

OPPOSITION GUIDELINES

Part 2

Chapter 2:

Likelihood of confusion

C. Similarity of signs

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CHAPTER 2: LIKELIHOOD OF CONFUSION

C. SIMILARITY OF SIGNS

I. SIMILARITY OF SIGNS

1. Principles underlying the comparison

The same basic principles explained above under subpoint II. 1 for the similarity of goods and services apply to the evaluation of similarity of signs. Hence, the similarity of signs

- is a *conditio sine qua non* for a finding of likelihood of confusion;
- must be evaluated in view of the likelihood of confusion, that is in view of the conflicting marks being capable of suggesting that the goods or services have their origin in the same or economically-linked undertakings;

When assessing the similarity of signs, the signs have to be compared in the form they enjoy protection. That means that earlier registered marks and contested CTM applications only have to be assessed in their *registered/applied for* form. The actual or possible use of the registered marks in another form is irrelevant for the comparison of signs. For the effect of *disclaimers*, see IV. 2. below.

The assessment of similarity must be carried out in relation to the respective territory where the earlier mark is protected. Where the earlier mark is a national mark, the relevant criteria must be analysed in relation to the relevant public in that particular country. Thus, the similarity may be different from country to country because of differences in meaning and pronunciation. When the earlier mark is a CTM application or registration, the analysis must extend to whole Community, and presence of similarity in one part of it will suffice.

2. Overall impression

2.1. Distinctive and dominant components

The Court stated in *Sabel* 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. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel*, paragraph 23). It should be pointed out that in that case the conflicting marks consisted of a leaping wild animal as the earlier mark and a similar animal together with the word SABEL in the later mark.

This finding of the Court establishes the two following basic principles:

- the assessment of similarity of signs must not only be based on some isolated elements, but on the *global appreciation* of both signs under comparison;
- the *distinctive and dominant components* are “in particular” important for the evaluation of similarity between signs.

The Court has used the concept of *distinctive and dominant components* in a general manner and without any further specification. It is however obvious that the assessment of the elements forming the sign requires an agreement as to the criteria that will be used to identify the *distinctive* and the *dominant* elements.

The notions of *distinctive* and *dominant* describe the well-known phenomenon that signs, unless they are unitary (such as single word, a single figure, a single colour), are perceived in normal life by focussing on the dominant element, that which distinguishes the sign. At a next level of analysis, beyond the mere visual perception, judgement is involved, and it is here that “distinctive” obtains its additional value as a tool: signs or elements of signs which have no distinctiveness in the legal sense, i.e. are descriptive, generic or for other reasons non-distinctive for the goods or services involved, will be largely or totally disregarded when determining similarity in the legal sense, however much they may, as a matter of mere perception, dominate the sign.

The perception of what is dominant or distinctive will also vary depending on whether the analysis centers on visual, oral or conceptual similarities.

2.2. Assessment of the overall impression

The assessment of the similarity of the signs is based on the fact that the relevant public does not tend to analyse a sign in detail when confronted by it. The public, however, pays more attention to the distinctive and dominant components of signs. This may be a merely unconscious reflex, since the eye focuses on the distinctive and dominant components more readily than on the less distinctive components. Consumers may, however, consciously focus on the more distinctive components of a sign in order to differentiate it more easily from the marks already known in the relevant market.

Furthermore, the differentiation between different components of signs takes account of the fact that consumers, in general, do not have both signs in front of them at the time of being confronted with either of them, such as in advertising, or when purchasing certain goods or services. When confronted with a sign, they rather compare it with their recollection of signs already known for the relevant area of goods and services. However, consumers do not clearly recollect all the details of the signs, but rather their more distinctive and dominant components. The sign at hand and the “imperfect recollection” of another sign are the basis on which consumers evaluate whether the respective signs are the same or similar ones or not (see *Lloyd*, paragraph 26).

Experience shows that similarities of signs are more significant than dissimilarities for the outcome of this evaluation.

