

**OPPOSITION GUIDELINES**

**PART 2**

**CHAPTER 2:**

**LIKELIHOOD OF CONFUSION**

**D. GLOBAL ASSESSMENT**

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## **CHAPTER 2: LIKELIHOOD OF CONFUSION**

### **D. GLOBAL ASSESSMENT**

#### **I. GLOBAL ASSESSMENT - INTERDEPENDENCE**

##### **1. Global assessment of all the factors**

As the degree of similarity that may lead to confusion is not fixed, all factors relevant to the circumstances of the case must be considered.

As the Court stated the 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, on the association that the public might make between the two marks and the degree of similarity between the signs and the goods [and services] (*Sabèl*, paragraph 22). Furthermore, 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 (*Sabèl*, paragraph 23).

The Court added that in the assessment of the similarity of the signs a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks and vice versa (*Canon*, paragraph 17).

These principles suggest a balanced appreciation of all the relevant factors, and in particular, an assessment of the distinctiveness of the earlier mark, the degree of similarity of the signs and goods at issue, and the kind of link that the public might make between the two marks.

Hence, this stage of the examination deals with the question of whether or not in a global assessment of all the relevant factors, the respective weight of these factors is sufficient to give rise to a likelihood of confusion.

##### **2. Distinctiveness of the earlier mark**

In general trade mark doctrine, and in current practice in the Office, including the Boards, as well as in member states, a distinction is usually made between “weak” and “strong” trade marks. “Strength” in this context is equivalent to “degree” of distinctiveness in the ECJ language.

“Weak” trade marks are those that have only a small degree of inherent distinctiveness.

Marks just beyond the line of “weak” are marks that have some or an “average” degree of inherent distinctiveness. This is about the limit to which marks get when there is no proof of use and thus enhanced distinctiveness.

“Enhanced” distinctiveness requires recognition of the mark by the relevant public. This enhanced distinctiveness is available both for inherently “weak” marks and for those which are inherently distinctive.

At the upper end of the scale are marks that are well-known, and marks that have a reputation.

Finally, there are “famous” marks, marks that are equivalent to household words, usually singular (but not necessarily so) in the sense that there are no competing, and even no non-competing, products on the market under such sign.

The greater the degree of distinctiveness in accordance with the above criteria is, the larger will be the scope of protection.

This is in line with the established case-law of the European Court of Justice.

The Court explicitly laid down that the more distinctive the earlier marks, the greater will be the likelihood of confusion (*Sabèl*, paragraph 24). Therefore, 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 (*Canon*, paragraph 18). In determining the distinctive character of a mark, an overall assessment has to be made 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 (*Lloyd*, paragraph 22).

Therefore, the distinctiveness of the earlier mark always has to be taken into account when deciding on likelihood of confusion.

It should be further noted that the Court has made clear that the strong distinctiveness of the earlier mark is an argument in favour of a finding of likelihood of confusion and not an argument against it, as has sometimes been expressed in literature on trade marks.

239/2000 ADOLFO DOMÍNGUEZ / ADOLFO (EN),  
62/2001 NEXT / NEXTEYE (EN),  
675/2001 VIÑA ESMERALDA / EMERALD HILL (EN).

As the Court indicated in the *Lloyd* case, all marks have a greater or lesser capacity to identify the goods or services covered, and thus to distinguish those goods or services from those of other undertakings. It follows that marks of limited distinctive character have a lesser capacity to serve as an indicator of origin. In view of the above-mentioned statement of the Court in *Sabèl*, it can be concluded that the finding of a limited distinctive character of

the earlier mark may serve as an argument that confusion with this mark is less likely than with marks of stronger distinctiveness.

76/1998	EN	Negritelle	LOS NEGRITOS
188/1999	EN	ACTIVIN	ACTILINE
584/1999	ES	LA ARGENTINA	CARNES ARGENTINAS
1043/1999	EN	NEOLUX	NEOLITE
329/2000	EN	BANKEUROPA	EUROBANK
937/2001	EN	VITAL	PHYTO-VITAL
1789/2001	EN	MEDIA MARKT	MEDIA-SOUND
2350/2001	EN	Das leben leicht gemacht EUROSHOP VERSAND (fig.)	EUROTOPS

The distinctiveness of the earlier mark is not constant, but variable, depending on the perception the public has of the mark. The perception of the public may not only change due to the enhanced or diminished reputation of the specific mark, but also due to other factors (all these elements can only be considered from the evidence submitted by the parties). This might be in particular the case where the mark or some element thereof has been used in the meantime in a similar way by various marks in the relevant market sector. In this context, it is also important to assess carefully whether the mentioned situations exist in all the geographical areas and as regards all the relevant goods and services. In general it will be sufficient to evaluate the distinctiveness of the earlier mark at the time of the decision.

