them, in the sense that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking (11/05/2011, T-74/10, Flaco, EU:T:2011:207, § 40; 21/11/2012, T-558/11, Artis, EU:T:2012:615, § 25; 04/02/2013, T-504/11, Dignitude, EU:T:2013:57, § 44).

The complementary relation between the goods/services can be, for example, functional.

Example

- *Internet site hosting services* in Class 42 cannot exist without *computer programming services* in Class 42. There is a functional complementarity between those services, which, by their nature, belong to the field of information technology. Moreover, these services are aimed at the same public and use the same distribution channels. They are therefore similar (29/09/2011, T-150/10, Loopia, EU:T:2011:552, § 36, 43).

By definition, goods intended for different publics cannot be complementary (22/06/2011, T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 30; 12/07/2012, T-361/11, Dolphin, EU:T:2012:377, § 48). See also paragraph 3.3.1.

Example

- *Textile products* in Class 24 (aimed at the public at large) and *treatment services relating to textile products* in Class 40 (aimed at professionals) cannot be

complementary (16/05/2013, T-80/11, Ridge Wood, EU:T:2013:251, § 28-32). These goods and services are not similar.

Complementarity is not usually conclusive on its own for finding similarity between goods and/or services. Even where a degree of complementarity exists, goods and/or services may be dissimilar.

Example

- There is a degree of complementarity between *wine* (Class 33) and *wineglasses* (Class 21) insofar as wineglasses are intended to be used for drinking wine. However, that complementarity is not sufficiently pronounced to conclude that these goods are similar. Furthermore, these goods are not of the same nature or usual origin nor do they usually share distribution channels (12/06/2007, T-105/05, Waterford Stellenbosch, EU:T:2007:170, § 34; confirmed 07/05/2009, C-398/07 P, Waterford Stellenbosch, EU:C:2009:288, § 45).

However, when complementarity between goods/services has been found in combination with other factors, such as 'usual origin' and/or 'distribution channel', similarity may be found.

Examples

- *Skis* (Class 28) and *ski boots* (Class 25) are complementary because the use of one is indispensable for the use of the other. The relevant public may think that the production of these goods lies with the same undertaking. In addition, they share the same public and distribution channels. These goods are consequently considered similar.
- *Teaching materials* in Classes 9 and 16 (such as printed matter, pre-recorded data carriers and audio/video cassettes) are essential and thus complementary to *educational courses* in Class 41. Generally the materials are issued by the same undertaking, and share the same public and distribution channels. These goods are similar to the services in question (23/10/2002, T-388/00, ELS, EU:T:2002:260).
- *Services of an architect (designing of buildings)* (Class 42) are indispensable for *building construction* (Class 37). These services are often offered together through the same distribution channels, by the same providers and to the same public. Consequently, these services are complementary and similar (09/04/2014, T-144/12, Comsa / COMSA S.A., EU:T:2014:197, § 65-67).

3.2.4.1 Use in combination: not complementary

Complementarity has to be clearly distinguished from use in combination where goods/services are merely used together, whether by choice or convenience (e.g. bread and butter). This means that they are not essential for each other (16/12/2013, R 634/2013-4, ST LAB (fig.) / ST et al., § 20). In such cases similarity can only be found on the basis of other factors, not on complementarity.

Example

- Even if the functioning of *transmission belts* in Class 12 can be measured with the help of a *device for motor-vehicle testing* in Class 9, this does not mean that the

goods are complementary. It can be convenient in certain cases to measure the performance of one or the other parameter but simple convenience is not sufficient to conclude that one product is indispensable for the other (03/10/2013, R 1011/2012-4, SUN (fig.) / SUN (fig.) et al., § 39).

Certain goods that are often coordinated with each other but do not fall within the scope of other similarity factors were determined by the Court to have 'aesthetic complementarity' (01/03/2005, T-169/03, Sissi Rossi, EU:T:2005:72, § 62; 11/07/2007, T-150/04, Tosca Blu, EU:T:2007:214, § 35-39; 11/07/2007, T-443/05, Pirañam, EU:T:2007:219, § 49-50; 20/10/2011, T-214/09, Cor II, EU:T:2011:612, § 32-37). This relationship between the goods falls outside the existing definition of complementarity.

Example

- *Handbags* (Class 18) and *clothing* (Class 25) are closely connected but not complementary, since one is not essential for the use of the other. They are merely often used in combination. They are, however, similar because of the fact that they may well be distributed by the same or linked manufacturers, bought by the same public and can be found in the same sales outlets.

3.2.4.2 Ancillary goods/services: not complementary

When certain goods and/or services only support or supplement another product or service, they are not considered to be complementary within the meaning of the case-law. Ancillary goods are typically those used for packaging (e.g. bottles, boxes, cans) or for promotion (e.g. leaflets, posters, price lists). Equally, goods/services offered for free in the course of a merchandising campaign are usually not similar to the primary product or service.

Examples

- *Organisation and conducting of exhibitions* is not similar to *printed matter, including event notes* (Class 16), since the goods merely serve to promote and announce the specific event. These goods and services are not complementary.
- *Herbal nutritional supplements* in Class 5 are not indispensable or important for the use of *beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages* in Class 32. Any combined consumption of those products is merely ancillary. Therefore, these goods are not complementary. Furthermore, since their purpose, distribution channels and usual producers are different, and they are not in competition, these goods are not similar (23/01/2014, T-221/12, Sun fresh, EU:T:2014:25, § 84).

3.2.4.3 Raw materials, parts, components and fittings: not complementary

Lastly, where the goods concern raw materials, the complementarity criterion is not applicable in the analysis of similarity.

Raw materials as a significantly important basic component of an end product may be found similar to that product, but not on the basis of complementarity. Similar

considerations apply to parts, components and fittings (see also Annex I, paragraphs 1 and 2, and Annex II, paragraphs 5.1 and 5.2).

Example

- *Plastic or synthetic products used as raw or semi-finished material* (in Classes 1 and 17) cannot be regarded as complementary to *finished products* (made from these materials in Classes 9 and 12) on the ground that the raw materials are intended to be turned into the finished products (09/04/2014, T-288/12, Zytel, EU:T:2014:196, § 39).

3.2.5 In competition

Goods/services are in competition with each other when one can substitute the other. That means that they serve the same or a similar purpose and are offered to the same actual and potential customers. In such a case, the goods/services are also defined as 'interchangeable' (04/02/2013, T-504/11, Dignitude, EU:T:2013:57, § 42).

Examples

- *Wallpaper* (Class 27) and *paints* (Class 2) are in competition because both cover or decorate walls.
- *Rental of movies* (Class 41) and *services of a cinema* (Class 41) are in competition because they both allow you to watch a film.
- *Electric shavers* and *razor blades* (both in Class 8) are in competition because they serve the same purpose.

In some cases the price of goods/services in competition may differ significantly, but this fact alone does not affect the analysis of whether they are in competition with each other or not.

Example

- *Jewellery made of gold* and *fashion jewellery* ⁽⁴³⁾ (both in Class 14) are in competition even though their price (and value) may greatly differ.

3.2.6 Distribution channel

Although 'distribution channel' is not explicitly mentioned in the *Canon* judgment, it is widely used internationally and nationally in the assessment of whether two goods/services are similar. It has been taken into account as an additional factor in several judgments of EU courts (21/04/2005, T-164/03, *monBeBé*, EU:T:2005:140, § 53). The reasoning for this is as follows.

If the goods/services are made available through the same distribution channels, the consumer may be more likely to assume that the goods or services are in the same market sector and are possibly manufactured by the same entity and vice versa.

⁴³ Fashion/costume jewellery is understood to be jewellery made from inexpensive metals and imitation gems or semi-precious stones, worn for decorative purposes.

The term ‘distribution channel’ does not refer so much to the way of selling or promoting a company’s product as to the place of distribution. For the analysis of the similarity of goods/services, the distribution system — whether direct or indirect — is not decisive. The question to be asked is rather: do the goods/services have the same points of sale, or are they usually provided or offered at the same or similar places?

However, too much emphasis should not be placed on this factor as modern supermarkets, drugstores and department stores sell goods of all kinds. The relevant public is aware that the goods sold in these places come from a multitude of independent undertakings. Therefore, the point of sale is less decisive when deciding whether the relevant public considers that goods share a common origin merely because they are sold at the same outlet.

Only where the goods in question are offered in the same **section** of such shops, where homogeneous goods are sold together, will this favour similarity. In such cases it must be possible to identify the section by its territorial and functional separation from other sections (e.g. dairy section of a supermarket, the cosmetics section of a department store).

Similarly, this factor may apply in cases in which goods are sold exclusively or commonly in specialised shops. In that event, consumers may tend to believe the origin of the goods to be the same if they are both sold in the same specialised shops and may tend to deny that mutual origin if they are not usually sold in the same shops.

Conversely, different sales outlets may weigh against the similarity of goods.

Example

- *Wheelchairs* versus *bicycles*.

Although both fall under *vehicles* in Class 12, they will not be found at the same outlets. Bicycles are usually sold either in specialist bicycle stores or in a retail store where sporting equipment is available. By contrast, the distribution channels for *wheelchairs* are the specialised distributors of medical equipment and devices that supply hospitals, and specialised shops where devices for disabled or physically handicapped people are sold.

3.2.7 Relevant public

The relevant public, such as the actual and potential customers of the goods and services in dispute, constitutes another factor to be dealt with in the analysis of similarity (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

The relevant public can be composed of:

- the general public (public at large) or
- a professional public (business customers or specialised public).

The relevant public does not necessarily mean the end user; for instance, the end users of *food for animals* in Class 31 are animals, not the relevant public. The relevant public in this case would be the general consumer.

The mere fact that the potential customers coincide does not automatically constitute an indication of similarity. The same group of customers may be in need of goods or services of the most diverse origin and nature. The fact that, for example, television sets, cars and books are bought by the same relevant public, namely the public at large, has no impact on the analysis of similarity. In many cases, either one or both lists of goods/services under comparison target the public at large, but the purpose (of covering customers' needs) is different in each case. Such circumstances weigh against similarity.

While a coincidence in the relevant public is not necessarily an indication of similarity, largely diverging publics weigh heavily against similarity.

Diverging customers can be found in the following cases, where:

1. the goods/services of both lists are directed at the public at large, who can, however, be clearly categorised by their different (personal) needs, ages, etc.
Example: *wheelchairs* versus *bicycles* (Class 12).
2. the goods/services of both lists target business customers, who may, however, be acting in a very different market sector.
Example: *chemicals used in forestry* versus *solvents for the lacquer industry* (Class 1).
3. one relevant public consists of general consumers and the other of business customers.
Example: *containers for contact lenses* (in Class 9) versus *surgical apparatus and instruments* (in Class 10).

3.2.8 Usual origin (producer/provider)

Although the Court of Justice did not explicitly mention this factor in its *Canon* judgment, it follows from the general concept of likelihood of confusion that the usual origin of the goods and services is of particular importance for the analysis of similarity. As the Court has stated, it is 'the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, [that] constitutes a likelihood of confusion' (29/09/1998, C-39/97, *Canon*, EU:C:1998:442, § 29). Hence, there is a strong indication of similarity when, in the mind of the relevant public, the goods/services have the same usual origin.

However, this should not be misinterpreted as turning the examination of likelihood of confusion and similarity of goods/services upside down: the finding of a likelihood of confusion depends on many other factors (such as the similarity of signs and the distinctiveness of the earlier mark) and is not exclusively determined by the usual origin, which as such is only one factor in the analysis of the similarity of goods/services.

A finding that consumers will not be confused about the origin of the goods/services is not an argument appropriate to the comparison of goods/services. This finding should be mentioned in the overall assessment of likelihood of confusion. Origin, in this context, relates mainly to the manufacturing sector (industry) or kind of undertaking

producing the goods or offering the services in question rather than to the identity of the producer.

The 'origin' is not merely defined by the actual place of production/provision (e.g. factory, workshop, institute or laboratory) but primarily by taking into consideration who manages and/or controls the production/provision of the goods/services. In other words, the question to be asked is: who is responsible for manufacturing the product or providing the service?

The geographical origin (e.g. China) is not relevant for the finding of similarity of goods/services.

In the *ELS* judgment, the Court held that even goods and services can have the same origin if it is common for the same type of company to produce/provide both. *Educational textbooks* (Class 16) were considered to have the same origin as *provision of correspondence courses* (Class 41) since 'undertakings offering any kind of course often hand out those products to pupils as support learning materials' (23/10/2002, T-388/00, *ELS*, EU:T:2002:260, § 55).

The criterion 'usual origin' has to be applied in a restrictive way in order not to dilute it. If all kinds of goods/services deriving from one large (multinational) company or holding were found to have the same origin, this factor would lose its significance.

Example

- *Cosmetics* (Class 3) and *foodstuffs* (Classes 29 to 31) may be produced under the umbrella of one company but this does not reflect common trade customs, according to which these types of goods have different producers, each belonging to a specific industry.

3.2.8.1 Features defining a common origin

When determining the usual origin of a product/service the following features might be relevant.

Manufacturing sites

Example

- *Varnishes, lacquers, colorants and mordants* (Class 2) are typically produced by the same production enterprises, normally specialised chemical companies.

The place of production can be a strong indicator that the goods/services in question come from the same source. However, while the same manufacturing sites suggest a common usual origin, different manufacturing sites do not exclude that the goods come from the same or economically linked undertakings. For instance, *books* (Class 16) and *electronic media* (Class 9) (goods in competition, with e-media substituting books) are both goods of a publishing house.

Methods of manufacture

Example

- *Leather belts* (Class 25) and *leather handbags* (Class 18) are not only manufactured in the same sites, for example, leather workshops, but are also manufactured using the same tools and machines for the treatment of leather.

(Technical) know-how

Example

- *Computer virus protection services* (Class 42) and *software design* (Class 42) involve similar technical know-how in the field of information technology.

Established trade custom known to the public

An established trade custom, such as when manufacturers expand their businesses to adjacent markets, is of particular importance for concluding whether goods/services of different nature have the same origin. In such situations, it is necessary to determine whether such expansion is common in the industry or, conversely, whether it may occur in exceptional cases only.

Example where extension has become customary

- *Shoes* (Class 25) and *handbags* (Class 18): it is customary in the market for the producers of shoes also to be involved in the manufacture of handbags.

Example where extension is not (yet) common

- *Clothing* (Class 25) and *perfumes* (Class 3): even though some designers that make fashion clothes nowadays also sell perfumes under their marks, this is not the rule in the clothing industry, and rather applies only to (economically) successful designers.

3.3 Relation between different factors

The Canon criteria were enumerated in the corresponding judgment without any indication of relationship or hierarchy (weight) among them. They were considered one by one. However, they cannot be considered independently since some criteria are interrelated and some criteria are more important than others, regardless of whether goods are being compared with goods, services with services or goods with services. As a result of weighing all these factors in accordance with their respective importance in relation to the goods/services at issue, similarity may be found to various degrees: low, average or high (see paragraph 3.3.4).

3.3.1 Interrelation of factors

In many cases there will be relationships between the factors in the sense that where one is shared, another one might coincide as well.

Examples

- Based on the purpose, it is also possible to determine who the actual and potential customers (i.e. the relevant public) are.
- The purpose, together with the relevant public, may also reveal whether goods/services are in competition.

- The same distribution channel goes hand in hand with the same public. In other words, where the distribution channels are different, the public may be different as well.
- Goods/services intended for different publics cannot be complementary (11/05/2011, T-74/10, Flaco, EU:T:2011:207, § 40, 22/06/2011; T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 30).
- The method of use usually depends on the nature and purpose of the goods.

There are cases in which it is difficult to make a distinction between various factors. This is particularly true as far as 'nature', 'purpose' and 'method of use' are concerned. Where the examiner encounters such difficulties, it is sufficient to treat these factors jointly.

Example

- An *engine* is a machine for converting any of various forms of energy into mechanical force and motion. In such a case, it is difficult to distinguish the nature from the purpose of the product. Therefore, in this case, no distinction between what is nature and what is purpose is necessary.

3.3.2 Importance of each factor

In assessing the similarity of goods and services, **all** relevant factors characterising the relationship between them should be taken into account. However, depending on the kind of goods and services, a particular criterion may be more or less important. In other words, the various criteria do not have a standard value; rather, their specific importance should be determined in the context of each individual case.

In general, the weight of each factor will depend on the impact it has on possible confusion regarding origin. Criteria clearly suggesting that the goods/services come or do not come from the same undertaking or economically linked undertakings should take precedence.

Generally strong factors

- Usual origin (because it has a strong impact on likelihood of confusion, which relates to common commercial origin).
- Purpose (because it is decisive for the choice made by the customer buying or selecting goods/services).
- Nature (because it defines the essential qualities and characteristics of the goods/services).
- Complementarity (because the close connection between the use of the goods/services makes the public believe that they share the same source).
- In competition (usually goods/services that are in competition have the same purpose and target the same public).

Less important factors

- Method of use (even dissimilar goods can be used in the same manner, e.g. *baby carriages* and *shopping trolleys*).

- Distribution channels (even dissimilar goods can be sold in the same section of stores depending on different display practices, e.g. *chewing gum* (Class 30) and *cigarettes* (Class 34)).
- Relevant public (especially when goods/services target the general public).

3.3.3 Different types of comparisons: goods versus goods, services versus services and goods versus services

In principle, the same factors for comparing goods with goods are relevant for the comparison of services with services. However, in applying these factors, the basic difference between goods and services (tangible versus intangible) must be considered.

Furthermore, the same principles that apply for the comparison between goods and goods and between services and services also apply in cases where goods are compared with services.

By their nature, goods are generally dissimilar to services. They can, however, be complementary. Services can also have the same purpose and thus be in competition with goods. It follows that under certain circumstances similarity between goods and services can be found.

3.3.4 Degree of similarity

Goods and/or services can be found similar to different degrees (low, average or high), depending on how many factors they share and the weight given to each of them. The degree of similarity found between the goods and services is of relevance when making a final decision on the likelihood of confusion.

Generally, one factor on its own is not sufficient for finding similarity between the goods/services, even if it is a strong factor.

Examples of dissimilarity

- *Cars* and *bicycles* (both in Class 12) share the same purpose (taking oneself from A to B), but this does not make them similar.
- Although *window glass* (Class 19) and *glasses for spectacles* (Class 9) have the same nature, they are not similar, since they do not coincide in other relevant factors, such as purpose, producers, distribution channels and relevant public.

It is the combination of various factors and their weight that allows the final conclusion on similarity. The combination of two strong factors, such as nature and producer, or the combination of one strong and two weak factors will often lead to similarity. In contrast, the combination of two weak factors, such as distribution channel and relevant public are, in principle, not conclusive for a finding of similarity between the goods and services.

Examples of similarity

- *Milk* and *cheese* (both in Class 29) have a different purpose and method of use; they are not in competition or complementary. However, the fact that they share the

same nature (dairy goods) and usual origin (dairy company) is decisive for a finding of similarity.

- Although *pharmaceuticals* and *plasters* (both in Class 5) have a different nature, they share a similar purpose: treating diseases, disabilities or injuries. Furthermore, they have the same distribution channels and relevant public. Therefore, they are similar.

The number of coinciding factors found, together with their importance/weight, establishes the degree of similarity. Generally speaking, the higher the number of common factors, the higher the degree of similarity. A similarity found on the basis of only two factors would normally not be high, unlike in cases where the goods/services coincide in four or more relevant factors.

However, no mathematical analysis is possible since it always depends on the specific circumstances of each case.

Obsolete

4 Annex I: Specific Questions on the Similarity of Goods and Services

This part does not establish any new criteria for finding similarity between goods and services. It merely helps to clarify how to compare specific groups of goods and services for which, apart from the Canon criteria, some general rules and exceptions apply.

4.1 Parts, Components and Fittings

The mere fact that a certain product can be composed of several components does not automatically establish similarity between the finished product and its parts (27/10/2005, T-336/03, Mobilix, EU:T:2005:379, § 61).

Examples of dissimilarity

- *Fan blades* (Class 7) and *hair dryer* (Class 11)
- *Electric cable* (Class 9) and *lamp* (Class 11)
- *Buttons* (Class 26) and *clothing* (Class 25).

Similarity will only be found in exceptional cases and requires that at least some of the main factors for a finding of similarity, such as producer, public and/or complementarity, are present.

Such an exception is based on the fact that parts and fittings are often produced and/or sold by the same undertaking that manufactures the end product and target the same purchasing public, as in the case of spare or replacement parts. Depending on the product involved, the public may also expect the component to be produced by, or under the control of, the 'original' manufacturer, which is a factor that suggests that the goods are similar.

In general, a variety of factors may be significant in each particular case. For instance, if the component is also sold independently, or if it is particularly important for the functioning of the machine, this will favour similarity.

Examples of similarity

- *Electric toothbrush* (Class 21) and *replacement brush heads* (Class 21)
- *Printer* (Class 9) and *ink jet cartridges* (Class 2)
- *Sewing machines* (Class 7) and *walking feet for sewing machines* (Class 7).

4.2 Raw Materials and Semi-Processed Goods

A similar approach is followed in relation to raw materials and semi-processed goods on the one hand and finished goods on the other.

In most cases, the mere fact that one product is used for the manufacture of another will not be sufficient in itself to show that the goods are similar, as their nature, purpose,

relevant public and distribution channels may be quite distinct (13/04/2011, T-98/09, T Tumesa Tubos del Mediterráneo S.A., EU:T:2011:167, § 49-51). According to case-law, the raw materials subjected to a transformation process are essentially different from the finished products that incorporate, or are covered by, those raw materials, in terms of nature, aim and intended purpose (03/05/2012, T-270/10, Karra, EU:T:2012:212, § 53). Furthermore, they are not complementary since one is manufactured with the other, and raw material is in general intended for use in industry rather than for direct purchase by the final consumer (09/04/2014, T-288/12, Zytel, EU:T:2014:196, § 39-43).

Examples of dissimilarity

- *Leather, animal skins* (Class 18) and *clothing* (Class 25)
- *Precious metals* (Class 14) and *jewellery* (Class 14).

However, the final conclusion may depend on the specific circumstances of the case, such as the degree of transformation of the raw material or whether it is the basic component of the end product. The greater the significance of the raw material for the end product, the more likely it is that the goods will be similar. Consequently, similarity might be established when the raw material or the semi-finished product can be decisive for the form, character, quality or value of the end product. In these cases, the raw material can often be obtained separately from the end product through the same distribution channels.

Example of similarity

- *Precious stones* (Class 14) and *jewellery* (Class 14). Contrary to *precious metals*, *precious stones* can be obtained in jewellery shops independently of the end product.

See also Annex II, paragraph 5.5.1, 'Ingredients of prepared food'.

4.3 Accessories

'Accessories' with no further qualification is an unclear or imprecise term as described in paragraph 1.5.2 'The relevant scope', and should be treated accordingly.

An accessory is something extra that improves or completes the main product it is added to. Unlike parts, components and fittings, an accessory does not constitute an integral part of the main product, although it is usually used in close connection. An accessory usually fulfils a useful technical or decorative purpose.

The rules in respect of parts, components and fittings are to a certain extent also valid in the case of accessories. The mere fact that a certain product is used in combination with another is not necessarily conclusive for a finding of similarity.

Examples of dissimilarity

- *Clothing* (Class 25) and *hair ornaments* (Class 26)
- *Fragrances for automobiles* (Class 3) and *vehicles* (Class 12).

However, it is common for some accessories also to be produced by the manufacturer of the main product. Consequently the consumer may expect the main product and

accessories to be produced under the control of the same entity, especially when they are distributed through the same channels of trade. In such cases, there is a strong indication of similarity.

Examples of similarity

- *Bicycles* (Class 12) and *panniers for bicycles* (Class 12)
- *Glasses* (Class 9) and *cases for glasses* (Class 9).

4.4 Installation, Maintenance and Repair Services

These services belong to the category of goods-related services.

Since, by nature, goods and services are dissimilar, similarity between goods and their installation, maintenance and repair can only be established when:

- it is common in the relevant market sector for the manufacturer of the goods to also provide such services; **and**
- the relevant public coincides; **and**
- installation, maintenance and repair of these goods are provided independently of the purchase of the goods (not aftersales services).

The installation of virtually all goods is classified in Class 37, such as *installation of air conditioning apparatus, consumer electric appliances, elevators or lifts, fire alarms, freezing machines, kitchen appliances*. The *installation and repair of computer hardware* is also in Class 37, as it is a physical repair and installation activity. However, *installation and repair of computer software* is classified in Class 42 because it involves computer programming without any physical installation or repair.

Examples of similarity

- *Data processing equipment and computers* (Class 9) and *installation and repair of computer hardware* (Class 37)
- *Air conditioning apparatus* (Class 11) and *installation, maintenance and repair of air conditioning apparatus* (Class 37)
- *Machinery for working metal* (Class 7) and *maintenance of machinery* (Class 37).

Examples of dissimilarity

- *Building materials* (Class 19) and *installation of building insulation* (Class 37)
- *Shoes* (Class 25) and *repair of shoes* (Class 37)
- *Vehicles* (Class 12) and *dent removal for motor vehicles* (Class 37) (15/12/2010, T-451/09, Wind, EU:T:2010:522, § 28-30).

4.5 Advisory Services

Advisory services refer to providing advice that is tailored to the circumstances or needs of a particular user and that recommends specific courses of action for the user. *Provision of information*, however, refers to providing a user with materials (general or

specific) about a matter or service but not advising the user on specific courses of action.

With the 8th edition of the Nice Classification, *professional consultation services* in Class 42 were eliminated. Since then consultation services — as well as *advisory and information services* — have been classified in the class of the service that corresponds to the subject matter of the consultation. For instance, *transportation consultancy* belongs to Class 39, *business management consultancy* falls under Class 35, *financial consultancy* is classified in Class 36 and *beauty consultancy* in Class 44. The rendering of the advice, information or consultancy by electronic means (e.g. telephone, computer) does not affect the classification of these services.

Advisory, consultancy and information services are in principle always similar, or even identical, to the *services* to which they relate.

Examples

- Financial information services (Class 36) are included in *financial affairs* (Class 36) and are thus identical (27/02/2008, T-325/04, Worldlink, EU:T:2008:51, § 58).
- Computer software advisory services (Class 42) are similar to the installation and maintenance of software (Class 42) because, although they may not necessarily be included in installation and maintenance of software, they are often complementary.
- When it comes to comparing advisory, consultancy and information services with goods, similarity can be found under conditions akin to those concerning maintenance, installation and repair (see paragraph 4).

Examples of similarity

- *Advisory services in computer technologies (hardware and software)* (Class 42) and *computer software* (Class 9)
- *Beauty consultancy* (Class 44) and *cosmetics* (Class 3).

Examples of dissimilarity

- *Information services concerning the purchase of fashion articles (shoppers guide information)* (Class 35) and *clothing, footwear and headgear* (Class 25), as it is not common in the market for the manufacturer of articles in Class 25 to provide such information services.
- *Providing information in the field of entertainment* (Class 41) and *toys* (Class 28), as it is not common in the market for the manufacturer of toys in Class 28 to provide such information services.

4.6 Rental and Leasing

Rental services are classified in the same classes as the service provided by means of the rented objects:

- *rental of telephones* is in Class 38 because *telecommunication services* are in Class 38;
- *rental of cars* is in Class 39 because *transport services* are in this class.

Leasing services are analogous to rental services and therefore are classified in the same way. However, hire- or lease-purchase financing is classified in Class 36 as a financial service.

Based on the understanding that *leasing* in English means rental, these services must be clearly distinguished from any financial services. The comparison of rental and leasing services leads to the outcomes shown in the following paragraphs.

4.6.1 Rental/leasing versus related services

Even though rental services are classified in the same classes as the service provided by means of the rented objects, they are not automatically identical to this service. The comparison between these services has to be made applying normal criteria for identity and similarity.

Examples

- There is identity between *rental of flats* (Class 36) and *real estate affairs* (Class 36) because *rental of flats* is included in *real estate affairs*.
- The same reasoning cannot apply to *rental of bulldozers* (Class 37) and the related services of *building construction* (Class 37). *Rental of bulldozers* is not included in *building construction* and therefore these services are not considered to be identical.

4.6.2 Rental/leasing versus goods

Rental/leasing services are in principle always dissimilar to the goods rented/leased.

Examples

- *Vehicle rental* (Class 39) and *vehicles* (Class 12)
- *Rental of films* (Class 41) and *DVDs* (Class 9).

Exceptions exist where it is common for the manufacturer of the goods to provide rental services.

- *Rental and leasing of computer software* (Class 42) and *computer software* (Class 9) are considered to be similar to a low degree.
- *Rental of automatic vending machines* (Class 35) and *automatic vending machines* (Class 7) are considered to be similar to a low degree.

5 Annex II: Specific Industries

5.1 Chemicals, Pharmaceuticals and Cosmetics

5.1.1 Chemicals (Class 1) versus chemical products (Classes 3 and 5)

Although major chemical companies are usually involved in the production of all kinds of basic chemicals, speciality chemicals and life science products, including pharmaceuticals and pesticides, as well as consumer products, such as cleaning preparations and cosmetics, the mere fact that their nature coincides — as all of them can be broadly classified as chemical products — is not sufficient to find them similar. Special attention must be drawn to the specific purpose of these chemicals, as well as to their public and distribution channel. What has been said in paragraph 4.2 as to the relation between raw materials, semi-processed and finished products particularly applies to these products.

Consequently, although goods in Class 3 and Class 5 are usually combinations of various chemicals, they are in principle not considered similar to goods included in Class 1. Their purpose as a finished product usually differs from goods in Class 1, which are mainly in their raw, unfinished state and not yet mixed with other chemicals and inert carriers into a final product. The finished products in Class 3 and Class 5 usually also target a different public and do not share the same distribution channels.

However, it cannot be excluded that goods such as *chemicals used in agriculture, horticulture and forestry* require few processing steps to be considered finished products, such as *fungicides*. Such chemicals may be considered to already share the inherent purpose of *fungicides*: to kill or inhibit fungi or fungal spores, in particular when they consist of the fungicide's active ingredient. Furthermore, the same (agro-)chemical companies may produce the semi-processed goods, as well as the final product. There is therefore a low degree of similarity between *chemicals used in agriculture, horticulture and forestry* and *fungicides* (08/10/2013, R 1631/2012-1, QUALY / QUALIDATE, § 27-28).

Furthermore, there are also goods in Class 1 that are not mere chemicals but are semi-finished or even finished products with a specific purpose of use, which is an important factor that must be taken into account when comparing goods in Class 1 with goods in other classes.

For example *manures* in Class 1 on the one hand and *pesticides, fungicides and herbicides* in Class 5 on the other are not only chemical products but also finished products with a specific use in the agricultural industry. They therefore have a similar purpose since the specific goods in Class 5 can be considered growth-enhancing by preventing conditions that could inhibit plant growth. As such they are similar to a low degree.

5.1.2 Pharmaceuticals versus pharmaceuticals

A pharmaceutical preparation refers to any kind of medicine, that is to say, a substance or combination of substances for treating or preventing diseases in human beings or animals. From its definition it can already be concluded that *veterinary preparations* — though separately mentioned in the class heading — are included in the broader term of *pharmaceutical preparations*. Therefore, they are identical.

The same applies to herbal and homoeopathic medicines since they are included in the broad term of *pharmaceutical preparations*.

Equally, testing preparations, that is to say, chemical reagents for medical — including veterinary — purposes, also fall under the general indication of *pharmaceutical preparations*.

Specific pharmaceuticals are considered to be similar to other specific pharmaceuticals. This is because several, if not all, criteria for similarity are usually met: they share the same nature because they are specific chemical products; their purpose is, broadly speaking, healing and/or curing; they are sold in the same places, namely, pharmacies; and they come from the same source, which is the pharmaceutical industry. This industry manufactures a wide variety of drugs with various therapeutic indications, something the general public is aware of. Furthermore, their method of use can be the same and they can be in competition with one another (17/11/2005, T-154/03, Alrex, EU:T:2005:401, § 48).

However, the degree of similarity found between specific pharmaceuticals may vary depending on their specific therapeutic indications.

Example 1

- *Sedatives versus pain killers*. These pharmaceuticals are highly similar.

Example 2

- *Anti-epileptics versus pharmaceutical preparations, except medicines to combat diseases in connection with the central nervous system*. These pharmaceutical preparations are considered to be similar (24/05/2011, T-161/10, E-Plex, EU:T:2011:244, § 24-25).

Example 3

- *Cardiovascular preparations versus pharmaceutical preparations for the treatment of central nervous system [CNS] diseases*. These pharmaceutical preparations are only similar to a low degree. In this regard, it should be noted that a low degree of similarity should only be established in exceptional cases, for example, when it can be clearly established that they have different therapeutic indications and different methods of use.

Whether a specific pharmaceutical is sold under prescription is not of particular relevance for the comparison of the goods. Therefore, a prescription medicine is generally to be considered similar to an over-the-counter drug for the reasons stated above. (For information on the relevant public and the degree of attention in relation to

pharmaceuticals, see the Guidelines, Part C, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention.)

5.1.3 Pharmaceuticals versus dietetic substances adapted for medical use

Dietetic substances and food supplements adapted for medical use are substances prepared for special dietary requirements with the purpose of treating or preventing a disease. Bearing this in mind, their purpose is similar to that of *pharmaceutical products* (substances used in the treatment of diseases) insofar as they are used to improve a patient's health. The relevant public coincides and the goods generally share the same distribution channels. For the above reasons, these goods are considered to be similar.

5.1.4 Pharmaceuticals versus cosmetics

The general categories *pharmaceuticals* and *cosmetics* are considered to be similar. Cosmetics include preparations used to enhance or protect the appearance or odour of the human body and they are also often fragranced to add a pleasant smell. Pharmaceuticals, however, comprise products, such as skin or haircare preparations with medical properties. They may coincide in purpose with cosmetics. Moreover, they share the same distribution channels since they can be found in pharmacies or other specialised shops. They target the same public and are often manufactured by the same companies.

However, when comparing specific pharmaceuticals with cosmetics, they may only show a low degree of similarity or they may even be entirely dissimilar, depending on the specific drug and its specific purpose (medical indication/effect) or its method of use.

Example

- A *painkiller* is dissimilar to *nail polish*.

5.1.5 Pharmaceuticals versus services

Although pharmaceutical companies are heavily involved in research and development activities, they do not usually provide such services to third parties. Consequently, Class 5 goods are generally dissimilar to all services covered by Class 42.

With regard to the link between *pharmaceutical products* in Class 5 on the one hand, and *scientific and technological services and research* that encompass, for example, chemical, biological and bacteriological research and analysis, and other services in Class 42 pertaining to the pharmaceutical industry on the other hand, the following factors must be considered. Admittedly, carrying out research and development activities is a prerequisite before launching any pharmaceutical product on the market. In addition, a certain overlap in the relevant public of these goods and services cannot be denied, since professionals in the pharmaceutical industry that are the target public of the research services can also be the consumers of pharmaceutical goods.

Nevertheless, there is a clear difference between the respective channels of distribution, since these services would not be made available or acquired where the goods are offered for sale, in pharmacies or outlets dealing in medical supplies for health-care institutions. Furthermore, there is no complementary relationship between these goods and services. Although pharmaceutical companies advertise the fact that, due to their research and development activities and innovation, they continuously improve their products and even if such services may be important as part of the production process of pharmaceuticals, complementarity applies only to the use of goods and not to their production process (see paragraph 3.2.4, Complementarity, and 11/05/2011, T-74/10, Flaco, EU:T:2011:207, § 40; 11/12/2012, R 2571/2011-2, FRUITINI, § 18) and in this case neither of them is important or essential for the use of the other. The same considerations apply where the pharmaceutical studies and other research activities are performed for, or in cooperation with, third parties. Therefore, these goods and services are dissimilar.

Dissimilarity should also be found when comparing *pharmaceutical preparations* and *medical (including veterinary) services* in Class 44. Even though a certain link cannot be denied, due to the common goal of treating disease, the differences in nature and especially in the usual origin clearly outweigh any similarities. Although it is true that medical services generally use pharmaceutical products when those services are offered, the fact remains that the relevant public does not expect a doctor or veterinarian to develop and market a drug, also bearing in mind the stringent requirements that any medical product, whether for humans or animals, must comply with before it reaches the end users.

5.1.6 Medical and veterinary apparatus and instruments (Class 10) versus healthcare services (Class 44)

Medical and veterinary apparatus and instruments, prosthetics and artificial implants, orthopaedic and mobility aids, and physical therapy equipment in Class 10, have no similarity to *healthcare services* in Class 44, such as medical services, dentistry, services of hospitals and/or nursing homes.

Healthcare professionals do not manufacture any of the aforesaid goods themselves, but obtain them from specialist undertakings. There is a recognisable distinction for the relevant public between the provider of the service and the manufacturer of the goods. Moreover, the goods and services in question are intended for and are indeed purchased by different publics; therefore, any complementary relationship between the goods or services concerned is ruled out.

Consequently, *medical and veterinary apparatus and instruments* (Class 10) are dissimilar to *healthcare services* (Class 44).

5.2 Automobile Industry

The automobile industry is a complex industry involving various kinds of companies, including car manufacturing companies as well as any suppliers that provide the car

manufacturer with their raw materials (metal, aluminium, plastics, paints, etc.), parts, modules or complete systems. Several areas of production can be distinguished: drive engineering, chassis, electronics, interior and exterior.

The complexity of the industry and the fact that the final product incorporates some component parts and accessories complicate the examination of similarity between the end product (e.g. a car) and the various parts or materials used for its production. Furthermore, when purchasing a car, the general public knows that a car incorporates many items from many sources and that the car manufacturer might assemble components that have been manufactured by others. However, as far as the consumer of a car is concerned, the goods are normally offered under only one sign, which makes it almost impossible for the general public to identify other manufacturers or to differentiate their source of production. Exceptions include car batteries or tyres, where other signs are usually visible.

As with other industries, the Canon criteria accordingly apply and in particular the general principles set out for the comparison of parts, components, and fittings have to be taken into consideration.

In particular, it should be kept in mind that there are goods that will only be purchased by the automobile industry without any possibility of them ever reaching or being purchased by the general public (end consumer). One example is the common metal (Class 6) used to form the chassis. Such goods are clearly dissimilar to the car and probably dissimilar to all other parts, components and fittings. However, there are spare parts that might also be purchased by the general public for repair or maintenance purposes. Assessment of the similarity of these goods will mainly depend on whether the specific spare part is commonly produced by the car manufacturer.

5.3 Electric Apparatus/Instruments

The expression *electric apparatus and instruments* in Class 9 is an unclear or imprecise term as described in paragraph 1.5.2, The relevant scope, and should be treated accordingly.

5.4 Fashion and Textile Industries

Goods classified in Classes 22, 23, 24 and 25 are textile related. There is a certain progression through these classes: *raw fibrous textile materials*, such as *fibres* (Class 22), are further made into *yarns and threads* (Class 23), then into *textiles*, such as fabrics (Class 24), and end up as finished *goods made of textile* (Class 24) or *clothing* (Class 25).

Moreover, Class 18 goods that are made of leather and/or imitations of leather are also related to the fashion and textile industries.

5.4.1 Raw or semi-processed materials versus finished goods

Since the relationship between Classes 22, 23, 24 and 25 is often based on the fact that one product is used for the manufacture of another (e.g. *textiles* in Class 24 are used for the manufacture of *clothing* in Class 25), in comparisons of this kind, general rules concerning raw materials apply (see Annex I, paragraph 2).

For example, raw materials such as *leather and imitations of leather, animal skins and hides* (Class 18) are dissimilar to clothing, footwear and headgear (Class 25). The mere fact that leather is used for the manufacture of footwear (shoes made of leather) is not sufficient in itself to conclude that the goods are similar, as their nature, purpose and relevant public are quite distinct: raw materials are intended for use in industry rather than for direct purchase by the final consumer.

However, a low degree of similarity is found between *textiles* and *textile goods* such as *bed sheets* and *table covers*, in Class 24. In such cases, the degree of transformation required from material to end product is often insignificant: the fabric is merely cut into shape and/or sewn to obtain the finished product. Furthermore, many establishments allow customers to purchase the base material or ready-made cushions, etc. made from such material. Therefore, the relevant public may expect these goods to come from the same undertakings.

5.4.2 Textile goods (Class 24) versus clothing (Class 25)

The main commonality between *textile goods* in Class 24 and *clothing* in Class 25 is that they are made of textile. However, this is not enough to justify a finding of similarity. They serve completely different purposes: *clothing* is meant to be worn by people, or serves as a fashion article, whereas *textile goods* are mainly for household purposes and interior decoration. Therefore, their method of use is different. Moreover, the distribution channels and sales outlets of *textile goods* and *clothing* are different and the relevant public will not think that they originate from the same undertaking. Therefore, *textile goods* are considered to be dissimilar to *clothing* (31/05/2012, R 1699/2011-4, GO (fig.) / GO GLORIA ORTIZ, § 16; 26/07/2012, R 1367/2011-1, PROMO TEXTILE (fig.) / Promodoro, § 17; 01/08/2012, R 2353/2010-2, REFRIGUE FOR COLD (fig.) / REFRIGIWEAR (fig.) et al., § 26).

An exception to the general principle that if a broad term encompasses a very specific good that is similar to another specific good falling under a different broad term, both broad terms should be similar, are the specific goods *bathrobes* in Class 25 compared to the specific goods *towels of textile* in Class 24. The definition of *bathrobes* falls outside the normal definition of *clothing*. The purpose of *clothing* is essentially to cover the body, whereas the main purpose of *bathrobes* is to absorb moisture after a bath. The purpose of covering the body is merely secondary. Therefore, when *bathrobes* are compared to the specific goods *towels of textile* the pair is found to be highly similar as they coincide in nature, purpose, they are in competition and share the same producer, distribution channels and end users (28/07/2014, R 1998/2013-5, TIFANY / TIFFANY & CO. et al.).

5.4.3 Clothing, footwear and headgear (Class 25)

Class 25 goods, namely *clothing, footwear and headgear*, are of an identical or very similar nature. They serve the same purpose since they are used to cover and protect various parts of the human body against the elements. They are also articles of fashion and are often found in the same retail outlets. Consumers, when seeking to purchase clothes, will expect to find footwear and headgear in the same department or shop and vice versa. Moreover, many manufacturers and designers will design and produce all of the aforementioned items. Therefore, these goods are similar to each other.

5.4.4 Fashion accessories

As explained in the paragraph on 'Accessories' (see Annex I, paragraph 3), the mere fact that a certain product is used in combination with another is not necessarily conclusive for a finding of similarity. However, it is common for some accessories also to be produced by the manufacturer of the main product. Consequently, the consumer may expect that the main product and the accessories are produced under the control of the same entity, especially when they are distributed through the same trade channels. In such cases, there is a strong indication for similarity. Therefore, not all goods that are considered as fashion accessories will be found to be similar to *clothing, footwear and headgear* (Class 25).

Goods such as (hand)bags, sports bags, briefcases, purses, in Class 18 are related to articles of *clothing, headgear and footwear* in Class 25, in the sense that they are likely to be considered by consumers as aesthetically complementary accessories to articles of outer clothing, headgear and even footwear because they are closely coordinated with these articles and may well be distributed by the same or linked manufacturers, and it is not unusual for clothing manufacturers to directly produce and market them. Moreover, these goods can be found in the same retail outlets. Therefore, these goods are considered to be similar to *clothing, headgear and footwear*.