Therefore, comparison of signs will always have to take into account whether some components are more distinctive and dominant than others are. This applies to both signs under comparison. The pertinent criteria are not only those applied when evaluating the overall distinctiveness of the sign (see subpoint IV.2.), but also other factors, such as a different graphical presentation or a different size of the various components.

However, the Court left open the question of what is to be regarded as a “component” of signs. This cannot depend on whether a sign is visually divided into different parts. Rather *the perception of the sign by the relevant public* is decisive. The relevant public often regards one-word-signs as composed of different elements, in particular, in cases where a part has a clear and evident meaning whereas the rest is meaningless, or where there are visual indications such as a dash or the use of different type sizes and / or typefaces. In such cases, the elements of one-word-signs could be regarded as “components” as mentioned by the Court.

101/1998	FR	ÖKOVITAL	VITAL	No LoC
188/1999	EN	ACTILINE	ACTIVIN	No LoC
268/1999	EN	GOLDSHIELD	SHIELD	No LoC
1449/1999	EN	COLORSPERSE	AROSPERSE	LoC
10/2000	EN	STAR	PetSTAR	No LoC
2558/2000	EN	FEMINEX	FEMIPRES	No LoC
1713/2000	EN	MAXDATA	TRAXDATA	No LoC
2543/2001	EN	NEVADENT	NEODENT	No LoC
2895/2001	EN	POSTEX	POSTECS	No LoC
674/2001	EN	BRANDSHAPE	BRANDCAST	No LoC

However, it is *not* appropriate to split up a sign *artificially*, that is, in those cases where it is not likely that the public will perceive the sign as composed of different elements. In this evaluation, it should be taken into account that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

44/1999	EN	TELIA	teeli	LoC
911/1999	EN	VICO	VICOUNT	No LoC
1450/1999	EN	SUN	SUNNYLINE	No LoC
1503/1999	EN	SANIT	VASANIT	No LoC
813/1999 confirmed by BoA Dec. 813-1999-1	EN	ATLANTIC	PAPETERIES DE L'ATLANTIQUE	No LoC
1303/1999 confirmed by BoA Dec. 292/2000-3	EN	TARAFORTE	TARKA	No LoC
1476/1999	EN	GENOTROPIN	GRANDITROPIN	No LoC

Less distinctive or dominant parts *always* have to be taken into account when evaluating the similarity of signs. The Court made clear that the comparison of the marks has to be based on their overall impression. The less distinctive components have some influence on this as well. These components are of less importance in this respect than the distinctive and dominant ones. Nevertheless, they may be the factors which tip the balance in the evaluation of similarity.

355/1999 (EN) CAMOMILA INTEA / INTESA, (No LoC) confirmed by BoA Dec. 499/1999-1. (The case is pending before the CFI)

It is also important to note that in certain cases the combination of two words which are descriptive *per se* may nevertheless have a certain degree of distinctiveness, since the distinctive character may lie in the combination of the words.

1756/2000 (EN) EUROBAIT / EUROBAITS (LoC); 1267/2001 (EN) MOVICOM / MOBILCOM (LoC; pending in BoA).

When assessing and comparing the distinctiveness and dominance of the various components of signs, it is necessary to distinguish *the relevant territory*, since, mainly due to linguistic reasons, the perception of signs may be different.

758/1999 confirmed by BoA R728/1999-2 and 792/1999-2 pending in the ECJ	EN	MATRATZEN	MATRATZEN CONCORD	LoC
1982/2000 confirmed by BoA R1045/2000-2, pending in the CFI	EN	MATRATZEN	MATRATZEN CONCORD	LoC
248/2000	EN	ACTIVE WEAR	INTERACTIVE WEAR	LoC

1457/1999	EN	MEGAKID	MEGARIG	No LoC
377/2000	EN	CALCITRANS	CALCITUMS	No LoC

Furthermore, it is necessary to distinguish between *the different goods and services involved*, as the finding of a descriptive meaning of a component could affect only part of the goods. To this extent the same considerations are pertinent as in the determination of the distinctiveness of the earlier sign as such (see subpoint IV.2. below).