### 2.1. *Distinctiveness by nature – Inherent distinctiveness*

The Court stated that in determining the distinctive character of a mark account should be taken 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 (*Lloyd*, paragraph 23). The Court has also stated (Joined Cases C-108/97 and C-109/97, *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger*, [1999] OJ OHIM 7-8/99, p. 1054, paragraph 37) that the assessment of distinctiveness also has to take into account the degree of familiarity amongst consumers with the sign (a *geographical name*, in the case), with the characteristics of the place designated by the sign, and with the category of goods concerned.

Furthermore, the inherent distinctiveness of the earlier mark has to be evaluated by taking into account (each of) the relevant geographical area(s). Due to different linguistic and cultural backgrounds, the public in some of the relevant areas might not understand the descriptive content of an earlier mark. In such cases, the distinctiveness of the earlier mark is not to be regarded as limited in respect of these areas.

1191/1999	EN	RIPOLIN	RENTOLIN
1457/1999	EN	MEGAKID	MEGARIG
189/2000	EN	TELEBINGO	TeleBingo
1658/2000	EN	AROMA	MAROMA
2450/2000	EN	MARIE CLAIRE	<b>cloire's</b> accessories
2920/2001	EN	Selenium Spezial A-C-E	Selenium-ACE

It should also be carefully assessed whether the finding of descriptiveness is valid for all the goods and services of the earlier mark. If this is not the case, a differentiation is necessary between the relevant goods and services. This might result in a different outcome as regards the finding of likelihood of confusion for different goods and services.

Although not conclusive at all, an indication of an inherent descriptiveness of the earlier mark may be the registration of a variety of marks with the same element in the Community register or in the relevant national registries. The presence of many registered trade marks with the same element and protecting similar products will show, at least, that the element of choice is not particularly original. However, only a few such registrations are not sufficient to prove that the earlier mark has limited distinctiveness.

85/1999 LISAP / LISA (EN), 248/2000 ACTIVE WEAR / INTERACTIVE WEAR (EN).

The fact that a mark may be inherently distinctive is not necessarily conclusive for a finding of its “strength”. This is so because there are marks with a low degree of distinctiveness (marks at times called “suggestive” or “evocative”).

## 2.2. *Distinctiveness through use*

The Court has given some guidance in respect of the evaluation of distinctiveness acquired through use of the earlier mark. The Court has laid down the following factors to be considered: 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 (*Lloyd*, paragraph 23). This list is not exhaustive.

The requirements for a finding of distinctiveness through use have to be stricter in cases where the earlier mark has only a limited inherent distinctiveness.

282/1999 CAFÈ NOIR / CARTE NOIRE (EN).

The evidence of distinctiveness acquired through use must refer both to the relevant geographical area and to the relevant goods and services. It has to be precisely established for which goods and services, according to the submitted evidence, such distinctiveness has been acquired (see part F Article 8(5) as regards the method of assessment of such evidence)

226/1999	FR	MIKO	MIK
1000/1999	ES	CRISTAL	CRISTAL CASTELLBLANCH
1193/1999	EN	JOHN SMITH	PAUL SMITH
1224/1999	EN		
1340/1999	EN	BOSS	BOSSI
130/2000	ES	PEPE	PEPE CABALLERO
62/2001	EN	NEXT	NEXTEYE
675/2001	EN	VIÑA ESMERALDA	EMERALD HILL

### 3. Degree of similarity between the signs and the goods and services

The Court has put also forward that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the signs and vice-versa (*Canon*, paragraph 17). Hence, the similarities between the signs must be assessed bearing in mind the similarities between the goods and services and vice versa. This means that if there are lesser similarities in one aspect they will be reinforced by stronger similarities in the other aspect which could lead to a likelihood of confusion.

969/99 BARONIA / BERONIA (ES),  
789/99 ALLEGRO / ALLEGRO (EN),  
1999/2001 BLÛ / B.L.U. (EN).

Consequently, identity or close similarity of either signs or goods and services will generally be an indication towards confusion, unless there are clear differences in the other direction enabling the consumer to distinguish between them.