In contrast, hair accessories such as *hair pins* and *ribbons* are dissimilar to *clothing*. Even though these goods might have some distant link to the fashion market, the mere fact that someone might want to match hair pins and clothing is not sufficient to conclude that these goods are complementary and therefore similar. The goods can only be considered to be complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other and is not merely ancillary. In the present case, these conditions are not fulfilled. Furthermore, the nature and method of use of these goods is different. They are not in competition with each other. The production of these goods involves different know-how, they do not belong to the same category of goods and they are not regarded as components of a general array of goods that potentially have the same commercial origin (03/10/2011, R 1501/2010-4, Wild Nature (fig.) / WILD NATURE, § 18).

Likewise, luxury goods such as glasses (Class 9) and jewellery (Class 14) are considered to be dissimilar to clothing, footwear and headgear. The nature and the main purpose of these goods are different. The main function of clothing is to dress the

human body whilst the main purpose of glasses is to improve eyesight, and jewels are worn for personal adornment. They do not have the same distribution channels and they are neither in competition nor complementary (30/05/2011, R 106/2007-4, OPSEVEN2 / 7SEVEN (fig.), SEVEN (fig.), § 14; 12/09/2008, R 274/2008-1, Penalty / PENALTY, § 20; 05/10/2011, R 227/2011-2, OCTOPUSSY / OCTOPUSSY (fig.) et al., § 23-26).

The same reasoning applies to luxury goods, such as perfumes (Class 3) — the main purpose of which is to impart a long-lasting scent to the body, stationery, etc. — and goods such as travelling bags (Class 18), which are intended for carrying things when travelling. Even though nowadays, designers also sell perfumes, fashion accessories (such as glasses and jewellery) and travel accessories under their marks, this is not the rule, and rather applies only to (economically) successful designers.

5.4.5 Sports clothing, footwear and headgear (Class 25) versus sporting and gymnastic articles (Class 28)

The general category of *clothing, footwear and headgear* includes sports clothing, footwear and headgear, which are garments or items of apparel designed specifically to be used when performing an activity or sport. Although the nature of these goods is different from those of *sporting and gymnastic articles*, which are articles and apparatus for all types of sports and gymnastics, such as weights, halters, tennis rackets, balls and fitness apparatus, there are undertakings that manufacture both *sporting and gymnastic articles* as well as *sports clothing/sports footwear*. Therefore, the distribution channels can be the same. There is a low degree of similarity when *sports clothing/sports footwear* is compared with *sporting and gymnastic articles*.

5.4.6 Fashion design (Class 42) and tailoring services (Class 40) versus clothing (Class 25)

There is a low degree of similarity between *clothing* and *fashion design* and *tailoring* services since they share the same relevant public and might coincide in the same usual origin (producer/provider). Producers of ready-made clothing (especially suits and wedding dresses) frequently provide *tailoring* services, which are closely related to *fashion design*, which is an earlier step in the clothing production process.

5.5 Food, Beverages and Restaurant Services

5.5.1 Ingredients of prepared food

Ingredients used for the preparation of foodstuffs are a subcategory of raw materials and treated in the same way as raw materials in general. Consequently, the mere fact that one ingredient is needed for the preparation of a foodstuff will generally not be sufficient in itself to show that the goods are similar, even though they all fall under the general category of foodstuffs (26/10/2011, T-72/10, Naty's, EU:T:2011:635, § 35-36).

Examples of dissimilarity

- *Eggs* (Class 29) and *ice cream* (Class 30)
- *Yeast* (Class 30) and *bread* (Class 30).

5.5.2 Main ingredient

When the ingredient can be considered as being the main ingredient of the prepared dish, a similarity will exist only if the goods share some other relevant criterion or criteria, in particular the usual origin, nature, purpose or method of use.

Examples of similarity (main ingredient plus other criteria)

- *Milk* (Class 29) and *yoghurt* (Class 29)
- *Fish* (Class 29) and *fish sticks* (Class 29)
- *Dough* (Class 30) and *pizzas* (Class 30).

See also the judgment of the General Court of 04/05/2011, T-129/09, *Apetito*, EU:T:2011:193, where the Court confirms the finding of similarity between a particular foodstuff and prepared meals **mainly** consisting of the same particular foodstuff.

There is no complementarity in such cases simply because one ingredient is needed for the production/preparation of another foodstuff. Complementarity applies only to the use of goods and not to their production process (see paragraph 3.2.4 and 11/05/2011, T-74/10, *Flaco*, EU:T:2011:207, § 40; 11/12/2012, R 2571/2011-2, *FRUITINI*, § 18).

5.5.3 Non-alcoholic beverages (Class 32) versus alcoholic beverages (except beers) (Class 33)

In Case T-150/17 of 04/10/2018, *FLÜGEL / VERLEIHT FLÜGEL et al.*, EU:T:2018:641, § 77-84, the Court found that a very large number of alcoholic and non-alcoholic drinks are generally mixed, consumed, or indeed marketed together, either in the same establishments or as premixed alcoholic drinks. To consider that those goods should, for that reason alone, be described as similar, when they are not intended to be consumed in either the same circumstances, or in the same state of mind, or, as the case may be, by the same consumers, would put a large number of goods which can be described as 'drinks' into one and the same category for the purposes of the application of Article 8(1) EUTMR.

Thus, it cannot be considered that an alcoholic drink and an energy drink are similar merely because they can be mixed, consumed or marketed together, given that the nature, intended purpose and use of those goods differ, based on the presence of, or absence of alcohol in their composition ... Furthermore, it must be held that the undertakings which market alcoholic drinks premixed with a non-alcoholic ingredient do not sell that ingredient separately and under the same or a similar mark as the premixed alcoholic drink at issue'.

As such, *non-alcoholic beverages* in Class 32 are considered to be dissimilar to *alcoholic beverages (except beers)* in Class 33 (see also Grand Board of Appeal decision R 1720/2017-G of 21/01/2019). There may, however, be some exceptions

when comparing specific alcoholic beverages and specific non-alcoholic beverages, such as alcohol-free wine in Class 32 and wine in Class 33. Since these goods target the same relevant public, share the same distribution channels and can be produced by the same undertakings, they are similar. Any other exceptions to this general rule will be reflected in Similarity.

5.5.4 Beers (Class 32), alcoholic beverages (except beers) (Class 33)

There is a similarity between different alcoholic beverages in Class 33, as well as between the broad category of *alcoholic beverages* and *beer* in Class 32. Although their production processes are different, these goods all belong to the same category of alcoholic drinks (nature) intended for the general public. They can be served in restaurants and in bars and are on sale in supermarkets and grocery stores. These drinks can be found in the same area of supermarkets, even if some distinction according to their respective subcategory can be made. Furthermore, some alcoholic beverages may originate from the same undertakings.

Examples

- *Beers* are similar to *alcoholic beverages (except beers)*
- *Wines* are similar to *alcoholic beverages (except wines)*.

5.5.5 Provision of food and drinks versus food and drinks

The provision of food and drinks in Class 43 mainly covers services of a restaurant or similar services, such as catering, cafeterias and snack bars. These services are intended for serving food and drinks directly for consumption.

The mere fact that food and drinks are consumed in a restaurant is not sufficient reason to find similarity between them (09/03/2005, T-33/03, Hai, EU:T:2005:89, § 45; 20/10/2011, R 1976/2010-4, THAI SPA / SPA et al., § 24-26).

Nevertheless, in certain situations these goods and services can be complementary (17/03/2015, T-611/11, Manea Spa, EU:T:2015:152, § 52; 15/02/2011, T-213/09, Yorma's, EU:T:2011:37, § 46). As shown in paragraph 3.2.4, goods or services are complementary if one is indispensable or important for the use of the other in such a way that consumers may think that responsibility for the production of those goods or the provision of those services lies with the same undertaking.

The mere fact that food and/or drinks are essential to the services of restaurants, bars, cafeterias, etc. does not in itself lead consumers to think that responsibility for the production of those goods and provision of those services lies with the same undertaking (e.g. salt in restaurants).

However, consumers may think that responsibility does lie with the same undertaking if the market reality is that the provision of food and drinks and the manufacture of such goods are commonly offered by the same undertaking under the same trade mark (e.g. coffee in their coffee shops, ice cream in their ice cream parlours, beer in pubs). In such cases, there is a low degree of similarity.

5.6 Services to Support Other Businesses

All services listed in the class heading of Class 35 are aimed at supporting or helping other businesses to do or improve business. They are therefore in principle directed at the professional public.

When comparing specific services falling within Class 35 it is very useful to focus on the question: who is providing this kind of service? Is it an advertising agency, a management consultant, a human resources consultant, an accountant, an auditor, a sales agent or a tax advisor? Once the usual origin has been established, it is easier to find the general indication to which the specific service belongs.

Advertising services consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing the client's position in the market and enabling them to acquire a competitive advantage through publicity. In order to fulfil this target, many different means and products might be used. These services are provided by advertising companies, which study their client's needs, provide all the necessary information and advice for the marketing of their products and services, and create a personalised strategy regarding the advertising of their goods and services through newspapers, websites, videos, the internet, etc.

Examples of advertising services are *rental of advertising time on communication media, telemarketing services, marketing, public relations and demonstration of goods*, since they are all intended to promote other companies' goods/services, albeit via different means.

However, when compared to the *organization of trade fairs for commercial or advertising purposes*, the latter consist of the arrangement of events, presentations, exhibitions or trade fairs to facilitate or encourage the promotion and sale of the client's goods and services. These services are normally provided by specialised companies in their specific field. As such, the services in question are to be considered similar to *advertising services* since these could be offered to third parties in the form of the organisation, arranging and conducting of an exhibition or trade fair on their behalf (01/12/2014, R 557/2014-2, TRITON WATER (fig.) / TRITON COATINGS TRITON (fig.) et al., § 31).

Example

Marketing research is the collection and analysis of information about a particular market to assess the viability of a product or service.

The nature and purpose of advertising services are fundamentally different from the manufacture of goods or from the provision of many other services. Therefore, advertising is generally dissimilar to the goods or services being advertised. The same applies to the comparison of advertising services with goods that can be used as a medium for disseminating advertising, such as DVDs, software, printed matter, flyers and catalogues.

Management services are in Class 35 when they relate to the business aspects of an entity. As there are management services in other classes, a management service in Class 35 is taken to relate to business purposes.

Business management services are intended to help companies manage their business by setting out the strategy and/or direction of the company. They involve activities associated with running a company, such as controlling, leading, monitoring, organising, and planning. They are usually rendered by companies specialised in this specific field such as business consultants. They gather information and provide tools and expertise to enable their customers to carry out their business or to provide businesses with the necessary support to acquire, develop and expand their market share.

Examples of business management are business research and appraisals, cost-price analyses and organisation consultancy, since they are all intended to help with the strategy of a commercial undertaking. These services also include any ‘consultancy’, ‘advisory’ and ‘assistance’ activity that may be useful in the management of a business, such as how to efficiently allocate financial and human resources, improve productivity, increase market share, deal with competitors, reduce tax bills, develop new products, communicate with the public, carry out marketing, research consumer trends, and launch new products; how to create a corporate identity, etc.

Examples

Business research is the analysis and interpretation of economic information, such as income, employment, taxes, and demographics. This research information is used by entrepreneurs for making business decisions such as establishing marketing strategies.

Business appraisals involve an investigation into the nature and potential of a business and an assessment of its performance in relation to its competitors.

A *cost-price analysis* is a combination of both an evaluation of the proposed total price of a project and the cost of the separate elements of that project (e.g. labour, materials) to determine if they are permissible, related to the project requirements and reasonable. It is used to determine whether going ahead with a project is a sound business decision. It is therefore considered as a service that helps with the management of the business affairs or commercial functions of an industrial or commercial enterprise. Using the information gained from a cost-price analysis, a business may then go on to make the financial decisions associated with engaging in the project.

When comparing *business management* with *advertising* it should be noted that advertising is an essential tool in business management because it makes the business itself known in the market. As stated above, the purpose of advertising services is ‘to reinforce the [business] position in the market’ and the purpose of business management services is to help a business in ‘acquiring, developing and expanding market share’. There is not a clear-cut difference between ‘reinforcing a business position in the market’ and ‘helping a business to develop and expand market share’. A professional who offers advice about how to efficiently run a business may

reasonably include advertising strategies in that advice because there is little doubt that advertising plays an essential role in business management. Furthermore, business consultants may offer advertising (and marketing) consultancy as a part of their services, and therefore the relevant public may believe that these two services have the same professional origin. Consequently, considering the above, these services are similar to a low degree (22/11/2011, R 2163/2010-1, INNOGAME / INNOGAMES, § 13-17). This clear link between the two services also follows from the definitions given above of marketing research (an advertising service) and business research (a business management service).

Business administration services are intended to help companies with the performance of business operations and, therefore, the interpretation and implementation of the policy set by an organisation's board of directors. These services consist of organising people and resources efficiently so as to direct activities toward common goals and objectives. They include activities such as personnel recruitment, payroll preparation, drawing up account statements and tax preparation, since these enable a business to perform its business functions and are usually carried out by an entity that is separate from the business in question. They are rendered by, inter alia, employment agencies, auditors and outsourcing companies.

Example

Business auditing involves the evaluation of a variety of business activities. It encompasses a review of organisational structures, management, processes, etc.

When comparing *business administration* to *advertising* it should be noted that these services are usually dissimilar, since a professional who helps with the execution of business decisions or the performance of business operations will not offer advertising strategies.

The line between *business management* and *business administration* is blurred, and it is sometimes very difficult to clearly distinguish between them. They both fall under the broader category of business services. As a general rule, it can be said that business administration services are performed in order to organise and run a business, whereas business management follows a higher approach aimed at setting the common goals and the strategic plan for a commercial enterprise.

Office functions are the internal day-to-day operations of an organisation, including the administration and support services in the 'back office'. They mainly cover activities that assist in the operation of a commercial enterprise. They include activities typical of secretarial services, such as shorthand and typing, compilation of information in computer databases, invoicing, and administrative processing of purchase orders, as well as support services, such as the rental of office machines and equipment.

Example

Book-keeping is the act of recording financial transactions.

5.7 Retail Services

Retail is commonly defined as the action or business of selling goods or commodities in relatively small quantities for use or consumption rather than for resale (as opposed to wholesale, which is the sale of commodities in quantity, usually for resale).

However, it should be noted that the sale of goods is not a service within the meaning of the Nice Classification. Therefore, the activity of retail in goods as a service for which protection of an EUTM can be obtained does not consist of the mere act of selling the goods, but in the services rendered around the actual sale of the goods, which are defined in the explanatory note to Class 35 of the Nice Classification by the terms 'the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods'.

Moreover, the Court has held that the objective of retail trade is the sale of goods to consumers, which includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, *inter alia*, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor (07/07/2005, C-418/02, *Praktiker*, EU:C:2005:425, § 34).

Retail services allow consumers to satisfy different shopping needs in one place and are usually directed at the general consumer. They can take place in a fixed location, such as a department store, supermarket, boutique or kiosk, or in the form of non-shop retailing, such as through the internet, by catalogue or mail order.

The following principles apply as regards the similarity of the goods or services at issue.

5.7.1 Retail services versus any good

Retail services in general ⁽⁴⁴⁾ (i.e. where the specification is not limited to the sale of particular goods) is an unclear or imprecise term, as described in paragraph 1.5.2, The relevant scope, and should be treated accordingly.

Retail services in general are not similar to any goods that are capable of being sold by retail. Apart from being different in nature, given that services are intangible whereas goods are tangible, they serve different needs. Furthermore, the method of use of those goods and services is different. They are neither in competition with, nor necessarily complementary to, each other.

⁴⁴ 'Retail services' as such are not acceptable for classification purposes by the Office, unless further specified (see the Guidelines, Part B, Examination, Section 3, Classification).

5.7.2 Retail services of goods versus goods

In relation to retail services of specific goods, the similarity, or the lack thereof, between the goods to which the retail services relate and the goods themselves constitute an essential factor which needs to be taken into account. Retail services of specific goods can be similar to varying degrees, or dissimilar to specific goods depending on the degree of similarity between the goods themselves, but also taking into account other relevant factors.

5.7.2.1 Retail services of specific goods versus the same specific goods

Retail services concerning the sale of specific goods are similar to an average degree to these specific goods (20/03/2018, T-390/16, DONTORO dog friendship (fig.)/TORO et al., EU:T:2018:156, § 33; 07/10/2015, T-365/14, TRECOLORE / FRECCIE TRICOLORI et al., EU:T:2015:763, § 34). Although the nature, purpose and method of use of these goods and services are not the same, it should be noted that they display similarities, having regard to the fact that they are complementary and that the services are generally offered in the same places as those where the goods are offered for sale. Furthermore, they are directed at the same public.

The goods covered by the retail services and the specific goods covered by the other mark have to be identical in order to find an average degree of similarity between the retail services of those goods and the goods themselves, that is to say, they must either be exactly the same goods or fall under the natural and usual meaning of the category.

Examples of an average degree of similarity

- *Retail of sunglasses v sunglasses* (the goods themselves are identical).
- *Retail of optical goods v sunglasses* (the goods themselves are identical).

5.7.2.2 Retail services of specific goods versus similar specific goods

There is a low degree of similarity between the retail services concerning specific goods and other specific similar or highly similar goods, because of the close connection between them on the market from the perspective of the consumer. Consumers are accustomed to the practice that a variety of similar or highly similar goods are brought together and offered for sale in the same specialised shops or in the same sections of department stores or supermarkets. Furthermore, they are of interest to the same consumer.

A low degree of similarity between the goods sold at retail and the goods themselves may also be sufficient to lead to a finding of a low degree of similarity with the retail services provided that the goods involved are commonly offered for sale in the same specialised shops or in the same sections of department stores or supermarkets, belong to the same market sector and, therefore, are of interest to the same consumer.

Such goods and services are dissimilar, when the goods at issue are not offered in the same places, do not belong to the same market sector and target a different consumer.

Examples of a low degree of similarity

- *Retail of sportswear v sports bags* (the goods themselves are highly similar).
- *Retail of clothing v headgear; footwear* (the goods themselves are similar).
- *Retail of computers v bags adapted for laptops* (the goods themselves are similar to a low degree, are commonly offered in the same specialised shops or in the same sections of department stores, and are of interest to the same consumer).

Example of dissimilarity

- *Retail of protective clothing v clothing* (the goods themselves pertaining to Classes 9 and 25 respectively are similar to a low degree, however, they are not commonly offered through the same channels of distribution and are of interest to different consumers).

5.7.2.3 Retail services of specific goods versus dissimilar specific goods

When goods sold at retail are dissimilar to the actual goods themselves, no similarity can be found between them.

Example of dissimilarity

- *Retail of furniture v pharmaceuticals*.

5.7.3 Retail services versus retail services or retail services of specific goods

Retail services in general (i.e. where the specification is not limited to the sale of particular goods) is an unclear or imprecise term, as described in paragraph 1.5.2, The relevant scope, and should be treated accordingly.

5.7.4 Retail services of specific goods versus retail services of other specific goods

Retail services of specific goods and retail services of other specific goods have the same nature as both are retail services, have the same purpose of allowing consumers to conveniently satisfy different shopping needs, and have the same method of use.

Similarity is found between the retail services of specific goods where the goods are commonly retailed together in the same outlets and they are directed at the same public. However, the degree of similarity between retail of specific goods on the one hand and retail of other specific goods on the other hand may vary depending on the proximity of the retailed goods and the particularities of the respective market sectors.

Similarity is, in principle, excluded where the goods concerned are not commonly retailed together and target different publics, or are dissimilar. Nevertheless, a degree of similarity may still be found if, because of the particularities of the market, such dissimilar goods are retailed together in the same outlets and target the same public.

Examples of similarity

- *Retail of clothing v Retail of handbags.*
- *Retail of computers v Retail of peripherals adapted for use with computers.*
- *Retail of alcoholic beverages v Retail of non-alcoholic beverages* (despite the dissimilarity between the goods they are often retailed together and target the same public).

Example of dissimilarity

- *Retail of furniture v Retail of pharmaceuticals* (the goods are dissimilar, are not commonly retailed together and target different publics).

5.7.5 Services to which the same principles apply

The principles set out above in relation to retail services apply to the various services rendered that revolve exclusively around the actual sale of goods, such as **retail store services**, **wholesale services**, **internet shopping**, **catalogue or mail order services**, etc. (to the extent that these fall into Class 35).

5.7.6 Services to which the same principles do not apply

In contrast, the principles set out above in relation to retail services do not apply to other services that do not revolve exclusively around the sales of goods, or that do not fall into Class 35, such as **auctioneering services** (Class 35), **import and export services** (Class 35), **distribution and transport services** (Class 39) or **repair services** (Class 37), etc.

Example

- **Auctioneering services**

Auctions are public sales at which goods are sold to the highest bidder. Similarity between these services and the retail of specific products will only be found insofar as the retail services relate to goods that are commonly sold at auctions, such as objects of art.

Therefore, the specific retail or wholesale services of *pharmaceuticals, veterinary and sanitary preparations and medical supplies* for example, would be considered dissimilar to *auctioneering services*, since it is not common on the market for pharmaceuticals, etc. to be sold to the highest bidder.

Example

- **Import and export services**

Import and export services are not considered to be a sales service and thus cannot be subject to the same arguments as the comparison of goods with retail or wholesale services.

Import and export services relate to the movement of goods and normally require the involvement of customs authorities in both the country of import and the country of export. These services are often subject to import quotas, tariffs and trade agreements.

While these services are aimed at supporting or helping other businesses to do business and are preparatory or ancillary to the commercialisation of goods, they do not relate to the actual retail or wholesale of the goods. For these reasons, goods are to be considered dissimilar to import and export services for those goods. The fact that the subject matter of the import/export services and the goods in question are the same is not a relevant factor for finding similarity.

Example

- *Import and export of tobacco products* (Class 35) is dissimilar to *tobacco products* (Class 34).

The judgment of 09/06/2010, T-138/09, Riojavina, EU:T:2010:226, is not followed, where a low degree of similarity was found between import/export of vinegar and wine.

5.8 Financial Services

Financial services concern the management of money, capital and/or credit and investments and are provided by the finance industry. The finance industry encompasses a broad range of organisations that deal with the management, investment, transfer, and lending of money. Among these organisations are, for example, banks, credit card companies, consumer finance companies, stock brokerages and investment funds.

5.8.1 Banking services (Class 36) versus insurance services (Class 36)

Providing *banking services* consists of the provision of all those services carried out for savings or commercial purposes concerning the receiving, lending, exchanging, investing and safeguarding of money, issuing of notes and transacting of other financial business.

Providing *insurance services* consists of accepting liability for certain risks and respective losses. Insurers usually provide monetary compensation and/or assistance in the event that a specified contingency occurs, such as death, accident, sickness, breaking of a contract or, in general, any event capable of causing damages.

Insurance services have different purposes from the services usually provided by banks, such as providing credit or asset management, credit card services, financial evaluation or stocks and bonds brokerage. Nevertheless, they have some significant aspects in common.

Insurance services are of a financial nature, and insurance companies are subject to licensing, supervision and solvency rules similarly to banks and other institutions providing financial services. Most banks also offer insurance services, including health insurance, or act as agents for insurance companies, with which they are often economically linked. Additionally, it is not unusual to see financial institutions and an insurance company in the same economic group.

Therefore, although *insurance services* and *banking services* have different purposes, they are of a similar nature, may be provided by the same undertaking or related undertakings and share the same distribution channels. These circumstances demonstrate that *insurance services* are similar to *banking services*.

5.8.2 Real estate affairs (Class 36) versus financial affairs (Class 36)

The term 'real estate affairs' comprises real estate property management and evaluation, and real estate agency services, as well as the consultancy and provision of related information. This mainly involves finding a property, making it available for potential buyers and acting as an intermediary. Consumers clearly distinguish real estate agents' services from those of financial institutions. They do not expect a bank to find housing or a real estate agent to manage their finances.

Financial and banking services do not have the same nature, the same intended purpose or the same method of use as real estate services. Whereas financial services are provided by financial institutions for the purposes of managing their clients' funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or the performance of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of such a property. Furthermore, as regards the fact that the services in question might be found in the same distribution channels, it is clear that real estate services are not, in principle, provided on the same premises as financial services (17/09/2015, T-323/14, Bankia / BANKY, EU:T:2015:642, § 34-38).

Any other conclusion would mean that all non-financial transactions subject to funding would be complementary to a financial service. It must therefore be concluded that these services are dissimilar even if financial services are essential or important for the use of real estate. The consumers would not attribute responsibility for both services to the same company (11/07/2013, T-197/12, Metro, EU:T:2013:375, § 47-51).

5.8.3 Credit cards (Class 9) versus financial services (Class 36)

A credit card is a small plastic card issued to users as a system of payment. It allows its holder to buy goods and services based on the holder's promise to pay for these goods and services. The issuer of the card creates a revolving account and grants a line of credit to the consumer (or the user) from which the user can borrow money for payment to a merchant or as a cash advance to the user.

Financial services are offered by institutions like banks for the facilitation of various financial transactions and other related activities in the world of finance.

The intended purpose of credit cards is that they may be used in the course of financial transactions. If this were not the case, they would have no use and would serve no purpose. In this respect, it appears that credit cards have a dual nature: although they physically take the form of a plastic rectangle, they also correspond to a set of contractual relationships between, inter alia, an issuer or a supplier of financial services, which manages accounts and, as the case may be, grants credit, on the one

hand, and clients, who use those cards to make payments or establish credit, on the other.

Although credit cards are generally manufactured by specialist undertakings, whose name may even appear on them, and other undertakings are also involved in the service chain (from installing payment terminals to implementing compensation mechanisms), the fact nonetheless remains that their issuers are financial institutions and that the public will not usually consider who has actually produced a credit card, but rather who has issued it. The public will therefore believe that the financial institutions that issue credit cards are responsible for ensuring that they function correctly.

Furthermore, the sole objective of producing credit cards is for use in the course of financial transactions, so that it is of little importance whether they are manufactured by entities that are distinct from the financial institutions that issue them. These goods, which are developed in order to market certain specific services, would be meaningless in the absence of those services.

Accordingly, 'credit cards' are closely connected with 'financial services' and, hence, with 'financial affairs', with the result that those goods and services are complementary. (26/09/2017 T-83/16, WIBIDA / ING DiBa (fig.) et al., EU:T:2017:662 § 59-69).

Therefore, *credit cards* in Class 9 are considered similar to *financial, monetary and banking services* in Class 36 as they coincide in purpose and usual commercial origin insofar as their issuer/provider is concerned; as such, they are complementary.

5.9 Transport, Packaging and Storage

5.9.1 Transport of goods (Class 39) versus any product

Services of *transport* are not considered to be similar to goods. These services are provided by specialist transport companies whose business is not the manufacture and sale of the goods concerned. As regards the nature of the goods and services, *transport services* refer to a fleet of trucks or ships used to move goods from A to B.

Example

- *Pastry and confectionery* are dissimilar to *transport services*. They are different in terms of their nature, intended purpose and method of use; they are neither complementary nor in competition. All these differences explain why the service of transport and the goods of pastry and confectionery target different consumers. Transport is predominantly aimed at professionals (those who need to move goods) whereas pastry and confectionery target non-professional consumers (ordinary people who require food) (07/01/2014, R 1006/2012-G, PIONONO (fig.), § 28-36).

5.9.2 Packaging and storage of goods (Class 39) versus any product

Equally, *packaging and storage services* merely refer to the service whereby a company's or any other person's goods are packed and kept in a particular place for a fee. Those services are not similar to any kind of goods, including any of the goods that may be packaged and stored (07/02/2006, T-202/03, Comp USA, EU:T:2006:44; 22/06/2011, T-76/09, Farma Mundi Farmaceuticos Mundi, EU:T:2011:298, § 32; 07/01/2014, R 1006/2012-G, PIONONO (fig.), § 38).

5.10 Information Technology

5.10.1 Computers versus software

What we call a *computer* is actually a 'system', a combination of components that work together. The hardware devices are the physical components of that system. The hardware is designed to work hand in hand with *computer programs*, referred to as *software*. Computer hardware companies also manufacture software, share the same distribution channels and target the professional public (e.g. for use in banking and finance, education, medicine, business and entertainment/recreation) and/or the general public. Moreover, they are complementary. These goods are considered to be similar.

5.10.2 Software versus apparatus/services that use software

In today's high-tech society, almost all *electronic or digital apparatus* function using integrated *software*. Also, many services in the financial or business sectors in the IT and telecommunication industries clearly depend on software or computer-aided software in order to be rendered. This does not, however, lead to the automatic conclusion that software is similar to goods/services that use software to function successfully.

Example of dissimilarity

- Although a *digital scale* functions using integrated *software*, this does not lead to the conclusion that software and scales are similar. One could argue that the software is important for the use of the scale; however, they are not complementary because they are not aimed at the same public. The digital scale is for the general public, whereas the software is aimed at the actual manufacturer of these scales. The producers are not the same, nor are the distribution channels, and they do not have the same purpose.
- Although many financial services are rendered with the use of software, for example online banking platforms, such software is an integral part of the financial services themselves and is not sold independently from them. Financial companies or institutions are not normally engaged in the development of highly specialised software. Rather, they would outsource the development of such software to IT

companies. These goods and services are clearly provided by different undertakings with expertise in completely different areas, and at the same time target different users, which rules out any complementary relationship. Besides taking into account that by nature goods are different from services, they neither coincide in their purpose, method of use or channels of distribution.

However, when the software is not an integral part of an apparatus/service, can be purchased independently from it and serves, for example, to give more or different functionalities, similarity can be established.

Example of similarity

- A *digital camera* and *software*, insofar as their purpose is to increase the functionalities of the camera, are both aimed at the same public and produced by the same or related undertakings. They are distributed through the same channels and use of the one is indispensable for use of the other.
- Telecommunication services and software, insofar as they enable access to these services, are both aimed at the same public and are provided through the same channels of distribution. Clearly, these goods and services are complementary and serve the same purpose.

5.10.3 Software, downloadable ‘apps’ and downloadable electronic publications

Application software, also known as ‘an app’, is *computer software* that is designed to help the user perform various tasks on a computer. Application software differs from system software in that it can be accessed by the user and run on a computer. Application software is usually designed with the user in mind. The definition of *application* is used to refer to the small apps that are designed to be downloaded onto smartphones; however, the definition covers all applications on tablets, computers, etc. Consequently, *software*, *application software* and *downloadable applications* are considered to be identical.

Downloadable electronic publications are electronic versions of traditional media, like e-books, electronic journals, online magazines, online newspapers, etc. It is becoming common to distribute books, magazines and newspapers to consumers through tablet-reading devices by means of apps in the form of electronic publications. Consequently, there is a complementary relationship between software/apps and downloadable electronic publications. Their producers can be the same; they follow the same distribution channels and the public is generally also the same. These goods are considered to be similar.

5.10.4 Specific software versus specific software

There are many types of software, and although software by nature (a set of instructions that enables a computer to perform a task) is the same, this does not mean that their specific purpose is the same. This implies that very specific software could even be dissimilar to another type of software.

Example

The field of application of *computer games software* is not the same as *software for apparatus that diagnose diseases*. Due to these significantly different fields of application, the expertise needed to develop these types of software is not the same, nor are their end users or distribution channels. These goods are therefore dissimilar.

5.10.5 Computers and software (Class 9) versus computer programming (Class 42)

Computer programming consists, inter alia, of the process of writing source code (29/03/2012, T-417/09, Mercator Studios, EU:T:2012:174 § 26), and a computer program is a set of coded instructions that enables a machine, especially a computer, to perform a desired sequence of operations.

Computers are devices that compute, especially programmable electronic machines that perform high-speed mathematical or logical operations or that assemble, store, correlate, or otherwise process information. Computers need programs to operate.

Software is composed of programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation.

Therefore, *computer programming services* are closely linked to *computers* and *software*. This is because in the field of computer science, producers of computers and/or software will also commonly provide computer and/or software-related services (e.g. as a means of keeping the system updated).

Consequently, and in spite of the fact that the nature of the goods and services is not the same, both the end users and the producers/providers of the goods and services coincide. Furthermore, they are goods and services that are complementary. For these reasons, these goods and services are considered similar.

5.10.6 Communications equipment, computers and software (Class 9) versus telecommunication services (Class 38)

Communications equipment includes means, such as computer networking-, broadcasting-, data- and point-to-point communications equipment, antennas and aerials to enable remote communication.

Owing to rapid developments in the field of information technology, in particular the growing importance of the internet, the markets for communications equipment, IT hardware and software on the one hand, and telecommunications services on the other, have clearly become interlinked.

Goods such as modems, telephones, smartphones, computers, network routers and/or servers are used in close connection with telecommunication services because they are, or can be, absolutely necessary for performing these services and, from the viewpoint of the consumer, they are indispensable for accessing them. They are, moreover, regularly marketed together.

Nowadays, computers are generally networked and their autonomous use is actually the exception to the rule; the rule being that communications equipment, computers and software, insofar as they enable access to those services or provide the ability to perform them, renders them complementary. See decision of 25/04/2017, R 1569/2016-1, § 22-23; judgment of 15/10/2018, T-444/17, life coins / LIFE et al., EU:T:2018:681, § 37.

Therefore, these goods and services are similar, given their complementary character; although their nature is different, their purpose, consumers and distribution channels are the same.

By analogy, peripherals adapted for use with computers and other smart devices are to be found similar to telecommunication services insofar as they comply with the above rule that they enable access to telecommunication services, such as visual display screens would but, for example, mouse pads would not.

5.10.7 Data carriers versus recorded content

Magnetic data carriers, recording discs are carriers that use magnetic technology to operate, such as floppy discs, magnetic tapes or hard drives. It follows, that not all data carriers are covered by this general indication; in particular, many of the more popular data carriers, such as CDs, solid-state memory devices or USB sticks, do not use magnetic technology and are, therefore, not covered by this general indication.

Data carriers are all kinds of memory devices, whether removable, detachable or transportable. In particular, the term can cover diskettes as well as hard drives, which can be computer consumables, computer peripherals or parts of computers.

A distinction must be made between (*magnetic*) *data carriers* and recorded content on such carriers. Although the Nice Classification does not state explicitly that *magnetic data carriers* should be interpreted as being blank, it does include the following in the explanatory note:

This Class includes, in particular: all computer programs and software regardless of recording media or means of dissemination, that is, software recorded on magnetic media or downloaded from a remote computer network.

This effectively distinguishes between 'content' and 'blank' media and in the case of content emphasises the lesser relevance of the media or means of dissemination by using 'regardless'.

This distinction also accords with the reality of the marketplace, where blank recording media and media that contain recorded data are very distinct products. For example, the difference between the market for blank recordable CDs and that for CDs pre-recorded with music is vast. In the latter, the subject matter recorded on the CD determines the fundamental characteristic of the product. The consumer is, in essence, purchasing the recorded data. Consumers looking for a CD of their favourite band would not buy a blank CD instead or another music CD. The recorded data characterises the product and the maker of the medium (CD) is irrelevant. It would be

wrong to ignore this and to have a situation where a term covers both blank and recorded media; the difference between the two is too significant.

Therefore, for the purposes of the comparison of goods and services, if magnetic data carriers and data carriers have to be considered to be blank, they cannot be found to be similar to the recorded content they could contain. There is no similarity between blank data carriers (of any kind) and other goods merely on the basis that the latter goods can be stored or saved onto data carriers, as the latter are merely ancillary goods in this situation.

In particular, as regards goods in Class 16, these are printed on paper (*printed matter, teaching materials, printed publications, magazines*). They do not include electronic publications/books. No relevant Canon criteria apply to printed matter and blank data carriers. Consequently, *magnetic data carriers* and goods in Class 16, are dissimilar.

Likewise all kinds of recorded content such as *audio visual recordings, digital music, electronic books* or *audio books* in Class 9 must also be found to be dissimilar to *magnetic data carriers*.

However, an exception can be made for *software*. There is a close correlation between software and the recording device, and recording devices, such as USB sticks, very often come with their own integrated software. The reality in the market is that consumers are likely to believe that these goods could coincide in origin or producer. For that reason, and exceptionally in relation to recorded content, *magnetic data carriers* are considered to be similar to a low degree to *software*.

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 3

Relevant public and degree of attention

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1 Introduction

With regard to the relevant public, the Court of Justice has held that a likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29). The Court has also held that it is the **perception of marks in the mind of the relevant public of the goods or services in question** that plays a decisive role in the global assessment of the likelihood of confusion (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23; 22/06/1999, C-342/97, Lloyd Schufabrik, EU:C:1999:323, § 25).

Accordingly, the first task is to define the consumer circles that are relevant for the purposes of the case. The method for identifying the relevant public is discussed in paragraph 2 below. Thereafter, the relevant public's degree of attention and sophistication must be established. The impact of the relevant public's attention and sophistication on the assessment of the likelihood of confusion is discussed in paragraph 3.

In addition, the relevant public plays an important role in establishing a number of other factors that are relevant for the assessment of the likelihood of confusion.

1.1 Comparison of the goods and services

The actual and potential customers of the goods and services in dispute constitute one of the factors to be dealt with in the analysis of their similarity. While a coincidence in the relevant public is not necessarily an indication of similarity of the goods or services, largely diverging publics weigh heavily against similarity (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services).

Example

Leather, animal skins and hides are raw materials that go to industry for further processing, whereas *goods made of leather* are final products targeted at the general public. The relevant public is different, which is a fundamental factor in the assessment of similarity and which leads to the conclusion that the goods in question are dissimilar. Similar reasoning applies to *precious metals* and *jewellery*.

1.2 Comparison of the signs

The question of the relevant public also plays a role in the comparison of the signs. The same word may be pronounced differently depending on the relevant public. Conceptually, the public in one part of the European Union may understand the meaning of the sign, while consumers in other parts may not understand it (see the

Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs).

Example

The Court has already confirmed that the general public in the Scandinavian countries, the Netherlands and Finland has a basic understanding of English (26/11/2008, T-435/07, *New Look*, EU:T:2008:534, § 23).

1.3 Distinctive elements of the signs/distinctiveness of the earlier mark

The inherent distinctiveness of a sign or one of its elements also depends on the relevant public for the goods and services. For example, depending on the relevant public's knowledge, background and language, an element contained in a trade mark may be non-distinctive or have a low degree of distinctiveness, or it may be distinctive because, *inter alia*, it is perceived as a fanciful term without any meaning claimed (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

Example

The French word 'cuisine' will not be understood as a descriptive indication for goods in Classes 29 and 30 in some Member States (23/06/2010, R 1201/2009-1, *GREEN CUISINE / Cuisine* (fig.), § 29-33).

Example

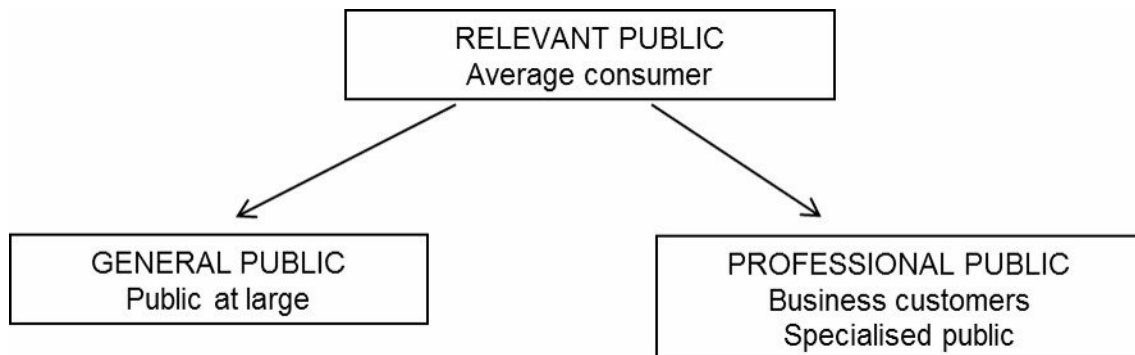
Professionals in the IT and scientific fields are in general more familiar with the use of technical and basic English words than the general public. In *Gateway v Activy Media Gateway*, the Court held that the common word 'gateway' directly evokes, in the mind of the relevant consumer, the concept of a gateway, which is commonly used in the computing sector (27/11/2007, T-434/05, *Activy Media Gateway*, EU:T:2007:359, § 38, 48; confirmed 11/12/2008, C-57/08 P, *Activy Media Gateway*, EU:C:2008:718).

2 Defining the Relevant Public

In accordance with Article 8(1)(b) EUTMR, it must be determined whether a likelihood of confusion exists 'on the part of the public in the territory where the earlier mark is protected'.

The term '**average consumer**' is a legal concept that is used in the sense of the '**relevant consumer**' or '**relevant public**'. It should not be confused with the 'general public' or 'public at large', although the Courts sometimes use it in this sense. However, in the context of relative grounds, the term 'average consumer' must not be used as a synonym of 'general public' as it can refer to both **professional** and **general public**. In this respect, in cases concerning the likelihood of confusion, the Court normally distinguishes between the **general public** (or **public at large**), and a **professional or**

specialised public (or **business customers**), based on the goods and services in question.



In order to properly define the relevant public in the context of relative grounds, two factors have to be taken into account:

- **the territory defined by the earlier mark:** the relevant public is always the public in the territory(ies) where the earlier right(s) is/are protected. Consequently, in the case of an earlier national right, the relevant public concerned is the one of that particular EU Member State (or Member States in the case of Benelux trade marks). For an earlier European Union trade mark, the public in the whole European Union has to be taken into account. For an international registration, it is the public in each of the Member States where the mark is protected.
- **the goods and services that have been found identical or similar:** likelihood of confusion is always assessed against the perception of the consumers of the goods and services that have been found identical or similar. Depending on the goods or services, the relevant public is the general public or a professional/specialised public.

The relevant public always includes both the **actual** and the **potential** consumers, that is, the consumers who are currently purchasing the goods/services or who may do so in the future.

If a **significant part of the relevant public** for the goods or services at issue may be confused as to the origin of the goods, this will be sufficient to establish a likelihood of confusion. It is not necessary to establish that all actual or potential consumers of the relevant goods or services are likely to be confused.

As stated by the Court, the relevant public for the assessment of the likelihood of confusion is composed of **users likely to use both the goods and services covered by the earlier mark and the product covered by the mark applied for that were found to be identical or similar** (01/07/2008, T-328/05, Quartz, EU:T:2008:238, § 23; appeal 10/07/2009, C-416/08 P, Quartz, EU:C:2009:450, dismissed).

When defining the part of the public **by reference to which a likelihood of confusion is assessed** the following applies:

- if the goods or services of both marks target the general public, the relevant public by reference to which a likelihood of confusion will be assessed is the general public.

Example

In a case in which both the earlier and the contested mark concerned articles of clothing, the Court held that ‘clothing for men and women are everyday consumer items and the trade mark on which the opposition is based is registered as a European Union trade mark. It follows that the relevant public by reference to which the likelihood of confusion must be assessed is composed of the general public in the European Union’ (06/10/2004, T-117/03 – T-119/03 & T-171/03, NL, EU:T:2004:293, § 25).

- If the goods and services of **both marks** are directed at the same or a similar **professional public**, the likelihood of confusion will be assessed from the perspective of those specialists.