3. Visual, phonetic and conceptual comparison

3.1. General principles

As stated by the Court in *Sabel*, the similarity of the signs has to be appreciated globally, i.e. including a visual, aural and conceptual assessment (*Sabel*, paragraph 23).

Therefore, it is never appropriate to assess the similarity of signs only in some of these aspects. The similarity between signs always has to be evaluated with respect to their visual, aural and conceptual aspects.

However, this does *not* mean that a finding of likelihood of confusion is only given in cases where similarity of the signs can be found in all the aspects mentioned.

On the contrary, the Court clarified that a *mere aural similarity* between trade marks may create a likelihood of confusion, depending on the further circumstances of the case (*Lloyd*, paragraph 28).

The mere aural similarity between marks has been found sufficient, according to the particular circumstances of the case, to establish likelihood of confusion when the goods or services involved are recommended or ordered orally, such as clothes. (See section B. I.3.7.2.(b)).

851/1999 confirmed by CFI	EN	FIFTIES	MISS FIFTIES	LoC
309/1999	DE	WOOKI	WALKI	LoC
1949/2001	DE	HZ	Hazet	LoC
2032/2000	EN	OLLY GAN	HOOLIGAN	LoC; reversed by BoA R1072/2000
148/2000	EN	COPAT	QPAT	LoC
1593/2001	EN	INCELL	LINCEL	LoC

According to the Court, it is possible that a *mere 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, either *per se* or because of the reputation it enjoys with the public (*Sabel*, paragraph 24).

Likewise, a mere visual similarity between the signs may suffice, according to the particular circumstances of the case, for a finding of likelihood of confusion (in this respect, see also following section 3.3).

113/1998 (EN) SUNRISE / SUNSET, confirmed by BoA 109/1999-2 (LoC);
482/1999 (EN) MASTER CADENA / CHAIN MASTER (LoC);

1499/2000 (EN)  /  (LoC).



However, the finding of likelihood of confusion always depends on the specific circumstances of each individual case. All the circumstances have to be carefully assessed and weighted. It is always necessary to consider *all aspects of similarity together* in order to determine the outcome. Additionally, it may be decisive that one aspect of similarity is of specific importance in respect of the goods and services involved (see subpoint IV.4. below).

Taking all these considerations into account, even a weak similarity in all the different aspects (visual, phonetic and conceptual) may, when considered together, lead to a finding of likelihood of confusion.

On the other hand, a strong difference between the signs in respect of only one of the different aspects may lead to a finding that confusion is not likely, in spite of the similarity found in respect of the other aspect(s).

As regards cases where the key difference lies in the visual element, it should be noted that there is a need to acknowledge a strong visual difference between the signs.

1233/2001 (EN)  /  (No LoC);


1039/2000 (EN)  /  (the remarkable visual differences prevail over the similarity of the word part; No LoC).

Moreover, as regards cases where the key difference lies in the concept, it is necessary that the difference is sufficiently remarkable. This implies that the conceptual meaning of the relevant signs has to be clearly understood by the relevant consumers.

BoA R-0048/200-3 MARCO / MARCA, reversing Decision 1279/1999 where the importance of the conceptual difference was *overestimated*, as it was considered that German consumers would understand “marca” as meaning “Marke”.

In most of the cases where a clear conceptual difference is acknowledged, it is because both trade marks convey very different messages.

286/1999	EN	MOUNTAIN	MOUNTAIN BIKER	No LoC
651/1999	EN	BIG DEAL	D.E.A.L.	No LoC
873/1999	EN	ALTA	ALTA FIDELIDAD	No LoC
960/1999	EN	GUESS?	GLISS	No LoC
1443/1999	EN	METRO	MAESTRO	No LoC
167/2000 pending in CFI	DE	Mixery	MYSTERY	No LoC
490/1999	FR	PELLET	PELE	No LoC
256/2000	EN	GOLDMARK	GOLD BLOCK	No LoC

In some particular cases it may even be that a strong and clear conceptual meaning of one of the signs under comparison is to be regarded as sufficient to avoid likelihood of confusion. However, this approach is to be only applied in special circumstances. Such circumstances could be given, in particular, where the meaning of the sign has a very strong impact on its overall impression.