Examples of dissimilar signs:

394/99  /  (EN), 1974/2001 DERS / SHADERS (EN)

E.g. TMS identical or very similar but G/S dissimilar:

964/99	EN	THE GREY LINE	GREYLINE
1031/99	EN	STARTER	STARTER
1113/99??	EN	AFTER DARK	AFTER DARK
419/99	EN	FLEXI	FLEXI
1039/2001	EN	ABM	a.b.m.victoria
1428/2001	ES	(fig)	(fig)
1847/2001	EN	MARTIN LOOGAN	MARTIN LOGAN

1489/2001	EN	DOM	DOM
1979/2001	ES	BRK	

4. Impact of the kind of goods and services on the assessment of resemblances

The Court has further stated that when evaluating the importance attached to the degree of visual, phonetic and conceptual similarity between the signs, it is appropriate to take into account the category of goods and the way they are marketed (*Lloyd*, paragraph 27).

The category of goods and services involved may increase the importance of one of the different aspects of similarity of signs (visual, phonetic and conceptual). For example an aural or conceptual identity or similarity of 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, it is the visual impression of the signs that counts more for the finding on likelihood of confusion.

309/99 WOOKI / WALKIE (DE),  
851/99 FIFTIES / MISS FIFTIES (EN) confirmed by BoA Dec. 757/1999-2,  
394/99 L / L (EN),  
1207/99 ILS / ELS INTERNATIONAL (EN).

Moreover, the circumstances in which the goods are marketed as well as the country where they are marketed may play an important role. These circumstances may enhance or diminish the ability of the public to perceive the differences between the signs.

1999/2001 BLÛ / B.L.U. (EN)

For example, it may be common to order and buy the specific goods and services with reference to hand-written notes. This may lead to a blurring of subtle differences between the signs. However, in view of the principle that the signs have to be compared in the form they enjoy protection, such findings have to be applied very cautiously.

The phonetic perception of the sign may be influenced by factors such as the presence of various other sounds perceived by the addressee at the same time. In particular, this may be the case as regards sales points with an increased noise factor, such as supermarkets or bars.

R251-2000-3 MYSTERY / MIXERY (EN), 31/1999  
Landana / LANDAMANN (DE)

5. The degree of sophistication and attention of the relevant public

5.1. *The average consumer*

For the Court, the average *consumer* is deemed to be *reasonably well informed and reasonably observant and circumspect* (*Lloyd*, paragraph 26). This general statement relates both to sophistication and to attention: being reasonably well informed to sophistication, being reasonably observant and circumspect to attention.

This qualification of the average consumer applies *mutatis mutandis* to the business customers. In their case, to be *reasonably well informed and reasonably observant and circumspect* will often mean a higher level of sophistication and attention than that of consumers.

If the average customer of one product or service is the average business customer, and the other public consists both of the average consumer customer and the average business customer, only the average business customer will be of relevance.

Example:

*Paints* in general are sold both to painters (i.e. for professional uses of these business customers) and to consumers for do-it-yourself purposes. *Paints for industry*, on the other hand, are not marketed to consumers. Therefore, when the specifications of the two marks cover paints and paints for industry respectively, only business customers constitute the relevant public since only they might usually get in connection with both marks

For the Court, the “level of attention” of the average consumer varies according to the category of the goods and services in question (*Lloyd* paragraph 26). More precisely, as shown above, what matters is the “level of sophistication and attention”.

This is not only true for goods and services, which are exclusively offered to business customers, but also for specific categories of goods and services that possess features affecting the sophistication and/or attention even where the general public is targeted, as will be explained in the following sections. The enhanced sophistication and / or attentiveness of the public as regards the relevant goods and services either of the CTM application or of the earlier mark will generally be a significant indication against confusion.

## *5.2. Degree of sophistication of the customer*

### *5.2.1. Meaning of the criterion*

The degree of sophistication differs both between the consumers and the business customers and within the two groups. The more sophisticated the customer, the less likely it is that confusion will occur.

The degree of sophistication is of relevance for the customers’ capacity to perceive the various likelihood-of-confusion factors, and in particular the criteria for determining the similarity of the goods and services and the similarity of the signs. For instance, a good knowledge of the market situation

relating to the goods/services in question tends to reduce likelihood of confusion (see below, under 5.2.2.b and 5.2.3.).

### 5.2.2. Consumers

#### a. Mass consumption goods/services

Where the consumers are the public at large, as in the case of mass consumption goods, the degree of sophistication is that of a *reasonably well-informed* consumer.

#### b. Technical or very specific goods/services

In cases, where only a section of the public at large is concerned, as in the case of technical or very specific goods/services, the level of *education* or *knowledge* in relation to the goods and services concerned has to be taken into account. This level can be of importance both for the perception of the marks (e.g. foreign language terms) and for the particular type of goods or services (e.g. financial services).