Example

The relevant goods of both the earlier and the contested mark were raw plastic materials, chemical products, resins and the like. These are goods for industrial use. The targeted consumers are, therefore, engineers and/or chemists, that is to say, highly skilled professionals who will process these products and use them in manufacturing activities. The relevant public was considered to be professional (15/02/2012, R 2077/2010-1, PEBAFLEX / PEBAX, § 18; 16/09/2010, R 1370/2009-1, CALCIMATT / CALCIPLAST et al., § 20, confirmed 29/03/2012, T-547/10, EU:T:2012:178).

- If the goods or services of **both marks** target **both the general public and specialists**, the likelihood of confusion will be assessed against the perception of the part of the public displaying the lower degree of attentiveness as it will be more prone to being confused. If this part of the public is not likely to be confused, it is even more unlikely that the part of the public with a higher degree of attention will be.

Example

In a case in which both the earlier and the contested mark concerned goods in Classes 3 and 5 that targeted both the general public and professionals (e.g. doctors for pharmaceuticals in Class 5), the Court assessed the likelihood of confusion for the general public only, because it is the one displaying the lower degree of attention (15/07/2011, T-220/09, ERGO, EU:T:2011:392, § 21).

- If the goods and services of the earlier mark target the **general and professional public** and the contested goods and services target a **professional public** exclusively (or vice versa), the relevant public for assessing likelihood of confusion will be the professional public only.

Example

The goods of the earlier mark are *polish for metals*, while the goods of the application are *preparations for cleaning waste pipes for the metal-working industry*. As stated in the relevant GC judgment: ‘Although “polish for metals” can consist equally well of everyday consumer goods as of goods intended for a professional or specialised public, it is not disputed that the goods to which the trade mark application relates must be regarded as directed solely at persons operating in the metal-working industry.

Therefore, the only public likely to confuse the trade marks in question is formed of such operators' (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 81).

Example

Paints in general are sold both to professional painters (i.e. for business purposes) and to the public at large for 'do-it-yourself purposes'. By contrast, *paints for industry* do not target the general public. Therefore, when the specifications of the two marks cover paints in general and paints for industry respectively, only professionals constitute the relevant public since they are likely to be the only consumers who encounter both marks.

Example

The services of the earlier mark are *telecommunications*. The contested services are *telecommunication services, namely collocation, telehousing and interconnection services* addressed at professionals only. The definition of the relevant public must be adjusted to the more specific list, and likelihood of confusion should be assessed for professionals only (24/05/2011, T-408/09, ancotel, EU:T:2011:241, § 38-50).

- If the relevant goods are pharmaceuticals the following applies:
The relevant public of **non-prescription** pharmaceuticals (sold over the counter) is the general public, and the likelihood of confusion will be assessed in relation to that public.

According to the case-law, the general public cannot be excluded from the relevant public, also in the case of pharmaceuticals that require a **doctor's prescription** prior to their sale to end-users in pharmacies. Thus, the relevant public comprises both general public and health professionals, such as doctors and pharmacists. Consequently, even though the choice of those products is influenced or determined by intermediaries, a likelihood of confusion can also exist for the general public, since they are likely to be faced with those products, even if that takes place during separate purchasing transactions for each of those individual products at various times (09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 42-45; 26/04/2007, C-412/05 P, Travatan, EU:C:2007:252, § 56-63). In practice, this means that the likelihood of confusion will be assessed against the perception of the general public, which is more prone to confusion.

In the case of pharmaceutical goods **targeted only at specialists** for professional use (e.g. *sterile solutions for ophthalmic surgery*), the likelihood of confusion must be assessed from the point of view of that specialist public only (26/04/2007, C-412/05 P, Travatan, EU:C:2007:252, § 66).

In cases where the pharmaceutical goods of the EUTM application are **sold over the counter**, while the pharmaceutical goods covered by the earlier registration would **only be available on prescription, or vice versa**, the Office must assume that the relevant public consists of both qualified professionals and the general public, without any specific medical and pharmaceutical knowledge. The likelihood of confusion will be assessed in relation to the general public, which is more prone to confusion.

Example

The goods covered by the earlier mark were pharmaceutical preparations with *digoxin for human use for cardiovascular illnesses*, while the contested goods were *pharmaceutical preparations for the treatment of metabolic disorders adapted for administration only by intravenous, intra-muscular or subcutaneous injection*.

Although both the goods of the earlier mark and the goods of the contested mark are prescribed by and administered under the supervision of healthcare professionals, the GC held that the relevant public comprises both healthcare professionals and the general public.

(23/09/2009, T-493/07, T-26/08 & T-27/08, Famoxin, EU:T:2009:355, § 50-54; 09/07/2010, C-461/09 P, Famoxin, EU:C:2010:421).

3 Defining the Degree of Attention

The Court has indicated that for the purposes of the global assessment, the average consumer of the products concerned is deemed to be **reasonably well informed and reasonably observant and circumspect**, and that the relevant public's degree of attention is likely to vary according to the category of goods or services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).

Whether its degree of attention will be **higher or lower will depend, inter alia, on the nature of the relevant goods and services and the knowledge, experience and purchase involvement of the relevant public**.

The fact that the relevant public consists of the **general public** does not necessarily mean that the degree of attention cannot be high (for instance, when expensive, potentially hazardous or technically sophisticated goods are purchased). Likewise, the fact that the goods at issue target **specialists** does not necessarily mean that the degree of attention is always high. It is true that, in principle, the professional public has a high degree of attention when purchasing a specific product. This is when these professional consumers are considered to have special background knowledge or experience in relation to the specific goods and services. Moreover, purchases made by professional consumers are often more systematic than the purchases made by the general public. However, this is not always the case. However, in some cases, for example, such as when the relevant goods or services are used by a given professional on a daily basis, the level of attention paid may be average or even low even in relation to those professional consumers.

Properly defining the degree of attention of the relevant public is necessary, as this factor can weigh for or against a finding of a likelihood of confusion. Whilst the relevant consumer only rarely has the chance to make a direct comparison between the different signs and must rely on an imperfect recollection of them, a high level of attention of the relevant consumer may lead to conclude that the relevant consumer will not confuse the marks, despite the lack of direct comparison between

the trade marks (22/03/2011, T-486/07, CA, EU:T:2011:104, § 95). Therefore, the degree of attention will be established in the decision.

However, **a high degree of attention does not automatically lead to a finding of no likelihood of confusion**. All the other factors have to be taken into account (**interdependence principle**) (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment). For example, in view of the specialised nature of the relevant goods and/or services and the high degree of attention of the relevant public, likelihood of confusion may be ruled out (26/06/2008, T-79/07, Polaris, EU:T:2008:230, § 50-51). However, a likelihood of confusion can exist despite a high degree of attention. For example, when there is a strong likelihood of confusion created by other factors, such as identity or close overall similarity of the marks and the identity of the goods, the attention of the relevant public alone cannot be relied upon to prevent confusion (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 53-56; 06/09/2010, R 1419/2009-4, Hasi (fig.) / Hasen IMMOBILIEN).

3.1 Higher degree of attention

A higher degree of attention is usually connected with the following types of purchases: expensive purchases, the purchase of potentially hazardous or technically sophisticated goods. The average consumer often seeks professional assistance or advice when choosing or buying certain types of goods and services (e.g. cars, pharmaceutical products).

A higher degree of attention can also apply to goods when brand loyalty is important for the consumer.

3.1.1 Expensive purchases

When purchasing expensive goods, the consumer will generally exercise a higher degree of care and will buy the goods only after careful consideration. Non-specialised or non-professional consumers often seek professional assistance or advice when choosing or buying certain types of goods and services. The attention may be enhanced in cases of luxury goods and where the specific product is regarded as reflecting the social status of its owner.

Examples

Cars. Taking into consideration their price, consumers are likely to pay a higher degree of attention than for less expensive purchases. It is to be expected that these consumers will not buy a car, either new or second-hand, in the same way as they would buy articles purchased on a daily basis. The consumer will be an informed one, taking all relevant factors into consideration, for example, price, consumption, insurance costs, personal needs or even prestige (22/03/2011, T-486/07, CA, EU:T:2011:104, § 27-38; 21/03/2012, T-63/09, Swift GTi, EU:T:2012:137, § 39-42).

Diamonds, precious and semi-precious stones. In its decision of 09/12/2010, R 900/2010-1, Leo Marco (fig.) / LEO, § 22, the Board held that consumers generally

put a certain amount of thought into the selection of these goods. In many cases the goods will be luxury items or will be intended as gifts. A relatively high degree of attention on the part of the consumer may be assumed.

Financial services. These services target the general public, which is reasonably well informed and reasonably observant and circumspect. However, since such services are specialised services that may have important financial consequences for their users, the consumers' level of attention would be rather high when choosing them (03/02/2011, R 719/2010-1, f@ir Credit (fig.) / FERCREDIT, § 15) (appealed 19/09/2012, T-220/11, F@ir Credit, EU:T:2012:444, dismissed; appealed 14/11/2013, C-524/12 P, F@ir Credit, EU:C:2013:874, dismissed).

In the overall impression combined by the signs at issue, the visual and conceptual differences between the signs are sufficient to outweigh their limited phonetic similarity, particularly since the relevant public is highly attentive and well informed (22/06/2010, T-563/08, Carbon Capital Markets, EU:T:2010:251, § 33, 61).

Real estate services. The purchase and sale of property are business transactions that involve both risk and the transfer of large sums of money. For these reasons, the relevant consumer is deemed to possess a higher-than-average degree of attention, since the consequences of making a poor choice through lack of attentiveness might be highly damaging (17/02/2011, R 817/2010-2, FIRST THE REAL ESTATE (fig.) / FIRST MALLORCA (fig.) et al., § 21).

3.1.2 Potentially hazardous purchases

The impact on safety of goods covered by a trade mark (e.g. lights for vehicles, saws, electric accumulators, electric circuit breakers, electric relays) may result in an increase in the relevant consumer's degree of attention (22/03/2011, T-486/07, CA, EU:T:2011:104, § 41).

3.1.3 Brand loyalty

Furthermore, a higher degree of attention can be the consequence of brand loyalty.

Example

Although tobacco products are relatively cheap articles for mass consumption, smokers are considered particularly careful and selective about the brand of cigarettes they smoke, so a higher degree of brand loyalty and attention is assumed when tobacco products are involved. Therefore, in the case of tobacco products a higher degree of similarity of signs may be required for confusion to occur. This has been confirmed by several Board decisions: 26/02/2010, R 1562/2008-2, victory slims (fig.) / VICTORIA et al., where it was stated that the consumers of Class 34 goods are generally very attentive and brand loyal, and 25/04/2006, R 61/2005-2, Granducato / DUCADOS et al.

3.1.4 Pharmaceuticals

It is apparent from the case-law that, insofar as pharmaceutical preparations are concerned, the relevant public's degree of attention is relatively high, whether or not issued on prescription (15/12/2010, T-331/09, Tolposan, EU:T:2010:520, § 26; 15/03/2012, T-288/08, Zydus, EU:T:2012:124, § 36 and quoted case-law).

In particular, *medical professionals* have a high degree of attentiveness when prescribing medicines. With regard to *non-professionals*, they also show a higher degree of attention, regardless of whether the pharmaceuticals are sold without prescription, as these goods affect their state of health.

3.2 Lower degree of attention

A **lower degree of attention** can be associated, in particular, with habitual buying behaviour. Purchase decisions in this area relate to, for example, inexpensive goods purchased on a daily basis (15/06/2010, T-547/08, Strumpf, EU:T:2010:235, § 43).

The mere fact that the relevant public makes an impulse purchase of some goods (e.g. sweets) does not mean that the level of that public's attention is lower than average (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199, § 34).

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 4

Comparison of signs

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Obsolete

1 General Principles of the Trade Mark Comparison

1.1 Overview

This chapter deals with the comparison of signs. The purpose of comparing signs is to determine if the signs are identical (see paragraph 2 below), similar (see paragraph 3 below), or dissimilar (see paragraph 4 below).

The identity of trade marks is a prerequisite for applying the provision of Article 8(1)(a) EUTMR ('double identity'). Goods or services also have to be identical.

The similarity (or identity) of signs is a necessary condition for it to be found that there is a likelihood of confusion for the purposes of Article 8(1)(b) EUTMR (23/01/2014, C-558/12 P, WESTERN GOLD / WeserGold et al., EU:C:2014:22, § 44). If the signs are dissimilar, an examination of likelihood of confusion will stop at this point.

Whether a likelihood of confusion exists depends on an assessment of several interdependent factors, including (i) similarity of the goods and services, (ii) the relevant public, (iii) **similarity of the signs**, taking into account their distinctive and dominant elements and (iv) the distinctiveness of the earlier mark.

1.2 Structure

If the signs are not identical (see paragraph 2 below) it must be determined whether they are similar or dissimilar. A global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by them, bearing in mind their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23). A comparison of trade marks must integrate, therefore, an assessment of the distinctive character and dominance of their elements, if any, and the impact of their overall impression.

A comparison of trade marks should, in principle, contain the following considerations: an assessment of the distinctive and dominant character of the coinciding and differing elements, an assessment of the common features of and differences between the signs, and a final conclusion that is reached after the assessment of the impact of distinctive/dominant elements on the overall impression of the signs. It might also be useful to tackle these issues by means of addressing the relevant arguments of the parties, if raised, in the comparison of signs.

The order of the examination at the 'comparison of signs' stage **should not be predetermined** but rather, depending on the particular context, adjusted to provide logical coherence to the decision. Nevertheless, with the aim of having a consistent decision format that follows, where possible, a similar structure, the following order is appropriate for the majority of cases.

1. Representation/description of the signs

As a preliminary step, the signs should be portrayed in a table, followed by a short description of the marks (if necessary). The purpose of this chapter is to identify the type of signs (word marks, figurative marks) and their elements in order to establish a framework for comparison ('what is there?').

Since the marks are reproduced in the table, a **separate** description is not necessary. It might, for example, be better placed within the visual/phonetic and conceptual comparison or the assessment of the distinctive or dominant elements. How detailed the description is depends on the case.

However, a separate description as a preliminary point might be useful to correctly define the framework of the analysis of similarity of the marks to avoid that an element of either sign is overlooked.

If elements are considered negligible (see paragraph 1.5 below) they should be identified up front, as they will not be taken into account in the assessment.

1. Inherent distinctiveness/dominance of elements of both marks

As a second step, an assessment of **inherent distinctiveness and dominance of the components** is carried out (see paragraphs 3.2 and 3.3 below). The purpose of this chapter is to identify the degree of relevance of the components for the comparison of signs, for example, whether the distinctiveness of the common element is limited.

Importantly, the **distinctiveness of the earlier mark as a whole (including the issue of enhanced distinctiveness)** must be distinguished from the distinctiveness of the components of the marks (see paragraph 3.2 below). The assessment of the distinctiveness of the earlier mark **as a whole** is addressed under a separate heading (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

1. Visual, phonetic and conceptual comparison of signs taking into account the previously established inherent distinctiveness and the dominant character of the components as well other relevant factors and final conclusion

The third step entails the comparison of marks at a **visual, aural** and **conceptual** level, considering and integrating the previous findings on the distinctiveness/dominance of the components (see paragraph 3.4 below) and a decision as to whether the marks are similar in each of these aspects and if so, to what degree (see paragraph 3.5 below).

1.3 Three aspects: visual, aural and conceptual

Signs are compared at three levels, namely visually (see paragraph 3.4.1 below), aurally (see paragraph 3.4.2 below) and conceptually (see paragraph 3.4.3 below). This is because one can perceive signs visually, aurally and conceptually (if they evoke a concept). If it is not possible to compare the marks at one level (e.g. the aural comparison when both marks are purely figurative), this will be stated in the decision.

1.4 Possible outcome of the comparison

The comparison of signs leads to the finding of one of the following three outcomes: identity, similarity or dissimilarity. The result is decisive for further examination of the opposition as it has the following implications.

- A finding of **identity** between signs leads to absolute protection according to Article 8(1)(a) EUTMR if the goods and/or services are also identical.
- A finding of **similarity (or identity)** leads to the opening of the examination on likelihood of confusion in accordance with Article 8(1)(b) EUTMR.
- The finding of **dissimilarity** in all three aspects excludes the likelihood of confusion. There is no need to examine further prerequisites of Article 8(1)(b) EUTMR. If there is some degree of similarity at one or more of the three levels, then the signs cannot be declared dissimilar overall (02/12/2009, T-434/07, Solvo, EU:T:2009:480, § 50-53).

The Court has stated that if there is **some similarity, even faint**, between the marks, a global assessment must be carried out in order to ascertain whether, notwithstanding the low degree of similarity, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion between the marks (24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 66).

The comparison has to lead to a finding on the **degree of this similarity** in every aspect of the comparison (visual, aural and conceptual).

- The **finding on the level of similarity of the marks can be decisive** for the outcome of the decision. The examiner should be aware, that not ‘any similarity’ can lead to likelihood of confusion, even for identical goods and/or services (interdependence principle). The finding of the level of similarity of the marks will make the decision more understandable. For example, the final finding that there is no likelihood of confusion for identical/highly similar goods and/or services is easier to understand in the overall assessment if the marks were previously held as only ‘similar to a low degree’.
- **It is especially important to emphasise in each comparison the degree of similarity of marks if it is high (above average) or low (below average). However, even if the level of similarity is average, the decision should state this, to avoid misunderstandings.** A mere statement that ‘the marks are similar’ is not clear as it can be interpreted in two ways — either in the sense that they are similar to an average degree, or just in the general sense that there is (some) similarity allowing for further examination. If the word ‘similar’ is used without further qualification, the meaning must be explained.

The three levels of similarity are low/average/high. Synonyms can be used as far as they are clear (e.g. average = medium), however, it has to be noted that the term ‘enhanced’ is not a synonym for ‘high’. Moreover, nothing prohibits examiners from assessing the similarity further, like ‘only very low’ or ‘high degree of similarity, almost identical’ if this supports the outcome. The wording, however, must be as clear as

possible. This is not the case for expressions like ‘not particularly high’, which can be understood in two ways — in this example not as high as ‘average’ or just ‘low’.

- The **level of similarity must be established for each aspect of the comparison** (visual/phonetic/conceptual), since the particular field (e.g. the visual or phonetic similarity) may be decisive for the purposes of the overall assessment, depending on how the goods are purchased (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 4).
- After the level of similarity has been defined (for the visual, phonetic and conceptual comparison), a conclusion can be added (if applicable), stating that ‘since the marks have been found similar in at least one aspect of the comparison’, examination of the likelihood of confusion will proceed.

1.5 Signs to be compared and negligible elements

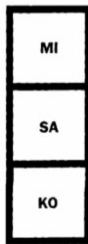
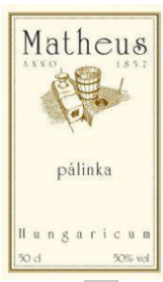


When assessing identity or similarity, the signs have to be compared in the form in which they are protected, that is, in the form in which they are registered/applied for. The actual or possible use of the registered marks in another form is irrelevant when comparing signs (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199, § 38). For the effect of disclaimers, see paragraph 3.2.3.3 below.

The comparison should **cover signs in their entirety**. Consequently, it is wrong to discard comparing elements of signs just because they are, for example, smaller than other elements in the signs (unless they are negligible as explained below) or because they are non-distinctive (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 41-42; 13/12/2011, T-61/09, Schinken King, EU:T:2011:733, § 46).

Exceptionally, in the event of **negligible elements**, the Office may decide not to take such elements into consideration for the purposes of the actual comparison, after **having duly reasoned** why they are considered negligible (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42). This is especially important where the negligible element is the common element in the signs. The notion of negligible elements should be interpreted strictly and, in the event of any doubt, the decision should cover the signs in their entirety.

The Office considers that a negligible element refers to an element that, due to its size and/or position, is not noticeable at first sight or is part of a complex sign with numerous other elements (e.g. beverage labels, packaging) and, therefore, very likely to be disregarded by the relevant public.

Examples

Earlier sign	Contested sign	Case No
	 (GREEN BY MISSAKO)	11/11/2009, T-162/08, EU:T:2009:432 The words 'by missako' are almost illegible: the size and script make them difficult to decipher.
	LUNA	12/12/2011, R 2347/2010-2 The element 'Rótulos Luna S.A.' was considered negligible.
MATHEUS MÜLLER		09/09/2010, R 396/2010-1 The Board did not assess the elements '50 cl', '50 % vol.' 'ANNO' or '1857' phonetically or conceptually.
MAGNA		17/05/2006, R 1328/2005-2 The Board described the contested sign in full, but negligible elements such as '70 cl' were not included in the comparison.
		03/09/2010, T-472/08, EU:T:2010:347 The elements other than 'cachaça'/'pirassununga' and '51', the latter written in white within a circle that is itself partially within a circle that is itself partially within a broad band running from one side of the sign to the other, are negligible in the overall impression created by those marks (para. 65).

It should also be noted that informative indications that the mark is registered (such as the symbols “™” and “®”) are not considered part of the mark (see the Guidelines, Part B, Examination, Section 2, Formalities). Consequently, such symbols will not be taken into account in the comparison of the signs.

1.6 Relevant territory and relevant public

Similarity must be assessed for the territory in which the earlier mark is protected. The relevant territory must be indicated. Moreover, the perception of the relevant public plays an important role when comparing signs (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

Where the earlier mark is a national mark, the relevant criteria must be analysed for the relevant public in that particular EU Member State (or Member States in the case of Benelux trade marks). The perception of similarity may differ from one Member State to another because of differences in pronunciation and/or meaning/understanding.

When the earlier mark is an EUTM registration, the analysis must in principle extend to the **whole** EU. However, in situations where there is likelihood of confusion in a part of the EU **and** when justifiable for reasons of economy of procedure (such as to avoid examining specific pronunciations or meanings of marks in several languages), the Office’s analysis need not extend to the whole EU but may instead focus on only one **part or parts** where there is a likelihood of confusion.

The unitary character of the EUTM means that an earlier EUTM can be relied on in opposition proceedings against any application for registration of an EUTM that would adversely affect the protection of the first mark, even if only in the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 56-57 and subsequent case-law; 18/09/2012, T-460/11, Bürger, EU:T:2012:432, § 52 and the case-law quoted).

If the opposition is based on an international registration, the territory for which the basic mark is protected is not to be considered as the relevant territory of the earlier international registration designating or subsequently designating other relevant territories (except if the owner has protection in the whole EU — IR designating or subsequently designating the EU where the same country of the basic registration is covered).

Where the relevant public consists of both general and professional consumers, the finding of a likelihood of confusion in relation to just one part of the public is sufficient to uphold the opposition. Usually it is the general public that is more prone to confusion. Consequently, if the likelihood of confusion is to be confirmed on the part of the general public, there is no need to examine it based on the perception of professionals (see the Guidelines, Part C, Opposition, Section 0, Introduction, paragraph 4).

2 Identity of Signs

2.1 The concept of identity

As indicated above, a finding of identity between signs will lead to the success of the opposition pursuant to Article 8(1)(a) EUTMR if the goods and services are also identical.

The differences between Article 8(1)(a) EUTMR and protection in the event of likelihood of confusion, pursuant to Article 8(1)(b) EUTMR, must be borne in mind in order to understand the concept of identity and its attached requirements.

Protection pursuant to Article 8(1)(a) EUTMR is absolute, because registration of a later identical sign for identical goods or services would compromise the function of the earlier mark as a means of identifying commercial origin. Where identical signs or marks are registered for identical goods or services, it is impossible to conceive of circumstances in which all likelihood of confusion could be ruled out. There is no need to consider any other factors, such as the degree of attention of the public or the distinctiveness of the earlier trade mark.

However, pursuant to Article 8(1)(b) EUTMR, the earlier trade mark is protected against the likelihood of confusion: even if the trade marks differ in some elements, their similarity — in combination with further elements that have to be assessed globally — may lead to the assumption that the relevant goods and services originate from the same or an economically linked undertaking.

Due to the absolute protection conferred by Article 8(1)(a) EUTMR, the concept of identity between trade marks must be interpreted strictly. The absolute protection in the case of an EUTM application ‘which is identical with the [earlier] trade mark in relation to goods or services which are identical with those for which the trade mark is registered [pursuant to Article 8(1)(a) EUTMR] cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by [Article 8(1)(b) EUTMR]’ (20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 50-54 in relation to the corresponding provisions of the Directive).

2.2 Threshold for a finding of identity

The very definition of identity implies that the two signs should be the same in all respects. There is, therefore, identity between trade marks where the EUTM application reproduces, without any modification or addition, all the elements constituting the earlier trade mark.

However, since the perception of identity between the two signs is not always the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between trade marks may go unnoticed by the average consumer.

Therefore, **the EUTM application should be considered identical to the earlier trade mark ‘where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer’** (20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 50-54).

An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon examining the marks side by side. ‘Insignificant’ is not an objective term, and its interpretation depends on the level of complexity of the trade marks being compared. Insignificant differences are those that, because they concern elements that are very small or are lost within a complex mark, cannot be readily detected by the human eye upon observing the trade mark concerned, bearing in mind that the average consumer does not normally indulge in an analytical examination of a trade mark but perceives it in its entirety.

The finding that an element is ‘insignificant’ must be accompanied by sufficient reasoning for its lack of impact on the global perception of the trade mark.

It follows from the definition of identity above that the following conditions have to be met in order for trade marks to be considered identical in accordance with Article 8(1) (a) EUTMR.

- **Complete identity of the signs taken as a whole.** Partial identity is not sufficient under Article 8(1)(a) EUTMR; however, a coincidence in any part of the mark may lead to similarity between the signs and should be addressed when carrying out the examination of Article 8(1)(b) EUTMR.

Any additional element is sufficient for concluding that the marks are not identical; it is immaterial whether the added element is a word, a figurative device or a combination of the two.

Consequently, two word marks will not be considered identical if one is contained within the other but is accompanied by further characters (see paragraph 2.4 below) or by words — irrespective of distinctiveness or possible descriptive character.

Earlier sign	Contested sign and comments	Case No
Millenium	MILLENIUM INSURANCE COMPANY LIMITED It was found that ‘the signs at stake were obviously not identical’, even if ‘Insurance company limited’ was descriptive in English for the related services.	24/11/2011, R 696/2011-1
INDIVIDUAL		18/12/2008, R 807/2008-4

- **Identity on all levels of comparison.** There must be identity between the signs at all relevant levels of trade mark comparison, that is, visual, phonetic and conceptual. If the trade marks are identical in some aspects (visual, phonetic or conceptual) but not in others, they are not identical overall. In the latter case, they may be similar and, therefore, likelihood of confusion must be examined.

2.3 Identity of word marks

Word marks are marks consisting of letters, numbers and other standard typographic characters (e.g. '+', '@', '!') reproduced in standard typeface. This means that they do not claim any particular figurative element or appearance. Where both marks are registered as word marks, the typeface actually used by the office concerned in the official publication is immaterial. Differences in the use of lower- or upper-case letters are, in general, immaterial. **Word marks** are identical if they coincide exactly in the string of letters, numbers or other typographic characters.

The following word marks are identical.

Earlier sign	Contested sign	Case No
BLUE MOON	Blue Moon	27/01/2011, R 835/2010-1
GLOBAL CAMPUS	Global Campus	23/01/2009, R 719/2008-2
DOMINO	Domino	18/03/2009, R 523/2008-2
Apetito	APETITO	04/05/2011, T-129/09, EU:T:2011:193

In general, it should be checked whether the sign has been registered as a word mark. For example, examining only the graphic representation of the trade mark (e.g. in the Madrid System) can be misleading because, depending on the graphic representation of the signs used in the certificates, bulletins, etc., a mark **claimed as** a word mark may include figurative or stylised elements or fonts. In these cases, the claim will prevail over the exact reproduction in the certificate, bulletins, etc.

Marks in non-Roman characters must be considered as word marks in the designated jurisdictions where those characters are officially used (e.g. Cyrillic in the case of an EUTM or an IR designating Bulgaria or the EU, in accordance with the indication of category No 28.05 'inscriptions in Cyrillic characters' of the Vienna Classification of figurative elements). The following Cyrillic word marks are identical.

Earlier sign	Contested sign	Case No
ВАСИЛЬКИ	Васильки	31/01/2012, B 1 827 537

A difference of just one letter is sufficient for a finding of non-identity.

Earlier sign	Contested sign	Case No
NOVALLOY	NOVALOY	17/12/1999, B 29 290
HERBO FARMA	HERBOFARM	14/07/2011, R 1752/2010-1

Whether or not a space, a punctuation mark (e.g. hyphen, full stop) or an accent, or the use of a combination of upper- and lower-case letters that departs from the usual way of writing, introduces a difference so insignificant that it may go unnoticed by the consumer in accordance with the ‘Arthur et Félicie’ judgment (20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 50-54) is assessed on a case-by-case basis, taking into consideration the relevant language. In some languages, a term can be written either together or with a space or hyphen (e.g. weekend versus week-end) so the public will not notice the difference. However, the use of a space, hyphen or accent, or the use of a combination of upper- and lower-case letters that departs from the usual way of writing, may change the meaning of the word element and therefore influence how the sign is perceived. The following word marks **are not** identical.

Earlier sign	Contested sign	Case No
She, SHE	S-HE	23/09/2009, T-391/06, EU:T:2009:348



2.4 Word marks and figurative marks

A **word mark** and a **figurative mark**, even when both consist of the same word, will not be identical unless the differences are so insignificant that they may go unnoticed by the relevant public.

In the following examples the signs are clearly **not identical**.

Earlier sign	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
	ELCO	13/03/2009, R 803/2008-1
eClear		09/02/2012, R 1807/2010-1
BIG BROTHER		10/05/2011, R 932/2010-4






However, the finding that trade marks are not identical can be more difficult if the figurative trade mark is written in normal typeface. Nevertheless, in the following examples the trade marks were found **not** to be **identical**.

Earlier sign	Contested sign	Case No
	THOMSON	22/04/2009, R 252/2008-1
	Klepper	24/02/2010, R 964/2009-1

2.5 Identity of figurative marks

Two figurative marks are identical when both signs match in all their elements (shape, colours, contrast, shadowing, etc.).

It goes without saying that use of the same word will not suffice for a finding of identity when the figurative element is not the same. The following marks **are not** identical.

Earlier sign	Contested sign	Case No
		09/02/2012, R 558/2011-1
		31/03/2011, R 1440/2010-1
		12/04/2013, 7078 C

However, since in the following case the difference in the presentation of the letters 'TEP' in italics would go unnoticed by the public, the marks were considered **identical**.





Earlier sign	Contested sign	Case No
		28/02/2013, B 2 031 741

2.6 Identity of an earlier black and white (B&W) or greyscale mark with a colour mark application





In the framework of the European Trade Mark and Design Network, the Office and a number of trade mark offices in the European Union have agreed on a Common Practice with regard to the scope of identity of earlier B&W or greyscale marks with coloured versions of the same sign.

According to this Common Practice, the **differences** between an earlier B&W or greyscale mark and a coloured version of the same sign **will normally be noticed** by the average consumer, with the consequence that the marks are not considered identical. It is only under **exceptional circumstances** that the signs will be considered identical, namely where the differences in the colours or in the contrast of shades are so **insignificant** that a reasonably observant consumer will perceive them only upon examining the marks side by side. In other words, for the finding of identity the differences in the colour of the signs in question must be hardly noticeable by the average consumer.



Invented examples of **significant** differences with the consequence of no identity.

Earlier sign	Contested sign
	
	

Invented examples of **insignificant** differences with the consequence of identity.

Earlier sign	Contested sign
	
	

In relation to the findings above, the issue as to whether a trade mark registered in B&W or greyscale should be considered to cover all colours has also been addressed by the Court in a subsequent judgment (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199).

Earlier sign	Contested sign	Case No
		09/04/2014, EU:T:2014:199 T-623/11,
<p>The Court considered that the fact that 'the proprietor of a mark may use it in a colour or a combination of colours and obtain for it, as the case may be, protection under the relevant applicable provisions ... does not mean ... that the registration of a mark which does not designate any specific colour covers all colour combinations which are enclosed with the graphic representation' (para. 39).</p> <p>In this particular case, the Court considered that the Board was right in finding 'that one difference between the mark applied for and the first and second earlier marks lay in the fact that the mark applied for consisted, in part, of a yellow background with white vertical stripes' (para. 40).</p>		

3 Similarity of Signs

3.1 Introduction

The similarity of signs depends on the distinctiveness (see paragraph 3.2 below) and dominant character (see paragraph 3.3 below) of their components, and on other possible relevant factors defined in the opposition decision. In the comparison of marks, the visual, phonetic and conceptual similarity must be assessed by weighing up the coinciding and the differing elements, and by taking into consideration their distinctiveness and dominance (see paragraph 3.4 below) and whether and to what degree these elements coin the overall impression produced by the marks. All these considerations will lead to a conclusion on the degree of similarity in each (visual, phonetic and conceptual) aspect (see paragraph 3.5 below).

3.2 Distinctive elements of the marks

In the *Sabèl* judgment (11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528, § 23), the Court held that '... (the) global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components'. Therefore, the degree of distinctiveness of the various components of composite marks is an important criterion that must be considered within the trade mark comparison.

When assessing the similarity of signs, the degree of distinctiveness of their coinciding and differing components should be established because distinctiveness is one of the factors that determine the importance of those elements in each sign and, accordingly,

their impact in the overall impression of the signs. A coincidence in a distinctive element and/or a difference in an element with no or little distinctiveness tend to increase the degree of similarity. A difference in a distinctive element tends to decrease the degree of similarity. The same applies where the coincidence found concerns an element with no or reduced distinctiveness.

Consequently, although trade mark proprietors commonly use non-distinctive or weak elements as part of a trade mark to inform consumers about certain characteristics of the relevant goods or services, it may be more difficult to establish that the public may be confused as to origin due to similarities that solely pertain to non-distinctive or weak elements.

Therefore, in principle, the distinctiveness of all components of both the earlier **and** of the contested mark should be examined.

It is important to distinguish between the analysis of the distinctive character of (i) the component of a mark and (ii) the earlier mark as a whole. Analysing the components determines whether the signs in conflict coincide in a component that is distinctive (and therefore important), non-distinctive or weak (therefore being of less importance in the trade mark comparison). The analysis of the earlier mark as a whole determines the scope of protection afforded to that mark, which is a separate consideration within the likelihood of confusion, independent from the comparison of the trade marks (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

However, if either mark consists of one element only, the decision in the part dealing with the comparison of signs will establish whether the distinctiveness of that element is normal or lower than normal. In this case, it cannot be found that the element lacks distinctiveness. Regarding the earlier mark, this would amount to denying its distinctive character (for details, see paragraph 3.2.3.4 below). As regards the contested sign, this would mean that a new examination of absolute grounds would have to be carried out.

3.2.1 What is a component of a sign?

The Court has not defined what is to be regarded as a ‘component’ or ‘element’ of a sign. It is easy to identify components when a sign is visually divided into different parts (e.g. separate figurative and verbal components). However, the term ‘component’ encompasses more than these visual distinctions. Ultimately, the perception of the sign by the relevant public is decisive and a component exists wherever the relevant public perceives one. For example, the relevant public will often regard one-word signs as being composed of different components, in particular, where one part has a clear and evident meaning while the rest is meaningless or has a different meaning (e.g. in the mark EUROFIRT, ‘Euro’ will be widely understood as referring to Europe whereas ‘Firt’ is meaningless, giving this word mark two components: ‘Euro’ and ‘Firt’). In such cases, the elements of one-word signs could be regarded as ‘components’ in the terminology of the Court.

However, **words should not be artificially dissected**. Dissection is not appropriate unless the relevant public will clearly perceive the components in question as separate

elements. A case-by-case assessment is required as to whether the division of a sign into components is artificial (e.g. whether splitting the word 'LIMEON' for fruit into the components 'LIME' and 'ON' would be artificial or not) (see also paragraphs 3.4.3.2 and 3.4.5.1 below).

3.2.2 Examination of distinctiveness

3.2.2.1 What is distinctiveness?

The Court has defined distinctiveness in the following manner:

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the **greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings** (emphasis added).

(22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 22).

Importantly, distinctive character is a matter of degree and, when analysing distinctiveness, a sliding scale applies whereby a component of a sign can lack distinctiveness entirely, be fully distinctive (to a normal degree) or be at any point in-between.

At this point, it must be noted that it is not, in principle, the Office's practice to recognise a higher than average degree of inherent distinctiveness for individual components of signs. Any higher degree of distinctiveness (enhanced distinctiveness, reputation) is related to actual recognition of the mark by the relevant public, and is eventually examined only with respect to the earlier mark (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark). A mark or, by analogy, its components will not have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services (16/05/2013, C-379/12 P, H / Eich, EU:C:2013:317, § 71).

An element of a sign is **not distinctive** if it is exclusively descriptive of the goods and services themselves or of the characteristics of those goods and services (such as their quality, value, purpose, provenance, etc.) and/or if its use in trade is common for those goods and services. Similarly, an element of a sign that is generic (such as a common shape of a container or a common colour) will also lack distinctiveness.

An element of a sign may be **distinctive to a low degree (weak) if it refers to** (but it is not exclusively descriptive of) characteristics of the goods and services. If the allusion to the goods and services is sufficiently imaginative or clever, the mere fact that there is an allusion to characteristics of the goods might not materially affect distinctiveness, as in the following examples.

- 'Billionaire' for *gaming services* is allusive in a manner that would affect distinctiveness, because it implies, for instance, that you may become a billionaire.

- ‘Billy O’Naire’, which sounds identical to ‘billionaire’ in English, would be allusive for *gaming services* as a clever word-play on Irish names, in a manner that would not affect distinctiveness in a material way; it would be considered to have a ‘normal’ degree of distinctiveness.

An element of a sign that is neither non-distinctive nor weakly distinctive possesses a **‘normal’ degree of inherent distinctiveness**. This means that the element of a sign in question is fully distinctive, in the sense that its capacity to identify the goods and services covered by the mark as coming from a particular undertaking is not in any way diminished or impaired.

One of the most frequent arguments brought by applicants is that the earlier trade mark or one of its components has a low distinctive character given that there are many trade marks that consist of, or include, the element in question. Where this argument is supported only by the applicant referring to trade mark registrations, the Office takes the view that the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of registered data only, it cannot be assumed that all the trade marks have been effectively used.

It follows that the evidence submitted must demonstrate that consumers have been exposed to widespread use of, and become accustomed to, trade marks that include the element in question in order to prove that the element in question has a low degree of distinctive character (13/04/2011, T-358/09, Toro de Piedra, EU:T:2011:174, § 35; 08/03/2013, T-498/10, David Mayer, EU:T:2013:117, § 77-79).

3.2.2.2 Relevant point in time

The inherent distinctiveness of the components should be assessed at the time of the decision.

Establishing the precise point in time for evaluating distinctiveness is important because the degree of distinctiveness of the marks is not constant, but varies depending on the perception of the public. This perception may change not only due to the nature of the use of the specific mark, but also due to other factors (all these elements can only be considered from the evidence submitted by the parties). For instance, the public’s perception may change where a mark or some component thereof has been used in the meantime in a similar way by various businesses/traders in the relevant market sector. This common use of a sign can erode the uniqueness of a sign and, consequently, its ability to indicate the origin of the goods and services. In this context, it is important to assess carefully whether the situation described exists in all the relevant geographical areas and with regard to all the relevant goods and services.

As an example, due to technological changes in the field of IT, there has been an increased number of instances where components such as ‘I’ (internet), ‘E’ (electronic) and ‘M’ (mobile) are used adjoined to a meaningful word. In the context of electronic communications, they are currently found to be descriptive (19/04/2004, R 758/2002-2, ITUNES, § 11), whereas previously they were considered distinctive.

3.2.2.3 Relevant goods and services

The assessment of the **inherent distinctiveness** of the components is carried out only for the goods or services that are identical or similar, that is:

- the earlier mark is assessed with respect to the registered goods and services that are identical or similar to the contested goods and services;
- the contested trade mark is assessed with respect to the contested goods or services that are identical or similar to those of the earlier mark.

3.2.2.4 General principles of examination of distinctiveness

The examination of inherent distinctiveness is carried out in two phases: first, it should be determined whether the relevant public recognises semantic content of the element at issue and, second, whether or not the semantic content perceived is related to and/or commonly used in trade for the identical or similar goods and services.

As regards the **first phase**, that is to say, whether the relevant public recognises a semantic content, the inherent distinctiveness of the components of the marks has to be evaluated by taking into account (each of) the relevant geographical area(s) and their different linguistic and cultural backgrounds. As such, the public in some parts of the relevant territory might not understand the descriptive content that a mark may have in other parts. In these cases, the distinctiveness of the mark in one area is not affected by the fact that it may be perceived differently in other areas.

Below is an example of a case where linguistic considerations were vital to the issue of distinctiveness.

Earlier sign	Contested sign	Case No
FRUTISOL	Solfrutta	27/01/2010, T-331/08, EU:T:2010:23
<p>G&S: Classes 29, 30 and 32</p> <p>Territory: EU</p> <p><i>Assessment of the components 'frut' and 'sol':</i> '... it is necessary to distinguish between the perception by the public in those Member States, such as Italy and Spain, where the elements "sol" and "frut" are generally recognisable and can be understood as alluding to "sun" and "fruit" respectively, and the perception by the public in those Member States, such as Hungary, Finland and Lithuania, where those elements have no such close equivalent in their national languages'. In the first category of Member States, consumers are liable to associate both marks with the notions of 'fruit' and 'sunshine'. There will consequently be a certain level of conceptual similarity between them. In Member States of the second category, consumers will not perceive any conceptual similarity between the signs since they will not attach any particular meaning to the constituent parts of either sign (paras 21-24).</p>		

The **second phase** consists of correlating any meaning that the public perceives in the components with the identical or similar goods and services in dispute. If the relevant public perceives this meaning as descriptive, laudatory or allusive (in a manner that materially affects distinctiveness), etc. for these goods and services, then its distinctiveness will be diminished accordingly. It may be necessary to distinguish between the various goods and services involved because the finding of no or limited distinctiveness might relate to only part of those goods and services. In the event that no meaning can be attributed to a verbal element, it cannot be descriptive, laudatory or allusive in any way and as such is considered distinctive.


The criteria applied to examining the inherent distinctiveness of a component of a sign are the same as the relevant principles applied when examining marks on absolute grounds (see the Guidelines, Part B, Examination) ⁽⁴⁵⁾. However, in relative grounds disputes, the question is not merely whether a component is distinctive or not (i.e. whether it reaches the minimum distinctiveness threshold for registration), but also to what degree it is distinctive within the sliding scale previously mentioned. Therefore, for instance, a term that is not descriptive but merely allusive for the goods or services in question might be distinctive enough to pass the absolute grounds test, but still have less than normal distinctiveness for the purposes of relative grounds.

The outcome of the examination of inherent distinctiveness will be one of the following.







- The component has **no distinctiveness** or has **less than normal distinctiveness**. See the examples below.
- The component has normal distinctiveness because it is neither non-distinctive nor weak for identical or similar goods or services.

As noted in paragraph 2.1 above, word marks consisting of a single word may still contain various components, some of which may be more distinctive than others (27/01/2010, T-331/08, Solfrutta, EU:T:2010:23).