1175/1999	EN	NEPAL	HEPAL	No LoC
1316/1999	EN	ODOL	IDOLE	No LoC
109/1998	EN	Da Marco	MAGOR	No LoC
309/1999	DE	WALKIE	WOOKI	LoC
1044/1999	EN	ADVANTAGE	ADVANTA	No LoC
1045/1999	EN	EASTPOLE	EASTPAK	No LoC
1208/1999, pending in CFI	EN	ILS	ELS	No LoC

When evaluating whether a strong visual or conceptual difference between the signs may be sufficient for a finding that confusion is unlikely, the following should be considered:

First, such a finding is only possible under the condition that the relevant public is able to *perceive* the visual or conceptual difference.

1233/2001 (EN)   (No LoC).

In this context it has to be taken into account that visual or conceptual differences are sometimes totally imperceptible to the relevant public when the signs are communicated *orally*. If this is the case, the effect of the phonetic similarity on the finding of likelihood of confusion *cannot* be regarded as limited by the visual or conceptual differences.

64/1998 (ES) SSI STAR SERVICES INTERNATIONAL / SSI USA (LoC);
309/1999 (DE) WOOKI / WALKI (LoC), confirmed by BoA, R 429/1999-1

Secondly, such a finding of no likelihood of confusion further requires that the conceptual difference exist in *all* the geographical areas that are relevant when comparing the signs.

611/1999 (EN) VERITÈ / VERI (LoC);
1280/1999 (EN) MANFIELD / PENFIELD (No LoC), confirmed by BoA
120/2000-1.

If a significant part of the relevant public is not able to understand the meaning of the sign, the conceptual differences will not lead to a finding of likelihood of confusion.

3.2. Visual comparison: practical criteria


The visual comparison is obviously decisive as regards figurative signs. However, it may also play an important role when comparing word marks. Not only the number of the letters is relevant in this context, but also the number of words and the structure of the signs. Further particularities may be of relevance, such as the existence of special letters or accents that may be perceived as an indication of a specific language.

It should be noted that in the case of *word signs*, the word *as such* is protected and not its written form. Therefore, it is irrelevant whether word marks are represented in small or capital letters. The same applies to different letter-types, at least insofar as they are common in the relevant market.

31/1999 (DE) Landana / LANDAMANN (LoC);
62/1998 (EN) Cash Guard / CASHGUARD (LoC).



As regards *colour signs*, the use of the same colour or colour pattern is an argument in favour of finding visual similarity. The exact effect of colours or colour patterns has to be assessed individually in each case, since this depends very much on the impact of the colour on the overall impression of the signs involved.


41/1998 (EN)  (fig.) (No LoC);

1019/1999 (ES)  TPS /TPS CALL SCIENCES (LoC);

1159/1999 (EN) EUROPA/  (LoC);

In the comparison between *three-dimensional signs* and two-dimensional signs the same basic principles are to be applied. Of course the particular features of the three-dimensional sign may have a special influence usually on the visual impact of the sign. However, this must be considered in respect of the overall impression as usual.

2567/2000 (EN)  /  (LoC);

or 41/1999 (ES)  (considered as 3D device) / (considered as a 2D device) (No LoC);



As regards the comparison between three dimensional signs, a comparison between the same devices as in case 41/1999 (cones) but this time assuming both are 3D can also be seen in decision 787/2001.

This decision was adopted following the decision of the Boards of Appeal in case 41/1999 that made the OD accept that the CTM application is not a 2D drawing but just different views of a three dimensional device (BoA R-174/1999-2 and subsequent decision of OD 787/2001).

In this case, as both are 3D signs, it was held that they produced a similar impression overall. In the decision, on the one hand, the device was considered original in relation to the relevant goods (snacks) and, on the other hand, the simplicity of the devices was also taken into consideration (cones or similar are generated by a rotation in space of a triangles, one of the simplest 2D figures; LoC).

3.3. Phonetic comparison: practical criteria

The opposition may be based on earlier signs which enjoy protection in different Member States. In such cases the different pronunciations and intonations of the signs *in all the relevant areas* are to be taken into account.