If specialised or technical knowledge is required for using a product, a more educated public in respect of that product may be involved, even where such products are not specifically intended for business customers but are also available to the public at large.

Similar considerations apply to goods or services where the level of attention is high, as discussed below. In these instances, e.g. where *tobacco* or *newspapers* are concerned, the consumers may have a degree of sophistication that goes far beyond the average level.

512/1999 MAXDATA / MAXTECH (EN),  
1390/2001 FOCUS / FOCUS DYNAMICS (fig) (FR).

### 5.2.3. Business customers

Their specific professional knowledge and expertise relating to the goods/services in question have to be taken into account.

Examples:

The highly qualified customers of the goods in question will recognise that ELISA is an abbreviation for enzyme linked immunoassay solvent assay (a sensitive diagnostic test for a past or current exposure to an infectious agent such as the AIDS virus).

1183-2002 RELISA / VARELISA (EN)

Business customers will be aware of the fact that financial institutions or insurance companies will not be responsible for the technological aspects of issuing magnetic or chip cards.

2066/2001 DENCARE / DentCard (fig)(DE)

### 5.3. Degree of attention of the customer

The Court stated: “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” (*Lloyd*, paragraph 26). The greater the level of attention, the lesser the likelihood of confusion.

#### 5.3.1. Consumers

It is the level of the so-called purchase *involvement* which has a significant impact on consumer choices of goods and services. The level of involvement relates to the importance of a decision to the consumer. Thus, it corresponds to his/her degree of attention.

##### a. High degree of attention

A *high degree of attention* is usually connected with three types of purchases: expensive, infrequent or risky purchases. They can be rational. The average consumer often seeks professional assistance or advice when choosing or buying certain types of goods/services. Examples are *computers* (expensive), *financial services* (infrequent), or *prescription drugs* or *pharmaceutical products* sold exclusively in pharmacies (risky). A high degree of attention can also apply to emotional purchases, e.g. those concerning jewellery.

##### (A) Pharmaceuticals

##### (a) Practice of the Opposition Division from October 2001

##### (aa) Average consumer

Where pharmaceutical goods are prescribed or sold by qualified professionals such as doctors or pharmacists, the ‘average consumers’ are, on the one hand, specialist experts such as doctors or pharmacists and, on the other hand, the usual consumers who do not have any specific medical and pharmaceutical knowledge. However, even in the case of drugs which require a prescription in certain European countries, these drugs may, in practice, be sold by pharmacists to consumers without a prescription. Therefore, the consumer should always be taken into consideration when determining the relevant public. Where the pharmaceutical goods are not prescribed or sold by qualified professionals but are freely sold on the market, the average consumer is mostly the patient him/herself. Furthermore, pharmaceuticals currently available only on prescription may in the future become available as over-the-counter (OTC) medicines.

Where the pharmaceutical goods of the CTM application are sold over the counter and the pharmaceutical goods covered by the national registration would probably only be available on prescription, or vice versa, the Office must assume that the relevant public is both qualified professionals and also

patients or average consumers without any specific medical and pharmaceutical knowledge. The Office may not limit such protection by hypothetical considerations concerning the preparations which might be sold under the mark.

(bb) Attention

(i) Prescription pharmaceuticals

A *general* rule according to which the average consumer is to be regarded as more attentive exists only in relation to *prescription pharmaceuticals*, since these are in general prescribed by a doctor and checked and handed over to the patients by a pharmacist.

Medical persons or pharmacists, because of their professional education, knowledge or experience, will normally be able to distinguish between drugs with small name differences, simply because of their different therapeutic purpose. Furthermore, a patient who is aware of the potentially detrimental impact of pharmaceuticals will pay specific attention to the names of the products and to their “evocative” meaning.

(ii) Non-prescription (OTC) pharmaceuticals

Summary

However, the same does not apply to *non-prescription (OTC) pharmaceuticals* for two reasons:

Even though consumers should pay more attention when purchasing such drugs, they may in fact not do so. Furthermore, their attention will depend on the therapeutic indication.

The consequence for OD decisions is:

The attention is evaluated on a case-by-case basis. A finding of increased attention of consumers of OTC pharmaceuticals cannot be assumed in general but must be established from the circumstances of the case. Therapeutic indications, in particular, matter.

Where *both* marks cover prescription drugs, the attention will generally be higher.

However, where either the earlier mark *or* the CTM is for OTC drugs, there will be NO general presumption of an enhanced degree of attention. This is because the final consumers of the prescription pharmaceuticals (who receive them via specialists) might choose non-prescription (OTC) pharmaceuticals themselves, which are covered by one of the marks.