3.2.2.5 Examples of descriptive components

Earlier sign	Contested sign	Case No
BYLY		14/04/2010, T-514/08, EU:T:2010:143
<p>G&S: Class 3</p> <p>Territory: EU</p> <p><i>Assessment of the element 'products': '... the term "products" is not distinctive enough to be taken into consideration by the consumers' (para. 39).</i></p>		


⁴⁵ See also Objective 2 of the Common Practice on the Impact of Non-Distinctive/Weak Components on Likelihood of Confusion agreed in the framework of the European Trade Mark and Design Network.

Earlier sign	Contested sign	Case No
Earlier sign	Contested sign	Case No
		22/06/2010, T-490/08, EU:T:2010:250
<p>G&S: Class 36</p> <p>Territory: EU</p> <p><i>Assessment of 'CAPITAL MARKETS':</i> 'the relevant public, consisting of consumers who are very attentive, well-informed and familiar with basic English financial terminology, will attach little significance to the meaning of the words "capital" and "markets", which are descriptive of those services and which do not enable the commercial origin of the trade marks at issue to be identified' (para. 59).</p>		
Earlier sign	Contested sign	Case No
		11/01/2010, R 834/2009-1
<p>G&S: Classes 3 and 5</p> <p>Territory: EU</p> <p><i>Assessment of the earlier right:</i> even though the signs have some similarities, the expression 'NATURAL BRONZE' is descriptive of the purpose of the goods (tanning) for the goods in Class 3 (para. 31).</p>		
Earlier sign	Contested sign	Case No
 (CINEDAY <i>et al.</i>)	CINETAIN	16/11/2010, R 1306/2009-4
<p>G&S: Classes 38 and 41</p> <p>Territory: Spain</p> <p><i>Assessment of the element 'CINE':</i> the word 'cine' has a descriptive meaning in the sense of 'cinema (film)'. Therefore, this component has only limited relevance in the perception of the signs (para. 36).</p>		
Earlier sign	Contested sign	Case No
	NATURAL BEAUTY FROM WITHIN	19/11/2010, R 991/2010-2


Earlier sign	Contested sign	Case No
<p>G&S: Classes 3 and 5</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment of the element 'NATURAL BEAUTY':</i> the element 'NATURAL BEAUTY' is a plain and essential indication of the kind and quality of the goods. The German public understands the meaning of these two basic words as well as the combination thereof (paras 31-35).</p>		
Earlier sign	Contested sign	Case No
FORCE-X	FSA K-FORCE	04/02/2015, T-558/13, EU:T:2015:135
<p>G&S: Classes 9 and 12</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> the word 'force', synonymous with strength and power, can describe one of the characteristics of the goods concerned. Furthermore, for some goods in Class 12, it must be held that that word can also designate one of their purposes. Furthermore, as is apparent from the evidence adduced by the applicant, the word 'force' is commonly used, on the European market, in trade marks in the domain of cycling, thus rendering it banal (paras 38-39).</p>		

3.2.2.6 Examples of laudatory components

Earlier sign	Contested sign	Case No
	MAGIC SEAT	09/09/2008, EU:T:2008:319 T-363/06,
<p>G&S: Class 12</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment of the element 'MAGIC':</i> the word 'magic' will be perceived by the relevant public as a simple qualifier for the word 'seat' on account of its resemblance to the Spanish word 'mágico', which is purely laudatory (para. 39).</p>		
Earlier sign	Contested sign	Case No

STAR SNACKS		11/05/2010, EU:T:2010:186	T-492/08,
<p>G&S: Classes 29, 30 and 32</p> <p><i>Territory:</i> EU</p> <p><i>Assessment of the element 'STAR':</i> the word element 'STAR' is laudatory, as it merely constitutes (together with the remaining elements of the signs) a reference to high-quality food products (para. 52).</p>			


3.2.2.7 Examples of allusive components

Earlier sign	Contested sign	Case No
	WORLDLINK	27/02/2008, EU:T:2008:51
<p>G&S: Class 36</p> <p><i>Territory:</i> EU</p> <p><i>Assessment of the element 'LINK':</i> the element 'LiNK' of the earlier mark is not immediately descriptive of inter alia 'banking services for the dispensing of cash; funds transfer and payment services; financial information services' (Class 36) covered by the earlier mark, but merely allusive in relation to them (para. 68 et seq.).</p>		

3.2.3 Specific cases

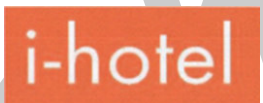
3.2.3.1 Commonplace and banal elements


There are instances where signs are composed of one (or various) distinctive verbal element(s) and one (or various) figurative element(s) that are perceived by the relevant public as being commonplace or banal. These figurative elements frequently consist of a simple geometrical shape (e.g. frames, labels) or of colours frequently used in the market sector (e.g. red for fire extinguishers, yellow or red or orange for the postal sector depending on the Member State concerned). For this reason, these commonplace and banal elements are considered non-distinctive.

Earlier sign	Contested sign	Case No
ARCO		05/10/2011, R 1929/2010-2
<p>G&S: Class 9</p> <p>Territory: EU</p> <p><i>Assessment of figurative elements:</i> the verbal elements of the two signs coincide. Even if it is not negligible in terms of its size, the figurative element of the contested EUTM is likely to be perceived by consumers essentially as a mere decorative element, and not as an element indicating the commercial origin of the goods (para. 43).</p> <p>The marks are visually highly similar and phonetically and conceptually identical (paras 45-48).</p>		

3.2.3.2 Identical verbal elements accompanied by non-distinctive figurative elements

When comparing a word mark with a figurative mark containing an identical word element as its only word element, it is not necessary to assess the distinctiveness of the word if the figurative elements are not distinctive (mere colour, background or common typeface) and not dominant. In such cases, it is irrelevant that the word has only limited distinctiveness in relation to some goods and services in some languages, since this applies equally to both marks, while the figurative elements are clearly not sufficient to distinguish the marks.

Earlier sign	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
<p>G&S: services related to travel, accommodation and congresses in Classes 35, 39, 41, 42, 43.</p> <p>Territory: EU</p> <p><i>Assessment:</i> The Court did not go into the assessment of the inherent distinctiveness of the elements of the signs and agreed with the Board that the signs were visually highly similar and phonetically and conceptually identical (paras 83-92). The Board, therefore, correctly found the signs to be 'almost identical' (para. 93). The differentiating elements (the orange background and the particular way of writing) were considered to be insignificant.</p>		
Earlier sign	Contested sign	Case No

LEMON GOLD		21/11/2018, B 2 943 036
<p>G&S: Class 31</p> <p>Territory: Spain</p> <p><i>Assessment:</i> The earlier mark is entirely reproduced in the contested mark, where it is the only verbal component. Whether or not the identical verbal components are understood by the relevant Spanish public is immaterial since, given the present circumstances, they are on an equal footing regarding their distinctiveness. The only differences between the signs reside in the figurative elements of the contested sign, namely a lemon on a black, label-shaped, background. However, neither of these elements is distinctive given that lemons are the relevant goods and the label is a commonplace, banal shape. Consequently, the signs are aurally and conceptually identical, and visually highly similar.</p>		

3.2.3.3 One-letter components, numerals and short components

In its judgment of 09/09/2010, C-265/09 P, α , EU:C:2010:508, the Court held that the distinctiveness of single-letter trade marks must be assessed according to an examination based on the facts, focusing on the goods or services concerned and the **same criteria that apply to other word marks** (paras 33-39). Although that judgment deals with absolute grounds, the Office considers that the principle established by the Court (i.e. that the application of the criterion of distinctiveness must be the same for all marks) also applies in *inter partes* cases when it comes to determining the distinctiveness of single-letter components in trade marks.

The Court, although acknowledging that it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks, held that these circumstances do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law.

In the context of analysis of distinctiveness of components of signs, the Office considers the ruling to mean that, when establishing the distinctiveness of a single letter, being a component of a sign, it is not correct to rely on assumptions such as a priori statements that consumers are not in the habit of perceiving single letters as trade marks or on generic arguments such as that relating to the availability of signs, given the limited number of letters.

The General Court has since stated in a number of cases that a trade mark containing a **single letter** or a single numeral may indeed be inherently distinctive (08/05/2012, T-101/11, G, EU:T:2012:223, § 50; 06/10/2011, T-176/10, Seven for all mankind, EU:T:2011:577, § 36; 05/11/2013, T-378/12, X, EU:T:2013:574, § 37-51).

In its judgment of 10/05/2011, T-187/10, G, EU:T:2011:202, the General Court dismissed the applicant's argument that single letters are generally per se devoid of

distinctive character and that, therefore, only their graphic representation would be protected (paras 38-49).

The above considerations apply both to single-letter/numeral trade marks depicted in standard characters (i.e. word marks) and to stylised single-letter/numeral trade marks.

Furthermore, in accordance with the *α* judgment, as regards these components, unless the letter combination itself is descriptive or otherwise related to the goods and services (e.g. 'S', 'M', 'XL' for goods in Class 25), these components are not necessarily limited in their distinctiveness. The same rules apply to numerals.

3.2.3.4 Disclaimers

Pursuant to former Article 37(2) CTMR (deleted by Amending Regulation (EU) 2015/2424), the Office could impose a disclaimer if the mark contained an element that was not distinctive and if inclusion of that element would have led to doubts as to the scope of protection. The Office also accepted disclaimers entered voluntarily. Some national trade mark systems also provide for disclaimers.

Following the entry into force of Amending Regulation (EU) 2015/2424, the Office is no longer able to request disclaimers; similarly, no requests for disclaimers entered by the EUTM applicant will be accepted.

However, disclaimers in marks registered by the Office before the entry into force of Amending Regulation (EU) 2015/2424 and in earlier national marks will still be binding on the Office and must be taken into account even if the element might appear distinctive when analysed independently.

The effect of a disclaimer is:

- if the earlier mark contains a disclaimer, that the proprietor is prevented from successfully invoking rights in the disclaimed element. Therefore, similarity between two signs cannot be induced or increased because of coincidence or similarity in the disclaimed element (06/10/2008, R 21/2008-4, AUTENTICO JABUGO / FLOR SIERRA DE JABUGO JABUGO (fig.) et al., § 17, where JABUGO was disclaimed).
- that if the earlier figurative mark contains two words and both are disclaimed, the scope of protection is reduced to the precise manner and sequence in which the two words are combined.

Disclaimers in the contested EUTM application (irrespective of whether they were requested by the Office or entered voluntarily by the applicant before the entry into force of Amending Regulation (EU) 2015/2424) cannot bind the owner of the earlier mark, that is to say, the applicant cannot unilaterally reduce the scope of protection of the earlier mark (11/02/2010, R 229/2009-2, DOUGHNUT THEATER / DONUT et al., § 58; 29/03/2012, R 2499/2010-1, ACETAT Silicon 101E (fig.) / 101 et al., § 18-19).

3.2.3.5 Earlier marks, the distinctiveness of which is called into question

If the distinctiveness of the earlier mark is questioned, the Office applies the practice clarified in the *F1-Live* judgment (24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314),

namely that in proceedings opposing the registration of an EUTM, the validity of earlier trade marks may not be called into question.

Consequently, the elements corresponding to the earlier mark cannot be considered as devoid of distinctive character in the trade mark comparison, but must be deemed to be endowed with some (low/minimal) degree of distinctiveness.

Earlier sign	Contested sign	Case No
GLANC		23/10/2013, R 2306/2012-1
<p>G&S: Classes 29, 30 and 32</p> <p>Territory: the Czech Republic</p> <p>Assessment: 'The Board also notes that the earlier mark "Glanc" is registered in the Czech Republic for the goods in question and, therefore, for the purpose of the present proceedings, it must be deemed to be endowed with at least some degree of distinctive character'.</p>		

3.3 Dominant elements of the marks

It is the Office's practice to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean '**visually outstanding**'.

For a finding that there is a dominant element within a sign, the sign should have at least two identifiable components ⁽⁴⁶⁾. The rules explained in paragraph 3.2.1 above apply accordingly.

The decision should establish whether there is a dominant element or codominant elements and identify them.

Even though, according to the established case-law of the Court, aspects other than the visual one (such as a possible semantic meaning of part of a one-word sign) may come into play when defining the notion of the dominant element of a sign, it is the practice of the Office to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean 'visually outstanding' and to leave any other considerations for the overall assessment. As a result, the Office's practice is that the dominant character of a component of a sign is **mainly determined**

⁴⁶ In this text the words 'component' and 'element' are used interchangeably.

by its position, size, dimensions and/or use of colours, to the extent that they affect its visual impact. As stated by the Court:

With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.

(23/10/2002, T-6/01, *Matratzen + Matratzenmarkt Concord* (fig.), EU:T:2002:261, § 35; confirmed 28/04/2004, C-3/03 P, *Matratzen + Matratzenmarkt Concord* (fig.), EU:C:2004:233).

In addition, the Court has held that:

... the weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them.

(13/06/2006, T-153/03, *Peau de vache*, EU:T:2006:157, § 32).


Consequently, the fact that a component of a mark may or may not be considered non-distinctive (or as having a low degree of distinctiveness) has no bearing on the assessment of dominant character.


As a rule of thumb, the following should be considered.

- The assessment of dominant character applies to both the signs under comparison.
- For a finding that there is a dominant component, the sign should have at least two identifiable components.
- Word marks have no dominant elements because by definition they are written in standard typeface. The length of the words or the number of letters is not an issue of dominance but of overall impression (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment).
- Figurative elements may be dominant in signs where word elements are also present.
- Whether or not an element is visually outstanding may be determined in the visual comparison of the signs; if that is the case, it must be consistent with an evaluation of dominant character.
- Lastly, if it is difficult to decide which of the (at least) two components is dominant, this may be an indication that there is no dominant element or that no element is more dominant than the other (which includes cases of codominance). The establishment of dominant character implies that one component is visually outstanding compared to the other component(s) in the mark. If this applies to two or more components, they are codominant. If that assessment is difficult to make, it is because there is no dominant or codominant element(s).

Examples of cases

Sign	Dominant component and reasoning	Case No
	RPT: 'the dominant element of the earlier marks is the acronym RPT, in which the letter "p" predominates' (para. 33).	04/03/2009, T-168/07, EU:T:2009:51
	Free: 'the word "free" dominates the visual impression created by the mark of which it forms part, because it is considerably larger than the other components and, in addition, is much easier to remember and pronounce than the slogan in question' (para. 39).	27/10/2010, T-365/09, EU:T:2010:455
	Xtreme: 'On the visual level, it must be concluded that in the mark applied for, the term "XTREME" occupies a central position. Indeed, the size of its typeface is bigger than that of the other verbal elements, and the word is highlighted with a white outline ... The other verbal components "RIGHT GUARD" and "SPORT", are written in a much smaller type and are shifted to the right and towards the edge of the sign' (para. 55).	13/04/2005, T-286/03, EU:T:2005:126

Sign	Dominant component and reasoning	Case No
 <p>(by missako)</p>	<p>GREEN by missako: ‘It must be noted, as a first point, that the representation of the sun has an important place within the mark applied for, in that it is positioned in the centre and covers almost two thirds of the area. Next, the position of the word element “green” is also important within the mark, as it is portrayed in large-typeface, stylised upper case letters in black and takes up about one third of the area. As observed by the Board of Appeal in para. 28 of the contested decision, those two elements thus occupy the major portion of the mark applied for and are, therefore, striking in the overall impression of the mark. Lastly, as regards the word element “by missako”, the Board of Appeal correctly held, in para. 28 of the contested decision, that those words were almost illegible because of their size and that the handwriting made them difficult to decipher. It follows, first, that the dominant nature of the word “green” and of the representation of the sun are thereby further reinforced and, secondly, that the word element “by missako” is negligible in nature’ (paras 37-39).</p>	<p>11/11/2009, EU:T:2009:432</p> <p>T-162/08,</p>

Sign	Dominant component and reasoning	Case No
	<p>BÜRGER: The dominant element of the mark applied for is undeniably the word element in upper case letters that stands out, simply because of its position and the very large size of its lettering, from all the other elements that make up the label (para. 38).</p>	<p>18/09/2012, T-460/11, EU:T:2012:432</p>

3.4 Comparison of signs

In the following paragraphs the application of the principles explained above will be explained with regard to the visual (see paragraph 3.4.1 below), phonetic (see paragraph 3.4.2 below) and conceptual comparison (see paragraphs 3.4.3 and 3.4.4 below). Thereafter, the impact of distinctiveness and dominant character of the common and differing elements (see paragraph 3.4.5 below) and other principles to be taken into account in the comparison of signs (see paragraph 3.4.6 below) will be presented.

3.4.1 Visual comparison

Within the visual comparison it is important to note first that the public perceives word elements of a mark in a different way from other elements. Word elements can be read or associated with a sequence of letters. Other elements are just assessed as to their graphical or figurative characteristics. In the following, the principles of visual comparison will be presented depending on the type of trade marks involved.

3.4.1.1 Word marks versus word marks

A word mark is a mark consisting exclusively of words or letters, numerals, other standard typographic characters or a combination thereof, represented in standard script and layout, without any graphic feature or colour (Article 3(3)(a) EUTMIR).

The protection of a word mark concerns the word as such. Therefore, it is irrelevant, for the purposes of the comparison of word marks, if one of them is written in lower-case letters and the other in upper-case letters.

Earlier sign	Contested sign	Case No (level of similarity)
BABIDU	babilu	31/01/2013, T-66/11, EU:T:2013:48, § 57, 58 (high)
FRUTISOL	Solfrutta	27/01/2010, T-331/08, EU:T:2010:23, § 16, 17, 24 (low)
metabiarex	METABIOMAX	11/06/2014, T-281/13, EU:T:2014:440, § 41, 52-54 (low)

Nevertheless, where a word mark combines upper- and lower-case letters in a manner that departs from the usual way of writing ('irregular capitalisation'), this must be taken into account. Pursuant to Article 3(2) EUTMR, the representation of the trade mark defines the subject matter of the registration. The perception of the relevant public, who will not fail to notice the use of irregular capitalisation, also cannot be disregarded.

Irregular capitalisation may have an impact on how the public perceives the sign, and consequently, on the assessment of similarity. The impact of irregular capitalisation on the comparison of signs is assessed on a case-by-case basis. For example, it may change the meaning of the word element in the relevant language and therefore influence how the sign is perceived.

Earlier sign	Contested sign	Case No
AIDAmia	Damia	31/03/2016, R 3290/2014-4
<p>G&S: Classes 12, 18, 25, 29, 30, 32, 35</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> Due to its specific spelling, the earlier sign will be divided by the consumer into the words 'aida' and 'mia'. The consumer will first and foremost perceive the 'AIDA' component of the earlier mark, which has no aural or visual equivalent in the contested sign (paras 36, 38, 45).</p>		

Hence, the use of irregular capitalisation may justify breaking down a single word into components, which may result in a relevant overlap with the conflicting mark (see paragraphs 3.4.3.2 and 3.4.5.1 below).

For word marks, the visual comparison is based on an analysis of the number and sequence of the letters/characters, the position of the coinciding letters/characters, the number of words and the structure of the signs (e.g. whether word elements are separated or hyphenated).

However, the average consumer normally perceives a sign as a whole and does not proceed to analyse its various details. Therefore, small differences in the (number of) letters are often not sufficient to exclude a finding of visual similarity, particularly when the signs have a common structure.

In the following cases the marks were held to be visually similar.

Earlier sign	Contested sign	Case No (level of similarity)
MEDINETTE	MESILETTE	13/06/2012, T-342/10, EU:T:2012:290 (average)
FORTIS	FORIS	17/03/2003, R 49/2002-4 (high)
ARTEX	ALREX	17/11/2005, T-154/03, EU:T:2005:401 (very high)
MARILA	MARILAN	27/01/2011, R 799/2010-1 (high)
EPILEX	E-PLEX	24/05/2011, T-161/10, EU:T:2011:244 (average)
CHALOU	CHABOU	16/11/2011, T-323/10, EU:T:2011:678 (high)

The following word marks are visually dissimilar.

Earlier sign	Contested sign	Case No
CAPOL	ARCOL	25/03/2009, T-402/07, EU:T:2009:85; 04/03/2010, C-193/09 P, EU:C:2010:121;




The Board held that although those marks shared the letter 'a' and the ending 'ol', they 'clearly differ[ed]' visually. The General Court agreed. It held that **the same number of letters in two marks is not, as such, of any particular significance for the relevant public**, even for a specialised public. Since the alphabet is made up of a limited number of letters, which, moreover, are not all used with the same frequency, it is inevitable that many words will have the same number of letters and even share some of them, but they cannot, for that reason alone, be regarded as visually similar. In addition, the public is not, in general, aware of the exact number of letters in a word mark and, consequently, will not notice, in the majority of cases, that two conflicting marks have the same number of letters (paras 81-82). The Court held that **what matters in the assessment of the visual similarity of two word marks is the presence, in each of them, of several letters in the same order** (para. 83). The ending 'ol' of the marks at issue constituted a common element of the marks but comes at the end and is preceded by completely different groups of letters ('arc' and 'cap' respectively), so the Board of Appeal correctly concluded that that this commonality does not render the marks visually similar (para. 83). The Court of Justice upheld this assessment from a visual perspective (para. 74).

3.4.1.2 Word marks versus figurative marks with word elements



When figurative marks with word elements and word marks are compared visually, what matters is whether the signs share a significant number of letters in the same position and whether the word element in the figurative sign is highly stylised. Similarity may be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour.

In principle, when the same letters are depicted in the same sequence, any variation in stylisation has to be high in order to find visual dissimilarity.

The following marks were considered visually **similar** because there was no high variation in the stylisation of the word elements in the figurative marks and the word element was easily recognisable and legible.

Earlier sign	Contested sign	Case No (level of similarity)
VITAFIT		25/10/2012, T-552/10, EU:T:2012:576 (average)
COTO DE IMAZ		04/02/2010, R 409/2009-1 (high)
vendus sales & communication group		15/07/2010, R 994/2009-4 (high)

However, where the word in the figurative mark is highly stylised, the marks should be found visually **dissimilar**, as in the following examples.







Earlier sign	Contested sign	Case No
NEFF		20/09/2010, R 1242/2009-2
	NODUS	27/07/2007, R 1108/2006-4

The protection that results from the registration of a word mark concerns the word mentioned in the application for registration and not any specific graphic or stylistic







elements that the mark might eventually adopt in the future. Therefore, the argument that a word mark may be used with a stylisation similar to that of the conflicting figurative mark, so that the signs would look more similar, cannot prosper (see, in this regard, 20/04/2005, T-211/03, Faber (fig.) / NABER, EU:T:2005:135, § 37, 38; 13/02/2007, T-353/04, Curon, EU:T:2007:47, § 74).

3.4.1.3 Figurative marks with word elements versus figurative marks with word elements

When comparing signs in terms of their **word elements**, the Office considers signs similar insofar as they share a significant number of letters in the same position and are not highly stylised or are stylised in the same or a similar manner. Similarity may be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour (18/06/2009, T-418/07, LIBRO, EU:T:2009:208; 15/11/2011, T-434/10, Alpine Pro Sportswear & Equipment, EU:T:2011:663; 29/11/2012, C-42/12 P, Alpine Pro Sportswear & Equipment, EU:C:2012:765, appeal dismissed). In the following examples, the marks were considered visually **similar** because they shared some words or sequences of letters and the typeface was deemed not to be highly stylised.

Earlier sign	Contested sign	Case No (level of similarity)
		03/09/2007, R 1454/2005-4; confirmed 18/06/2009, T-418/07, EU:T:2009:208 (average)
		19/04/2016, T-198/14, EU:T:2016:222 (high); confirmed 10/11/2016, C-351/16 P, EU:C:2016:866
		16/01/2014, T-383/12, EU:T:2014:12 (high)

In the following examples, however, the marks were considered visually **dissimilar** in spite of the fact that they shared some words and/or letters and/or figurative devices, because the shared letters were highly stylised and/or placed differently and/or there were additional figurative devices.

Earlier sign	Contested sign	Case No
		11/05/2005, T-390/03, EU:T:2005:170
		23/01/2008, T-106/06, EU:T:2008:14
		05/03/2009, R 1109/2008-1
		02/08/2010, R 111/2010-4

When comparing figurative signs with word elements visually, it is still possible to find visual similarity when the figurative elements are different (i.e. neither match nor have the same or similar contours) and the word elements are different. Similarity will be found when the overall stylisation, structure and colour combination render the signs visually similar overall.

The following example illustrates how similar structure, stylisation and colour combination render signs visually similar.





Earlier sign	Contested sign	Case No (level of similarity)
		29/09/2008, B 1 220 724 (high)

3.4.1.4 Purely figurative marks versus purely figurative marks

When comparing signs in conflict in terms of their **purely figurative elements**, the Office considers the latter as images: if they match in one, separately recognisable,

element or have the same or a similar contour, it is likely that some visual similarity will be found.

The following purely figurative signs were found to be visually **similar**.

Earlier sign	Contested sign	Case No (level of similarity)
		15/03/2012, T-379/08, EU:T:2012:125 (average)
		11/03/2009, B 1 157 769 (medium)






The following purely figurative signs were deemed to be visually **dissimilar**.

Earlier sign	Contested sign	Case No
		11/10/2010, B 1 572 059

3.4.1.5 Figurative marks with word elements versus purely figurative marks

A coincidence in a figurative element that is visually perceived in an identical or similar way may lead to a visual similarity.

The following examples are cases where there are visual similarities because of matching figurative elements.

Earlier sign	Contested sign	Case No (level of similarity)
		14/12/2006, T-81/03, T-82/03 & T-103/03, EU:T:2006:397 (significant)
(i)  (ii) 		17/11/2010, R 144/2010-2 (low)

In the following example the figurative elements were different and the signs were considered visually **dissimilar**.





Earlier sign	Contested sign	Case No
		30/05/2002, B 134 900 The marks were considered visually dissimilar

3.4.1.6 Signs consisting of a single letter




In cases of conflicting signs consisting of the same single letter, the visual comparison is of decisive importance, these signs being phonetically and usually also conceptually identical.



The fact that the conflicting signs comprise the same single letter can lead to a finding of visual similarity between them, depending on the particular way the letters are depicted.


In the following examples, the signs were found to be visually similar **to a high or medium degree**.


Earlier sign	Contested sign	Case No
		13/07/2004, T-115/02, EU:T:2004:234
<p>G&S: Classes 9, 16, 25, 35, 41</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> as regards the visual similarity of the conflicting signs, the Board of Appeal rightly considered that both marks in question include as a dominant element the lower-case white letter 'a', of a commonplace typeface, on a black background. That dominant element makes an immediate impression and is remembered. Conversely, the graphic differences between the trade marks in question — namely the shape of the background (oval for the trade mark applied for and square for the earlier trade mark), the position of the letter on that background (in the centre in the case of the trade mark applied for and in the lower right-hand corner in the case of the earlier trade mark), the thickness of the line used to represent that letter (the trade mark applied for uses a slightly broader line than that used in the earlier trade mark) and the calligraphic details of the letters of the respective marks — are minor and do not constitute elements that will be remembered by the relevant public as effective distinguishing features. Consequently, the conflicting signs are very similar from the visual point of view.</p>		
Earlier sign	Contested sign	Case No
		20/05/2011, R 1508/2010-2
<p>G&S: Classes 9, 18, 24, 25, 28</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> the Board found the signs visually similar to a medium degree.</p>		

In the following cases, the signs were found to be visually similar **to a low degree** (that resulted, depending on a particular case, both in likelihood of confusion and no likelihood of confusion).



Earlier sign	Contested sign	Case No
<p>(i)</p>  <p>(ii)</p> 		<p>10/05/2011, EU:T:2011:202</p> <p>T-187/10,</p>
<p>G&S: Classes 9, 18, 25</p> <p><i>Territory:</i> EU, Italy</p> <p><i>Assessment:</i> The contested sign comprised a stylised letter G and the text 'G Line' in miniscule letters underneath. The signs were found to be similar to a low degree from a visual point of view (likelihood of confusion).</p>		



Earlier sign	Contested sign	Case No
		<p>14/03/2017, T-276/15, EU:T:2017:163</p>
<p>G&S: Class 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> even though the signs can both be perceived as representing the letter 'e', they differ visually in their respective colours, typefaces and the overall impressions they convey (para. 25).</p> <p>The outcome of this case: likelihood of confusion for identical goods and services (this part of the BoA decision was not challenged before the General Court). No likelihood of confusion for the similar and dissimilar goods and services (inter alia, <i>electric energy emanating from wind power; plants for the production of renewable energy; leasing of wind power energy generating facilities</i>) for which the relevant public has a high degree of attention.</p>		

Earlier sign	Contested sign	Case No
A		22/09/2011, T-174/10, EU:T:2011:519 dismissed 10/10/2012, C-611/11 P, EU:C:2012:626
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> on the basis of the particular graphic design of the contested trade mark, the Court only found a low degree of visual and conceptual similarity (para. 31). A phonetic comparison was not possible, as it was found that the public would most likely not pronounce the contested trade mark given the particular graphic design (para. 32). Please note that the outcome in this case was that of no likelihood of confusion, although the Court found low visual similarity between the signs.</p>		

Earlier sign	Contested sign	Case No
F		12/06/2007, R 1418/2006-2
<p>G&S: Class 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> visually, the earlier mark is an upper case letter 'F' written in a standard typeface, whereas the contested mark is a stylised letter 'F', in which the horizontal line is embellished with a distinctive drawing that amounts to a relevant visual difference. The outcome of this case was that of no likelihood of confusion.</p>		

Finally, in the examples below the signs were found to be **visually dissimilar** due to the different stylisations or graphic elements of the single-letter signs. The final outcomes of these cases were those of no likelihood of confusion.

Earlier sign	Contested sign	Case No
		12/12/2007, R 1655/2006-4

Earlier sign	Contested sign	Case No
<p>G&S: Class 25</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> even though the marks share the presence of the letter 'm', they cannot be considered visually similar since the overall visual impression that each mark makes on the relevant public is clearly distinct. The EUTM applied for is a complex graphic device that includes a black lowercase letter 'm' and in addition, other significant figurative elements, namely a bold curved dark line placed above a background circle in which the letter 'm' is almost included. These additional elements are of particular importance since the heavy bold line echoes the form of the background circle and the dark shade of the letter 'm', which is placed over the background. In the earlier mark, the letter 'm' appears in outline font with a characteristic inclination to the right and an uneven height so that the right-hand size of the letter is lower. Consequently, these dissimilarities between the signs are sufficient for it to be held that they do not give the consumer the same visual impression (para. 18).</p>		
Earlier sign	Contested sign	Case No
		04/10/2010, R 576/2010-2; confirmed 24/01/2012, T-593/10, EU:T:2012:25
<p>G&S: Classes 25, 41, 43</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> due to the different colours, figurative element and stylisation, the marks were found to be visually dissimilar. Visually, the earlier mark can be perceived as a boomerang, accompanied by the letter 'B', which is the first letter of 'boomerang'.</p>		

It should be pointed out that the verbal representation of 'one-letter/one-digit sign' is not to be considered equivalent to the sign (e.g. 'ONE' is not equal to '1' or 'EM' to 'M'). Therefore, the aforementioned arguments are not directly applicable to such cases.

Finally, it must be noted that the above considerations also apply to signs consisting of single numbers.

3.4.1.7 Other types of marks

When comparing other types of marks (shape marks, motion marks, etc.), the same basic principles as for word and figurative marks as described above are to be applied.

3.4.2 Phonetic comparison

When the opposition is based on earlier signs that enjoy protection in different EU Member States, in principle, account must be taken of all the different pronunciations of the signs by the relevant public in all official languages of those Member States. Local accents are not taken into account. Nevertheless, as already mentioned, when the earlier mark is an EUTM registration, the analysis must in principle extend to the **whole** EU. However, where there is a likelihood of confusion for a part of the EU **and** it is justifiable for reasons of economy of procedure (such as to avoid examining specific pronunciations or meanings of marks in several languages), the Office's analysis need not extend to the whole EU but may instead focus on only a **part or parts** where there is a likelihood of confusion.

The overall phonetic impression produced by a sign is particularly influenced by the number and sequence of its syllables. The common rhythm and intonation of signs play an important role in how signs are perceived phonetically. The *Collins English Dictionary* defines 'rhythm' as 'the arrangement of words into a more or less regular sequence of stressed and unstressed or long and short syllables'. 'Intonation' is defined as 'the sound pattern of phrases and sentences produced by pitch variation in the voice'.

Therefore, the key elements for determining the overall phonetic impression of a trade mark are the syllables and their particular sequence and stress. The assessment of common syllables is particularly important when comparing marks phonetically, as a similar overall phonetic impression will be determined mostly by those common syllables and their identical or similar combination.

The following are examples of phonetically **dissimilar** marks.

Earlier sign	Contested sign	Relevant territory	Case No
CLENOSAN	ALEOSAN	ES	28/03/2011, R 1669/2010-2
GULAS	MARGULIÑAS	ES	12/04/2011, R 1462/2010-2

The following are examples of phonetically similar/identical marks.

Earlier sign	Contested sign	Relevant territory	Case No (level of similarity)
CAMEA	BALEA	EU	14/01/2015, T-195/13, EU:T:2015:6 (low)
		PT: the part of the relevant public that has some knowledge of the English language will read and pronounce the earlier mark in the same way as the mark applied for insofar as the latter uses the English word 'forever' (para. 70). The marks at issue share the same ending 'ever'; the Board of Appeal did not err in finding that those marks were phonetically similar to an average degree for the part of the relevant public with no knowledge of the English language (para. 72).	16/01/2014, T-528/11, EU:T:2014:10 (identity/average)
FEMARA		EU	12/02/2010, R 722/2008-4 (above average)
	FOR US	BX	16/09/2010, R 166/2010-1 (identity)
		DE	09/06/2010, R 1071/2009-1 (low)





3.4.2.1 Signs and elements in signs that must be assessed


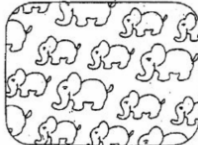
The Office conducts a phonetic comparison when both trade marks can be pronounced or have a sound. Accordingly, a figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. In other words, purely figurative marks (i.e. those not containing any word element) are not subject to a phonetic assessment. The ‘meaning’ that the image evokes, or its ‘description’, will be assessed visually and conceptually.

In this respect, the Office follows the case-law established by the judgments of 07/02/2012, T-424/10, *Éléphants dans un rectangle*, EU:T:2012:58, § 46; 08/10/2014, T-342/12, *Star*, EU:T:2014:858, § 48; 30/09/2015, T-364/13, *KAJMAN / Device of a crocodile et al.*, EU:T:2015:738, § 46; 25/11/2015, T-320/14, *Device of two wavy black lines (fig.) / Device of wavy black link (fig.)*, EU:T:2015:882, § 45-46. The contrary position taken by the Court in the judgment of 07/05/2015, T-599/13, *GELENKGOLD / FORM EINES TIGERS et al.*, EU:T:2015:262, § 65 cannot be considered as a prevailing trend until clarification is given by the Court of Justice.

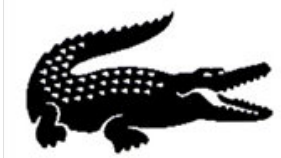

The Office does not undertake an indirect phonetic comparison, based on the description or a meaning attributed to the image by the public, given that in most cases, it is difficult to define which description the public will attribute to a figurative element and that the comparison based on such a description would lead to a subjective and arbitrary outcome. Furthermore, if the phonetic comparison is based on a description of a figurative element or on its meaning, it will only repeat the outcome of the visual or conceptual comparison respectively, where these elements have already been assessed.

The following are examples of where no phonetic comparison could be made because the marks are purely figurative.

Earlier sign	Contested sign	Case No
		25/11/2015, EU:T:2015:882 T-320/14,
		08/10/2014, EU:T:2014:858 T-342/12,

Earlier sign	Contested sign	Case No
		07/02/2012, EU:T:2012:58 T-424/10,

Furthermore, when one of the signs has elements that can be read and the other has only figurative elements, the two signs cannot be phonetically compared directly, as in the following examples.

Earlier sign	Contested sign	Case No
		30/09/2015, EU:T:2015:738 T-364/13,

Earlier sign	Contested sign	Case No
	 (KUNGFU)	17/11/2010, R 144/2010-2

With regard to the pronunciation of figurative elements reminiscent of a letter, it should be noted that the relevant public will tend to read these figurative elements only when they are linked to or form part of a word known to the relevant public, such as in the following examples.

Earlier sign	Contested sign	Case No
OLI SONE		16/04/2010, B 1 269 549
ROCK		13/10/2009, EU:T:2009:398 T-146/08,

In the following case, however, the figurative element will not be recognised and read as 'X' and the contested sign read as 'be light'.

Earlier sign	Contested sign	Case No
BECKs		30/05/2013, EU:T:2013:286 T-172/12,

As a general rule, all word elements (including letters and numbers) are subject to the phonetic comparison. It may be the case, however, that the relevant public refers aurally to a sign by some elements and omits some words/letters.


For example, the relevant public may omit verbal elements that are clearly less prominent than ones that stand out visually, or are otherwise secondary in the overall impression given by the mark.

Furthermore, in its judgment of 03/07/2013, T-206/12, LIBERTE american blend, EU:T:2013:342, the Court found that the public will not pronounce the words 'american blend' due to their **descriptive character**. In its judgment of 03/06/2015, in joined cases T-544/12, PENSA PHARMA, EU:T:2015:355 and T-546/12, pensa, EU:T:2015:355, the Court stated that consumers would not pronounce the word 'pharma', inasmuch as that word was superfluous because of the nature of the goods and services at issue.


Economy of language might be another reason for assuming that some elements will be pronounced while others will be omitted, particularly in case of very long marks (11/01/2013, T-568/11, interdit de me gronder IDMG, EU:T:2013:5, § 44).

Finally, while words, letters and numbers should in principle be assessed phonetically, some symbols and abbreviations give rise to uncertainty.

For example, the logogram '&' (ampersand) will generally be read and pronounced and therefore should be included in the phonetic comparison. However, the pronunciation of a given symbol may differ where different languages are concerned.



Earlier sign	Contested sign	Case No
	DNG	15/09/2010, R 160/2010-2 The ampersand ‘&’ will be pronounced in most European Union languages and is recognised as the corresponding translation of the conjunction ‘and’.



The same goes for the typographic character @, which in principle will be pronounced. Obviously, the pronunciation of a given symbol may differ where different languages are concerned.

Earlier sign	Contested sign	Case No
	VODAFONE AT HOME	30/08/2010, R 138/2010-2 @ will be pronounced as ‘at’ or ‘arobase’ in the Benelux (para. 21).

In the above case, it cannot be denied that a part of the relevant public — in particular English speakers — would read the ‘at’ symbol and thus pronounce the trade mark as ‘at home’. This possibility must, therefore, be taken into consideration, together with other possibilities such as ‘a home’ or simply ‘home’. Naturally, the symbol may be read in a different way in other languages (e.g. ‘arroba’ in Spanish and Portuguese).



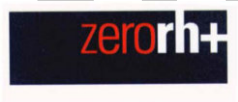
However, compare this with the following examples.

Earlier sign	Contested sign	Case No
		03/02/2011, R 719/2010-1; dismissed 19/09/2012, T-220/11, EU:T:2012:444; dismissed 14/11/2013, C-524/12 P, EU:C:2013:874 The @ will be perceived as the letter ‘a’ by (at least) the EN public (para. 25).

Earlier sign	Contested sign	Case No
		20/07/2016, T-745/14, EU:T:2016:423 The symbol '@' will easily be understood by the consumer as replacing the letter 'a' (para. 26).



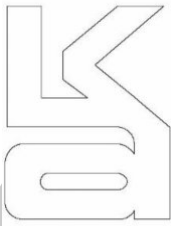


The plus (+) and minus/hyphen (-) symbols may or may not be pronounced by the relevant public, depending on the circumstances. The minus symbol may be pronounced when used in combination with a number, for example, '-1', but it will not be pronounced if used as a hyphen (as in 'G-Star').



In the following examples, the symbol '+' in the contested EUTM application would be pronounced as 'plus'.

Earlier sign	Contested sign	Case No
AirPlus International		03/03/2010, T-321/07, EU:T:2010:64; dismissed 25/11/2010, C-216/10 P, EU:C:2010:719
		16/09/2009, T-400/06, EU:T:2009:331

Currency symbols (€, \$, £, etc.) may also be pronounced when the relevant mark is pronounced. As an example (fictional), in the United Kingdom the sign '£ 20' would be pronounced as '20 pounds'. Therefore, the signs '£ 20', '20 pounds' and 'twenty pounds' are phonetically identical.

However, sometimes the way in which symbols — or letters — are used makes it unrealistic to assume that they will be read and pronounced in a particular way, for example, when in a figurative mark a symbol is repeated in order to create a pattern or is highly distorted or when the letters/numbers are otherwise not clearly legible/identifiable. This is illustrated by the following examples.

Sign	Explanation
	<p>24/01/2012, T-593/10, EU:T:2012:25</p> <p>In this figurative mark, the letter 'B' can be read. The mark must, therefore, be assessed phonetically.</p>
	<p>24/01/2012, T-593/10, EU:T:2012:25</p> <p>In this figurative mark, the letter 'B' is so highly distorted that the Court found that for part of the public it is difficult to clearly identify if it is indeed the letter 'b' or the figure '8'.</p>
	<p>22/06/2011, R 1779/2010-4</p> <p>It is very difficult to determine the pronunciation of the sign. An aural comparison may, therefore, lead to very different results, ranging from identity to dissimilarity.</p>
	<p>28/01/2009, B 1 127 416</p> <p>In this figurative mark the letter 'H' can be read and, therefore, must be assessed phonetically.</p>
	<p>28/01/2009, B 1 127 416</p> <p>In this sign, the pattern makes it unlikely that consumers will read an 'H' (or rather several 'H's). This mark cannot be assessed phonetically.</p>



Sign	Explanation
	16/10/2013, T-282/12, EU:T:2013:533 The Court held that, although hardly legible at first sight, the words 'FREE' and 'STYLE' in both of the signs are pronounced identically regardless of the language of the public.
	30/11/2017, T-475/16, EU:T:2017:856 The General Court held that it was not likely that the public would detect the letter 'y' in the figurative element of the mark. First, there is a great difference between the letter 'y' and the heart symbol. Second, the heart symbol is not usually used to replace the letter 'y'.

In summary, whether or not a given symbol/letter is pronounceable depends on the type of character in question, how it is depicted, and how it is combined with other elements of the sign.

3.4.2.2 Identical/similar sounds in different order

Where the opposing trade marks are formed of syllables or words that are identical or highly similar but in a different order, so that if just one of the syllables or words were rearranged the signs would be identical or highly similar phonetically, the conclusion should be that the signs are phonetically similar.

Examples

Earlier sign	Contested sign	Case No (level of similarity)
VITS4KIDS	Kids Vits	09/12/2009, T-484/08, EU:T:2009:486; dismissed 22/10/2010, C-84/10 P, EU:C:2010:628 (significant)
		11/06/2009, T-67/08, EU:T:2009:198 (high)

3.4.2.3 Signs consisting of or including foreign or invented words

When a sign contains foreign words, it should be assumed in principle that the relevant public is unfamiliar with how foreign native speakers pronounce their own language. Accordingly, the public will tend to pronounce a foreign word in accordance with the phonetic rules of their own language.