In principle, when word-only signs are involved, the aural impression will be of greater relevance than the visual impression. Word only signs could be written using different combinations of letters that, nevertheless are pronounced very similarly or identically.

1197/1999 (EN) KÄMPGEN / CAMPERS (LoC);
1280/1999 (EN) MANFIELD / PENFIELD (No LoC);
194/2000 (EN) eldou / VEL DOUX (LoC);
2895/2001(EN) POSTEX / POSTECS (LoC).

When a sign contains foreign words, it is possible that a significant part of the relevant public is unfamiliar with the foreign language of the specific foreign words used. In this case consumers would pronounce the words in accordance with the phonetic rules of their native language.

1280/1999 (EN) MANFIELD / PENFIELD (No LoC);
146/2000 (EN) BRIDGE / OXBRIDGE (LoC);
2032/2000 (EN) OLLY GAN / HOOLIGAN (LoC; pending before CFI).

In cases where a significant part of the relevant public pronounces the foreign word correctly, but another significant part of the relevant public applies the rules of their mother tongue, both ways of pronunciation have to be taken into account when assessing the phonetic similarity of the signs.

309/1999 (DE) WOOKI / WALKIE (LoC).

The aural similarity between the marks may be offset by conceptual or visual differences.

1158/2000 DERMO BABY / THERMOBABY (No LoC).

As far as purely figurative marks are concerned, it is, in principle, not possible to make a phonetic comparison. A phonetic comparison could only be possible in cases where, either because of the direct and unequivocal term suggested by the sign or, mostly, because the owner of the trade mark has “taught” consumers (through advertising, promotion, etc) that his trade mark is to be pronounced in a particular way. Such cases occur where the parties have managed to prove that the mark can be referred to orally either because of a “training” of consumers or because there is no possible alternative way of referring to the device. An example of the first case could be a device of a bag with a question mark that is insistently advertised as “the trade mark of the ‘mystery bag’”. It also has to be taken into consideration that possible names also depend on the different relevant languages.

Therefore, these cases are not particularly frequent and depend mostly on the evidence submitted by the parties to support the argument of the *phonetic* aspect of the figurative sign.

3.4. Conceptual comparison: practical criteria

The signs are conceptually identical or similar when the public perceives the two signs as having the same or a similar semantic content. Conceptual similarity is also possible between word signs in different languages or between word and figurative signs. It is sufficient that the perception of a common meaning of the signs is shared by a *significant part of the relevant public*. This evaluation has to be carried out as regards (each of) the relevant area(s).

131/1999	EN	CINCO OCEANOS	5 OCEANS	LoC
348/1999 confirmed by BoA 380/1999-2	EN	LINDENER	LINDEBOOM	LoC
476/1999	EN	NUTRIFORM	NUTRAFERM	LoC
482/1999	EN	CHAIN MASTER	MASTER Cadena	LoC
758/1999,	EN	MATRATZEN		LoC
1191/1999	EN	RIPOLIN	Rentolin	No LoC
182/2000	EN	LIMMIT	NO LIMITS	LoC
3111/2000	EN	RED BARON	BARON ROJO	LoC
1917/2000	ES	MAJORICA	MINORICA	LoC
2962/2001	EN	OPERATION SOURIRE	OPERATION SMILE	LoC













When signs are in a *foreign language*, a significant part of the relevant public may only have a limited command of the relevant foreign language and therefore might not be able to distinguish the subtle differences between the meaning of two signs. Already the perception of their meaning by the public may be then to some extent blurred. This further influences their recollection which will be less clear and less exact than the recollection of meanings originally perceived in the native language.

113/1998 (EN) SUNRISE / SUNSET (LoC);
 495/1999 (EN) SECRET PLEASURES / PRIVATE PLEASURES (LoC), confirmed by BoA 616/1999-1;
 2432/2001 (ES) BILBAO BLUE / BILBAO (LoC; BoA, CTM partially accepted



The outcome may be different in cases where *one* of the two signs is written in the native language of the relevant public. The perfect understanding of its meaning and, therefore, its better recollection may enable the relevant public to perceive the differences in the meaning of the signs.