Background

It cannot be claimed as a general rule that an unqualified consumer who wants to buy an over-the-counter medicine for a specific purpose in a

pharmacy will be able to distinguish between drugs with small name differences. The attention paid by this consumer depends on the specific drug and the specific purpose, need or effect. It may be that for more complicated purposes or more serious disorders the normal attention of an average consumer could be higher. However, with regard to medicines for mild disorders and minor afflictions such as painkillers, sleeping pills or healing ointments, the degree of attention may be very low.

A leaflet giving all the necessary detailed information about the product is normally provided with pharmaceutical preparations. The average consumer will normally not read this description before or during the act of purchasing but perhaps afterwards, and the pharmacist will not automatically provide advice, especially in relation to non-toxic drugs, at least not without a request from the customer. There is an increased tendency in society of self-cure, through self-diagnosis and reliance on oral recommendations of relatives, colleagues or friends. Only in special cases, for example in relation to dangerous drugs, will the pharmacist enquire about the cause and make comments or give instructions.

T 10 / 01-6 PREDONIUM / SEDONIUM (EN) ‘statement of case’

(b) Boards of Appeal

Medical persons or pharmacists can distinguish between drugs by small differences of the names simply because of a different therapeutic purpose. But there is no common principle that the average consumer will usually be very careful when purchasing a drug and will in general be particularly attentive to small differences between the marks.

The kind of attention of the normal consumer who wants to buy a non-prescribed medicine for a special indication in a pharmacy depends on the special drug and the special purpose, need or effect.

For more complicated purposes the normal attention of an average consumer could be higher. But regarding medicines for mild disorders, minor afflictions, distresses, or bodily ailments, such as painkillers, sleeping pills or healing ointments, the degree of attention may be very low.

A-MULSIN/ALMOXIN, R 816/1999-3 (EN) (25/04/2001): I.o.c found;  
R 0401/2000-3 GASTRIN / EUGASTRIM (EN) (07/06/2001) and R 0964/2000-3 ABACOR / ACCUCOR (EN) (12/09/2001): no I.o.c.

It must be taken into account that in some countries medicinal products are administered over the counter, without prescriptions, some consumers tend to resort to self-prescription and professionals are often overworked and tend to write prescriptions with a hardly legible handwriting.

R 1178/2000-1 TEMPOVATE / EMOVATE (or) EUMOVATE (EN) (14/02/2002)

In the *earlier* case-law of the Boards of Appeal, the former OD practice that no distinction between OTC and prescription drugs must be made was corroborated. When buying pharmaceutical products, the average consumer will pay a higher degree of attention with respect to these products (independently of whether or not these are OTC).  
R 303/1999-2 BONOLAT / PONALAR (DE) (02/08/2000)

(B) Expensive purchases, in particular cars

High price, in particular in the case of luxury products, is a good reason for the consumer to be more circumspect as to the origin and the quality of the article concerned. The attention may even be enhanced in cases where the specific product is regarded as reflecting the social status of its owner.

Example: cars and related services

Taking into consideration the price of the cars involved, the average consumer will only be the affluent part of the general public. It is to be expected that the average consumer will not buy a car, either new or second hand, in the same way as he or she would buy articles of daily use. The average consumer will be an informed one, taking all relevant factors into consideration, for example, price, consumption, insurance costs, personal needs or even prestige. Besides the dealers, other sources of information can be car magazines, colleagues and friends or the Internet.

As regards *motor vehicle maintenance and repair services* the average consumer is also expected not to take the car to just any garage but to inform themselves in advance about the garage, qualifications and specialisation.

S TYPE / S-CLASS R 969/2000-1 (EN)

The above principles, however, must not lead to the conclusion that highly distinctive marks are not adequately protected even if the goods are identical, merely because the goods are expensive, but may be protected against similar goods/services which are not similarly expensive. Such a result can be avoided by properly assessing the reputation of the earlier mark in the global likelihood-of-confusion analysis, which will weigh heavily in favour of likelihood of confusion.

(C) Products with high brand loyalty: the example of *tobacco*

Furthermore, a high degree of attention can be the consequence of brand loyalty, such as in the case of tobacco products and articles.

Smokers are considered particularly careful and selective as to 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.

R-78/1999-3 FOSTER / FROSTY (DE): even though tobacco products are relatively cheap mass articles, the consumers have a high taste and brand loyalty in this field and therefore recognise quickly the preferred brand.

16/1998 ARISTON / HORIZON (EN),  
113/1998 SUNSET / SUNRISE (EN),  
959/1999 KINGS / SUPERKINGS (EN).