Earlier sign	Contested sign	Case No
LIDL	LIFEL	19/10/2010, R 410/2010-1 The first two letters and the last one are the same in both marks. Aurally, the similarity is even stronger because LIDL will often be pronounced as if spelt LIDEL. For phonological reasons, 'D' and 'L' are nearly impossible to pronounce in most languages without inserting a vowel between them. Therefore, the marks would be pronounced LIFEL and LIDEL in languages like French, German, Italian and Spanish.
KAN-OPHTAL PAN-OPHTAL	BAÑOFTAL	12/07/2012, T-346/09, EU:T:2012:368 The relevant territory is Germany. The Court found a phonetic similarity. The German consumer will probably pronounce the letters 'N' and 'Ñ' in the same way. Moreover, the letters 'P' and 'B' are pronounced with both lips and their sound can be confused if they are accompanied by the same vowel; the signs PAN-OPHTAL and BAÑOFTAL are aurally very similar.

GLANZ	GLÄNSA	13/07/2011, T-88/10, EU:T:2011:368 The GC concluded that the umlaut would not alter the overall phonetic impression for EN, ES and FR speakers, since the languages in question do not have the letter 'ä' (para. 40).
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However, this will not be the case when the relevant public is familiar with a word, for example in the following scenarios.

- When it is an established fact that a foreign language is known by the relevant public. For example, the Court has already confirmed that there is at least a basic understanding of the English language by the general public in the Scandinavian countries, the Netherlands and Finland (26/11/2008, T-435/07, New Look, EU:T:2008:534, § 23).
- When certain terminology is clearly known by the relevant public for certain classes of goods and/or services. For example, IT professionals and scientists are generally considered to be more familiar with the use of technical and basic English vocabulary than the average consumer, irrespective of territory (27/11/2007, T-434/05, Activy Media Gateway, EU:T:2007:359, § 38, 48 for the IT field (11/12/2008, C-57/08 P, EU:C:2008:718, dismissed); 09/03/2012, T-207/11, Isense, EU:T:2012:121, § 21-22 for German professionals in the medical field).
- When very basic words will be understood in all Member States, such as the English words 'baby', 'love', 'one', 'surf', the Italian word 'pizza', which has also entered the English language, etc.

Earlier sign	Contested sign	Case No
Babylove Baby Love		08/07/2011, R 883/2010-2

- Finally, when any one of the parties provides compelling evidence that a word is known by a significant portion of the relevant public.

Where a significant part of the relevant public pronounces the foreign word correctly, but another significant part applies the rules of their mother tongue, any assessment of phonetic similarity should mention both pronunciations and provide reasoning.



Earlier sign	Contested sign	Case No
WRITE	RIGHT	(example only)
		English: highly similar aurally
		Spanish: dissimilar aurally
	ZIRH	03/03/2004, T-355/02, EU:T:2004:62; dismissed 23/03/2006, C-206/04 P, EU:C:2006:194 Similar in English-speaking countries and Spain.

As regards **invented or fanciful words** (words that do not correspond to any existing word in the EU), the relevant consumer might pronounce them not only as they would sound according to the rules of pronunciation of their mother tongue but also as they are written.

Earlier sign	Contested sign	Case No
BAMIX	KMIX	21/02/2013, T-444/10, EU:T:2013:89 The GC noted that the word element 'kmix' does not correspond to any existing word in the European Union and that it may be pronounced by part of the relevant public as it is written, as a single syllable. However, it also considered it possible that the mark applied for would be pronounced as a two-syllable word, namely 'ka' and 'mix'. In certain languages of the European Union (in particular French and German), the letter 'k' is pronounced as 'ka' and the pronunciation 'km' is not usual (para. 32).

3.4.2.4 Single letter signs

Marks consisting of a single letter can be compared phonetically. The following marks are phonetically identical insofar as they both reproduce the letter 'A'.

Earlier sign	Contested sign	Case No
		13/07/2004, EU:T:2004:234 T-115/02,

3.4.3 Conceptual comparison: the semantic content of marks

Two signs are identical or similar conceptually when they are perceived as having the same or analogous semantic content (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24). The 'semantic content' of a mark is what it means, what it evokes or, when it is an image or shape, what it represents. In this text the expressions 'semantic content' and 'concept' will be used indiscriminately.

If a mark consists of various elements (e.g. a word and a figurative element) the concept of each of the elements must be defined. However, if the mark is a meaningful expression (made up of two or more words), what matters is the meaning of the expression as a whole and not of each of the words in isolation.

Not every concept has to be defined: only those concepts likely to be known by the relevant public, as defined by the relevant territory, matter. For example, if the relevant territory is Spain, the fact that the word has a meaning in Polish is normally irrelevant.

The conceptual comparison may be influenced by the relevant goods and services. For example, if a term has many meanings, one of which is of particular significance to the relevant goods and services, the conceptual comparison may focus on this meaning. In any event, what matters is how the term is perceived by the relevant public. A link between the goods and services and what the sign means, evokes or represents must not be forced or artificially constructed. For example, if the relevant goods relate to *lighting* and the sign is or contains the element 'LED', 'light-emitting diode' is one of the various possible meanings of 'LED'. Therefore, the conceptual comparison may focus on this meaning.

3.4.3.1 The semantic content of words

When the mark consists of or contains a word, the first step for an examiner is to look up the explanation of that word in dictionaries and/or encyclopaedias in the language(s) of the relevant territory. If the word is in the dictionary/encyclopaedia, the described meaning will be its semantic content.

As a starting point, it should be noted that the relevant public in the various EU Member States mainly speak the languages predominant in their respective territories (23/10/2002, T-6/01, *Matratzen + Matratzenmarkt Concord* (fig.), EU:T:2002:261, § 27). These languages are normally the official languages of the relevant territory.

Earlier sign	Contested sign	Case No
HALLOUMI	HELLIM	13/06/2012, T-534/10, EU:T:2012:292
<p>'Hellim' is the Turkish translation of 'Halloumi' (Greek) (a type of cheese). The relevant territory was Cyprus. The Court held that while Turkish is not an official language of the EU, it is one of the official languages of the Republic of Cyprus. Therefore, Turkish is understood and spoken by part of the population of Cyprus (para. 38).</p> <p>Therefore, the Court found that the average consumer in Cyprus, where both Greek and Turkish are official languages, will understand that the words HALLOUMI or HELLIM both refer to the same specialty cheese from Cyprus. Consequently, there is some conceptual similarity between these words (para. 41).</p>		



However, the Court has made equally clear that this rule only concerns the primary linguistic understanding of the public in those territories. This is not an inflexible rule. The relevant public should not automatically be considered as having as its mother tongue the language that is predominant in the Member State concerned, or to have no particular knowledge of other languages (03/06/2009, C-394/08 P, *Zipcar*, EU:C:2009:334, § 51).

For instance, in the following scenarios, languages other than the predominant one are to be taken into account.

- When the word in another language is very close to the equivalent word in the official language of the relevant territory. For example, the English word 'bicycle' will be understood in Spain because it is very close to the Spanish equivalent word, 'bicicleta'.
- When the word in a foreign language is commonly used in the relevant territory. For example, the Spanish word 'bravo' is commonly used as a term denoting praise, in the sense of 'well done' in Germany.
- When it is known that the relevant public is familiar with a foreign language. For example, the Court has already confirmed that the general public in the Scandinavian countries, the Netherlands and Finland, has at least a basic understanding of the English language (26/11/2008, T-435/07, *New Look*, EU:T:2008:534, § 23).
- When it is known that the relevant public is familiar with a certain language for certain classes of goods and/or services. For example, English IT terms are normally understood by the relevant public for IT goods and services, irrespective of territory.

- Very basic words, which will be understood in all Member States because they have become internationally used, such as ‘baby’, ‘love’, ‘one’, ‘surf’, the Italian word ‘pizza’, which has also entered the English language, etc.
- Finally, when any one of the parties submits evidence that a word is known by a relevant portion of the relevant public.

The following are **examples** of concepts behind words.

Sign	Territory	Concept	Case No
Mirto	ES	[in EN: myrtle] in Spanish describes a shrub of the family <i>Myrtaceae</i> , two to three metres high.	19/03/2010, T-427/07, Mirtillino, EU:T:2010:104
Peer	EN	Lord	08/07/2010, T-30/09, Peerstorm, EU:T:2010:298
Storm	EN	Bad weather	08/07/2010, T-30/09, EU:T:2010:298
 --- STAR SNACKS	EU	The terms ‘star snacks’ and ‘star foods’ will be understood as referring to quality food not only by English speakers, but also by most of the relevant public.	11/05/2010, T-492/08 (Star foods I), EU:T:2010:186 10/10/2012, T-333/11 (Star Foods II), EU:T:2012:536
	EU	There is some degree of conceptual similarity, based on ‘Mc’ and the words ‘baby’ and ‘kids’ that both refer to children (para. 42).	05/07/2012, T-466/09, EU:T:2012:346

As shown in some of the examples above, it is not always necessary to give a complete dictionary definition of what a word means. It is sufficient to use a synonym, such as Peer = Lord or Storm = Bad weather.

Additionally, when part of the public will perceive the concept while another part either will not or will perceive a different meaning, a distinction should be made accordingly.

When the mark conveys a **meaningful expression**, the meaning of the expression as a whole, as long as it is understood as such by the relevant public, and not that of the individual words, is the one that is relevant for the conceptual comparison (however,


note the exception below concerning expressions in foreign languages). Therefore, individual assessment of each element of the mark should be avoided.

Fictional example: 'KING'S DOMAIN' v 'KING SIZE'.

Incorrect assessment: 'KING' means 'a male sovereign', 'DOMAIN' means 'a territory over which rule or control is exercised' and 'SIZE' means 'the physical dimensions, proportions, magnitude, or extent of an object'. The marks are conceptually similar insofar as they share the notion of 'king'.

Correct assessment: 'KING'S DOMAIN' means 'a territory under the control of a king'; 'KING SIZE' means 'larger or longer than the usual or standard size'. The marks are conceptually dissimilar even though they share the word 'KING'.

This is further illustrated by the following example from case law:

Earlier sign	Contested sign	Case No
BLACK TRACK		06/03/2015, T-257/14, EU:T:2015:141
<p>G&S: Class 28</p> <p>Territory: EU</p> <p><i>Assessment:</i> The English-speaking public will perceive the expression 'black jack' as a whole designating a card game and will not perceive the word 'black' independently within that expression. The expression constituting the earlier mark, 'black track', will also be perceived with its distinct meaning. Therefore, it cannot be held that the signs are conceptually similar just because they both contain the word 'black'. The signs are conceptually dissimilar (paras 38-42).</p>		

Furthermore, when the mark is composed of a noun and a qualifying adjective, in general it will be perceived as a conceptual unit and will not be broken down into its constituent elements.

Earlier sign	Contested sign	Case No
EAU PRECIEUSE	NUIT PRECIEUSE	12/09/2018, T-905/16, EU:T:2018:527 (02/05/2019, C-739/18 P, ECLI:EU:C:2019:356, appeal dismissed)

G&S: Class 3

Territory: France

Assessment: The relevant public will clearly perceive the meaning of each of the signs at issue as a complete phrase containing a noun, 'nuit' and 'eau' respectively, with an identical qualifying adjective, namely 'précieuse'. While the first sign refers to the concept of water that is precious, the second refers to the idea of a cherished or esteemed night. Those are different concepts and, regard being had to their obvious meaning, the relevant public will not dissect those signs in order to distinguish each element of them (paras 62-64).

The abovementioned rule on meaningful expression has the following **exception**: when signs are in a foreign language, a significant part of the relevant public may have only a limited command of the relevant foreign language and, therefore, might not be able to distinguish the difference in meaning between two expressions. In these instances it may be that the meaning of an expression as such is not perceived; only the meanings of the individual elements. This may, therefore, lead to a finding of similarity insofar as the public understands only the common part. In the example above, if it is found that (part of the) public will only understand KING, the finding should be that the signs are conceptually similar.

Earlier sign	Contested sign	Case No
ICEBERG	ICEBREAKER	08/09/2010, T-112/09, EU:T:2010:361
<p>The GC considered that 'icebreaker' would be understood only by that part of the Italian public with a command of the English language. However, 'iceberg' is a common word with an immediately obvious meaning to the relevant public. Therefore, the earlier mark ICEBERG will have a clear meaning for the Italian public, whereas the mark applied for ICEBREAKER would be devoid of any clear meaning for that public.</p> <p>The GC further indicated that the marks at issue have the prefix 'ice' in common. The GC considered that this is a basic English word, understandable for most of the relevant public. It concluded that since the prefix 'ice' had a certain evocative force, it must be regarded as limiting the conceptual difference between the marks at issue, acting as a 'semantic bridge' (paras 41-42).</p>		

Similar considerations apply to expressions that include a combination of technical words understood by only part of the relevant public (e.g. Latin words, words belonging to highly specialised language) and commonly used words. In these cases, it may be that only the meaning of the commonly used words is perceived, and not the meaning of the expression as such.

3.4.3.2 The semantic content of parts of words



In this regard, the Court has held that, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, they will break it down into elements which, for them, suggest a specific meaning or which resemble words known to them (13/02/2007, T-256/04, *Respicur*, EU:T:2007:46, § 57).

Consequently, while the rule is that marks are perceived as a whole, the exception to the rule is that, under certain circumstances, consumers could break them down into smaller parts. Since this is an exception, it has to be applied restrictively.

It will be applied in the following cases.

- when a **visual separation** assists in identifying parts with a concept (e.g. through the use of lower- and upper-case letters, the stylisation of letters or the use of a special character separating the elements, such as a symbol, numeral, hyphen or other punctuation mark);
- when, without a visual separation, **all** the parts of the word suggest a concrete meaning known to the relevant public; or
- when, without a visual separation, **one** part of the word has a clear meaning.


i) Examples of signs where a visual separation assists in identifying parts.

Sign	Territory	Concept	Case No
	EU	The use of capital letters allows the sign to be separated immediately into two distinct words, namely 'invest' and 'hedge'.	11/06/2009, T-67/08, EU:T:2009:198, § 35
VITS4KIDS	EU	The mark contains VITS (allusive of 'vitamins') and KIDS.	09/12/2009, T-484/08, EU:T:2009:486
	EU	AGRO: reference to agriculture HUN: reference to Hungary UNI: reference to universal or union.	24/03/2010, T-423/08, EU:T:2010:116

ii) Examples of signs where, despite the absence of a visual separation, the single word can be broken down into parts, **all** of which suggest a concrete meaning known to the relevant public.

Sign	Territory	Concept	Case
Ecoblue	EU	The word element 'eco' is a common prefix or abbreviation in many languages spoken in the European Union, while the word 'blue' is English for the colour blue and part of the basic English vocabulary known to the relevant public.	12/11/2008, T-281/07, EU:T:2008:489; dismissed 22/01/2010, C-23/09 P, EU:C:2010:35
Solfrutta / FRUTISOL	EU	The elements 'sol' and 'frut' are generally recognisable and can be understood as alluding to 'sun' and 'fruit' respectively.	27/01/2010, T-331/08, EU:T:2010:23
RIOJAVINA	EU	The term 'riojavina' in the mark applied for refers directly, so far as the relevant public is concerned, to grapevine products and, more particularly, Rioja wine.	09/06/2010, T-138/09, EU:T:2010:226; Dismissed 24/03/2011, C-388/10 P, EU:C:2011:185

iii) Examples of signs where **one** part of the single word has a clear meaning. These are usually signs that include a common prefix or suffix.

Sign	Territory	Concept	Case No
	DE	'DERMA' may be perceived as referring to goods of a dermatological nature.	03/04/2009, B 1 249 467

RNAiFect	EU	The relevant public, particularly the specialist public, will perceive the first three letters as a reference to the English abbreviation for ribonucleic acid.	28/10/2009, T-80/08, EU:T:2009:416
nfon	EU	The relevant public will isolate the syllable 'fon' in the sign 'nfon', and perceive this term as relating equally to the words 'telephone' or 'phone.' (para. 60).	29/01/2013, T-283/11, EU:T:2013:41; dismissed 16/01/2014, C-193/13 P, EU:C:2014:35

As explained above, all three exceptions have to be construed narrowly; therefore, where it is not obvious that a part or parts suggest(s) a concrete meaning known to the relevant public, a sign should not be artificially dissected. In the examples below, no concept was found in the signs.


Sign	Territory	Concept	Case No
ATOZ	DE, ES, FR, IT, AT	The TM will not be perceived as 'from A to Z'. The letters 'to' (corresponding to an English preposition) do not stand out in any way from the letters 'a' and 'z'.	26/11/2008, T-100/06, EU:T:2008:527; dismissed 16/09/2010, C-559/08 P, EU:C:2010:529
SpagO	BX	The word 'SpagO' is an invented word that has no meaning in any of the official languages of Benelux countries. It should not be perceived as a combination formed by SPA + GO.	12/11/2009, T-438/07, EU:T:2009:434



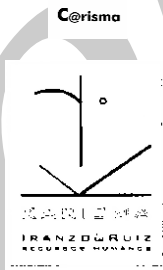
Sign	Territory	Concept	Case No
CITRACAL --- CICATRAL	ES	The word elements 'cica' and 'citra' do not have any concrete meaning, any more than the endings 'tral' and 'cal'. The signs at issue are, therefore, not likely to be broken down by the public into word elements that have a concrete meaning or resemble words known to it and that, together, would form a coherent whole giving a meaning to each of the signs at issue or to any one of them.	11/11/2009, T-277/08, EU:T:2009:433

3.4.3.3 The semantic content of misspelt words

It is not necessary for a word to be written properly for its semantic content to be perceived by the relevant public. For example, while the written word 'XTRA' is visually not the same as the 'correct' word 'EXTRA', because it is aurally identical to it, the concept of the 'correct' word (extra) will normally be transferred to the misspelt word (xtra).

The following examples illustrate this point.

Sign	Territory	Concept	Case
	EU	Part of the relevant public will regard it as a reference to the English word 'store', meaning 'shop, storage'.	21/01/2010, T-309/08, EU:T:2010:22

Sign	Territory	Concept	Case
CMORE	EN	CMORE will, in view of the common practice of sending text messages, probably be associated by a significant part of the general public in Denmark and Finland with an abbreviation or misspelling of the verb 'to see' in English, with the concept being perceived as 'see more'.	23/09/2011, T-501/08, EU:T:2011:527,
	EN	The word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public.	15/04/2010, T-488/07, EU:T:2010:145
	EU	The term contained in the mark will bring to consumers' minds the idea of 'yogurt', i.e. 'a semi-solid, slightly sour, food prepared from milk fermented by added bacteria'.	14/07/2009, B 1 142 688
	ES	The words 'KARISMA' and 'C@RISMA' refer to 'charisma' or 'charism', i.e. a special personal quality or power of an individual, making him or her capable of influencing or inspiring large numbers of people.	28/10/2008, B 1 012 857

Examiners should take care when attaching meaning to a misspelt word: the meaning is not likely to be transferable when the words are not (aurally) identical and/or when the misspelt element cannot be perceived independently.

Sign	Territory	Concept	Case No
Bebimil	EU	The mark applied for does not contain the word 'baby' but a fanciful word, which is further removed and without any clear and specific meaning, i.e. 'bebi'.	16/09/2006, T-221/06, EU:T:2009:330

3.4.3.4 The semantic content of names and surnames

The General Court has accepted that names have a concept. Therefore, a conceptual comparison must be made when conflicting signs are composed of names (see examples below).

Nevertheless, there are few situations where the fact that a trade mark contains a family name has conceptual significance. In particular, conceptual similarity cannot result from the mere fact that both trade marks contain a name, even the same kind of name (Celtic family name, Dutch name, etc.).

Sign	Territory	Concept	Case No
MCKENZIE / McKINLEY	EU	The relevant public recognises the prefix 'Mc', signifying 'son of', as a prefix to many Scottish or Irish family names. That public will, therefore, regard the word elements of the marks at issue as Celtic family names of no conceptual significance, unless the name is particularly well known as that of a famous person.	18/05/2011, T-502/07, EU:T:2011:223

Sign	Territory	Concept	Case No
VANGRACK / VAN GRAF	DE	The fact that both marks may be perceived as lower German or Dutch surnames is on its own neutral for comparison purposes.	12/09/2011, R 1429/2010-4

The mere fact that two names can be grouped under a common generic term of 'names' does not constitute conceptual similarity. For example, if FRANK and MIKE are compared: the fact that both are names would not lead to a finding of conceptual similarity; this is because the public is not likely to make the conceptual link between the two words. By contrast, the fact that FRANK and FRANKIE are the same name but the latter is the diminutive of the former is relevant and should lead to a finding of conceptual similarity.


Sign	Territory	Concept	Case No
SILVIAN HEACH (fig.) / H. EICH	Italy and other territories	Whereas 'HEACH' would be perceived as a surname of Anglo-Saxon origin, the element 'EICH' would be perceived as a surname of German origin (para. 66). In view of this, the consumers would realise that these surnames distinguish different persons. The signs are conceptually different (para. 69).	19/06/2012, T-557/10, EU:T:2012:309

The fact that a trade mark contains a name may have an impact on conceptual comparison in the following situations.

(a) When it is the name/surname of a well-known person (CERVANTES, MARCO POLO, PICASSO)

Sign	Territory	Concept	Case No
PICASSO	EU	The word sign PICASSO has a clear and specific semantic content for the relevant public. The reputation of the painter Pablo Picasso is such that it is not plausible to consider, in the absence of specific evidence to the contrary, that the sign PICASSO as a mark for motor vehicles would, in the perception of the average consumer, override the name of the painter.	22/06/2004, T-185/02, EU:T:2004:189; dismissed 12/01/2006, C-361/04 P, EU:C:2006:25

(b) Where the two marks represent the same name but in different versions (FRANK, with FRANKIE as a diminutive) or languages

Sign	Territory	Concept	Case No
	EU	The relevant public is certain to regard these as highly similar female names derived from the same root. In certain Member States, notably Austria, Germany, Ireland and the United Kingdom, and they will certainly be perceived by the relevant public as diminutives of the full forename Elizabeth.	24/03/2010, T-130/09, EU:T:2010:120
PEPEQUILLO / PEPE	ES	The Spanish public will understand 'Pepequillo' as a diminutive of 'Pepe', leading to conceptual identity.	19/05/2011, T-580/08, EU:T:2011:227

JAMES JONES / JACK JONES	EU	Both trade marks may be understood as referring to the same person.	23/02/2010, T-11/09, EU:T:2010:47
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(c) When both trade marks can be understood as referring to the same person, especially when the earlier trade mark is composed solely of a family name

This could be the case when one name is more important than the other.




Sign	Territory	Concept	Case No
EUTM application: Julián Murúa Entrena Earlier mark: MURUA	ES	The EUTM application contains a Spanish name (a forename and two surnames). The first surname, which for the Spanish public is the more important one, coincides with the earlier trade mark.	13/07/2005, T-40/03, EU:T:2005:285
EUTM application: MANZO DE VELASCO Earlier mark: VELASCO	ES	'Velasco' is a Spanish surname. The EUTM application can be understood as being composed of two surnames.	16/12/2008, T-259/06, EU:T:2008:575
EUTM application: Antonio Basile Earlier mark: BASILE	IT	The signs are conceptually similar in that they share the same surname (para. 60).	28/06/2012, T-133/09, EU:T:2012:327 & T-134/09, EU:T:2012:328

(d) If the name contained in the trade marks is meaningful in some languages, the coincidence in this meaning may lead to conceptual similarity




Sign	Territory	Concept	Case No
peerstorm / PETER STORM	EU, UK	English-speaking consumers will associate the surname 'Storm' with bad weather (para. 67).	08/07/2010, T-30/09, EU:T:2010:298

3.4.3.5 The semantic content of figurative, shape and colour marks

The concepts of marks consisting of or containing figurative elements and marks consisting of shapes (three-dimensional marks) will be what those figurative elements or shapes represent, such as in the following examples.

Sign	Territory	Concept	Case No
	BX, DE, ES, FR, IT, AT, PT	The representation of a red mug on a bed of coffee beans.	25/03/2010, T-5/08 & T-7/08, EU:T:2010:123
	DE	Part of the relevant public may recognise a peacock.	21/04/2010, T-361/08, EU:T:2010:152
	BX	The contested trade mark will be described as a businessman playing football.	02/12/2009, R 403/2009-2


Consequently, when a mark has both words and images, all concepts have to be assessed.

Sign	Territory	Concepts	Case No
	EN	<p>The word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public.</p> <p>A bulldog with a citrus fruit in front of it.</p>	15/04/2010, T-488/07, EU:T:2010:145
	EU	<p>The term 'Rioja' in the earlier mark, which is itself conceptually strengthened by the representation of a bunch of grapes and a vine leaf, refers directly to grapevine products and, more particularly, to Rioja wine.</p>	09/06/2010, T-138/09, EU:T:2010:226; dismissed 24/03/2011, C-388/10 P, EU:C:2011:185
	BL, BX, CY, DE, ES, FR, HU, RO, SK, IT	<p>The mark depicts a type of fish (a shark).</p> <p>The majority of the relevant language speakers will understand the term SPAIN in the contested mark as referring to that country.</p> <p>The word 'Tiburón' means 'shark' in Spanish but will not be understood by the rest of the relevant public.</p> <p>The remaining term, SHARK, will probably be understood by English-speaking consumers in the relevant territories.</p>	29/09/2008, B 1 220 724

Finally, the semantic content (concept) of colour marks per se is that of the colour they reproduce.


3.4.3.6 The semantic content of numbers and letters



The concept of a word representing a number is the figure it identifies, such as in the examples below.

Sign	Territory	Meaning	Case No
	DE	The word zero evokes the cardinal number 0.	16/09/2009, T-400/06, EU:T:2009:331
TV2000 (fig.)/TV1000	LT	The signs are conceptually similar to the extent that they both share the idea of 'television' combined with a round four-digit number, that furthermore correlate in the order of thousands (para. 47).	19/10/2012, R 2407/2011-2
7 (fig.)/7 (fig.)	EU	The BoA found that '7' had a meaning (para. 25).	14/02/2012, R 782/2011-2

The concept of a figure is the number it identifies, unless it suggests another concept such as a specific year.

The Office follows the approach that single letters can have an independent conceptual meaning. The Court has confirmed this approach (08/05/2012, T-101/11, G, EU:T:2012:223, § 56; 21/03/2013, C-341/12 P, G, EU:C:2013:206, appeal dismissed), finding conceptual identity where both trade marks can be seen as the same letter.



Sign	Territory	Meaning	Case No
	DE	For the part of the relevant public that interprets the signs as the letter 'e' and the part of the relevant public that interprets them as the letter 'c', the signs are conceptually identical (para. 99).	10/11/2011, T-22/10, EU:T:2011:651

Sign	Territory	Meaning	Case No
 <small>GI Line</small> /  et al.	EU	The signs were considered conceptually identical (paras 60-61).	10/05/2011, T-187/10, EU:T:2011:202

3.4.3.7 The semantic content of geographical names

The names of cities, villages, regions and other geographic areas evoke a concept that may be relevant for conceptual comparison if it is likely that the relevant public will recognise them as such. Usually, the general public in the European Union is familiar with the names of capitals and bigger cities as well as holiday or travel destinations. If the perception of the public in a particular Member State is relevant, knowledge of the names of small cities and towns in that country can also be assumed.

A lack of evidence or indication that the relevant public recognises the geographical name does not influence the conceptual comparison, as in the following example.

Sign	Territory	Concept	Case No
 v 	DE	The result of conceptual comparison is neutral. It is not possible to infer from the appellant's argument that the name 'Chtoura' designates an agricultural area in Lebanon renowned for its agricultural products that this meaning will also be familiar to trade circles in Germany.	08/05/2010, R 1213/2008-4

3.4.3.8 The semantic content of onomatopoeias

The analysis of the semantic content of onomatopoeias follows the general rules for conceptual comparison: their concept will be that depicted by the onomatopoeia in

question, provided it can be established that it will be recognised as such by the relevant public. For instance, 'WOOF WOOF' represents the bark of a dog for English speakers; 'MUUU' represents the mooing of a cow for Spanish speakers.

Sign	Territory	Concept	Case No
CLICK	DE	Conceptually, the contested mark 'CLICK' is an English onomatopoeia that expresses a short, sharp sound. This word will be readily understood in Germany given its close equivalent in German, 'Klick' (para. 45).	28/01/2008, R 1394/2006-2

In some cases, the context in which the onomatopoeia will be used can be decisive for establishing whether the relevant public will recognise its meaning. For instance, in the following case, the Board considered that the relevant public would not interpret the sign 'PSS' as onomatopoeia in the context of information technology services.

Sign	Territory	Concept	Case No
PSS	ES	The applicant's argument that the earlier mark could also be pronounced as an onomatopoeia [prompting another to be quiet] is far-fetched in view of the relevant information technology services at issue and the relevant public, who is accustomed, as noted by the applicant itself, to acronyms in this field (para. 42).	15/09/2008, R 1433/2007-2

3.4.4 How to make a conceptual comparison

In essence, when making a conceptual comparison, first it has to be determined if the signs have a concept in accordance with the principles described in the previous paragraph.

- If both signs have a concept, the conceptual comparison can lead to three possible outcomes.
- If the signs as a whole refer to the same concept, they are conceptually identical.
- If the signs refer to similar concepts, they are conceptually **similar**.
- If both signs have a meaning and those refer to different concepts, they are conceptually **dissimilar/not similar**.
- If only one of the signs evokes a concept, the signs are **not conceptually similar**.

On this point, the Office follows the judgment of 12/01/2006, C-361/04 P, Picaro, EU:C:2006:25. Although there is some case-law, such as the judgment of 22/10/2015, T-309/13, ELMA / ELMEX, EU:T:2015:792, which came to the conclusion that ‘it was not possible to make a conceptual comparison’, even though only one of the signs evoked a concept, these cases cannot be considered as a prevailing trend.

It follows that the term ‘**not similar**’ encompasses two scenarios, namely, when both signs have a concept albeit distinct or when only one of them has a concept. However the term ‘**dissimilar**’ is reserved only for the case where both signs have a concept albeit distinct.

- If neither sign has any concept, a conceptual **comparison is not possible** (13/05/2015, T-169/14, Koragel / CHORAGON, EU:T:2015:280, § 68-69). The conceptual aspect does not influence the assessment of the similarity of the signs.

The signs cannot be considered conceptually similar on the sole ground that a generic term covering both of them exists and/or they fall under the same general category of signs. If the semantic meanings are too different, the signs may share a general concept, but one so broad that the conceptual relationship is not relevant, as in the following examples.

- The mere fact that the two words or symbols can be **grouped under a common generic term** by no means constitutes a case of conceptual similarity. For example, in the case of ‘Jaguar’ v ‘Elephant’, the fact that both are animals would not lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words. In fact, because the words refer to different animals, they should be considered conceptually dissimilar.
- The same happens when two signs belong to the **same general category or type of mark**: the fact that ‘TDL’ and ‘LNF’ are both three-letter abbreviations is conceptually irrelevant and therefore, a conceptual comparison is not possible.
- Another example of signs ‘belonging to the same category’ concerns **names** and surnames that have a similar semantic content (see paragraph 3.4.3.4 above). If FRANK and MIKE are compared, the fact that they are both names is conceptually irrelevant (since they are on completely different levels); by contrast, the fact that

FRANK and FRANKIE are the same name but the latter is the diminutive of the former is relevant and should lead to a finding of conceptual similarity in that case.

In particular, the marks will be conceptually identical or similar in the following situations.





3.4.4.1 Both marks share a word and/or expression


When the two marks share the same word or expression, the marks will be conceptually similar, as in the following examples.

Earlier sign	Contested sign	Opposition No
		17/06/2009, B 1 209 618 (ES)
Similar: the marks share the concept of SOL (= sun: 'the star that is the source of light and heat for the planets in the solar system').		
Earlier sign	Contested sign	Case No
BLUE	ECOBUE	12/11/2008, T-281/07, EU:T:2008:489; (dismissed 22/01/2010, C-23/09 P, EU:C:2010:35 (EU)
The marks at issue are conceptually similar because they both refer to the colour blue.		
Earlier sign	Contested sign	Opposition No
T-MUSIC		B 1 081 167 (EU)
The marks above are conceptually similar because both refer to the concept of MUSIC (= 'the art of arranging sounds in time so as to produce a continuous, unified, and evocative composition, as through melody, harmony, rhythm, and timbre').		
Earlier sign	Contested sign	Opposition No
		29/09/2008, B 1 220 724 (BL, BX, CY, CZ, DE, ES, FR, HU, RO, SK and IT)

Earlier sign	Contested sign	Opposition No
The marks above are conceptually similar because both signs have an image of the same fish (a shark) and a reference to the word SHARK (= 'any of numerous chiefly marine carnivorous fishes of the class <i>Chondrichthyes</i> (subclass <i>Elasmobranchii</i>) ...').		
Earlier sign	Contested sign	Case No
EL CASTILLO	CASTILLO	04/11/2003, T-85/02, EU:T:2003:288 (ES)
The Court found that the signs were almost identical conceptually.		
Earlier sign	Contested sign	Case No
Servus et al.	SERVO SUO	29/02/2012, T-525/10, EU:T:2012:96 (EU, IT in particular)
The signs are conceptually similar from the point of view of the average Italian consumer insofar as both signs share a reference to 'servant'. The Court confirmed the BoA finding that the Italian public was likely to perceive the meaning of the Latin word 'SERVUS', given its proximity to the Italian word 'SERVO'.		

As already mentioned, misspellings may also have a semantic content and in such cases can be compared, as in the following examples.


Earlier sign	Contested sign	Case No
		14/09/2011, T-485/07, EU:T:2011:467 (ES)
For the relevant Spanish public, both signs invoke the concept of an olive. There is no evidence that the relevant Spanish consumer will understand the English word 'live'.		
Earlier sign	Contested sign	Opposition No
		14/07/2009 B 1 142 688 (EU)
Both marks refer to the word yogurt and consequently share the concept of 'a dairy product produced by bacterial fermentation of milk'.		

Earlier sign	Contested sign	Case No
Earlier sign	Contested sign	Opposition No
	C@risma	28/10/2008, B 1 012 857 (ES)
The above marks are conceptually similar because they both refer to the concept of 'charisma' (= 'the ability to develop or inspire in others an ideological commitment to a particular point of view').		


3.4.4.2 Two words or terms have the same meaning but in different languages

It is possible for the relevant public to assign a conceptual similarity or even identity in cases of marks with elements in different languages, as long as the meanings of the words in those languages are known to that public.

In the following example, it was found that the marks were conceptually identical because a substantial part of the Portuguese public would understand the words constituting the marks at issue given (i) the close proximity of the English word 'vitamin' to the Portuguese equivalent term 'vitamina', (ii) 'water' is a basic English word likely to be understood by that part of the Portuguese public that has sufficient knowledge of the English language, (iii) that 'aqua' is a widespread Latin expression and resembles the Portuguese equivalent term 'água' (paras 56-60).

Earlier sign	Contested sign	Case No
VITAMINWATER (relevant territory Portugal)		28/11/2013, T-410/12, EU:T:2013:615


As it is the actual understanding of the relevant public that matters, the mere fact that one term is objectively the foreign-language equivalent of the other may not be relevant at all in the conceptual comparison.

Earlier sign	Contested sign	Case No
	LE LANCIER	26/09/2012, T-265/09, EU:T:2012:472
The relevant territory is Spain. 'El lancero' (in Spanish) means 'le lancier' in French. Conceptually, the GC concluded that the average Spaniard only had a limited knowledge of French and that the expression 'le lancier' did not belong to the basic vocabulary of that language. Conceptually, the signs are not similar.		

3.4.4.3 Two words refer to the same semantic term or variations thereof

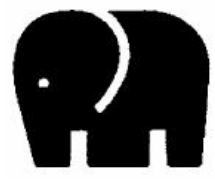
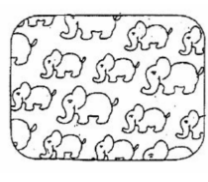
There is conceptual identity where synonyms are involved, that is to say where two words exist for the same semantic meaning (invented examples where English is the reference language: baggage/luggage; bicycle/bike; male horse/stallion).





Conceptual similarity was found in the following cases.

Earlier sign	Contested sign	Case No
SECRET PLEASURES	PRIVATE PLEASURES	15/06/2000, R 616/1999-1
	ORPHAN INTERNATIONAL	14/06/2010, R 1142/2009-2

3.4.4.4 Two purely figurative marks represent the same or a similar concept

When two purely figurative marks represent the same or a similar concept, the signs will be conceptually identical or similar.

Earlier sign	Contested sign	Case No
		07/02/2012, T-424/10, EU:T:2012:58 (identity)



Earlier sign	Contested sign	Case No
		12/04/2012, R 703/2011-2 (identity)
		17/06/2011, R 1107/2010-2 (identity)

3.4.4.5 When there is a word versus a figurative, shape or colour mark representing the concept behind the word

Conceptual identity also exists between a word and an image showing what the word represents (fictional examples: word mark 'TIGER' compared with a figurative mark depicting a tiger; or word mark 'orange' and a mark for the colour orange per se).

3.4.4.6 When both marks have figurative elements with the same or an analogous concept, one or both accompanied by verbal elements



If each of the signs has a non-negligible figurative element with an independently identifiable concept, and these concepts are the same (identical) or analogous (similar), the signs as a whole are conceptually similar. The degree of similarity depends on various factors, such as whether the concepts are identical or similar, whether the verbal elements reinforce the concept of the figurative elements or rather introduce different concepts, whether the verbal elements appear in both signs or in only one, and the distinctiveness of the common concept.

Earlier sign	Contested sign	Case No
		16/10/2018, T-548/17, EU:T:2018:686
<p>G&S: Classes 14, 18, 25</p> <p>Territory: EU</p> <p>Assessment: Notwithstanding the verbal elements that have no meaning, both marks represent a monkey that results in conceptual similarity for the signs taken as a whole (paras 46-49).</p>		

Earlier sign	Contested sign	Case No
Earlier sign	Contested sign	Case No
		27/02/2002, R 68/2001-4 & R 285/2001-4
<p>G&S: Classes 18, 24, 25, 28</p> <p><i>Territory:</i> Benelux, Germany, Spain, France, Italy, Austria</p> <p><i>Assessment:</i> the wording 'La Maison de la Fausse Fourrure' is not sufficient to reduce the impression of similarity between the conflicting marks. In addition to its possibly descriptive nature, the wording, compared with the footprint device, occupies a secondary position (it is placed under the device), is of a relatively limited size (four times smaller) and is in a conventional writing style (para. 22).</p>		

Signs with figurative elements corresponding to the meaning of the verbal elements

The concept inherent in the figurative element may be reinforced by the verbal part in defining a particular **concept** and may even help with the understanding of words that, in principle, might not be widely known to consumers. This strengthens the conceptual similarity.

Earlier sign	Contested sign	Case No	
		17/04/2008, T-389/03, EU:T:2008:114	
<p>G&S: Classes 1, 2, 17</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> As regards the earlier trade marks, it must be held that the word element 'Pelikan' will be understood by consumers as a direct reference to the figurative element. Each of those two elements, appearing side by side, reinforces the other, so that consumers more easily understand one because of the other. Taken together, the two elements clearly call to mind the idea of a pelican. The signs are conceptually identical (paras 90-91).</p>			
Earlier sign	Contested sign	Case No	
		30/09/2015, T-364/13, EU:T:2015:738	

Earlier sign	Contested sign	Case No
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The verbal element in the contested mark will be understood as a direct reference to the figurative element at least in Member States where the word 'kajman' or its close linguistic variation exists. Since the marks at issue are perceived as representing a reptile of the crocodilian order, they have analogous semantic content and are thus conceptually similar to at least an average degree (paras 47, 48, 53).</p>		
Earlier sign	Contested sign	Case No
		20/10/2011, T-238/10, EU:T:2011:613
<p>G&S: Class 18</p> <p><i>Territory:</i> Portugal</p> <p><i>Assessment:</i> Even assuming that some consumers might wonder for a moment whether the figurative element depicts a horse in the contested mark, any possible confusion is removed by the word element 'horse', which will be understood as such by the majority of the Portuguese public. The word and figurative elements reinforce each other, with the result that consumers will more easily understand one because of the other. As both marks will evoke the same concept of a horse, they are conceptually identical (paras 30, 39).</p>		
Earlier sign	Contested signs	Case No
		<p>14/12/2006,</p> <p>T-81/03, T-82/03 & T-103/03,</p> <p>EU:T:2006:397</p>

Earlier sign	Contested sign	Case No	
<p>G&S: Classes 32, 33</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The Spanish public will perceive the term 'venado' (meaning 'deer') not independently, but as a direct reference to the figurative element in the contested marks. The marks are conceptually similar (para. 100).</p>			

3.4.4.7 When the signs have a meaningful word in common that is distinctive, and one of them contains an additional word or figurative element without any meaning

Where the signs have a meaningful word in common that is distinctive, and one or both of them contains an additional word element without any meaning (a fanciful word or one that will not be understood in the relevant language area), the signs are considered conceptually highly similar, and not identical. In such a case, even if not understood, the relevant public will note the presence of the additional term that prevents the signs from being perceived as conceptually totally identical.

Earlier sign	Contested sign	Case No
VIKING	VIKING PRUX	Invented example
VIKING DREMBL	VIKING PRUX	Invented example
<p>The relevant territory is the European Union. The goods at issue are <i>cosmetics</i> in Class 3. The word 'VIKING' is understood throughout the European Union and is distinctive for the goods at issue. The words 'PRUX' and 'DREMBL' have no meaning. The signs are conceptually highly similar.</p>		

However, where the word that the signs have in common is accompanied by additional figurative elements that lack any particular concept (such as a background, colours or a particular typeface), the signs are considered conceptually identical. In such a case, the additional figurative elements have no impact on the conceptual perception of the signs.

Earlier sign	Contested sign	Case No
		Invented example

Earlier sign	Contested sign	Case No
The relevant territory is the European Union. The goods at issue are <i>cosmetics</i> in Class 3. The word 'VIKING' is understood throughout the European Union and is distinctive for the goods at issue. The additional figurative elements do not introduce any concept capable of altering the conceptual perception of the signs. The signs are conceptually identical.		

3.4.5 Impact of the distinctive and dominant character of the components on the similarity of signs

At each level (visual, phonetic and conceptual) the comparison of signs will lead to a decision as to whether the marks are similar and if so, to what degree. In general, the more elements in common, the higher the degree of similarity.

However, this finding depends, first, on whether the element they have in common is recognisable or rather remains unnoticed in the overall impression of both marks (paragraph 3.4.5.1 below), and furthermore, on the distinctiveness and dominant character of the common elements (paragraph 3.4.5.2 below), as well as on the impact of the remaining elements in the overall impression of the marks (paragraph 3.4.5.3 below).

3.4.5.1 Identifiable common element



Two marks are similar when, from the point of view of the relevant public, they are at least partly identical as regards one or more relevant aspects (23/10/2002, T-6/01, *Matratzen + Matratzenmarkt Concord* (fig.), EU:T:2002:261, § 30). The element they have in common must therefore be 'relevant' from the perspective of the consumer, who usually perceives a mark as a whole and does not proceed to analyse its various details (13/02/2008, T-146/06, *Aturion*, EU:T:2008:33, § 58).

The element in common can be clearly identified when it appears **independently** in each sign.