1121/1999 (EN) DAS GOLDENE BLATT / GOLDEN PAGES (LoC)

As regards figurative signs, the Court has stated that the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore 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, either *per se* or because of the reputation it enjoys with the public (*Sabel*, paragraph 24). Therefore, the underlying conceptual similarity in such cases is usually not sufficient for a finding of confusion unless the earlier trade mark is particularly distinctive. This means that some differences in the depiction representation of common elements and symbols may suffice to exclude likelihood of confusion, even if the underlying concept is not altered.

41/1998	ES			No LoC
641/199	EN			No LoC
696/1999	DE			No LoC
1368/1999	EN			No LoC
165/2000	EN			No LoC
1447/2000	DE			No LoC

The outcome may be different when the common figurative element is distinctive for the relevant goods/services or when the depiction of the earlier sign has acquired some distinctiveness through use (see previous section 3).

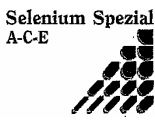
3006/2000 (EN)  /  (“deer’s head” for classes 32-33. LoC Pending in BoA)

1449/2000 (EN)  and  /  (LoC).

The *difference* in the meaning of the signs may be an argument against the finding of a likelihood of confusion. This requires that *all the significant parts* of the relevant public perceive the different meaning of the signs.

286/1999	EN	MOUNTAIN	MOUNTAIN BIKER	No LoC
611/1999	EN	VERITÉ	VERI	LoC
873/1999	EN	ALTA	ALTA FIDELIDAD	No LoC
1279/1999	EN			No LoC
870/2000	EN	PLANET		No LoC
276/2001	EN	PLANET	MIKADO PLANET	No LoC

In cases where a significant part of the relevant public, in particular due to linguistic reasons, does not understand the different meaning of the signs, the likelihood of confusion is not diminished in the respective territory (see subpoint 2. above).

2920/2001 (EN)  / SELENIUM-ACE (LoC).

It may not be sufficient for a finding of confusion if only one component of the signs has a common meaning for the relevant public. In such cases it should be evaluated whether the meaning of the common component is strong enough to establish that the relevant public will assign this particular meaning to the whole sign. In this context, it should be taken into account that the relevant public does not tend to analyse the various parts of a sign.

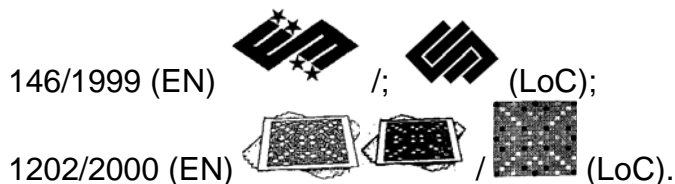
55/1998	IT	UNCLE WILLIAM	UNCLE BEN'S	No LoC
359/1999	EN	KINGSTON'S	KINGSTON ESTATE	LoC
1424/1999	EN	VIFIT	VIVITA	No LoC
1784/2001	EN	TEQUILA		No LoC

The consequence of a finding of conceptual similarity for the evaluation of likelihood of confusion depends on its strength and on the further circumstances of the case. The conceptual similarity has *less weight* in the evaluation of likelihood of confusion when the meaning of the signs clearly alludes to the respective goods and services or is common in the relevant market.

66/1999	EN	DINOKIDS	DINO	No LoC
1043/1999	EN	NEOLUX	NEOLITE	No LoC
1159/1999	EN	EUROPA / T	Europa	No LoC
763/2000	EN	XXL	XL(device)	No LoC
1139/2000	EN	SILBERQUELL E	SILVER SPRING CLEAR	No LoC
937/2001	EN	VITAL	PHYTO-VITAL	No LoC

As regards the conceptual aspect involved in the comparison of purely figurative trade marks, again it is a matter of assessing the particular factual circumstances of the case. The exercise is a bit easier than the consideration of the *aural* aspect of such signs (see preceding point 3.3), as it is necessary to consider whether a common concept can be immediately perceived in the signs. In essence, all the considerations as regards the owner having *trained* the public to associate a sign with a particular concept are also applicable.