Finally, it is important to mention that, in case of highly distinctive marks, brand loyalty must not lead to a lower degree of protection. Insofar, similar considerations as in the case of expensive purchases above apply.

b. Low degree of attention

*A low degree of attention* can be associated, in particular, with habitual buying behaviour. Rational purchase decisions in this area relate to, for example, basic foodstuffs. Emotional decisions cover, for example, sweets.

5.3.2. *Business customers*

Purchases made by business customers are often more systematic than consumer buying. They require accountability and their cost and efficiency are often monitored. Thus, the degree of attention when making such purchases is usually higher than that of consumer customers and the likelihood of confusion will therefore be lesser.

300/1999 PEROX (cl.3) / PELOX (cl.1, 3) (DE),  
371/1999 TAMRON (cl.9) / AMRON (cl.9) (EN).

In 1603/2002 FIBROSTEEL / FIRESTEEL (FR) it was held that the relevant public of the goods in classes 6 and 17 consisted of professionals who are more attentive.

6. Coexistence of the conflicting marks on the market in the same territory

Evidence of co-existence of parallel marks on a national level may weigh against likelihood of confusion.

85/1999 LISAP / LISA (EN),  
1193/1999 JOHN SMITH / PAUL SMITH (EN).

However, the indicative value of co-existence should be treated with caution. There might be different reasons why the two signs coexist on the national level, e.g. a different legal or factual situation in the past or prior rights agreements between the parties involved.

1340/1999 BOSS / BOSSI (EN),  
537/1999 SIDE / SIDE (EN).

Moreover, such a co-existence argument requires evidence that the signs have been *used* in the relevant market. Evidence of the existence of the relevant marks on the same Register does not suffice.

105/1999 Hollywood / Hollywood (FR),  
537/1999 SIDE 1 / SIDE (EN),  
1584/1999 Marco / MALCO (EN).

In several decisions the Third and Fourth Boards of Appeal have emphasised the importance of co-existence on the marketplace and not only on the Register. The OD follows these decisions.

R 360/2000-4 NO LIMITS / LIMMIT (EN):

Coexistence of confusingly similar marks in the trade mark register is not relevant. Article 8(1)(b) CTMR makes reference to confusion on the part of the public, i.e. confusion on the market place. Evidence of actual and peaceful coexistence of conflicting marks on the market is a circumstance that the Board may take into consideration in order to assess the likelihood of confusion in the meaning of Article 8(1)(b) CTMR. However, the appellant has failed to supply that evidence. The simple allegation that the respondent did not take action against registration or use of the appellant's mark for Spain is not sufficient. The argument of past peaceful coexistence must be supported by evidence of real presence of the two marks on the market place. Coexistence should be understood as 'co-use', namely concurrent use of the two (supposedly conflicting) marks, rather than 'co-registration', i.e. concurrent presence in a trade mark register. The appellant did not supply evidence that his mark and the respondent's mark have actually been co-used in Spain.

For the similar reasoning of the Third Board see R 0001/2002-3 CHEE.TOS/CHITOS (EN) and R 0851/2000-3 MAGIC / MAGIC BOX (EN).

Co-existence on the Register may, however, be considered as one element in the likelihood-of-confusion analysis. But this may only be the case if it is clear to the Office that the Member State, in which the concurrent earlier mark is on the Register, examined relative grounds for refusal *ex officio* in the course of the proceedings that led to the registration of the national mark concerned.

In *GOLDSHIELD*, the Board found that the marks had also coexisted on the marketplace for several years and that the opponent had made no attempt to challenge the validity of the national registration of the applicant's mark. The Board had considered in this case that coexistence may not be decisive but is nonetheless highly persuasive of an absence of likelihood of confusion. This latter conclusion is at odds with the OD's practice. The OD considers that coexistence on the marketplace *may weigh* against likelihood of confusion but *not* as being *highly persuasive* of its absence.

R 0415/1999-1 GOLDSHIELD / SHIELD (EN)

Practice change:

In general, contracts between parties when dealing with opposition actions will not be taken into account in opposition proceedings, unless:

there is an agreement between the parties in OHIM proceedings about its meaning, or  
there is a decision of a national court about its meaning.

Where the agreement is disputed it will not be taken into account. If there are pending court proceedings, the Opposition Division will decide whether to suspend the proceeding.

The previous practice according to which civil agreements between the parties of any kind were irrelevant in opposition proceedings is no longer followed.

## 7. Incidences of actual confusion

Likelihood of confusion, or the terms treated as synonyms in this Guide, i.e. “risk of confusion” and “danger of confusion”, does not require actual confusion but only the probability of confusion.