Earlier sign	Contested sign	Reason	Case No
BEYOND VINTAGE	BEYOND RETRO	Coinciding first word.	30/04/2014, T-170/12, EU:T:2014:238
SCHUHPARK	JELLO SCHUHPARK	The earlier trade mark is identical to the second word of the EUTM application.	08/03/2005, T-32/03, EU:T:2005:82

The element in common may also be identified as a **part of** a single word where a **visual** separation allows it to be perceived independently (e.g. through the use of

lower- and upper-case letters, the stylisation of letters or the use of a special character, such as a symbol, numeral, hyphen or other punctuation mark).

Earlier sign	Contested sign	Reason	Case No
ip_law@mbp	MBP	The earlier mark is composed of the elements 'ip-law' and 'mbp' separated by the '@' symbol, so that the marks have the element 'mbp' in common (para. 53).	16/09/2013, T-338/09, EU:T:2013:447
MAXX		The use of upper-case and lower-case letters and different colour shades immediately allows separate identification of the elements 'Nara' and 'Maxx', notwithstanding that neither of them has any meaning for the relevant Bulgarian public.	22/09/2017, T-586/15, EU:T:2017:643, § 37, 46
		The letters 'FET' have an independent role in the EUTM application due to the colour red (para. 48).	14/05/2013, T-19/12, EU:T:2013:242
TRONIC		The common element 'TRONIC' is separated visually in the contested mark by its white lettering (para. 38).	12/05/2016, T-775/14, EU:T:2016:293

Furthermore, the element in common may also be identified as a **part of** a single word where a clear **conceptual meaning** allows it to be perceived independently (see also paragraph 3.4.3.2 above).

Earlier sign	Contested sign	Reason	Case No
MARINE BLEU	BLUMARINE	The part 'marine' in the EUTM application will be understood as a reference to the sea and 'blu' as a misspelling of 'blue'.	14/05/2014, T-160/12, EU:T:2014:252
CADENACOR	COR	The Spanish-speaking public will be able to identify the element 'cor' separately within the earlier mark because the initial element 'cadena' suggests a concrete meaning (chain) to it (para. 47) — likelihood of confusion.	20/10/2011, T-214/09, EU:T:2011:612
BLUE	ECOBLEUE	The relevant public will split the EUTM application into the commonly used prefix 'eco' and the word 'blue' (para. 30) — likelihood of confusion.	12/11/2008, T-281/07, EU:T:2008:489; confirmed 22/01/2010, C-23/09 P, EU:C:2010:35

On the contrary, if it remains unnoticed, the mere coincidence in a string of letters is not enough for a finding of similarity. The rule remains that the public compares the marks as a whole and will not artificially dissect them. In the following cases **the similarity of the marks was denied** despite an overlap in some letters (see also paragraph 4 below, especially paragraph 4.2.4).

Earlier sign	Contested sign	Reason	Case No
CS	CScreen	The contested sign will probably be broken down into the elements 'C' and 'Screen', which has a meaning highly relevant for computers and their peripherals. It will not be perceived as containing the separate entity 'CS' corresponding to the earlier mark.	18/08/2010, R 545/2009-4

3.4.5.2 Distinctiveness and dominant character of the common elements



For the conclusion of similarity, the **degree of distinctiveness of the common element** (or elements) must be taken into account. The more distinctive the common element is, the higher the degree of similarity in each aspect of the comparison (visual, phonetic and conceptual). A finding that the common element has a limited distinctiveness will lower the similarity, with the consequence that if the only common element of both marks is non-distinctive, the degree of similarity at all levels of comparison will be low or that even — depending on the impact of the elements that differentiate the marks — the similarity will be entirely denied (see paragraph 4.2.5 below).


In the following examples, the common element was considered descriptive or otherwise non-distinctive, with the consequence that the level of similarity was considered low.

Earlier sign	Contested sign	Case No
FSA K-FORCE	FORCE-X	04/03/2015, T-558/13, EU:T:2015:135
The element 'force' has a weak distinctive character for the goods concerned. Low visual, phonetic and conceptual similarity — no likelihood of confusion.		

Earlier sign	Contested sign	Case No
ACTU+	News+	12/12/2014, T-591/13, EU:T:2014:1074
The presence of the '+' sign in both signs cannot generate a visual similarity as this is a mathematical symbol that implies a concept of increase, so it only enjoys a weak distinctive character (para. 29). The signs share a weak similarity on the phonetic side because of the presence of the '+' sign (paras 35-36) — no likelihood of confusion.		

Earlier sign	Contested sign	Case No
VISCOPLEX	VISCOTECH	19/11/2014, T-138/13, EU:T:2014:973
As regards the common initial part of the marks 'visco', it is descriptive for the German public with relation to one of the main characteristics of the relevant goods (oils, greases and fuels), namely its viscosity (para. 57). The marks are only vaguely similar visually and phonetically — no likelihood of confusion.		

Earlier sign	Contested sign	Case No
		22/05/2012, T-60/11, EU:T:2012:252
The word premium is laudatory (para. 44). The coincidence leads only to a low visual and phonetic and an average conceptual similarity — no likelihood of confusion.		

Earlier sign	Contested sign	Case No
	ULTIMATE GREENS	18/09/2013, R 1462/2012-G
The word 'ultimate' is a promotional word used to indicate the superior quality of the latest goods available on the market and, has no distinctive character at all (para. 22). Even if both trade marks share this element, there is only a low visual and phonetic similarity (paras 47-48). No conceptual similarity overall (para. 49) — no likelihood of confusion.		

The fact that the coinciding element is a non-distinctive element, does not however, suffice to deny any similarity between the marks, unless there are further factors differentiating them (see paragraph 4.2.5 below). If the public will notice the overlap, it must be taken into account in the comparison. The fact that an element is descriptive or otherwise non-distinctive is not on its own sufficient to conclude that that word is negligible in the overall impression produced by that mark (08/02/2011, T-194/09, *Líneas aéreas del Mediterráneo*, EU:T:2011:34, § 30).

(For the impact of common weak or non-distinctive components on likelihood of confusion see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment).

The conclusion on similarity also has to take into account **whether the common element is dominant** (visually outstanding) or **at least codominant** in the overall impression of the marks. As explained previously (see paragraph 3.3 above), within the assessment of the dominant character of one or more components, the intrinsic qualities (size, striking graphical representation, etc.) of each of those components have to be compared with the intrinsic qualities of the other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the composite mark (08/06/2017, T-341/13 *RENV, So'bio etic (fig.) / SO...? et al.*, EU:T:2017:381, § 40 and 44-56; confirmed by 28/02/2019, C-505/17 P, *So'bio etic (fig.) / SO...? et al.*, § 39-53).

The distinctiveness and dominant character of the common element(s) are separate but related terms. According to the Court:

It should also be noted that where some elements of a trade mark are descriptive or non-distinctive, they are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them.



(31/01/2013, T-54/12, *Sport*, EU:T:2013:50, § 24 and the case-law cited).

3.4.5.3 Importance of additional (not common) elements


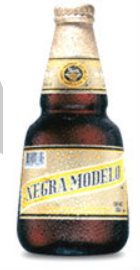
Within the comparison of trade marks as a whole, the impact of the non-common elements in their overall impression also has to be taken into account in order to reach a conclusion on similarity. The more differences the remaining elements of the marks present, the lower would be the similarity resulting from the common element.

It cannot be generally assumed that the elements of difference between the marks would tend to become less marked in the consumer's memory in favour of the elements of similarity. In accordance with settled case-law, the extent of the similarity or difference between the signs at issue may depend, in particular, on the inherent qualities of the signs (13/05/2015, T-169/14, *Koragel / CHORAGON*, EU:T:2015:280, § 84).

The distinctiveness and dominant character of the differentiating elements has to be, therefore, taken into account. If these elements are the distinctive ones and dominate the overall impression of the marks, the level of similarity will decrease.

Earlier sign	Contested sign	Case No
		18/06/2013, T-338/12, EU:T:2013:327
As regards the visual comparison, the figurative element representing a dog in the earlier mark constitutes the dominant one. Given that the respective graphic elements are different, the coincidence in the word element 'K9' leads to a visual similarity only to a low degree. The marks are phonetically similar to a high degree. As to the conceptual comparison, the contested mark does not contain any figurative element conveying the concept of a dog, the marks are not conceptually similar (paras 27-34).		

On the contrary, if the element in which the marks differ is of less inherent distinctiveness than the common element, this will increase the level of similarity.


Earlier sign	Contested sign	Case No
	 (NEGRA MODELO)	06/03/2002, R 536/2001-3; confirmed 15/02/2005, T-169/02, EU:T:2005:46
The earlier trade mark was a Portuguese registration. 'Negra' is descriptive for the relevant goods in Class 33, since it may be used in Portuguese to designate brown beer, i.e. the type of beer sold under the trade mark NEGRA MODELO. The attention of the average Portuguese consumer will be focused on the coinciding word 'modelo'. Low visual, average phonetic and strong conceptual similarity — likelihood of confusion.		

3.4.6 Other principles to be taken into account in the comparison of signs

3.4.6.1 The impact of the verbal element in the case of composite marks

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 19/12/2011, R 233/2011-4, BEST TONE (fig.) / BETSTONE, § 24; 13/12/2011, R 53/2011-5, JUMBO (fig.) / DEVICE OF AN ELEPHANT (fig.), § 59).

However, the verbal element of a sign does not automatically have a stronger impact (31/01/2013, T-54/12, Sport, EU:T:2013:50, § 40) and in certain cases, the figurative element of a composite mark may, owing to, inter alia, its shape, size, colour or position within the sign, rank equally with the word element (23/11/2010, T-35/08, Artesa Napa Valley, EU:T:2010:476, § 37). Below are some examples of such a scenario:

Earlier sign	Contested sign	Case No
GIOVANNI	 GIOVANNI GALLI	03/06/2015, T-559/13, EU:T:2015:353
<p>G&S: Class 3</p> <p>Territory: EU</p> <p><i>Assessment:</i> The figurative element of the mark applied for is as important as the word elements and has a significant impact on the overall visual impression given by that mark. It is positioned above the word elements and occupies more space than both of those elements combined. Furthermore, it is distinctive for the goods at hand, as a duck has no connection with cosmetic or cleaning preparations. In addition, the drawing of the duck is quite elaborate. Even if the element 'GIOVANNI' is placed before the element 'GALLI', there is only a low degree of visual similarity between the marks at issue, in view of the significant impact of the figurative element of the mark applied for on the overall impression given by that mark (paras 62-64, 72, 74).</p>		

Earlier sign	Contested sign	Case No
		<p>12/11/2015, EU:T:2015:839</p> <p>T-449/13,</p>
<p>G&S: Classes 32 and 33</p> <p><i>Territory:</i> Poland</p> <p><i>Assessment:</i> the figurative element of the mark applied for, consisting of the stylised representation of a bovine animal viewed in profile looking to the left and which may be perceived as a European bison, is of a similar size to that of the verbal element 'wisent' and occupies a comparable space in that mark. As a result of its shape, its size, its colour and its position, that representation of a bison [...] helps clearly to establish the image of the contested mark which the relevant public will retain in their mind, with the result that it cannot be discounted in the perception of that mark [...].</p> <p>As regards the earlier mark, a naturalistic representation of a bison standing on four legs in a circle against a background of trees, coloured green, brown and black, is clearly perceptible in that mark. That representation of a bison occupies a central position and is of a slightly larger size than the only perceptible verbal element, the term 'Żubrówka', represented in yellow and black and placed above that representation. Therefore the figurative element consisting of a naturalistic representation of a bison cannot be discounted in the overall impression created by the earlier mark [...]. Despite the presence of different verbal elements, as a whole the marks are visually similar to a low degree given the fact that they both contain a bison, the image of which will easily be retained by consumers in their memory as a result of their position within the marks at issue and their size (paras 76-77, 82, 85-86, 111, 113).</p>		

3.4.6.2 Beginning of the signs in the visual and phonetic comparison

In word signs or in signs containing a verbal element, the first part is generally the one that primarily catches the consumer's attention and, therefore, will be remembered more clearly than the rest of the sign. This means that in general the beginning of a sign has a significant influence on the general impression made by the mark

(15/12/2009, T-412/08, Trubion, EU:T:2009:507, § 40; 25/03/2009, T-109/07, Spa Therapy, EU:T:2009:81, § 30).

Nevertheless, the concept ‘beginning of the sign’ is undetermined, as there is no particular indication of what forms the beginning, what is the end or even if there is or is not a middle part of the sign. Again, this perception mostly depends on the circumstances of the case (length of sign, syllabic distribution, use of typeface, etc.) and not on a set rule. It could even be that a sign is perceived as having a short beginning and ending and a proportionally much larger middle or central part. Consequently, depending on the circumstances, the rule of the relevance of the beginning of the sign could have less weight to the benefit of a more relevant central part.

As it is usually the beginning of a sign that catches consumers’ attention, where signs only differ in their endings, this difference is often insufficient to exclude similarity. However, this is not a fixed rule and the outcome depends on the circumstances of the case. Moreover, this rule only applies when the sign contains a verbal element (which would explain reading from left to right) and when this verbal element is not very short (otherwise the sign will be perceived immediately in its entirety). The Office considers signs consisting of three or fewer letters/numbers as very short signs (see in more detail paragraph 3.4.6.3 below).

In principle, coincidences at the beginning of signs increase their similarity more than in the middle or at the end.

Earlier sign	Contested sign	Case No
ALENTIS	ALENSYS	10/02/2011, R 1243/2010-1
<p>G&S: Class 42</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> while both marks do not have any meaning and, thus, no conceptual comparison can be made, the trade marks are visually and phonetically highly similar, in particular because they coincide in their first four letters ‘ALEN’. It is generally accepted that people pay more attention to the first part of a trade mark, at least when they perceive the mark visually (para. 33).</p>		
Earlier sign	Contested sign	Case No
AZURIL	AZULIB	01/06/2011, R 1543/2010-1

Earlier sign	Contested sign	Case No
<p>G&S: Class 5</p> <p><i>Territory:</i> Greece</p> <p><i>Assessment:</i> the signs share five of their six letters and the first two syllables are identical. There is a certain degree of visual similarity. Aurally the signs are highly similar as the initial part, which is normally the most important, is identical. Neither sign has a meaning in Greek (paras 35-36).</p>		

However, the degree of similarity will usually be lower, despite identical beginnings, if those are the weak elements in the signs or if the remaining elements have a clearly different meaning.

Earlier sign	Contested sign	Case No
CALSURA	CALSORIN	15/12/2010, R 484/2010-2
<p>G&S: Class 5</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> visually, the marks share some similarity due to the coinciding letters 'C', 'A', 'L', 'S' and 'R' placed in the same order. Aurally, there is a low degree of similarity. Conceptually, the marks are similar insofar as they both contain the component 'CAL'. However, since this element clearly alludes to the kind of goods (containing 'calcium'), not much weight can be given to this conceptual similarity (paras 21-23) — no likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
NOBLESSE	NOBLISSIMA	22/07/2011, R 1257/2010-4
<p>G&S: Class 30</p> <p><i>Territory:</i> Denmark, Finland, Sweden</p> <p><i>Assessment:</i> the signs differ in the fifth letter and in their ending. They are visually similar to an average degree. In view of the length of the EUTM application, the signs differ in rhythm and intonation and are thus aurally similar to a low degree. The earlier signs 'NOBLESSE' do have a clear connotation in both Finland and Sweden. In these territories, the word 'NOBLISSIMA' lacks any meaning. They are, therefore, conceptually dissimilar. The earlier marks are laudatory in nature and to a certain extent descriptive of the characteristics of the goods 'chocolate', namely describing their superior character. The distinctive character is below average.</p>		
Earlier sign	Contested sign	Case No

ALBUMAN	ALBUNORM	01/02/2011, R 489/2010-2
<p>G&S: Class 5</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> visually, phonetically and conceptually the signs are similar insofar as they have the prefix 'ALBU' (abbreviation of 'albumin' or 'albumen') in common. But this similarity is of little significance because the prefix is generic and so devoid of distinctiveness. The second element of the earlier mark, 'MAN', is visually, phonetically and conceptually completely different from the second element, 'NORM', of the contested mark.</p>		

3.4.6.3 Short signs

The comparison of signs must be based on the **overall impression** given by the marks.

The length of signs may influence the effect of the differences between them. In principle, the shorter a sign, the more easily the public is able to perceive all its single elements. In contrast, the public is usually less aware of differences between longer signs. **However, each case must be judged on its own merits, having regard to all the relevant factors.**

The Courts have not defined exactly what a short sign is. However, signs with three or less than three letters/numbers are considered by the Office as short signs. The paragraphs below thus analyse the impact on the overall impression, and thus, on the similarity of the respective signs for one-, two- and three-letter/number signs.

The comparison between signs consisting of a single letter or a combination of three or less than three letters not recognisable as a word, **follows the same rules** as that for word signs comprising a word, a name or an invented term (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 47-48; 10/05/2011, T-187/10, G, EU:T:2011:202, § 49).

Single-letter/Single-number signs






It follows from the case-law of the Court that in the assessment of likelihood of confusion between signs comprising the same single letter, the **visual comparison** (see paragraph 3.4.1.6 above) is, in principle, decisive. The aural and conceptual identity may be overridden, in the assessment of likelihood of confusion, by sufficient visual differences between the signs (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 7.1).

Two-letter/number signs

The over-mentioned rule on the importance of visual comparison applies to two-letter/number marks accordingly. The comparison of these signs depends on their stylisation




and, especially, on whether the letters are recognisable as such in the sign. Consequently, the visual overall impression of the signs may be different when two conflicting signs, albeit containing or consisting of the same combination of two-letters, are stylised in a sufficiently different way or contain a sufficiently different figurative element, so that their different overall graphical representation eclipses the common verbal element.

In the following examples, the **marks were found visually similar** due to the graphic representations/visual similarities of the same two-letter combinations.


Earlier sign	Contested sign	Case No
(i) 		31/03/2000, B 61 046
(ii) 		
<p>G&S: Class 36</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> the overall visual impression of the conflicting marks is that they consist of two letters in an arbitrary figurative design that conveys the same impression. The trade marks are considered similar.</p>		
Earlier sign	Contested sign	Case No
GE 		28/02/2014, T-520/11, EU:T:2014:100
<p>G&S: Classes 6, 7, 9, 11, 17</p> <p><i>Territory:</i> UK</p> <p><i>Assessment:</i> it cannot be excluded that part of the relevant public will interpret the contested mark as the letter combination 'GE' (paras 33-35). The marks are phonetically identical and visually similar to a medium degree. As regards the conceptual comparison, it cannot be excluded that part of the relevant public will interpret the contested mark as the letter combination 'GE'.</p>		


In the following example, **the signs were found visually and phonetically dissimilar** due to the different graphic representation and the fact that they may not be read as the same letters.

Earlier sign	Contested sign	Case No
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<p>(i)</p>  <p>(ii)</p> 		<p>18/11/2011, R 82/2011-4</p>
<p>G&S: Class 33</p> <p>Territory: EU</p> <p><i>Assessment:</i> from a visual point of view, the graphic stylisation of the earlier marks is very different compared with the contested mark. The mere fact that one or both letters of the marks are identical is not enough to render the marks visually similar. There is no aural similarity if the contested mark will be pronounced as 'B' or 'PB' as in short signs differences have a higher impact on the overall impression than in longer marks. Conceptually, the contested mark and the earlier marks with no additional elements to the letter combination 'AB' do not have a meaning in any of the relevant languages: the conceptual comparison remains thus neutral (paras 17-19).</p>		


As to the difference in one of the letters see the following examples.

Earlier sign	Contested sign	Case No
<p>(i)</p> <p>CX</p> <p>(ii)</p> 	<p>KX</p>	<p>21/01/2011, R 864/2010-2</p>
<p>G&S: Class 7</p> <p>Territory: EU</p> <p><i>Assessment:</i> visually, the initial letters 'K' and 'C' show a clearly different shape and can be considered only visually similar to a low degree. The same degree of similarity — low — applies for the phonetic comparison. Aurally, the signs will be pronounced 'K-X' and 'C-X' respectively, and not as words. Neither of the marks has a conceptual meaning (paras 25-27).</p>		
Earlier sign	Contested sign	Case No



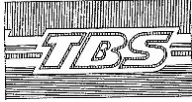


Earlier sign	Contested sign	Case No
KA		22/03/2011, T-486/07, EU:T:2011:104
<p>G&S: Classes 9, 11, 12</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> it must be concluded that, for each of the possible perceptions by the relevant public of the mark applied for, that public will perceive significant visual differences for each of the earlier marks (para. 65). Some degree of phonetic similarity between the marks at issue must be recognised, but it is not very high. Without making an error, the Board of Appeal, therefore, could find that the phonetic similarity between the marks at issue was not 'notable' (para. 71). As both marks have no meaning, no conceptual comparison can be made (para. 72).</p>		

Three-letter/number signs

When the signs in conflict are three-letter/number signs, a difference of one letter does not exclude similarity, especially if this letter is phonetically similar.

Earlier sign	Contested sign	Case No
	ELS	23/10/2002, T-388/00, EU:T:2002:260
<p>G&S: Classes 16, 35, 41</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> two of the three letters are identical and in the same sequence; the difference in a single letter does not constitute a significant visual and aural difference. The letters 'E' and 'I' in Germany are pronounced similarly (paras 66-71).</p>		
Earlier sign	Contested sign	Case No
Ran	R.U.N.	17/12/2009, T-490/07, EU:T:2009:522
<p>G&S: Classes 35, 38, 42</p> <p><i>Territory:</i> EU, Germany</p> <p><i>Assessment:</i> the Court held that the signs in the mind of the relevant consumer, having a good command of the English language, are visually, aurally and conceptually similar (para. 55).</p>		

In contrast, when trade marks are composed of only three letters, with no meaning, the difference of one letter may be sufficient to render them not similar.

Earlier sign	Contested sign	Case No
(i)  (ii)  (iii) 		07/02/2001, R 393/1999-2
<p>G&S: Class 25</p> <p><i>Territory:</i> Benelux, Germany, Spain, France, Italy, Portugal, Austria</p> <p><i>Assessment:</i> in this case the pronunciation of the first letters of the marks in dispute, i.e. 'J' and 'T', is different in all relevant languages. These letters are also visually dissimilar. Furthermore, the figurative elements of the compared marks do not resemble each other (paras 17-18).</p>		
Earlier sign	Contested sign	Case No
	COR	23/05/2007, T-342/05, EU:T:2007:152
<p>G&S: Class 3</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> the GC considered that the signs were only aurally similar to a low degree (paras 47, 50). The relevant public in Germany will certainly notice the differences in the beginning of the signs.</p>		

3.5 Conclusion on similarity

Each aspect of (visual, phonetic and conceptual) the comparison of signs leads to a decision as to whether the marks are similar and if so, to what degree. In general, the more commonalities that exist between marks, the higher the degree of similarity.

An assessment of similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components.

The conclusion as to the degree of similarity of the signs at each of the three levels is the result of an evaluation of all of the relevant factors. The main factors that may impact on an assessment of similarity have been explained in the previous paragraphs of this chapter. It should be borne in mind that in an assessment of similarity, the relevant factors (dominance, distinctiveness, etc.) are considered not only for the purpose of determining the common elements of marks, but also to establish any differing and/or additional elements in conflicting signs.

It must also be borne in mind that since the assessment of similarity is based on the overall impression of the signs, once signs have been found to be similar, it would not be consistent to find later, in the global assessment of the likelihood of confusion, that 'the overall impression of the signs is different' in order to support an outcome of no likelihood of confusion.

In general, the following should be considered when assessing similarity and degrees of similarity.

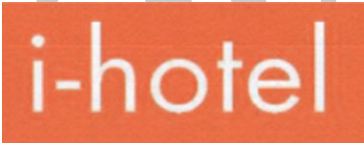

Impact of the distinctiveness of the elements

The greater or lesser degree of distinctiveness of the common elements of the signs is one of the relevant factors in assessing the similarity between signs.

For example, if the coincidences between the signs on any of the three aspects of comparison derive from an element with limited distinctiveness, the established degree of visual, aural and/or conceptual similarity, respectively, will be lower than where the elements in common have a normal distinctiveness.

For example, if the marks coincide in a descriptive or weak figurative component but also share a distinctive verbal element, the level of aural similarity is not affected. In addition, the impact of a coinciding figurative dominant element is clearly something that affects the visual comparison.

In the following examples the signs involved weak/descriptive elements but with different outcomes.

Earlier sign	Contested sign	Case No
		13/06/2012, T-277/11, EU:T:2012:295 (likelihood of confusion)
<p>G&S: Classes 35, 39, 41, 42 and 43</p> <p>Territory: EU</p> <p>Assessment: the Court found the signs visually highly similar, and identical phonetically and conceptually (paras 86, 88, 91 and 93).</p>		
Earlier sign	Contested sign	Case No

Earlier sign	Contested sign	Case No
	TRIDENT PURE	16/12/2015, T-491/13, EU:T:2015:979 (No likelihood of confusion)
<p>G&S: Class 30</p> <p><i>Territory:</i> inter alia EU</p> <p><i>Assessment:</i> with respect to the first earlier right, the Court established a low degree of visual similarity given that the coinciding element 'PURE', despite being descriptive for part of the public, was not on its own sufficient to conclude that the word is negligible in the overall impression produced by the mark (para. 70). They were deemed phonetically similar to a low degree for those who understood 'PURE' but aurally similar to an average degree for the remaining part of the public. On a conceptual level, they were similar for those understanding 'PURE' as a reference to the purity of the goods at issue and to the purity of breath' (para. 93). It was also stated that the fact that the word 'pure' is descriptive of the characteristics of the goods in question does not alter the conceptual content of those marks. With respect to the remaining earlier rights the degree of similarity was no greater.</p>		

Impact of the dominant elements

The conclusion on similarity also has to take into account whether the common element is dominant (visually outstanding) or at least codominant in the overall impression of the marks.



It should also be noted that where some elements of a trade mark are descriptive or non-distinctive, they are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them.

It should be emphasised that the abovementioned factors may not be applicable to all cases and the assessment of similarity is always undertaken on a case-by-case basis

and a consideration of further factors may be necessary. Furthermore, it should be noted that the above factors and principles do not call into question the principle that the examination of the similarity of trade marks must take into account the overall impression produced by them on the relevant public.

Impact of word versus figurative elements

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. Therefore, if the coincidences between composite signs (signs comprising word and figurative elements) lie within the verbal elements and the differences arise out of the figurative elements, the degree of visual and aural similarity is likely to be higher than average (see example below).

Earlier sign	Contested sign	Case No
		16/01/2014, T-149/12, EU:T:2014:11 (likelihood of confusion)
<p>G&S: Class 9</p> <p>Territory: Spain</p> <p><i>Assessment:</i> the signs were found visually highly similar and phonetically identical, notwithstanding the descriptive character of the element 'MICRO' (paras 54-55, 60) and taking into account that the differences were limited to banal graphical elements.</p>		

In general, the identity or similarity of the figurative component of the signs is insufficient to establish a considerable level of similarity where at least one of the signs contains a further verbal component that is not contained in the other sign.

However, although the word elements of a mark may have a greater impact, this is not necessarily the case where the figurative element visually dominates the overall impression made by the mark (see paragraph 3.4.6.1 above).



Beginning of signs

In principle, coincidences at the beginning of signs increase their similarity more than coincidences in the middle or at the end of signs.

Therefore, consumers attach less importance to the end of the mark and coincidences located at the end of signs would lead to a finding of a lower degree of visual similarity than common elements at the beginning of signs (see first example below). Likewise, the position of the coinciding/similar phonemes or syllables at the beginning of the conflicting signs would increase the degree of aural similarity.

However, the degree of similarity will usually be lower, despite identical beginnings, if those are the weak elements in the signs or if the remaining elements have a clearly different meaning (see second example below).

Earlier sign	Contested sign	Case No
OXYGESIC	Maxigesic	16/10/2013, T-328/12, EU:T:2013:537
<p>G&S: Class 5</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> the signs were found visually similar to a low degree due to the descriptive character of the suffix 'GESIC', given that it refers to painkillers (paras 35, 47), as well as the different beginnings (para. 49). Phonetically, they were found similar to an average degree (para. 51) and conceptually dissimilar, the latter again due to the descriptive content of 'GESIC' and the differing associations that could be made with the respective prefixes of the signs ('OXY' refers to oxygen/oxycodon and 'MAXI' to maximum (para. 53)), with the result that a likelihood of confusion was excluded.</p>		

Earlier sign	Contested sign	Case No
		05/02/2015, T-33/13, EU:T:2015:77
<p>G&S: Class 35, 36 and 42.</p> <p><i>Territory:</i> Austria, Benelux, Bulgaria, the Czech Republic, Cyprus, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Latvia, Lithuania, Poland, Portugal, Slovakia, Slovenia, Spain, Sweden and the United Kingdom.</p> <p><i>Assessment:</i> visually, the signs were deemed to have at least a certain degree of visual similarity, even if the coincidence in 'bonus' related to an element of a weak distinctive character (paras 32, 41). Phonetically, the signs were found similar to an average degree due to the identical pronunciation of the first two syllables (para. 34). Conceptually, there is at least a certain degree of similarity for a significant part of the public for whom the common element 'bonus' conveys an identical meaning (para. 42).</p>		

Short signs

The length of the signs may influence their overall impression and thus the effect of the differences between them. In principle, the shorter a sign is, the more easily the public is able to perceive all its single elements. In contrast, the public is usually less aware of differences between longer signs.

The application of the abovementioned principles and factors should not be automatic. The decision has to explain their relevance for the particular case and weigh them up.

However, the rules explained in this chapter have a general character and the particularities of a specific case may justify different findings. However, in such cases it is of even greater importance to provide a clear and thorough reasoning in the decision.

4 Dissimilarity of Signs

4.1 Introduction

The similarity of signs is a necessary condition for a finding of a likelihood of confusion under Article 8(1)(b) EUTMR. An assessment of the similarity between two marks must be based on the **overall impression** created by them, in particular, by their distinctive and dominant components (23/10/2002, T-6/01, Matratzen + Matratzenmarkt Concord (fig.), EU:T:2002:261, § 32 and the case-law cited). Where the overall impression is that the signs are dissimilar, this excludes the likelihood of confusion.

The finding as to whether signs are similar or dissimilar overall is the result of a combined assessment of (i) the visual, phonetic, conceptual overlaps and differences and (ii) the significance of the overlaps and differences in the perception of the relevant public.

Where the signs at issue are dissimilar,

- the general rule is that the goods and services do not need to be compared. Only the signs are compared and the examination stops upon concluding on the dissimilarity of the signs.
- Any claim of enhanced distinctiveness is not examined. If the signs are dissimilar, the opposition under Article 8(1)(b) EUTMR must be rejected regardless of any enhanced distinctiveness of the earlier mark. Where the marks in question are not similar, there is no need to take account of the reputation of the earlier mark, since it does not fall within the scope of the test of similarity and cannot serve to increase the similarity between those marks (14/03/2011, C-370/10 P, EDUCA Memory game, EU:C:2011:149, § 50-51 and the case-law cited).
- There is no global assessment of factors. The decision concludes that in the absence of one of the conditions, the opposition under Article 8(1)(b) EUTMR must be rejected.

4.2 Scenarios for dissimilarity

4.2.1 No element in common

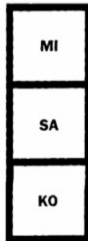



The signs are obviously dissimilar if they have nothing in common in any of the three aspects of comparison. This is more a hypothetical scenario as the signs at issue in an opposition under Article 8(1)(b) EUTMR normally have something in common. What is rather debated by the parties is the significance of the overlap in an element.

4.2.2 Overlap in a negligible element

The signs are dissimilar if the only element they have in common is **negligible** in one or both of the marks in the sense that, due to its size and/or position, it will be likely to go **unnoticed** or **disregarded** by the relevant public. Negligible elements, after **having duly reasoned** why they are considered negligible, will not be compared (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42). The notion of negligible elements should be strictly interpreted and, in the event of any doubt, the assessment should cover all the elements of the sign (see paragraph 1.5 above).

Concerning the assessment as to whether an element is negligible, the test is not whether the Office can, in a meticulous side-by-side examination of the signs, decipher the element concerned. The question is rather whether, in the overall impression of the sign, the element is noticeable by the average consumer who normally perceives a sign as a whole and does not proceed to analyse its various details.

Examples


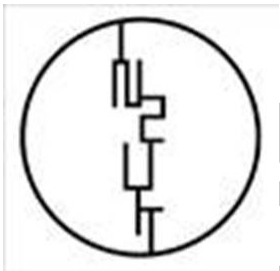
Earlier sign	Contested sign	Case No
		<p>11/11/2009, T-162/08, EU:T:2009:432</p> <p>The words 'by missako' are almost illegible: the size and script make them difficult to decipher</p>
 <p>(RL RÓTULOS LUNA S.A.)</p>		<p>12/12/2011, R 2347/2010-2</p> <p>The element 'Rótulos Luna S.A.' was considered negligible</p>

4.2.3 Overlap in a verbal element not noticeable due to high stylisation

The signs are dissimilar if the verbal element, which would give rise to similarity, is not discernible due to its high stylisation. Sometimes the way in which letters or symbols are used makes it unrealistic to assume that they will be read and pronounced, for example, when in a figurative mark a symbol or letter is repeated in order to create a pattern, is highly distorted or otherwise not clearly legible. If the verbal element is not recognisable in the overall impression of the sign, thus, not legible and not pronounceable, it will not be taken into account in the comparison.

Again, the test is not whether the Office can, in a meticulous side-by-side examination of the signs, identify the verbal element concerned. It is irrelevant if the verbal element is recognised only with the help of the other mark, as the consumer normally does not have the opportunity to compare signs side by side. Furthermore, it is irrelevant that the party refers to its mark by a particular verbal element in its submissions or if the particulars of the mark indicate a verbal element, because the consumer will not be assisted by that information on encountering the sign as registered or applied for.

Examples

Earlier sign	Contested sign	Case No
KA		22/06/2011, R 1779/2010-4
intuit		17/09/2015, R 164/2015-2


The question whether the verbal element is indeed 'lost' in the stylisation must be carefully assessed. The consumer intuitively looks for pronounceable elements in figurative signs by which the sign can be referred to. The high stylisation of one or more letters of a word may not prevent the consumer from identifying the verbal element as a whole, particularly, if it suggests a concrete meaning. It should also be emphasised that if the complex stylisation of the verbal element of a sign does not make it totally illegible, but merely lends itself to various interpretations, the comparison must take into account the different realistic interpretations. Thus, it is only in the — rather rare — case where the legibility of the sign is truly unrealistic, without being assisted by a mark description or the other mark, that the verbal element will be disregarded in the comparison.



4.2.4 Overlap in other irrelevant aspects

The fact that there is some coincidence between the signs does not necessarily lead to a finding of similarity. This is in particular the case when the overlapping part is not perceived independently within the overall impression of the marks. The Court considered the following signs dissimilar despite the overlap in a sequence of letters.





Examples

Earlier sign	Contested sign	Case No
StoCretec	CRETEO	28/01/2016, EU:T:2016:38 T-640/13,
<p>The conflicting signs are dissimilar (para. 87). In the visual impression created by the marks, the beginnings 'sto' and 'cre' and the endings 'tec' and 'o' play a more important role than the syllables 'cre' and 'te', which are placed in the middle of the signs and are less perceived by the relevant public. Therefore, it is concluded that there is no visual similarity between the signs (para. 71). The marks are not phonetically similar, in particular on account of their different beginnings and endings (para. 72). The conceptual comparison remains neutral, as 'StoCretec' and 'CRETEO' are coined terms without any meaning in German (para. 73).</p>		

Earlier sign	Contested sign	Case No
ALDI		26/11/2014, EU:T:2014:994 T-240/13,
<p>The figurative elements and the additional word 'foods' must not be disregarded when comparing the signs (paras 54-55). The overall visual impression of the conflicting signs is clearly dissimilar (paras 59-61). The signs are not phonetically similar bearing in mind, in particular, the additional element 'foods' of the contested mark (paras 65-66). Finally, the marks are also conceptually not similar (para. 73).</p>		

Earlier sign	Contested sign	Case No
		12/11/2014, EU:T:2014:944 T-524/11,
<p>The figurative elements of the earlier figurative marks further distinguish those marks from the mark applied for (para. 36). The signs at issue have a different rhythm of pronunciation (paras 43-44). The words have no meaning; it is not possible to carry out a conceptual comparison (para. 54).</p>		

The same applies to similarities in the figurative elements that are of minor impact.

Earlier sign	Contested sign	Case No
		16/07/2014, EU:T:2014:673 T-36/13,
The figurative elements of the signs have the same outline, but will be perceived as different by the relevant public (paras 45-47). The word elements are visually different since they have only two letters in common, which are also placed in distinct positions.		
Earlier sign	Contested sign	Case No
		22/03/2012, B 1 837 106
The marks coincide only in that the verbal elements are written in white on a contrasting grey background and the white frame that separates the verbal and the landscape elements in equal parts. These are commonplace figurative elements, omnipresent in marks in virtually all fields of trade. The consumer's attention is not caught by any of these details, but rather by the fanciful term 'tukaş' in the earlier mark and by the word 'Ekonomik' in the contested mark. As the signs visually overlap only in irrelevant aspects and have nothing in common aurally and conceptually, they are dissimilar overall.		

The decision must contain a thorough reasoning, in the comparison of signs, as to why the overlap in particular aspects is considered irrelevant.

4.2.5 Overlap in a non-distinctive element

If the signs overlap exclusively in an element that is **descriptive** or **non-distinctive** for the relevant goods and services in all parts of the relevant territory, and both **contain other distinctive element(s) capable of differentiating** between the signs, they can be considered dissimilar.

It follows that two conditions have to be fulfilled in order to find dissimilarity in this context:

- the coinciding element must be non-distinctive (if the coinciding element has some, even very low distinctiveness, the signs cannot be found dissimilar);
- both signs must contain other elements that are distinctive and capable of differentiating the marks.

Therefore, two signs may be dissimilar for some of the goods and services but not for others. In such a case, strategy may justify comparing some of the goods and services


to find them dissimilar, and then continuing with the assessment of the similarity of the signs for the remaining goods and services only.

Furthermore, if in part of the relevant territory the overlapping element is not perceived as descriptive or non-distinctive (e.g. due to non-understanding of the term), the signs cannot be considered dissimilar.

The following invented examples illustrate cases where the coincidence in one element cannot lead to any similarity because that element is non-distinctive and the other elements, which are clearly different, allow the public to differentiate sufficiently between the marks.



Earlier sign	Contested sign
HOTEL FRANCISCO	HOTEL ZENITH
G&S: provision of accommodation Territory: EU	
CASA ENRIQUE	CASA RACHEL
G&S: provision of restaurant services Territory: Spain (where 'casa' has also the meaning 'bar', 'restaurant')	
MARKET.COM	FITNESS.COM
G&S: telecommunications services Territory: EU	

Examples from case-law

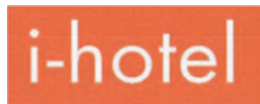
Earlier sign	Contested sign	Case No
	CARBON CAPITAL MARKETS	22/06/2010, T-563/08, EU:T:2010:251 (paras 39-61)
G&S: Class 36 Territory: EU (relevant public considered to be familiar with basic English financial terminology) Assessment: the common element 'capital markets' directly describes the services.		

According to the rules established above, despite a lack of distinctive character of the elements in common, it would **not** be appropriate to conclude on dissimilarity, where:

- the particular combination of the elements confer some distinctiveness on the signs (i.e. the combination would be protected)

Earlier sign	Contested sign	Case No
		22/05/2012, T-60/11, EU:T:2012:252
<p>G&S: Classes 30, 31, 42</p> <p>Territory: EU</p> <p><i>Assessment:</i> there is some similarity between the marks. The earlier mark consists of two elements that are non-distinctive for the goods in question — the image of a corn (descriptive for bakery products) and the laudatory word element 'PREMIUM'. The combination of these elements is arbitrary (unlike the word combination 'Capital markets' in the example above, which is an established expression). The coincidences between the marks are therefore not limited to non-distinctive elements but extend to their particular combination.</p>		

- the other element that is supposed to distinguish between the signs is perceived as an insignificant figurative detail, or is otherwise non-distinctive (see paragraph 3.2.3.1 above)

Earlier sign	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
<p>G&S: services related to travel, accommodation and congresses in Classes 35, 39, 41, 42, 43</p> <p>Territory: EU</p> <p><i>Assessment:</i> the visual differences between the marks (the orange background and the particular way of writing) do not distract from the common element. The marks are visually highly similar and aurally and conceptually identical (paras 83-92).</p>		

Earlier sign	Contested sign	Case No
waterPerfect	AquaPerfect	28/01/2015, T-123/14, EU:T:2015:52

Earlier sign	Contested sign	Case No
<p>G&S: Class 7</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> while the element 'Perfect' has weak distinctive character, the fact remains that none of the other elements can be considered to have greater distinctive character. The elements 'aqua' and 'water' also have weak distinctive character as they will be perceived by the relevant public as meaning 'water' and the goods covered all involve water in one way or another (para. 42).</p> <p>The signs were found visually, phonetically and conceptually similar to an average degree.</p>		

- the non-distinctive elements constituting (forming exclusively) the sign are entirely incorporated in the other sign

Earlier sign	Contested sign	Case No
POST	TPG POST	13/05/2015, T-102/14, EU:T:2015:279
<p>G&S: Class 39 and others related to postal services</p> <p><i>Territory:</i> Germany, EU</p> <p><i>Assessment:</i> although the element 'post' as such is non-distinctive for postal services, it corresponds to the earlier mark, which should be attributed with a minimum degree of distinctiveness (para. 43).</p>		

In summary, the finding of 'dissimilar overall' on account of an overlap exclusively in non-distinctive elements should be limited to evident cases where the other element serves to safely distinguish between the signs.

In less evident cases low similarity should be attributed to the marks. The examination will then proceed and the cases will be solved at the stage of the global assessment (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 6.2).

It must also be borne in mind that a finding of dissimilarity in the context of Article 8(1) (a) or (b) EUTMR is also binding for other grounds of refusal on which the opposition is based. It applies especially to Article 8(5) EUTMR, with the result that if the marks are found dissimilar, the protection on this ground is excluded (see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.2).

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 5

Distinctiveness of the earlier mark

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1 General Remarks

The Court of Justice of the European Union (the Court) held in its judgment of 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18, 24:

... marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

... the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

The assessment of the distinctiveness of an earlier mark is **especially** important in cases, when there is only a low degree of similarity between the signs, as it must be assessed, whether this low degree can be compensated by the high degree of similarity between the products (11/06/2014, T-281/13, Metabiomax, EU:T:2014:440, § 57; and 13/05/2015, T-102/14, TPG POST / DP et al., EU:T:2015:279, § 67) and vice versa.

According to the case-law, it is necessary to distinguish between the **notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark**, and the **notion of the distinctive character which an element of a composite mark possesses, which determines its ability to dominate the overall impression created by the mark** (27/04/2006, C-235/05 P, Flexi Air, EU:C:2006:271, § 43). While it is true that it is necessary to examine the **distinctiveness of an element of a composite mark at the stage of assessing the similarity of the signs (...)**, the **degree of distinctiveness of the earlier mark is an element to be taken into account in the context of the global assessment of the likelihood of confusion**. It is therefore not appropriate to take account of what may be a low degree of distinctiveness of the earlier mark at the stage of assessing the similarity of the signs (23/01/2014, C-558/12 P, WESTERN GOLD / WeserGold et al., EU:C:2014:22, § 42-45; 25/03/2010, T-5/08 & T-7/08, Golden Eagle / Golden Eagle Deluxe, EU:T:2010:123, § 65; 19/05/2010, T-243/08, EDUCA Memory game, EU:T:2010:210, § 27).