In the following decisions, the visual similarities were the only relevant element to consider as there was no possibility of a identifying an *aural* element in either trade mark and only the second decision permitted to additionally identify the intellectual link of a *board game*.



4. Particular issues as regards different kinds of signs

The following criteria have been developed and applied in a multitude of cases, in particular in the comparison of word signs. However, it should be stressed that these criteria are neither exhaustive nor applicable in all cases. Depending on the special circumstances of each individual case, different criteria may be pertinent.

4.1. Number of letters and structure



The overall visual impression produced by verbal or predominantly verbal signs depends to a great extent on the number of letters and the structure of the words. 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.

291/1999	EN	SUVIMAX	SULINAX	LoC
444/1999 BoA/CFI (settled)	EN	Sedonium	PREDONIUM	LoC
469/1999 confirmed by BoA R 622/1999-3	EN	CODEROL	CODIDOL	LoC
476/1999	EN	NUTRIFORM	NUTRAFER M	LoC
852/1999	EN	EVERGREEN	EVERDEEN	LoC
2044/2000	EN	RESVIN	RESVERIN	LoC
727/2001	EN	GERALDINO	GHERARDIN I	LoC
1917/2000	EN	MAJORICA	MINORICA	LoC
2694/2001	EN	FORTIS	FORIS	LoC, confirmed BoA R 0049 / 2002-4

4.2. Length of signs










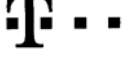


The length of the signs may influence the effect of differences between the signs. The shorter a sign, the more easily the public is able to perceive all its single elements. Thus, small differences may frequently lead in short words to a different overall impression. In contrast, the public is less aware of differences between long signs.

In many relevant markets it is a common practice to use short marks which are abbreviations of the name of the company or refer to the relevant goods or services. In these cases the public is aware of this practice and is generally used to distinguishing between many abbreviations and will not be easily confused.






1316/1999	EN	ODOL	IDOLE	No LoC
651/2001	EN	YSL	SL	No LoC
838/2001	EN			No LoC
1038/2001	EN	TOM	DOM	No LoC

There is the tendency to deny similarity between “one-letter-signs / one-numeral-signs” which are depicted in a different and imaginative style. In fact, a single letter *per se* is generally devoid of distinctive character and does not, in principle, serve in trade to distinguish the goods of one undertaking from those of other undertakings. Therefore, for “one-letter / numeral marks”, the protection is sought for the specific manner in which the letters are represented graphically and not for the single letter by itself. For this very same reason, its *aural and its conceptual* impression will necessarily be identical but irrelevant to the overall impression of the sign.

This implies that, for instance, if the marks in conflict consist in different graphic representations of the same letter, there will normally be no LoC.

10/1999	EN			No LoC
122/1999	EN			No LoC
394/1999	EN			No LoC
468/2001	EN			No LoC
1850/2001	EN			No LoC
1631/2000	FR			No LoC

Nevertheless, these signs accompanied by similar figurative elements can be similar:

570/2000 (EN)   /  (LoC);
 1087/2001 (EN)  /  (LoC).

It is necessary to clarify that a verbal representation of “one-letter / one digit signs” is not to be considered equivalent to the sign and that, therefore, the aforementioned arguments are not directly applicable to such cases. For example, a fancy representation of number one is not the same sign as the word trade mark “ONE”.

As regards trade marks built as “two letter / two digit signs”, it should be noted that similarity has been denied when they are compared to trade marks with different or more letters, also on the grounds of their reduced *intrinsic distinctiveness*.

596/1999 (EN) PC / BC (No LoC);
 337/1999 (EN) NTS / NT (No LoC);
 623/1999 (ES) EO / EOS (No LoC);
 1244/1999 (EN) ATS / at (No LoC);

Finally, special considerations such as the representation of those letters in a peculiar form can lead to likelihood of confusion:

649/2000 (EN)  (LoC).