However, evidence of actual confusion is a factor that weighs in favour of likelihood of confusion.

To properly weigh evidence on the number of occasions when actual confusion has arisen, it must be assessed in the light of the number of opportunities for confusion. If the business transactions are voluminous but the instances of confusion are sparse, such evidence will have little weight in the likelihood-of-confusion assessment.

Lack of actual confusion has been treated in the context of co-existence above.

## 8. Prior decisions by Community or national authorities involving conflicts between the same (or similar) marks

### 8.1. *Substantive aspects*

Decisions of national courts, including Community trade mark courts, and of national offices in parallel cases do not have a binding effect on the Office. However, 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. In view of the harmonisation of the national trade mark laws, national courts (not acting as Community trade mark courts) and offices apply

substantially the same law as the Community trade mark courts and the Office.

However, considering the decisions of national authorities requires the submission of sufficient information, in particular about the exact *facts* on which the decision is based. Furthermore, it may be relevant whether or not a national decision was based on a national law in which the EEC Harmonisation Directive had been properly implemented.

80/1998	DE	ZEWA	WEPA
449/1999	DE	DOCKERS	DOCKERS BY GERLI
1193/1999	EN	JOHN SMITH	PAUL SMITH
1389/1999	FR	Ives Rocher	Yves Roche
278/2000	EN	SEPHORA	Sephora
869/2002 (decision of the German Bundesgerichtshof not followed)	DE	Bit	Bud
R 1031/2001-3		SHAPE OF TUBES M&M's MINIS (3-D MARK)	SHAPE OF TUBES NESTLÉ (3-D MARK)
R 552/2000-4	EN	COSMOPOLITAN COSMETICS	COSMOPOLITAN

## 8.2. Procedural aspects

The OD follows the position of the Fourth Board. According to their view, the OD is not bound in its decision to refer to or to repeat every single submission or reference made by the applicant in the proceedings before it; provided that it is clear from the content of its decision that it has taken into account all the substantial issues of law and fact raised by the parties to the proceedings, which might be material to the final resolution one way or another of the dispute before it and that the decision is itself properly reasoned in a manner consistent with the conclusion reached.

R 0634/2001-1 “a” (fig.) / “a” (fig.) (CFI case)

According to the Third Board, not considering a submitted decision of a national authority in a parallel case would lead to insufficiency in the reasoning in accordance with Article 74 CTMR.

R 0235/2001-3 (EN) APAGARD / GARD, DENTAGARD

9. No confusion between the signs themselves, but confusion about the origin (indirect confusion)

### 9.1. Meaning

The Court has clarified that the concept of likelihood of association is not an alternative to that of likelihood of confusion, but serves to define its scope (*Sabèl*, paragraph 18). The Court has stated that a trade mark must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality. Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings, constitutes a likelihood of confusion (*Canon*, paragraph 28, 29).

This means that there is also a likelihood of confusion where the relevant public is able to distinguish between the marks, but may believe that the goods and services they cover are from the same undertaking or economically-linked undertakings.

It has not been explored yet what is to be regarded as a sufficient “economical link” in this context. The kind of link that the public might make between the marks is particularly significant for the overall assessment of confusion as it will show whether there is a risk that the consumer might be mistaken as to the origin of the mark or might simply associate the marks due to certain similarities. The final conclusion is largely a matter of degree. The connection made on the part of the consumer must be of such an intensity as to make him believe that the goods come from the same undertaking or from economically linked undertakings (see subpoint I.3.3. above).

1390/2001 FOCUS / FOCUS ONE (FR),  
1629/2001 XPRESSO / EXPRESSO (EN)

## 9.2. *Series (family) marks*

A sufficient degree of connection for making the consumers believe that the goods come from the same undertaking or from economically linked undertakings has been assumed, in particular, in cases of series or family trade marks.

House marks or product-line identifiers are often combined with other secondary elements in a series of marks showing common origin. The systematic use of a basic sign in different combinations and contexts may lead the public to disregard secondary differences, thinking that they merely indicate a new product in a product-line from the same business entity.

There is no need that some or all the signs forming the ‘family’ of marks enjoy reputation in order that the ‘root’ sign is perceived the common element as a business identifier of a certain undertaking, although it is clear that such evidence will strongly contribute in favour of such acknowledgement.

2551/2002 (EN) Mc NUGGETS, McCRISPY, McBACON, etc / Mc BAGEL

An assumption of family marks on the part of the public requires that the common component of the marks at issue has, by virtue of use, the necessary

distinctiveness to be able to serve, in the eyes of the public, as the principal indicator of a product line.