The Office therefore distinguishes between (i) the analysis of the distinctive character of the earlier mark as a whole, which determines the scope of protection afforded to that mark and is one of the factors in the global assessment of the likelihood of confusion, and (ii) the analysis of the distinctive character of a component of the marks within their comparison ⁴⁷.

Whereas distinctive character must be assessed for the components of both the earlier mark and the contested mark, distinctiveness of the mark as a whole is assessed only in respect of the earlier mark ⁴⁸. The distinctiveness of the contested mark as a whole

⁴⁷ See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs.

is not relevant, as such, to the assessment of likelihood of confusion, as explained in more detail in paragraph 2.1.2 below. Therefore, any reference below to the distinctiveness of the mark **as a whole** refers exclusively to the earlier mark.

2 Assessment of Distinctiveness of the Earlier Mark

The *Canon* judgment makes clear that (i) the more distinctive the earlier mark, the greater will be the likelihood of confusion and (ii) earlier marks with a highly distinctive character because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character. Consequently, the distinctive character of the earlier mark as a whole determines the strength and breadth of its protection and must be taken into consideration for the purposes of assessing likelihood of confusion.

2.1 General issues

2.1.1 Distinctiveness

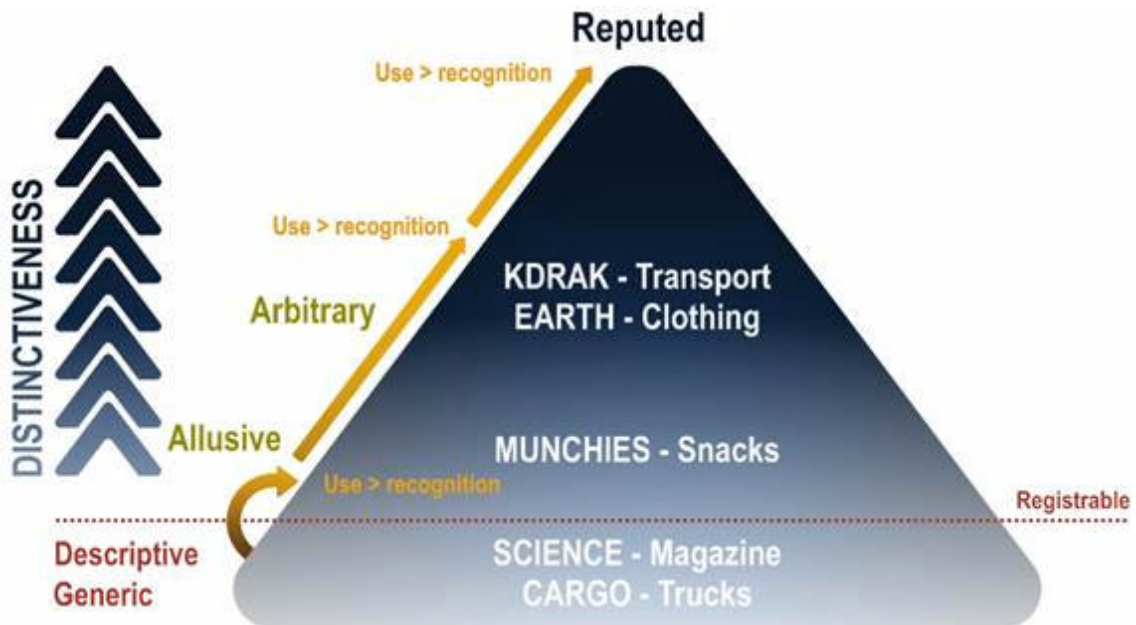
The Court has defined distinctiveness in the following manner:

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the **greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings** (emphasis added).

(22/06/1999, C-342/97, *Lloyd Schuhfabrik*, EU:C:1999:323, § 22).

Importantly, distinctive character is a matter of degree and, when analysing distinctiveness, a sliding scale applies, whereby a sign can lack distinctiveness entirely, be highly distinctive or be at any point in-between.

⁴⁸ See also Objective 1 of the Common Practice on the impact of non-distinctive/weak components on likelihood of confusion agreed within the framework of the European Trade Mark and Design Network (ETMDN).



A sign is **not distinctive** if it is descriptive of the goods and services themselves or of the characteristics of those goods and services (such as their quality, value, purpose, provenance, etc.), laudatory and/or if its use in trade is common for those goods and services. Similarly, a sign that is generic (such as a common shape of a container or a common colour) will also lack distinctiveness. The rules for the assessment of distinctive character follow those established by examination on absolute grounds.

A sign may be **distinctive to a low degree** if it alludes to (but is not exclusively descriptive of) characteristics of the goods and services. If the allusion to the goods and services is sufficiently imaginative or clever, the mere fact that there is an allusion to characteristics of the goods and/or services might not materially affect distinctiveness. For example:

- ‘Billionaire’ for *gaming services* is allusive in a manner that would affect distinctiveness, because it implies for instance that you may become a billionaire.
- ‘Billy O’Naire’, which sounds identical to ‘billionaire’ in English, would be allusive for *gaming services* as a clever wordplay on Irish names, in a manner that would not affect distinctiveness in a material way; it would be considered to have a ‘normal’ degree of distinctiveness.

A sign is deemed to possess a **‘normal’ degree of inherent** distinctiveness if there is no indication for a limitation thereof (e.g. due to a descriptive character, laudatory meaning, etc.). This means that the sign in question is fully distinctive, in the sense that its capacity to identify the goods and services for which it has been registered as coming from a particular undertaking is not in any way diminished or impaired.

Any **higher degree of distinctiveness** acquired by the earlier mark, which is often claimed by the opponent in order to broaden its scope of protection, has to be proven by its proprietor by submitting appropriate evidence (see paragraph 2.3 below). A mark will not necessarily have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services (16/05/2013, C-379/12 P, H/Eich, EU:C:2013:317, § 71).

However, an EUTM applicant may argue that the earlier sign is distinctive to a low degree. One of the most frequent arguments brought by applicants is that the earlier trade mark or one of its components has low distinctive character given that there are many trade marks that consist of, or include, the element in question. Where this argument is supported only by the applicant's referring to trade mark registrations, the Office takes the view that the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of register data only, it cannot be assumed that all the trade marks have been effectively used (13/04/2011, T-358/09, Toro de Piedra, EU:T:2011:174, § 35; 08/03/2013, T-498/10, David Mayer, EU:T:2013:117, § 77-79).

It follows that the evidence filed must demonstrate that consumers have been exposed to widespread use of, and become accustomed to, trade marks that include the element in question in order to prove that this element has a low degree of distinctive character.

When dealing with the distinctiveness of the **earlier mark as a whole**, the latter should always be considered **to have at least a minimum degree of inherent distinctiveness**. Earlier marks, whether EUTMs or national marks, enjoy a 'presumption of validity'. The Court made it clear, in its judgment of 24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 40-41, that 'in proceedings opposing the registration of a European Union trade mark, the validity of national trade marks may not be called into question'. The Court added that 'it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character'⁴⁹.

2.1.2 Inherent and enhanced distinctiveness

The Office must consider, as a first step, the overall **inherent distinctiveness** of the earlier mark (see paragraph 2.2 below) and, as a second step, if claimed and relevant to the outcome, whether the earlier mark has **acquired enhanced distinctiveness** as a consequence of the use the opponent has made of it (see paragraph 2.3 below).

The degree of distinctiveness of the earlier sign is one of the factors to be taken into account in the overall assessment (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23). It is a matter of law, which must be examined by the Office even if the parties do not comment on it. In contrast, the degree of enhanced distinctiveness acquired through use of the earlier sign is a matter of law **and** fact, which the Office cannot examine unless the opponent claims and substantiates it in due time (see the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.2, Substantiation).

The inherent distinctiveness of the **contested** trade mark **as a whole** is not examined within the framework of the opposition proceedings, as it is the scope of protection of the earlier mark that is relevant for the purposes of likelihood of confusion. Likewise, the enhanced distinctiveness of the contested sign is also irrelevant because likelihood

⁴⁹ See also Objective 1 of the Common Practice on the impact of non-distinctive/weak components on likelihood of confusion agreed within the framework of the ETMDN.

of confusion requires a consideration of the scope of protection of the earlier mark rather than that of the mark applied for. If an earlier mark is recognised as having a broader scope of protection by reason of its enhanced distinctiveness, the reputation acquired by the **mark applied for** is, as a matter of principle, irrelevant for the purpose of assessing likelihood of confusion (03/09/2009, C-498/07 P, La Española, EU:C:2013:302, § 84).

2.1.3 Relevant point in time

The inherent distinctiveness of the earlier mark(s) should be assessed at the time of the decision. The enhanced distinctiveness of the earlier trade mark(s) (if claimed) should exist (i) at the time of filing of the contested EUTM application (or any priority date) **and** (ii) at the time of the decision.

2.1.4 Relevant goods and services

The assessment of the **inherent distinctiveness** of the earlier mark is carried out only for the goods or services that have been found to be identical or similar to the contested goods and services.

Assessment of the **enhanced distinctiveness** of the earlier mark is carried out only in respect of the goods or services protected by the sign for which enhanced distinctiveness is claimed.

Furthermore, it is the perception of the relevant public for these goods and services that is of relevance (e.g. whether a specialist public is involved or not).

2.2 Examination of inherent distinctiveness of the earlier mark

2.2.1 General principles

The first step in examining the distinctiveness of the earlier mark is to examine its inherent distinctiveness. The same rules and principles apply as those for the examination of distinctiveness of components, in terms of the relevant public and its linguistic and cultural background, relevant territory, relevant goods and services, etc. (see the Guidelines, Part C, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 3.2).

At the stage of determining the distinctiveness of the earlier mark as a whole, distinctiveness of its various components (or its only component) has already been established in the section on comparison of signs. In principle, if an earlier mark contains a normally distinctive component, then the inherent distinctiveness of such an earlier mark as a whole is also normal, regardless of the possible presence of other non-distinctive or weak components. If the most distinctive component of the earlier mark is distinctive only to a low degree, then in principle the overall inherent distinctiveness of that mark will be no more than low.

As mentioned above, earlier registered trade marks are presumed to have **at least a minimum degree** of inherent distinctiveness (24/05/2012, C-196/11, F1-Live, EU:C:2012:314), even where persuasive evidence is submitted to challenge this presumption. If the EUTM applicant proves that it has started a cancellation action against the earlier registered mark, then it might be necessary to suspend the opposition proceedings pending the outcome of the said action.

The outcome of the examination of inherent distinctiveness of the earlier mark as a whole will be one of the following.

- The earlier mark has **less than normal distinctiveness** because, as a whole, it is allusive (in a way that materially affects distinctiveness) or laudatory of the characteristics of identical or similar goods or services (or because it is otherwise weak). As set out above, the Office will not conclude that an earlier mark as a whole is descriptive and/or non-distinctive.
- The earlier mark has **normal distinctiveness** because, as a whole, it is not descriptive, allusive (in a way that materially affects distinctiveness) or laudatory (or is not otherwise weak) in relation to identical or similar goods or services.

It is Office practice, when an earlier mark is not descriptive (or is not otherwise non-distinctive), to consider it as having no more than a normal degree of inherent distinctiveness. As indicated above, this degree of distinctiveness can be further enhanced if appropriate evidence is submitted showing that a higher degree of distinctiveness of the earlier mark has been acquired through use or because it is highly original, unusual or unique (26/03/2015, T-581/13, Royal County of Berkshire POLO CLUB (fig.) / BEVERLEY HILLS POLO CLUB et al., EU:T:2015:192, § 49, last alternative). It should, however, be recalled that a mark will not necessarily have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services (16/05/2013, C-379/12 P, H/Eich, EU:C:2013:317, § 71).

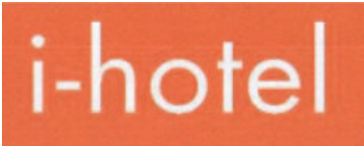
2.2.2 Impact of the low distinctiveness of the earlier mark


As explained in paragraph 2.1.1 above, the Office, following the case-law of the Court of Justice, attributes at least a minimum degree of distinctiveness to the earlier mark.

A finding that a trade mark has a low or even very low (minimal) degree of distinctiveness may have a different impact on the likelihood of confusion. In general, this finding is an argument against likelihood of confusion. It must however be balanced with the other factors, like the degree of similarity of the signs and the goods or services, as well as the level of attention and sophistication of the relevant public.

The Court has emphasised on several occasions that a finding of a low distinctive character for the earlier trade mark does not prevent a finding of a likelihood of confusion. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a high degree of similarity between the signs and between the goods or services covered (13/12/2007, T-134/06, Pagesjaunes.com, EU:T:2007:387, § 70).

The **likelihood of confusion was affirmed** for similar and identical goods, when the trade marks differed only in stylisation or non-distinctive figurative elements and showed therefore a high degree of similarity.

Earlier mark	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
<p>G&S: Class 43 and others related to travel and hotel services</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> the trade marks are visually highly similar; there is phonetic and conceptual identity.</p>		

Earlier mark	Contested sign	Case No
SHE		15/10/2015, T-642/13, EU:T:2015:781
<p>G&S: Class 25</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> the trade marks are visually and conceptually similar; there is phonetic identity.</p> <p>The finding of the likelihood of confusion is not called into question by the argument that the earlier word mark is purely descriptive and thus has a low distinctive character.</p> <p>The fact that the mark at issue consists of the same word sign as the earlier word mark and differs from it solely by a figurative element without particular meaning could be perceived as a particular configuration of the earlier word mark (paras 73, 77).</p>		

However, **the likelihood of confusion was excluded** even for identical goods in cases where the degree of similarity between the marks was low due to differences resulting from an additional fully distinctive element:

Earlier mark	Contested sign	Case No
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POST	TPG POST	13/05/2015, T-102/14, EU:T:2015:279
<p>G&S: Class 39 and others related to postal services</p> <p><i>Territory:</i> Germany, EU</p> <p><i>Assessment:</i> the earlier mark has limited distinctiveness. The differences between the marks due to the addition of the distinctive element 'TPG' will be perceived visually, phonetically and conceptually (paras 61, 68).</p>		

Earlier mark	Contested sign	Case No
F1	F1H2O	21/05/2005, T-55/13, EU:T:2015:309
<p>G&S: Class 9, 25, 38, 41</p> <p><i>Territory:</i> IT, UK and others</p> <p><i>Assessment:</i> the visual and phonetic similarity is low, the signs are conceptually dissimilar. The element 'F1' is indeed likely to create a link in the mind of the relevant public between those goods and services and the field of motor racing. The distinctiveness of the earlier word marks does not help confer on those marks, or on the element of the mark applied for composed of the alphanumeric combination 'F1', a dominant character or independent distinctive character, inasmuch as the mark applied for is not broken down by the relevant public, but would be perceived by that public in its entirety (paras 45, 50).</p>		

2.2.3 Specific themes

2.2.3.1 One-letter signs, numerals and short signs

The Court, in its judgment of 09/09/2010, C-265/09 P, α , EU:C:2010:508, held that the distinctiveness of single-letter trade marks must be assessed according to an examination based on the facts, focusing on the goods or services concerned and the **same criteria that apply to other word marks** (paras 33-39). Although that judgment deals with absolute grounds, the Office considers that the principle established by the Court (i.e. that the application of the criterion of distinctiveness must be the same for all marks) also applies in *inter partes* cases when it comes to determining the distinctiveness of single-letter trade marks.

The Court, while acknowledging that it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks, held

that these circumstances do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law.

The Office considers the ruling to mean that, when establishing the distinctiveness of an earlier mark, it is not correct to rely on assumptions such as a priori statements that consumers are not in the habit of perceiving single letters as trade marks or on generic arguments such as that relating to the availability of signs, given the limited number of letters.

The General Court has since stated in a number of cases that a trade mark containing a **single letter** or a single numeral may indeed be inherently distinctive (08/05/2012, T-101/11, G, EU:T:2012:223, § 50; 06/10/2011, T-176/10, Seven for all mankind, EU:T:2011:577, § 36; 05/11/2013, T-378/12, X, EU:T:2013:574, § 37-51).

In its judgment of 10/05/2011, T-187/10, G, EU:T:2011:202, the General Court dismissed the applicant's argument that single letters are generally per se devoid of distinctive character and that therefore only their graphic representation would be protected (paras 38, 49).

Consequently, whilst registered **earlier trade marks consisting of a single letter (or numeral)** represented in **standard characters** enjoy a presumption of validity, ultimately their degree of inherent distinctiveness will have to be assessed with reference to the goods and/or services concerned.

If the corresponding claim is made, account should be taken of evidence submitted by the opponent that demonstrates that its registered trade mark consisting of a single letter has acquired **enhanced distinctiveness**. This circumstance could lend the earlier trade mark a broader scope of protection.

The above considerations apply both to single-letter/numeral trade marks represented in standard characters (i.e. word marks) and to stylised single-letter/numeral trade marks.

Where the opponent has successfully proven that its single-letter trade mark has acquired enhanced distinctiveness through intensive use, the impact thereof on the final outcome has to be carefully assessed. Firstly, enhanced distinctiveness on the part of the earlier single-letter trade mark cannot justify a finding of likelihood of confusion if the overall visual impression conveyed by the signs is so different as to safely set them apart. Secondly, if the evidence shows use of a single-letter trade mark that is stylised or accompanied by additional figurative elements, the benefit of the resulting broader scope of protection accrues to the form in which it was used and not to the single letter as such or any other stylised variation.

Furthermore, in accordance with the α judgment, as regards **short signs**, unless a letter combination, as such, is intrinsically non-distinctive for the goods and services (e.g. 'S' or 'XL' for goods in Class 25), these signs are not necessarily distinctive only to a low degree. The same rules apply to numerals.

2.2.3.2 Collective marks

Where the mark on which the opposition is based is a collective mark, its inherent distinctiveness is to be assessed in the usual way. The mark may have a low or even very low degree of inherent distinctiveness when it refers to the nature or other characteristics of the goods concerned. The fact that the mark is a collective mark does not imply that its scope of protection is broader (13/06/2012, T-534/10, Hellim, EU:T:2012:292, § 49-52; 05/12/2012, T-143/11, F.F.R., EU:T:2012:645, § 61).

2.3 Examination of enhanced distinctiveness

After the obligatory **examination of inherent distinctiveness**, the second step is to check — provided the opponent has made the corresponding claim ⁵⁰ — whether the earlier mark has acquired enhanced distinctiveness at the time of filing (or priority date) of the contested EUTM application as a consequence of the use that the opponent has made of it.

The distinctiveness of the earlier mark always has to be taken into account when deciding on likelihood of confusion. The more distinctive the earlier trade mark, the greater will be the likelihood of confusion (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24). Therefore, marks with a highly distinctive character, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

In practice, this means that the fact that an earlier trade mark enjoys enhanced distinctive character or reputation is an argument in favour of finding a likelihood of confusion.

Enhanced distinctiveness requires recognition of the mark by the relevant public. This recognition may enhance the distinctiveness of marks with little or no inherent distinctiveness or those that are inherently distinctive.

Earlier mark	Contested sign	Case No
CRISTAL		17/11/2003, R 37/2000-2

⁵⁰ See the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 4.2.

G&S: Class 33

Territory: France

Assessment: (earlier mark 'CRISTAL') 'As regards the claim that "Cristal" is a descriptive word for the goods at issue (sparkling wines with crystalline character), the Board cannot accept it. On the one hand, it is an evocative indication which suggests the crystalline character of wines, but which in no way describes the product. On the other hand, [the Board] considers that a highly distinctive character of the mark CRISTAL on the French market had been shown.' (para. 31)

The Court has given some guidance in respect of the evaluation of distinctiveness acquired through use of the earlier mark and provided a non-exhaustive list of factors.

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.


(22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 23)

The evidence of enhanced distinctiveness acquired through use must refer to both (i) the relevant geographical area and (ii) the relevant goods and services. The opponent may claim enhanced distinctive character of the earlier mark for only part of the registered goods and services. According to the evidence submitted, the Office must establish precisely for which goods and services distinctiveness has been acquired. The nature, factors, evidence and assessment of enhanced distinctiveness are the same as for reputation. For further details on the evidence required and its assessment see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

However, a finding of reputation requires that a certain threshold of recognition be met whilst, as set out above, the threshold for a finding of enhanced distinctiveness may be lower.

Enhanced distinctiveness is anything above inherent distinctiveness.

Earlier mark	Contested sign	Case No
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EL COTO	<p style="text-align: center;">Coto D'Arcis</p> 	<p>12/03/2008, T-332/04, EU:T:2008:69</p>
<p>G&S: Classes 33, 35, 39</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> enhanced distinctiveness of the trade mark 'EL COTO': 'The Board of Appeal took into account the market knowledge of the earlier mark 'EL COTO' and made a proper assessment of the relevant case-law principles to conclude that the earlier mark 'EL COTO' has a highly distinctive character; it based its finding on the following facts: the certificate issued by the Secretary General of the Consejo Regulador de la Denominación de Origen Calificada 'Rioja', which certifies that the owner markets its wines, among others, under the brand names 'El Coto' and 'Coto de Imaz' since 1977 and that these marks 'enjoy a significant well-known character' in Spain, various decisions of the Spanish Patent and Trade Mark Office acknowledging that the mark 'EL COTO' is well known in Spain, a document on sales evolution, indicating that they had sold under the mark 'El Coto' 339 852, 379 847, 435 857 and 464 080 boxes of twelve bottles of wine in 1995, 1996, 1997 and 1998, respectively' (para. 50).</p>		

Importantly, acquisition of enhanced distinctive character by a mark may be a result of its use as part of another registered trade mark (07/07/2005, C-353/03, Have a break, EU:C:2005:432, § 30-32; 07/09/2006, T-168/04, Aire limpio, EU:T:2006:245, § 74).

The outcome of the examination of enhanced distinctiveness will be one of the following.

- Where there is no evidence of enhanced distinctiveness as regards the relevant goods and services or the territory, or the evidence is insufficient, the level of distinctiveness of the earlier mark will be its inherent distinctiveness (less than normal or normal).
- Where there is evidence of enhanced distinctiveness as regards all or some of the relevant goods and services and the territory, and the evidence is sufficient:
 - if the earlier mark has less than normal inherent distinctiveness, the mark/component may have acquired a normal or even a high degree of distinctiveness, depending on the evidence submitted⁵¹; or
 - if the earlier trade mark has normal inherent distinctiveness, it may have acquired high distinctiveness.

It must be recalled that although a mark as a whole may have acquired enhanced distinctiveness, there may be descriptive elements that will have less than normal or no distinctiveness. For example, the enhanced distinctiveness of the mark 'Coca Cola' as

⁵¹ For further details on the evidence required and its assessment see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

a whole does not alter the fact that the element 'Cola' remains entirely descriptive for certain products.

Obsolete

GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 6

Other factors

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1 Introduction

The Office normally examines the most salient and habitually relevant factors relating to likelihood of confusion under separate headings before the chapter on global assessment. These factors have been treated in the preceding chapters of these Guidelines.

However, the global assessment also takes into account **other factors, based on arguments and evidence submitted by the parties**, which are relevant for deciding on likelihood of confusion. This chapter deals with the frequent arguments/claims raised by the parties.

2 Family of Marks/Series of Marks

When an opposition to an EUTM application is based on several earlier marks and those marks display characteristics that give grounds for regarding them as forming part of a single ‘series’ or ‘family’, a likelihood of confusion may be created by the possibility of association between the contested trade mark and the earlier marks forming part of the series. The Courts have given clear indications on the two cumulative conditions that have to be satisfied (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 123-127, confirmed 13/09/2007, C-234/06 P, Bainbridge, EU:C:2007:514, § 63).

- Firstly, the proprietor of a series of earlier marks must submit **proof of use** of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a ‘series’ (i.e. at least three).
- Secondly, the trade mark applied for must **not only be similar** to the marks belonging to the series, but must also display characteristics capable of **associating** it with the series. Association must lead the public to believe that the contested trade mark is also part of the series, that is to say, that the goods and services could originate from the same or connected undertakings. This may not be the case where, for example, the element common to the earlier series of marks is used in the contested trade mark, either in a different position from that in which it usually appears in the marks belonging to the series, or with a different semantic content.

The argument that there is a ‘family of marks’ must be claimed before the expiry of the **time limit set for substantiating the opposition**. The opponent must prove within the same time limit that it has used the marks forming the alleged family in the marketplace to such an extent that the relevant public has become familiar with this family of marks as designating the goods and/or services of a particular undertaking.

A positive finding that the opponent has a family of marks entails **the use of at least three marks**, the minimum threshold for such an argument to be taken into due consideration. Proof of use relating to only two trade marks cannot substantiate the existence of a series of marks.

Normally, the trade marks constituting a ‘family’ and used as such are all registered marks. However, it cannot be precluded that the ‘family of marks’ doctrine may also include **non-registered trade marks**.

When the opponent has proven the existence of a family of marks, it would be wrong to compare the contested application individually with each of the earlier marks making up the family. Rather, the assessment of similarity **should be conducted to make a comparison between the contested mark and the family taken as a whole**, in order to establish if the contested sign displays those characteristics that are likely to trigger the association with the opponent’s family of marks in consumers’ minds. In fact, an individual comparison between the conflicting signs might even lead to a finding that the signs are not sufficiently similar to lead to a likelihood of confusion, whereas the association of the contested sign with the earlier family of marks might be the decisive factor that tips the balance to a finding of likelihood of confusion.

An assumption of a family of marks on the part of the public requires that the **common denominator of the contested application and the earlier family of marks must have a distinctive character**, either per se or acquired through use, to allow a direct association between all of these signs. Likewise, there will be no assumption of a family of marks where the further components of the earlier signs have a greater impact in the overall impression of those signs.

Earlier signs	Contested sign	Case No
Ophtal, Crom-Ophtal, Visc-Ophtal, Pan-Ophtal	ALERGOFTAL	06/06/2002, R 838/2001-1
<p>G&S: Class 5</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> the Board held that the differences between the signs were such as to exclude the likelihood that the contested mark would be perceived as belonging to the opponent’s family of marks (assuming the existence of this had been established). In particular, the Board considered that, whereas the claimed ‘series’ depended upon the presence in every case of the suffix ‘-ophtal’ (and not ‘oftal’) preceded by a hyphen, the contested sign did not contain exactly the same suffix nor reflect exactly the same principles of construction. When ‘ophtal’ is combined with ‘Pan-’, ‘Crom-’ and ‘Visc-’, these partly disjointed prefixes become of greater distinctive value, affecting quite significantly the overall impression made by each of the marks as a whole, and in each case providing initial elements quite clearly different from the first half — ‘Alerg’ — of the mark applied for. The German consumer, upon seeing ‘Alergoftal’ would not think of dividing it into two elements, as opposed to being invited to do so when encountering marks made up of two elements separated by a hyphen (paras 14, 18).</p>		
Earlier signs	Contested sign	Case No
TIM OPHTAL, SIC OPHTAL, LAC OPHTAL etc.	OFTAL CUSI	14/07/2011, T-160/09

G&S: Class 5

Territory: EU

Assessment: the element 'Ophtal', which denotes ophthalmologic preparations, is a weak element in the family of marks. The elements TIM, SIC and LAC are the distinctive elements (paras 92-93).

The finding that a particular mark forms part of a family of marks requires that the **common component of the signs is identical or very similar**. The signs must contain the same distinctive element, and this element must play an independent role in the sign as a whole. Minor graphical differences in the common component may not exclude an assumption of a series of marks, when these differences may be understood by the public to be a modern presentation of the same product line. In contrast, letters that are different from or additional to the common component generally do not allow an assumption of a family of marks.

Normally, the **common element that characterises the family appears in the same position within the marks**. Therefore, the same (or very similar) element appearing in the same position in the contested sign will be a strong indicator that the later mark could be associated with the opponent's family of marks. However, the common element appearing in a different position in the contested sign weighs heavily against such an association being established in the consumers' minds. For example, the contested sign ISENBECK is not likely to be associated with a family of BECK- marks where the element BECK is at the beginning of the signs making up the family.

Earlier signs	Contested sign	Case No
UNIZINS, UNIFONDS and UNIRAK	UNIWEB	16/06/2011, C-317/10 P
<p>G&S: Class 36 (<i>financial services</i>)</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> in this judgment the Court annulled a decision of the GC since it had not duly assessed the structure of the marks to be compared, nor the influence of the position of their common element on the perception of the relevant public (para. 57).</p>		

Examples where the Boards considered that a family of marks had been established

Earlier signs	Contested sign	Case No
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UniSECTOR UniSTARTUP UniSTRATEGIE	uni-gateway	05/03/2009, R 31/2007-1
<p>G&S: Class 36 (<i>financial services</i>)</p> <p>Territory: Germany</p> <p>Assessment: the Board considered that the opponent had in fact submitted sufficient evidence, by submitting, in particular, references from the relevant specialist press, such as FINANZtest, and by referring to its considerable 17.6 % market share of 'Uni' investment funds amongst German fund management companies, to show that it uses the prefix 'UNI' for a number of well-known investment funds. There is a likelihood of confusion from the point of view of the family of trade marks since the relevant trade circles would include in the series the trade mark applied for, since it is constructed in accordance with a comparable principle (paras 43-44).</p>		
Earlier signs	Contested sign	Case No
UNIFIX, BRICOFIX, MULTIFIX, CONSTRUFIX, TRABAFIX, etc.	ZENTRIFIX	11/09/2008, R 1514/2007-1
<p>G&S: Classes 1, 17 and 19 (<i>adhesives</i>)</p> <p>Territory: Spain</p> <p>Assessment: the Board considered that the opponent had proven the existence of a family of marks. Firstly, the Board discarded that the common element 'FIX' would be non-distinctive, given that it is not a Spanish word and even its Spanish meaning 'fijar' is not one that spontaneously comes to mind to average Spanish consumers in the context of glues and adhesives, since verbs like 'pegar', 'encolar' or 'adherir' are used more regularly in this context. Secondly, the opponent duly proved that all the marks forming the family are being used. Invoices and promotional literature duly show that goods bearing these marks are available to consumers on the market. Consumers, therefore, are aware that there is a family of marks. Thirdly, ZENTRIFIX has characteristics that replicate those of the trade marks in the family. The FIX element is placed at the end; the element that precedes it alludes to something that has some relevance to glues; the two elements are juxtaposed without any punctuation signs, dashes or physical separation; the typeface used for the two elements is the same (paras 43-44).</p>		
Earlier signs	Contested sign	Case No
CITIBANK, CITIGOLD, CITICORP, CITIBOND, CITICARD, CITIEQUITY, etc.	CITIGATE	30/04/2009, R 821/2005-1 (confirmed 26/09/2012, T-301/09, EU:T:2012:473)

G&S: Classes 9, 16 (potentially finance-related goods)

Territory: EU

Assessment: the Board considered that the evidence — consisting in particular of extracts from the opponents' websites, annual reports, press advertisements and so forth — is littered with references to the trade marks CITICORP, CITIGROUP, CITICARD, CITIGOLD, CITIEQUITY. The evidence demonstrates that CITIBANK is in the nature of a 'house mark' or basic brand and that the opponents have developed a whole series of sub-brands based on the CITI concept. The contested mark CITIGATE is the sort of mark that the opponents might add to their portfolio of CITI marks, in particular if they wished to offer a new service to customers and place the emphasis on the idea of access (paras 23-24).

3 Coexistence of Conflicting Marks on the Market in the Same Territory

The EUTM applicant may claim that the conflicting trade marks coexist in the relevant territory. Usually the coexistence argument comes up when the applicant owns a national trade mark corresponding to the EUTM application in the territory where the opposing trade mark is protected. The applicant may also refer to coexistence with a trade mark owned by a third party.

Therefore, two different situations, both referred to as 'coexistence' by the parties, should be distinguished:

- coexistence between the two marks involved in the opposition can be persuasive of the absence of a likelihood of confusion in the relevant public's perception (see below);
- where many similar marks (other than the two marks involved in the opposition) are used by competitors, the coexistence may affect the scope of protection of the earlier right. See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark.

3.1 Coexistence between the marks involved in the opposition

In opposition proceedings, it is most commonly argued by the EUTM applicant that the conflicting marks coexist on a national level and that the coexistence is tolerated by the opponent. Occasionally, it is argued that coexistence is accepted by the parties in a coexistence agreement.

The possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public (03/09/2009, C-498/07 P, La Española, EU:C:2013:302, § 82). In certain cases, the coexistence of earlier marks in the market could reduce the likelihood of confusion that the Office finds

between two conflicting marks (11/05/2005, T-31/03, Grupo Sada, EU:T:2005:169, § 86).

However, the indicative value of coexistence should be treated with **caution**. There might be different reasons why the two signs coexist on a national level, for example, a different legal or factual situation in the past or prior rights agreements between the parties involved.

Therefore, whilst the impact of coexistence on the finding of likelihood of confusion is accepted in theory, the conditions for this coexistence to be persuasive of the absence of a risk of confusion are, in practice, very difficult to establish and seldom prevail.

For the EUTM applicant to prove that the coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public, certain conditions must be met.

- **Comparable situation.** The earlier ('coexisting') marks and the marks at issue are **identical** to those involved in the opposition before the Office (11/05/2005, T-31/03, Grupo Sada, EU:T:2005:169, § 86; 18/09/2012, T-460/11, Bürger, EU:T:2012:432, § 60-61) and cover the same goods or services as those in conflict (30/03/2010, R 1021/2009-1, ECLIPSE / ECLIPSE (fig.), § 14).
- The coexistence concerns the relevant **countries** in the case (e.g. alleged **coexistence in Denmark is irrelevant when the opposition is based on a Spanish** trade mark; 13/07/2005, T-40/03, Julián Murúa Entrena, EU:T:2005:285, § 85). If the earlier trade mark is an EUTM, the EUTM applicant must show coexistence in the entire EU.
- Only coexistence in the **marketplace** can be taken into account. The mere fact that both trade marks exist in the national register (formal coexistence) is insufficient. The EUTM applicant has to prove that the trade marks were **actually used** (13/04/2010, R 1094/2009-2, BUSINESS ROYALS (fig.) / ROYALS (fig.), § 34). Coexistence should be understood as 'co-use' of concurrent and supposedly conflicting marks (08/01/2002, R 360/2000-4, NO LIMITS / LIMMIT, § 13; 05/09/2002, R 1/2002-3, CHEE.TOS / Chitos, § 22).
- The **period of coexistence** must be taken into consideration: in the judgment of 01/03/2005, T-185/03, Enzo Fusco, EU:T:2005:73, the alleged coexistence of only 4 months was considered obviously too short. Moreover, the coexistence of the trade marks has to relate to a period close to the filing date of the EUTM application (12/05/2010, R 607/2009-1, ELSA ZANELLA (fig.) / ZANELLA et al., § 39).
- The absence of a likelihood of confusion may be only inferred from the '**peaceful**' nature of the coexistence of the marks at issue on the market concerned (03/09/2009, C-498/07 P, La Española, EU:C:2013:302, § 82; 08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 74; 24/11/2005, T-346/04, Arthur et Félicie, EU:T:2005:420, § 64). This is not the case when the conflict has been an issue before the national courts or administrative bodies (infringement cases, oppositions or applications for annulment of a trade mark).
- Moreover, the peaceful coexistence of the trade marks in the relevant national market does not outweigh the likelihood of confusion if it is based on prior rights agreements between the parties, including agreements settling disputes before

national courts, since these agreements, even if based on the assessment of the legal situation made by the parties, may have purely economic or strategic reasons.

However, exceptional situations are possible. In its preliminary ruling of 22/09/2011, C-482/09, Budweiser, EU:C:2011:605, the Court of Justice ruled that two identical trade marks designating identical goods can coexist on the market to the extent that there has been a long period of **honest concurrent use** of those trade marks and that use neither has nor is liable to have an adverse effect on the essential function of the trade mark, which is to guarantee consumers the origin of the goods and services.

As regards **coexistence agreements** between the parties, when assessing likelihood of confusion, the Office's policy is that these agreements may be taken into account like any other relevant factor, but they are **in no way binding on the Office**. This is particularly true when the application of the relevant provisions of the EUTMR and the established case-law lead to a conclusion that is not in accordance with the content of the agreement.

If an agreement is disputed before national instances or there are pending court proceedings and the Office estimates that the outcome could be relevant for the case at issue, it may decide to suspend the proceedings.

In addition, as a general rule, nothing precludes the opponent from filing an opposition against an EUTM application, whether or not it previously opposed other (national) marks of the applicant. This cannot be considered as 'contradictory behaviour' and interpreted to the opponent's disadvantage, especially since in opposition proceedings, unlike invalidity proceedings, the defence of 'acquiescence' is not available (the rules for opposition proceedings do not contain an equivalent to Article 61 EUTMR, according to which an EUTM proprietor may invoke as a defence the fact that the applicant for invalidity has acquiesced to the use of the EUTM for more than 5 years).

4 Incidences of Actual Confusion

Likelihood of confusion means a **probability** of confusion on the part of the relevant consumer and does not require **actual** confusion. As expressly confirmed by the Court: '... it is not necessary to establish the existence of actual confusion, but the existence of a likelihood of confusion' (24/11/2005, T-346/04, Arthur et Félicie, EU:T:2005:420, § 69).

In the global assessment of likelihood of confusion, all relevant factors have to be taken into consideration. Evidence of actual confusion is a factor that may weigh in favour of likelihood of confusion; its indicative value should not, however, be overestimated for the following reasons:

- in everyday life there are always people who confuse and misconstrue everything, and others who are extremely observant and very familiar with every trade mark. Therefore, there is no legal value in highlighting the existence of these people since it could lead to subjective results;

- insofar as the targeted consumer's perception is concerned, the assessment is normative. The average consumer is assumed to be 'reasonably well informed and reasonably observant and circumspect', even though in purely factual terms some consumers are extremely observant and well informed, whilst others are careless and credulous (10/07/2007, R 40/2006-4, SDZ DIRECT WORLD / SAZ, § 32).

Therefore, incidences of actual confusion can influence the finding of likelihood of confusion only if it is proven that these incidences usually accompany the existence of the conflicting trade marks in the market in the typical situation in trade involving the goods and/or services concerned.

To properly weigh evidence on the number of occasions when actual confusion has arisen, the assessment must be made in the light of the number of opportunities for confusion. If the business transactions are voluminous but the instances of confusion are sparse, this evidence will have little weight in the assessment of likelihood of confusion.

Lack of actual confusion has been treated in the context of coexistence, in paragraph 3 above.

5 Prior Decisions by EU or National Authorities Involving Conflicts Between the Same (or Similar) Trade Marks

5.1 Prior Office decisions

As regards previous decisions of the Office in conflicts between identical or similar trade marks, the General Court has stated that:

... it is settled case-law ... that the legality of the decisions of the [Office] is to be assessed purely by reference to [the EUTMR] and not the Office's practice in earlier decisions.

(30/06/2004, T-281/02, Mehr für Ihr Geld, EU:T:2004:198, § 35.)

Accordingly, the Office is **not bound by its previous decisions**, since each case has to be dealt with separately and with regard to its particularities.

Notwithstanding the fact that previous decisions of the Office are not binding, their reasoning and outcome should still be **duly considered** when deciding upon the case in question. This was reinforced in the judgment of 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 73-75:

The Office is under a duty to exercise its powers in accordance with the general principles of European Union law, such as the principle of equal treatment and the principle of sound administration.

In the light of those two principles, the Office must, when examining an application for registration of a European Union trade mark, take into account the decisions already

taken in respect of similar applications and consider with special care whether it should decide in the same way or not ...

That said, the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality.


The indicative value of the previous decisions will in principle be limited to cases that bear a sufficiently close resemblance to the case in question. However, according to Article 95(1) EUTMR, in opposition proceedings the Office is restricted in the examination of the case to the facts, evidence and arguments submitted by the parties. For this reason, even in cases based on comparable facts and involving similar legal problems, the outcome may still vary due to the different submissions made by the parties and the evidence they present.

5.2 Prior national decisions and judgments

Decisions of national courts and of national offices in cases regarding conflicts between identical or similar trade marks on the national level **do not have a binding effect** on the Office. According to case-law, the European Union trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it and applies independently of any national system. Accordingly, the registrability of a sign as a European Union trade mark is to be assessed on the basis of the relevant legislation alone (13/09/2010, T-292/08, *Often*, EU:T:2010:399, § 84; 25/10/2006, T-13/05, *Oda*, EU:T:2006:335, § 59).

Therefore, the decisions adopted in a Member State or in a state that is not a member of the European Union are not binding for the Office (24/03/2010, T-363/08, *Nollie*, EU:T:2010:114, § 52).

Still, their reasoning and outcome should be **duly considered**, particularly when the decision has been taken in the Member State that is relevant to the proceedings. National courts have a thorough knowledge of the specific characteristics of their Member State, in particular as regards the marketplace reality in which goods and services are marketed and the customer perception of signs. This may, in particular cases, be relevant for the assessment made by the Office.

Earlier sign	Contested sign	Case No
MURUA		T-40/03

G&S: Class 33

Territory: Spain

Assessment: the Court took into consideration the reasoning of a judgment of the national court as far as it explained the perception of family names on the part of the public in the relevant country: regarding the question whether the relevant public in Spain will generally pay greater attention to the surname 'Murúa' than to the surname 'Entrena' in the trade mark applied for, the Court considers that, while it is **not binding** on EU bodies, Spanish case-law can provide **a helpful source of guidance** (para. 69).

Earlier sign	Contested sign	Case No
	OFTEN	T-292/08

G&S: Class 14

Territory: Spain

Assessment: the Court did not see the relevance of Spanish case-law, according to which an average member of the Spanish public has some knowledge of English for the assessment of the particular case:

In the present case, the applicant has not put forward any factual or legal consideration, deriving from the national case-law relied upon, which is capable of providing helpful guidance for determination of the case The mere finding that certain English words are known to the Spanish consumer, namely the words 'master', 'easy' and 'food', even if that is clear from the national case-law in question, cannot lead to the same conclusion as regards the word 'often' (para. 85).

Whilst it is, in principle, permissible to take into account decisions of national courts and authorities, these decisions should be examined **with all the required care and in a diligent manner** (15/07/2011, T-108/08, Good Life, EU:T:2011:391, § 23). Usually the understanding of such a decision will require the submission of sufficient information, in particular about the facts on which the decision was based. Their indicative value will therefore be limited to the rare cases when the factual and legal background of the case was presented completely in the opposition proceedings and is conclusive, clear and not disputed by the parties.

The above guidelines are without prejudice to the effects of the judgments of EUTM courts dealing with counterclaims for revocation or for a declaration of invalidity of EUTMs.

6 Irrelevant Arguments for Assessing Likelihood of Confusion

6.1 Specific marketing strategies

The examination of the likelihood of confusion carried out by the Office is a prospective examination. In contrast to trade mark infringement situations — where the courts deal with specific circumstances in which the particular facts and the specific nature of use of the trade mark are crucial — the deliberations of the Office on likelihood of confusion are carried out in a more abstract manner.

For this reason, specific marketing strategies are not relevant. The Office must take the usual circumstances in which the goods covered by the marks are marketed as its benchmark, that is, those circumstances that are expected for the category of goods covered by the marks. The particular circumstances in which the goods covered by the marks are actually marketed have, as a matter of principle, no impact on the assessment of the likelihood of confusion because they may vary in time depending on the wishes of the proprietors of the trade marks (15/03/2007, C-171/06 P, *Quantum*, EU:C:2007:171, § 59; 22/03/2012, C-354/11 P, G, EU:C:2012:167, § 73; 21/06/2012, T-276/09, *Yakut*, EU:T:2012:313, § 58).

For example, the fact that one party offers its everyday consumer goods (wines) for sale at a higher price than competitors is a purely subjective marketing factor that is, as such, irrelevant when assessing the likelihood of confusion (14/11/2007, T-101/06, *Castell del Remei Oda*, EU:T:2007:340, § 52).

6.2 Reputation of EUTM application

Applicants sometimes argue that there will be no likelihood of confusion with the earlier mark because the EUTM application has a reputation. This argument cannot prosper because the right to an EUTM begins on the date when the EUTM application is filed and not before, and it is from that date onwards that the EUTM has to be examined with regard to opposition proceedings. Therefore, when considering whether or not the EUTM falls under any of the relative grounds for refusal, events or facts that happened before the filing date of the EUTM are irrelevant because the opponent's rights, insofar as they predate the EUTM, are earlier than the applicant's EUTM.

***GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)***

Part C

Opposition

Section 2

Double identity and likelihood of confusion

Chapter 7

Global assessment

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1 Introduction

A likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. If a significant part of the relevant public of the goods or services at issue may be confused as to the origin of the goods or services, this is sufficient. Therefore, there is no need to establish that all actual or potential consumers of the relevant goods or services are likely to be confused.

The Court has stated that likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case; this appreciation depends on numerous elements and, in particular, on the degree of recognition of the mark on the market, the association that the public might make between the two marks and the degree of similarity between the signs and the goods and services (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

The Office normally examines the most salient and habitually relevant factors relating to likelihood of confusion and establishes their degrees:

1. similarity of the goods and services;
2. the relevant public and the level of attention;
3. similarity of the signs taking into account their distinctive and dominant elements;
4. the distinctiveness of the earlier mark.

In the last section of a decision containing the global assessment, those factors are weighed up. However, the global assessment can weigh up many other factors that are relevant to deciding on likelihood of confusion (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 6, Other Factors).

2 Interdependence Principle

The Court has set out the essential principle that evaluating likelihood of confusion implies some **interdependence between the relevant factors** and, in particular, between the previously established findings on the degree of similarity between the marks and that between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17). This principle of interdependence is crucial to the analysis of likelihood of confusion.

The interdependence of those factors is expressly referred to in recital 8 in the Preamble to the EUTMR, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends on numerous elements and, in particular, on the recognition of the mark on the market, the association that can be made with the used or registered sign, the degree of

similarity between the mark and the sign and that between the goods or services identified (10/09/2008, T-325/06, Capio, EU:T:2008:338, § 72 and case-law cited).

The requirement for a global assessment and the principle of interdependence means that where there is at least some degree of similarity between the signs and the relevant goods/services, there will be an assessment of likelihood of confusion involving an iterative process that weighs up all the relevant factors. This process takes place in the global assessment section.

In practice, this means that the **Office will weigh up**, inter alia, the degree of similarity between the goods and services and the degree of attention paid by the relevant public to those goods and services, the degree of similarity between the signs, and whether the impression produced by any one of the levels of comparison (visual/aural/conceptual) is more important, and the distinctiveness of the earlier mark.

The outcome depends on the particularities of each case, but as a rule of thumb it can be said that when there is an average degree of similarity between the signs and between the goods or services, the degree of attention of the relevant public is average and the earlier trade mark has a normal distinctiveness, there will be a likelihood of confusion. However, the lower the degree of one factor, the higher the degree of other factors must be in order to find a likelihood of confusion (bearing in mind that the likelihood of confusion is inversely affected by an increased degree of attention of the relevant public). Therefore, on the basis of an average degree of distinctiveness of the earlier mark and an average degree of attentiveness of the public, the finding of a likelihood of confusion may be justified when the signs are identical or highly similar, despite a low degree of similarity between the goods and/or services. However, such a finding is more difficult on the basis of a limited distinctiveness of the earlier mark and/or when the level of attention of the public is higher than average. Where the degrees of similarity of the marks are different in each aspect of comparison (visual, phonetic and conceptual), it has to be taken into account whether one aspect is more important for the public when purchasing the goods.

Moreover, the factors to be taken into account and their importance in the global assessment **will vary** according to the particular circumstances. For example, in clear-cut cases where the goods/services and the signs are highly similar or identical, the Office may find a likelihood of confusion without assessing all factors — such as enhanced distinctiveness, family of marks, etc.

Importantly, it is not possible to set out in the abstract whether one factor carries more weight than another, because these factors will have varying degrees of relative importance depending on the circumstances. For instance, the degree of visual similarity may weigh more heavily in connection with goods that are usually examined visually, whilst the degree of aural similarity may be more relevant to goods normally ordered orally (see paragraph 4 below).

3 Imperfect Recollection

Although the average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect, account is taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Even consumers with a high level of attention need to rely on their imperfect recollection of trade marks (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 54).

4 Impact of the Method of Purchase of Goods and Services

The Court has stated that, when evaluating the importance attached to the degree of visual, aural and conceptual similarity between the signs, it is appropriate to take into account the category of goods or services in question and the way they are marketed (22/09/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 27).





The category of goods and services involved may increase the importance of one of the different aspects of similarity between signs (visual, phonetic and conceptual) because of how goods and services are ordered and/or purchased. An aural or conceptual comparison between signs may be less important in the case of goods and services that are usually examined visually or may be tried on before being bought. In such cases, the visual impression of signs counts more in the assessment of likelihood of confusion.

However, it is important to emphasise that, as with all of the factors that are relevant to likelihood of confusion, the factors are interlinked and each set of circumstances must be examined on a case-by-case basis. This means that no general rule should be applied to broad categories of goods or services.

4.1 Visual similarity

A good example of where visual similarity can play a greater — but not an exclusive — role in the global assessment of the likelihood of confusion is *clothing*. Generally, in clothing shops, customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (14/10/2003, T-292/01, Bass, EU:T:2003:264, § 55; 06/10/2004, T-117/03-T-119/03 & T-171/03, NL, EU:T:2004:293, § 50; 18/05/2011,

T-502/07, McKenzie, EU:T:2011:223, § 50; 24/01/2012, T-593/10, B, EU:T:2012:25, § 47). These considerations played a role in finding no likelihood of confusion between the marks below for, inter alia, certain goods in Class 25.


Earlier sign	Contested sign	Case No
		T-502/07
		T-593/10

The same considerations were central to a finding of likelihood of confusion in the following cases also for, inter alia, certain goods in Class 25.

Earlier sign	Contested sign	Case No
		09/06/2009, R 1050/2008-4
PETER STORM	PEERSTORM	08/07/2010, T-30/09, EU:T:2010:298
		18/05/2011, T-376/09, EU:T:2011:225

However, granting preferential consideration to the visual perception does not mean that identical verbal elements can be overlooked due to the presence of striking figurative elements, as can be seen in the case below, where likelihood of confusion was found for goods in Class 25.

Earlier sign	Contested sign	Case No
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	FISHBONE	29/09/2011 T-415/09, EU:T:2011:550 (appeal 18/07/2013, C-621/11 P, EU:C:2013:484, dismissed)
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In a similar way, the visual impression for marks covering *video games* has also been held to be particularly relevant because these goods are normally purchased after a comprehensive examination of their respective specifications and technical characteristics, firstly upon the basis of information that appears in specialist catalogues or on the internet, and then at the point of sale. For these reasons, the visual differences were key to the finding of no likelihood of confusion below (08/09/2011, T-525/09, Metronia, EU:T:2011:437, § 38-47).

Earlier sign	Contested sign	Case No
		T-525/09

The visual similarity between signs may also have an increased importance where the goods are **ordinary consumer products** (e.g. goods in Classes 29 and 30) that are most commonly purchased in supermarkets or establishments where goods are arranged on shelves and where consumers are guided more by the visual impact of the mark they are looking for. Consequently, for such goods the visual differences were central to a finding of no likelihood of confusion in the United Kingdom between the marks below.

Earlier sign	Contested sign	Case No
	EGLÉFRUIT	15/04/2010, T-488/07, EU:T:2010:145

However, the broad principle above does not mean that for goods that are normally purchased visually, the phonetic impression can be overlooked. This latter point was highlighted in a case involving the marks below where the General Court, confirming the finding of a likelihood of confusion, held that although *computers and computer*

accessories are sold to consumers ‘as seen’ on shelves in self-service areas, the phonetic identity between the marks at issue was, in this case, at least as important as their visual similarity because an oral discussion of the characteristics of the goods and their mark is also likely to take place at the time of purchase. Furthermore, those goods could be advertised orally, on radio or by other consumers.

Earlier sign	Contested sign	Case No
CMORE		23/09/2011, T-501/08, EU:T:2011:527

4.2 Aural similarity

In contrast to the cases above, where visual similarity played a stronger role, similarity on the phonetic level may have more weight than similarity on the visual level when the goods or services at issue are, in a significant amount of cases, also ordered orally.

Where goods are ordered orally, the phonetic perception of the sign may also be influenced by factors such as the likely presence of various other sounds perceived by the recipient of the order at the same time. Such considerations are relevant where the goods in question are normally ordered at sales points with an increased noise factor, such as **bars or nightclubs**. In such cases, attaching particular importance to the phonetic similarity between the signs at issue may be appropriate. These considerations came into play in the finding of likelihood of confusion between the marks below for certain goods in Class 33 (15/01/2003, T-99/01, *Mystery*, EU:T:2003:7, § 48).

Earlier sign	Contested sign	Case No
MIXERY		T-99/01

Nevertheless, the broad principle above does not mean that the visual impression can be overlooked for goods normally purchased orally. Indeed, the General Court has held that although preponderant importance had sometimes been accorded to the phonetic perception of marks for beverages, the phonetic dissimilarities of the marks did not merit particular importance where the specific beverages were widely distributed and sold not only in specialist shops, where they would be ordered orally, but also in large shopping centres, where they would be purchased visually (03/09/2010, T-472/08, 61 *a nossa alegria*, EU:T:2010:347, § 106).

4.3 Conclusion



The circumstances set out above demonstrate that in certain situations the Office should grant preferential consideration to the visual or aural perception of marks depending on how the goods and services at issue are ordered or purchased. However, identical or highly similar visual or aural elements cannot be entirely overlooked even in these situations because all the relevant factors are interlinked and interdependent, and each set of circumstances must be examined on a case-by-case basis.

5 Impact of the Result of the Conceptual Comparison on the Likelihood of Confusion

5.1 The impact of conceptual identity or similarity

A conceptual **similarity** between signs with **analogous** semantic content may give rise to a likelihood of confusion where the earlier mark is particularly distinctive (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24, where the signs shared the broader concept of a 'bounding feline', but did not evoke the same animal: a puma in the earlier mark and a cheetah in the contested mark).

However, exceptionally, where the signs have the **same** distinctive concept in common accompanied by visual similarities between the signs, this may lead to a likelihood of confusion even in the absence of a particularly high distinctiveness of the earlier mark, as illustrated by the following example.


Earlier sign	Contested sign	Case No
		14/12/2006, T-81/03, T-82/03 & T-103/03, EU:T:2006:397

G&S: Classes 32, 33

Territory: Spain (where 'venado' means 'deer')

Assessment: The Court found that the signs had the same concept and that there was significant visual similarity. In the absence of a clear semantic link between a deer or a deer's head and alcoholic or non-alcoholic beverages, the Court found it impossible to deny that the concept of a deer's head portrayed facing forward inside a circle had at least average distinctive character for designating beverages (para. 110). Enhanced distinctiveness was not considered — likelihood of confusion (for the Spanish public).

A conceptual similarity between the signs may not be sufficient to outweigh the visual and phonetic differences where the concept in common is non-distinctive.

Earlier sign	Contested sign	Case No
K2 SPORTS		31/01/2013, T-54/12, EU:T:2013:50

G&S: Classes 18, 25, 28

Territory: Germany and the United Kingdom

Assessment: Contrary to the Board's finding that there is no conceptual similarity, the term 'sport', notwithstanding its descriptive character, refers to the same concept and leads to the conclusion that there is a degree of conceptual similarity. The Court concluded that this similarity was weak in the context of the overall impression of the signs and in particular of the very weak distinctive character of this term. However, the weak conceptual similarity did not offset the significant visual and phonetic differences between the signs (para. 49) — no likelihood of confusion.

5.2 The impact of conceptual difference

According to case-law, where one of the signs at issue has a clear and specific meaning that can be grasped immediately and the other has none, or where both signs have such a clear and specific meaning and these meanings are different, such conceptual differences between the signs may counteract their visual and phonetic similarity (12/01/2006, C-361/04, Picaro, EU:C:2006:25, § 20). According to Office practice, when a similarity is found in one aspect (visual/phonetic/conceptual), the examination of likelihood of confusion must continue ⁽⁵²⁾. Therefore, the question whether the conceptual difference is sufficient to counteract the visual and/or phonetic

⁵² See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 1.3.

similarity between the marks has to be examined in the global assessment of the likelihood of confusion.

Where none of the signs as a whole has a clear and specific meaning, any conceptual difference between the signs that may result from a vague concept that the sign may evoke may be insufficient to neutralise the visual and phonetic similarities.

Earlier sign	Contested sign	Case No
MUNDICOLOR	MUNDICOR	17/03/2004, T-183/02 & T-184/02, EU:T:2004:79
<p>G&S: Class 2</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> Whilst 'MUNDICOLOR' is to a certain extent evocative of 'colours of the world' or 'the world in colours' for the Spanish public, it cannot be regarded as having any clear and specific meaning. In the mark applied for, the same prefix is accompanied by the suffix 'cor', a term which has no meaning in the Spanish language. Therefore, notwithstanding the evocative nature of the prefix 'mundi' (world), the latter is ultimately devoid of any concept for that public. As neither of the signs has a clear and specific meaning likely to be grasped immediately by the public, any conceptual difference between them is not such as to counteract their visual and aural similarities (paras 90-99) — likelihood of confusion.</p>		

6 Impact on Likelihood of Confusion of Components that are Non-Distinctive or Distinctive Only to a Low Degree

When assessing the similarity of the signs, an analysis of whether the coinciding components are descriptive, allusive or otherwise weak is carried out in order to calculate the extent to which these coinciding components have a lesser or greater capacity to indicate commercial origin. It may be more difficult to establish that the public may be confused as to origin due to similarities that solely pertain to non-distinctive elements⁽⁵³⁾.

The Office and a number of trade mark offices of the European Union have agreed on a **Common Practice** under the European Trade Mark and Designs Network with regard to the impact on likelihood of confusion of components that are non-distinctive or distinctive only to a low degree.


⁵³ See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark.

6.1 Common components with a low degree of distinctiveness

According to the Common Practice ⁽⁵⁴⁾, when the marks share an element with a **low degree of distinctiveness**, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks, as previously assessed in the comparison of signs. That assessment takes into account the similarities/differences and distinctiveness of the non-coinciding components.


A coincidence in an element with a low degree of distinctiveness **will not normally on its own lead to likelihood of confusion**. However, there may be likelihood of confusion if the other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar. There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.


No likelihood of confusion was found in the following examples.

Earlier sign	Contested sign	Case No
	TORO XL	24/05/2012, T-169/10, EU:T:2012:261
<p><i>G&S: Class 33 Alcoholic beverages</i></p> <p><i>Territory: EU.</i></p> <p><i>Assessment:</i> The coinciding letters 'XL' have a low degree of distinctiveness for the goods in question. 'XL' is an abbreviation of extra-large size used within the whole EU. For the goods in question, namely <i>alcoholic beverages</i>, the public is likely to associate it with an extra quantity of a drink (paras 34, 35). The word element TORO is distinctive (para. 42).</p> <p>The marks are visually, and phonetically dissimilar (paras 46, 48) and there is only a weak conceptual similarity (para. 52). The likelihood of confusion is excluded (para. 57)</p>		

Earlier sign	Contested sign	Case No
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⁵⁴ For the purposes of the Common Practice, all the other factors that may be relevant for the global appreciation of likelihood of confusion are deemed not to affect the outcome. It is also considered that the goods and services are identical.

ZITRO SPIN BINGO,		29/01/2015, T-665/13, EU:T:2015:55
<p>G&S: Classes 9, 41, 42 in relation to <i>games</i></p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The word 'bingo' is descriptive of the corresponding game of chance, the English word 'spin' alludes to a rotating object or to the action of spinning something (para. 36).</p> <p>The Court confirmed the Board's finding that there was a low degree of visual, aural and conceptual similarity between the signs at issue, despite the fact that they contain the expression 'spin bingo'. On a visual level, the degree of similarity is low because, regarding the earlier sign, the public would pay attention to the more distinctive element 'zitro', which is devoid of any meaning in the relevant languages and is at the beginning of the sign. Concerning the contested sign, consumers will pay as much attention to the different colour elements of the device which are the circles and the reel on which there is a representation of a smiling face. On the aural level, the similarity was weak as well in the light of the descriptive meaning of the expression 'spin bingo', and the fact that the public will pay attention to the more distinctive element 'zitro'. On the conceptual level, the word 'zitro' was dominant and was not conceptually similar to the contested sign (paras 11, 44). There is no likelihood of confusion.</p>		

Earlier sign	Contested sign	Case No
	CLUB GOURMET	28/07/2011, R-1946/2010-1, confirmed 20/03/2013, T-571/11, appealed, 06/02/2014, C-301/13 P

G&S: Classes 16, 21, 29, 30, 32, 33

Territory: Spain

Assessment: The conflicting signs only share the two words 'CLUB' and 'GOURMET'. However, they differ in all their other characteristics. First, the dominant and distinctive element of the earlier sign is not reproduced in the contested sign. Second, the verbal element 'CLUB GOURMET' differs from the verbal element 'CLUB DEL GOURMET': the earlier sign has fourteen letters (whilst the contested sign has eleven) and it is separated by the word 'DEL' and followed by a comma. Finally, they differ with respect to the following aspects: the number of words (seven for the earlier sign, two for the contested sign), the use of punctuation marks (';' and '...' in the earlier sign), the triangle (which is absent in the contested sign and contains no figurative element at all) and the font (which is partly stylised in the earlier sign). The common elements 'CLUB' and 'GOURMET' only have a weak distinctive character in relation to the goods and services at issue. Indeed, there exists, for the relevant consumer, a strong conceptual link between the verbal element 'CLUB DEL GOURMET' and the goods provided for by the opponent's services, which mainly consist of food and beverages. In the consumer's mind, 'GOURMET' refers to the idea of a connoisseur or lover of good food or a person with a discerning palate, that is to say, someone who appreciates good food and drink. Although it sounds and is of French origin, the meaning will be immediately grasped by the Spanish consumer (paras 39, 40).

In the following example there was a likelihood of confusion because other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar.

Earlier sign	Contested sign	Case No
		11/02/2015, T-395/12, EU:T:2015:92

Territory: United Kingdom

G&S: Class 19.

Assessment: The word element 'solid floor' of the earlier mark is only of weak distinctive character (para. 32), but the differentiating element in the contested sign, 'The professional's choice', will be perceived by the relevant public as a clearly laudatory and banal slogan with no trade mark connotations that would allow them to perceive it as a badge of origin (para. 34) and the figurative elements of the signs at issue are limited (para. 35).

There is a [average] visual similarity and a high degree of phonetic and conceptual similarity (paras 36, 38, 40).

There is a likelihood of confusion for identical and similar goods, namely *building materials, not of metal, parquet flooring of plastic and wood, flooring of wood, cork and laminate; subfloors; transportable floors, not of metal.*

There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.

Earlier sign	Contested sign	Case No
waterPerfect	AquaPerfect	28/01/2015, T-123/14, EU:T:2015:52
<p><i>G&S:</i> Class 7</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> while the element 'Perfect' has a laudatory character, the fact remains that none of the other elements in the signs can be considered to have a greater distinctive character or be dominant. The elements 'aqua' and 'water' also have a weak distinctive character owing to the fact that they will be perceived by the relevant public as meaning 'water' and the goods covered all involve, in one way or another, <i>water</i> (para. 42). Visually and phonetically, the similarity of the signs at issue is not limited to the presence of the term 'perfect' within each of those two signs, since those signs also have the same length and the same number of syllables, that are identically stressed, and an almost identical sequence of vowels; based on an overall impression, the similar elements between the signs referred to prevail globally over the dissimilar elements (paras 28, 32). The signs were found visually, phonetically and conceptually similar to an average degree (paras 32-33, 40).</p>		


Further (invented) examples, agreed upon in the context of the Common Practice, where the common component(s) is/are considered to possess a low degree of distinctiveness can be found in the documents related to **CP 5. Relative Grounds — Likelihood of Confusion** ⁽⁵⁵⁾.

6.2 Common components with no distinctiveness

According to the Common Practice, when marks share an element with **no distinctiveness**, the assessment will focus on the impact of the non-coinciding components on the overall impression of the marks. The assessment will take into account the similarities/differences and distinctiveness of the non-coinciding components.



A coincidence only in non-distinctive components **does not lead to likelihood of confusion**. However, when marks also contain other figurative and/or word elements that are similar, there will be likelihood of confusion if the overall impression of the marks is highly similar or identical.

No likelihood of confusion was found in the following example, as the signs coincide solely in a non-distinctive element.

Earlier sign	Contested sign	Case No
		25/02/2016, T-402/14, EU:T:2016:100
<p>G&S: Classes 35, 37, 39, 40, 42</p> <p>Territory: EU</p> <p><i>Assessment:</i> The Court confirmed that the lack of distinctive character of the term 'AQUA' has to be taken into account and that the specialised relevant public will not pay much attention to the descriptive element 'AQUA', the only common element of the conflicting signs (paras 84-85). The figurative elements of the signs are totally different. They are basic but not insignificant, so they must be taken into account in the overall impression of the signs (paras 54-55). There is a low degree of visual similarity. There is a low degree of phonetic and conceptual similarity, even though the different suffixes allow the specialised public to gather a different conceptual content (paras 71-73).</p> <p>The differences between the signs are sufficient to exclude the likelihood of confusion, even for identical services and taking into account that the earlier trade mark, as a whole, has an enhanced distinctiveness (para. 86).</p>		

Likelihood of confusion was found in the following examples because the marks also contain other figurative and/or word elements that are similar, and the overall impression of the marks is highly similar or identical.

⁵⁵ Principles of the common practice CP 5. Relative Grounds — Likelihood of Confusion (Impact of non-distinctive/weak components) <https://www.tmdn.org/network/documents/10181/897c811d-65ca-4779-b91d-636c71de2ec9>, p. 9.

Earlier sign	Contested sign	Case No
		20/07/2016, T-745/14, EU:T:2016:423
<p>G&S: Classes 36, 38</p> <p>Territory: Bulgaria</p> <p><i>Assessment:</i> The Court confirmed that the signs at issue are visually and phonetically highly similar, and conceptually identical, given that they coincide in their word elements, and despite the figurative nature of the signs at issue, the fonts used for the word elements do not make it possible to detect any particular difference between them (para. 28 <i>in fine</i>).</p>		

Earlier sign	Contested sign	Case No
BIOCERT	BIOCEF	10/12/2014 T-605/11, EU:T:2014:1050
<p>G&S: Class 5</p> <p>Territory: Austria</p> <p><i>Assessment:</i> The Court found that although the element 'BIO' is descriptive for the goods in question, the trade marks coincide not only in these three letters, but also in their fourth and fifth letters, 'c' and 'e' (para. 38).</p> <p>The difference in the last letters, 'rt' versus 'f', does not counteract the important similarity arising from the fact that the first five letters at the centre of the two signs, which are of very similar length, are identical (para. 39).</p> <p>There is an average degree of visual and phonetic similarity (paras 40, 46), whereas the conceptual comparison is neutral (para. 48)</p>		

Further (invented) examples agreed in the context of the Common Practice, where the common component(s) is/are considered to possess a low degree of distinctiveness can be found in the documents related to CP 5. Relative Grounds — Likelihood of Confusion ⁽⁵⁶⁾.

⁵⁶ Principles of the common practice CP 5. Relative Grounds — Likelihood of Confusion (Impact of non-distinctive/weak components) <https://www.tmdn.org/network/documents/10181/897c811d-65ca-4779-b91d-636c71de2ec9>, p. 10.

6.3 Distinctiveness of the earlier mark versus distinctiveness of the common component

The abovementioned examples concern the coincidence in a weakly distinctive or non-distinctive element of the marks. The distinctiveness of an element of the mark is a separate question from the assessment of the distinctiveness of the earlier mark as a whole (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark, paragraph 2). The enhanced distinctiveness of the earlier mark does not automatically lead to an enhanced distinctiveness of the common element (e.g. 25/02/2016, T-402/14, AQUALOGY (fig.) / AQUALIA et al., EU:T:2016:100, in paragraph 6.2 above).

However, when the earlier trade mark is entirely contained in the contested EUTM application and recognisable as such, its degree of distinctiveness naturally equals that of the coinciding element, with the following consequences.

The analysis of the cases where the earlier mark is entirely contained in the contested EUTM application cannot follow the principles established in paragraph 6.2 above (Common components with no distinctiveness) but rather those established in paragraph 6.1 (Common components with a low degree of distinctiveness). This is because the Office applies the practice clarified in the judgment of 24/05/2012, C-196/11 P, F1-LIVE, EU:C:2012:314, namely that in proceedings opposing the registration of an EUTM application, the validity of earlier trade marks may not be called into question. Consequently, the elements corresponding to the earlier mark cannot be considered as devoid of distinctive character in the trade mark comparison, but must be deemed to be endowed with some (low/minimal) degree of distinctiveness (see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 3.2.3.5 (Earlier marks, the distinctiveness of which is called into question)).

If the earlier mark contained in the contested EUTM application enjoys enhanced distinctiveness through use despite low inherent distinctiveness, the common element corresponding to that mark cannot be considered distinctive to a low degree and the principles of the Common Practice mentioned in paragraphs 6.1 and 6.2 above do not apply.

Earlier sign	Contested sign	Case No
MINI		23/01/2015, R 596/2014-4, confirmed 10/03/2016, T-160/15, EU:T:2016:137

G&S: Class 12

Territory: United Kingdom

Assessment: The earlier trade mark is reputed for *cars*, and accordingly, it has enhanced distinctive character in the UK. Thus, for the relevant public in the UK, the contested composite sign will be perceived as the widely-known trade mark 'MINI' in combination with the descriptive word 'CARGO'. This is as a direct consequence of the earlier trade mark's repute in the field of motor vehicles (paras 19, 25-26).

7 Specific Cases

7.1 Short signs

As indicated before, the Courts have not exactly defined what a short sign is. However, signs with three or fewer letters/numbers are considered by the Office as short signs.

The General Court held that the global assessment of the likelihood of confusion between signs consisting of a single letter (or a combination of letters not recognisable as a word) **follows the same rules** as that in respect of word signs comprising a word, a name or an invented term (06/10/2004, T-117/03 – T-119/03 & T-171/03, NL, EU:T:2004:293, § 47-48; 10/05/2011, T-187/10, G, EU:T:2011:202, § 49).

In the assessment of the likelihood of confusion it is important to establish the degree of **inherent distinctiveness** of the earlier trade mark, and therefore its scope of protection. See in this respect the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark, paragraph 2.2.3.1.

As to the overall assessment of likelihood of confusion, the Court made it clear that the fact that two trade marks consisting of the same letter (or of the same sequence of letters) are found to be identical from an aural and a conceptual point of view is relevant when it comes to assessing the existence of a likelihood of confusion. In such cases, it is only when the later trade mark causes a **sufficiently different visual impression** that a likelihood of confusion can be safely ruled out (T-187/10, G, EU:T:2011:202, § 60).

Consequently, a likelihood of confusion can be safely excluded when two conflicting signs, albeit containing or consisting of the same single letter or a combination of letters not recognisable as a word, are stylised in a sufficiently different way or contain a sufficiently different figurative element, so that their different overall graphical representation eclipses the common verbal element. See examples in the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 3.4.1.6.

Where the opponent has successfully proven that its earlier mark has acquired enhanced distinctiveness through intensive use or reputation, the impact thereof on the final outcome has to be carefully assessed. Firstly, enhanced distinctiveness on the part of an earlier mark containing or consisting of a single letter or a combination of letters cannot justify a finding of a likelihood of confusion if the overall visual impression of the signs is so different as to safely set them apart. Secondly, if the evidence shows use of a single letter or combination of letters stylised or accompanied by additional figurative elements, the benefit of the resulting broader scope of protection accrues to the form in which it was used and not to the single letter as such or any other stylised variation.

7.2 Name/Surnames

7.2.1 Names




In principle, there are no specific criteria to be taken into account when likelihood of confusion between names is assessed. However, because of the very nature of names and surnames, there are certain aspects that come into play (as will be seen below) that have to be carefully considered and balanced, such as whether a given name and/or surname is common or not in the relevant territory.

7.2.2 Business names in combination with other components

The assessment of the likelihood of confusion may be influenced by the fact that one of the signs contains several verbal elements, where one such element could be seen as a business name, that is to say, indicating a specific trade origin (typically, a company name preceded by the preposition 'by').

In such a situation, either element (i.e. the business name or the element typically indicating the mark designating the line of product) may become more relevant in the overall impression of the sign, even if it has a lower degree of distinctiveness or is visually less prominent. This is because in such a situation, both elements of the sign (i.e. the business name and the mark designating the product line) will in principle play an independent distinctive role even where the distinctiveness *per se* of one of them is lower. On account of this particular configuration of the sign the consumer will perceive the elements independently, as each indicating an aspect of the commercial origin of the goods or services designated by it (e.g. a business name and a mark designating the product line).

Consequently, if the earlier mark is identical (or highly similar) to either element (the business name or the mark designating the product line), even if it is the one that otherwise would be less relevant (e.g. due to its size or due to its lower distinctiveness), there will, in principle, be a likelihood of confusion.

Earlier sign	Contested sign	Case No
		09/04/2014, EU:T:2014:198 T-386/12,
<p>G&S: Classes 32, 38, 39</p> <p><i>Territory:</i> United Kingdom</p> <p><i>Assessment:</i> In the present case, the particular structure of the mark applied for must also be taken into account. As the Opposition Division has pointed out, the presence within the mark applied for of the preposition 'by' will lead the consumer, insofar as they understand the meaning, to think that the mark applied for consists of two brands, the sub-brand 'elite' and the main brand 'Mondariz'. As a consequence, the word 'elite' will not be perceived as a mere denomination of one of the characteristics of the goods and services it designates, but rather as an independent and distinct part of the mark in question. That element is likely to reinforce the similarity between the signs at issue, regardless of the higher or lesser intrinsic distinctiveness of the word 'elite' (para. 107) — likelihood of confusion.</p>		
RICCI		15/09/2016, EU:T:2016:490 T-358/15,
<p>G&S: Classes 3, 25, 35</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> It is also necessary to reject the applicant's argument that the dominant element of the mark applied for is 'roméo has a gun', owing to its initial position and greater size in relation to the word element 'by romano ricci'. The relevant public would not pay attention only to the first word element of the mark applied for, but would seek to supplement it, inasmuch as it gave the impression of the title of, or citation from, an artistic work. The word element 'by romano ricci' thus has the effect, as the Board of Appeal stated in paragraph 31 of the contested decision, of giving further meaning to the first word element of the earlier mark RICCI, which confers on it an independent distinctive position. Furthermore, the Office is correct in submitting that it is usual in the field of fashion as regards personal care items and high fashion clothing to refer to the designer or source of a product, using the same format as that used by the mark applied for. In that field, the designer or source of a product, in particular, is likely to play a more important role for the relevant public than for other categories of goods. Therefore, the word element 'romano ricci' is of such a nature as to be perceived as the mark of the house, while the element 'roméo has a gun' will be perceived as the sign identifying a particular line of goods or services among a wider range of goods and services offered by the applicant (para. 46) — likelihood of confusion.</p>		

7.2.3 First and family names


The perception of signs made up of personal names may vary from country to country within the European Union. Family names have, in principle, a higher intrinsic value as indicators of the origin of goods or services than first names. This is because common experience shows that the same first names may belong to a great number of people who have nothing in common, whereas the presence of the same surname (provided it is not common in the relevant territory) could imply the existence of some link between them (identity of the persons or a family link). In determining whether, in a particular country, the relevant public generally attributes greater distinctiveness to the surname than the forename, the case-law of that country, although not binding on the Office or the EU courts, may provide useful guidelines (01/03/2005, T-185/03, Enzo Fusco, EU:T:2005:73, § 52).

There are instances where the applicants invoke, as a defence, their right to use their name. However, such arguments are not valid in opposition proceedings, since it does not influence the issue of whether there will be likelihood of confusion on the part of the public. Furthermore, the registration of trade marks does not hinder the use of names of natural persons, due to the special protection provided by Article 14(1)(a) EUTMR and the relevant national trade mark laws according to Article 14(1)(a) of the Trade Mark Directive.

- First name against the same first name or slight variations thereof

The rule of thumb is that when two conflicting signs consist exclusively of the same first name, consumers are likely to perceive the similar/identical goods/services marketed under those marks as coming from the same source. It is clear that in the absence of any differentiating element, **likelihood of confusion** is the necessary conclusion.

Earlier sign	Contested sign	Case No
GIORDANO	GIORDANO	16/12/2009, T-483/08, EU:T:2009:515
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> Portugal</p> <p><i>Assessment:</i> The two word marks at issue are identical, which increases the likelihood that consumers might perceive the goods marketed under those marks as coming from the same source. Moreover, the applicant has not shown that the Italian first name 'Giordano' which makes up both trade marks is common in Portugal (para. 32) — likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No

ELISE		24/03/2010, T-130/09, EU:T:2010:120
<p>G&S: Classes 9, 42</p> <p><i>Territory:</i> Portugal</p> <p><i>Assessment:</i> The Court considers that even if it is not certain that the relevant public throughout the European Union will necessarily perceive the signs at issue as being specifically diminutives of the name 'Elizabeth', the relevant public will certainly regard them as highly similar female names derived from the same root. In certain Member States, notably the United Kingdom, Ireland, Germany and Austria, they will certainly be perceived by the relevant public as being diminutives of the full forename Elizabeth (para. 36) — likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
GISELA	GISELE	08/03/2011, R 1515/2010-4
<p>G&S: Class 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The marks compared are both variations of the female first name 'Giselle' of old German and French origin and are overall very similar, so that a likelihood of confusion exists (paras 14, 15, 20) — likelihood of confusion.</p>		

- First name against identical first name plus surname

Whenever two signs share the same first name and one of the two also contains a surname, and when the **first name** is likely to be perceived as a **common** (let alone very common) name in the relevant territory, the rule of thumb is that there will be **no likelihood of confusion**, since consumers will be aware that there are many people with that name.

Earlier sign	Contested sign	Case No
LAURA	LAURA MERCIER	25/01/2002, R 95/2000-2

G&S: Class 3

Territory: Spain

Assessment: In the Board's view, the average Spanish consumer who is familiar with the trade mark 'LAURA' for perfumes will not be confused. Conceptually, 'LAURA' will be seen as a common first name in Spain. It is highly unlikely that the average Spanish consumer would consider linking the more specific name 'LAURA MERCIER' with 'LAURA' (para. 16) — no likelihood of confusion.

An **exception** applies when a given first name is likely to be perceived as **uncommon** in the relevant territory. In such cases, the presence of this uncommon element is likely to focus the consumers' attention and they could be misled into attributing a common origin to the goods/services concerned.

Earlier sign	Contested sign	Case No
AMANDA	AMANDA SMITH	17/03/2009, R 1892/2007-2
<p>G&S: Classes 29, 30</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The term 'SMITH' in the trade mark application will be perceived by the Spanish consumers as a common Anglo-Saxon surname and will have less weight than the first name 'AMANDA' (which is less common in Spain) (para. 31) — likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
ROSALIA	ROSALIA DE CASTRO	05/10/2011, T-421/10, EU:T:2011:565, (appeal 03/10/2012, C-649/11 P, EU:C:2012:603, dismissed)
<p>G&S: Classes 32, 33, 35</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The signs are visually and conceptually similar, and aurally very similar. The products are identical. The services are similar. Neither the name ROSALIA nor the surname DE CASTRO is common in Spain. None of these elements has a higher distinctive character than the other (paras 50-51) — likelihood of confusion.</p>		



- First name plus surname against identical first name plus different surname

When two conflicting signs contain the same first name but are followed by clearly different surnames, the rule of thumb is that there is **no likelihood of confusion**.

Consumers will realise that they distinguish goods/services of different, unconnected undertakings.

Invented example: 'Michael Schumacher' / 'Michael Ballack' (no likelihood of confusion).

However, when the overall impression created by the signs is one of clear similarity, that is to say, the differences between the signs are lost in the overall impression created by the signs, then, applying the normal criteria, the outcome will be that there is **likelihood of confusion**.

Earlier sign	Contested sign	Case No
 (Emidio Tucci fig.)		13/12/2004, T-8/03, EU:T:2004:358, 03/10/2002, R 700/2000-4 & R 746/2000-4, confirmed 28/09/2006, C-104/05 P, EU:C:2006:611
<p>G&S: Classes 3, 18, 24, 25</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> Both marks consist of the combination of a first name and a surname and give a similar overall impression — likelihood of confusion.</p>		

- First name plus surname against different first name plus identical surname

When the conflicting signs contain the same surname preceded by different first names, the outcome will very much depend on the perception of the surname in the relevant territory. The less common a surname is, the more likely it is that it will attract the consumers' attention (regardless of whether the first names are common or not).

Earlier sign	Contested sign	Case No
ANTONIO FUSCO	ENZO FUSCO	01/03/2005, T-185/03, EU:T:2005:73
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> Italy</p> <p><i>Assessment:</i> Since it was contested that 'Fusco' was not one of the most common surnames in Italy, the Court considered that, since the Italian consumer generally attributes greater distinctiveness to the surname than the forename, it will keep in mind the (neither rare nor common) surname 'Fusco' rather than the (common) forenames 'Antonio' or 'Enzo'. Therefore, a consumer faced with goods bearing the trade mark applied for, ENZO FUSCO, might confuse it with the earlier trade mark, ANTONIO FUSCO, so that there is a likelihood of confusion (paras 53, 67) — likelihood of confusion.</p>		

In contrast, when two marks have the same surname and this is likely to be perceived as common (let alone very common) in the relevant territory, consumers will not normally be misled into attributing a common origin to the goods/services concerned (01/03/2005, T-169/03, Sissi Rossi, EU:T:2005:72, § 82-83; 24/06/2010, C-51/09 P, Barbara Becker, EU:C:2010:368, § 36). Consumers are used to trade marks that contain common surnames and will not blindly assume that every time a common surname occurs in two conflicting signs the goods/services in question all emanate from the same source.

Earlier sign	Contested sign	Case No
VITTORIO ROSSI	CHRISTIAN ROSSI	15/09/2010, R 547/2010-2
<p>G&S: Classes 18, 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> Not only are consumers throughout the EU aware of the fact that people share the same surname without being necessarily related, but they will also be able to distinguish the Italian surname 'ROSSI' bearing two different first names in the fashion field (paras 33-35) — no likelihood of confusion.</p>		

- First name plus surname against different first name plus identical surname conjoined in a single word

In cases where one of the conflicting signs consists of a name and surname and the other of a single word that will, however, be broken down into separate components by at least part of the relevant public, due to the recognisable presence of a name and surname combined to form the one word making up that sign, the result will be one of likelihood of confusion whenever the overall impression created by the marks is one of similarity.

Earlier sign	Contested sign	Case No
PETER STORM	Peerstorm	08/07/2010, T-30/09, EU:T:2010:298
<p>G&S: Class 25</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> Both of the marks at issue are made up of a first name and a surname. It is common ground that the element 'storm' in the two marks at issue can be a surname. The elements 'peer' and 'peter' in the mark applied for and the earlier mark respectively are first names. In particular in the Nordic countries and in Germany, Peer is a first name. The fact that the mark applied for is written as one word cannot cast doubt on the finding that the two marks at issue are made up of a first name and a surname (para. 66) — likelihood of confusion.</p>		

- Surname against first name plus identical surname

When two signs contain the same surname but only one of them also contains a given first name, the rule of thumb is that normally there will be **likelihood of confusion**. Consumers might be misled and attribute a common origin to the goods/services concerned. The presence of a first name in one of the conflicting signs will not suffice to safely distinguish the signs in the minds of the consumers. The surname alone will be perceived as the short version of the full name, thus identifying the same origin.

Earlier sign	Contested sign	Case No	
MURÚA		13/07/2005, T-40/03, EU:T:2005:285	
<p>G&S: Class 33</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> It is common ground that the Spanish public will perceive the verbal element making up the trade mark applied for as a proper name (first name plus surnames) and the earlier trade mark as a surname. It is quite likely that the relevant public will regard the addition, in the trade mark applied for, of the first name 'Julián' and the surname 'Entrena' merely as a way of distinguishing a range of wines produced by the undertaking that owns the earlier trade mark or, at least, an undertaking economically linked to the intervener (paras 42, 78) — likelihood of confusion.</p>			
Earlier signs	Contested sign	Case No	
BRADLEY	VERA BRADLEY	01/09/2011, R 1918/2010-1	

G&S: Class 11



Territory: EU

Assessment: The sign for which the EUTM applied for seeks protection consists of the term 'Vera Bradley', which will most probably be seen as the name (forename and family name) of a person, fictitious or real. It is composed of the first name 'VERA', which is a common name for women in many EU countries such as, e.g. the Czech Republic, Germany, Ireland, the Netherlands, Austria, Slovenia and the United Kingdom, and the surname 'BRADLEY', which is an English family name. The latter surname is not a common family name, neither in English-speaking countries nor in any other countries within the European Union. Even if consumers might be able to distinguish between the signs due to the element 'Vera', which has no counterpart in the earlier trade mark, they will see a specific line of products or an extended form of the mark. Consequently, consumers might believe that the trade marks belong to the same undertakings or economically linked undertakings (paras 36-37, 52) —likelihood of confusion.

7.3 Colour marks per se

When likelihood of confusion of two colour marks per se is assessed, a phonetic or conceptual comparison of the signs cannot be made and the visual similarities will depend on the colour of the signs.

In the overall assessment, the Office takes into account the fact that there is a 'public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought' (24/06/2004, C-49/02 Blau/Gelb, EU:C:2004:384, § 41; 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 52-56). The inherent distinctiveness of colour marks per se is limited. The scope of protection should be limited to identical or almost identical colour combinations.

Earlier sign	Contested sign	Case No
		20/10/2010, R 755/2009-4

G&S: Class 8

Territory: EU

Assessment: In the case at hand, the colour combinations, identified by different colour codes, are not sufficiently close to lead to a likelihood of confusion, taking into account that the inherent distinctiveness is limited (para. 18). The BoA referred to CJEU judgments and public interest in ensuring that colours remain available to competitors (para. 19). The opponent did not prove enhanced distinctive character (para. 25) — no likelihood of confusion.

Obsolete