In order to allow the Office to acknowledge that the different trade marks invoked by the opponent effectively form such a family of marks, the opponent should demonstrate not only that he is the owner of the marks, but also that the public concerned recognises the common part of these marks as originating from one undertaking. Such 'recognition' by the public can only be inferred through submitting evidence of use of the family of trade marks.

2126/2000 BrainNet (EN) (confirmed by the BoA R 1131/2000-2),  
2342/2000 PEPPER (EN),  
2844/2000 LIFESOURCE (FR).

The family of marks doctrine may be regarded as a typical example of likelihood of association. Because of the perception of a particular part of a trade mark as originating from a specific undertaking, people will make associations and believe that if another sign is also composed of that element, it is another trade mark from the same undertaking in question.

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 include non-registered trade marks as well, if this is compatible with the provisions of the relevant national laws.

The argument that there is a 'family of marks' does not need to be brought into the proceedings as a ground of opposition, but can be considered as additional facts, evidence and arguments. Therefore, the opponent, having based his opposition on a single earlier trade mark (registered or not) could bring into the proceedings the argument - and the supporting evidence - that his earlier trade mark has been used together with other trade marks, forming a family of marks under the aforementioned substantive conditions.

It should be taken into account that there will be no assumption of a family of marks where the common component is quite weak or where the further components of the earlier signs are predominant in the overall impression of these signs.

75/1998	EN	SYSTEMACTION	SYSTEM
177/1999	DE	Plastoclean	PlastiClean Thyssen Schulte
610/1999	ES	ONDA MUNDO	MUNDO Ole
1222/1999	EN	QUICKSHIP	Quickstep
1738/2001	EN	OPHTAL, OPHTAL, OPHTAL, OPHTAL	CROM- VISC- PAN- ALERGOFTAL

The assumption that a particular mark forms part of a family of marks requires that the common component of the signs is nearly identical. This requirement also applies to its presentation and location in the signs.

57/1998 BECK's / ISENBECK (DE),  
189/1999, 625/1999 LUREDIS / LUREDOX (EN).

However, minor graphical differences in the common component may not exclude an assumption of a series of marks, since such differences may be understood by the public as a modern presentation of the same product line. Even a different order of the letters may be possible.

75/1998 SYSTEMACTION / SYSTEM (EN),  
1265/1999 SOREL/SOLERS (EN).

On the contrary, different or additional letters concerning the common component generally do not allow an assumption of a family of marks.

57/1998 BECK's / ISENBECK (DE),  
177/1999 Plastoclean / PlastiClean Thyssen Schulte (DE),  
1738/2001 OPHTAL, CROM-OPHTAL, VISC-OPHTAL, PAN-  
OPHTAL / ALERGOFTAL (EN).

Furthermore, the goods and services of the applicant's mark must be identical or similar to the "common core" of the goods or services covered by the earlier marks. The assumption of a family of marks is more likely where there is a close similarity or even an identity of the goods and services in question.

136/2000 ETCH A SKETCH / SKETCH (EN).

## **II. DISCLAIMERS**

Effect of disclaimers:

Pursuant to Article 38 CTMR, the Office may impose a disclaimer if the mark contains an element which is not distinctive and if inclusion of that element would lead to doubts as to the scope of protection.

The Office also accepts disclaimers entered voluntarily.

Some national trade mark systems also provide for disclaimers.

A disclaimer has the effect that the respective element of the mark must be considered non-distinctive.

Such disclaimers bind the Opposition Division; this effect is compulsory even if upon independent analysis the element might appear distinctive.

The effect of a disclaimer is therefore:

- If the earlier mark contains a disclaimer, the respective element must be considered lacking distinctiveness. As a general rule, there will be no protection against a younger mark which coincides only in the disclaimed element.
  
- If the earlier mark contains two words and both are disclaimed, the scope of protection is reduced to the precise manner and sequence the two words are combined.
  
- If the younger mark contains a disclaimer, the element is also regarded as lacking distinctiveness but this has basically no relevance as the degree of distinctiveness of the younger mark is usually not of relevance. Moreover, if the two marks coincide in the disclaimed element, a disclaimer entered by the owner of the younger mark cannot bind the owner of the earlier mark, and the owner of the younger mark cannot unilaterally reduce the scope of protection of the earlier mark.

**Practice change:**

The previous practice according to which disclaimers lack relevance as they do not appear on the market is no longer followed. The disclaimer is part of the registration and precisely serves to define the scope of protection.