To continue with the analysis of the signs that are considered weakly distinctive because of their reduced number of letters or figures, a further step towards the increase of distinctiveness would be that of “three-letter / three-numeral- signs”. In such cases, there seems to be a tendency to regard the signs as similar where the only difference lies in one phonetically similar letter.

The following were found similar:

52/1999 (EN) ILC / ILS (LoC);
771/1999 (EN) Aok / Ayk (LoC);
869/1999 (EN) kza / KSA (LoC);
1536/1999 (EN) SYM / SIM ((LoC).

In contrast, the following were found dissimilar:

168/1999 (EN) jbs / TBS (No LoC);
909/2001 (EN) BRU / BLU (No LoC);
125/2001 (EN) TPS / PTS (No LoC).

However, in this context it should also be noted that there is no set approach. Each case has to be judged on its own merits, i.e. by taking into account all its specific circumstances.

4.3. Beginning of signs

In predominantly verbal trade marks, 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 such cases, the beginning of a sign has a significant influence on the general impression given by the mark and may often be capable of excluding similarity.

Nevertheless, it has to be borne in mind that 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 not a *middle* part of the sign. Again, this perception mostly depends on the circumstances of the case (length of the sign, syllabic distribution, use of typeface, etc) and does not depend on a set rule. It could even be that a sign is perceived as having a short beginning and ending and a proportionally much bigger *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.

560/1999	EN	ELTON	HILTON	No LoC
715/1999 confirmed by BoA Dec. 731/1999-2	EN	VOBIS	COPIS	No LoC
769/1999 confirmed by BoA Dec. 794/1999-1	EN	PRESTA	Ersta	No LoC
800/1999	DE	YOSTNER	COSTNER	No LoC
1490/2000	EN	SINOIL	EMOIL	No LoC
2437/2000	EN	PLOVER	OLOVER	No LoC
1489/2000	EN	INOTENS	DUOTENS	No LoC

However, the exact effect of differences at the beginnings of signs always depends on the specific circumstances. An overall impression of similarity may be given, nevertheless, in cases where the difference at the beginning of the signs is visually, phonetically or conceptually not clearly perceptible, or where other features of the signs play an important role, such as their structure or their sequence of syllables.

65/1998	DE	BONAX	SONAX	LoC
80/1999	EN	 	REBEL	LoC
90/1998	EN	ZADOVIR	RADOVIR	LoC
592/1999	EN	XENOVA	RENOVA	No LoC
2396/2001	DE	ASPIRIN	BESPIRIN	LoC
1670/2001	EN	NORVIR	NOVIRIO	No LoC

In contrast, as it is usually the beginning of a sign which catches consumers' attention, where signs only differ in their *endings*, this difference is often insufficient to exclude similarity.

611/1999	ES	VERITÉ	VERI	LoC
685/1999	FR	QUINTON	QUINTONINE	LoC
1587/1999	EN	SHAPER	SHAPERITE	LoC
164/2000	EN	Lubrigel	lubrigyn	LoC
174/2000	EN	GASTROMIL	GASTROBIN	No LoC
2591/2000	EN	SATINANCE	SATINESSE	LoC

4.4. Sequence of syllables, rhythm and intonation

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 plays an important role in the phonetic perception of signs. 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 trade marks are the syllables and their particular sequence. The assessment of common syllables is particularly important in the phonetic comparison, as a similar overall phonetic impression will mostly be determined by the shared syllables and their equal or similar combination.

35/1998	FR	SIENA	LA SIRENA	No LoC
31/1999	DE	LANDANA	LANDAMANN	LoC
35/1999	EN	PHOTONICA	PHOTOKINA	LoC
44/1999	EN	TELIA	teeli	LoC
1618/1999	DE	kuku	KUDU	LoC

It should also be noted that what can constitute a common part of the opposing signs from a visual analysis can, nevertheless, produce a phonetic impression that is not so similar or even different. This depends on the way syllables are constructed (and, therefore, pronounced) according to the rules of the relevant language.

Dec. 473/2000 (EN) ACTOS / ENTACTOS, (Visually there was a clear coincidence: the last part of the CTMA reproduced the earlier sign: -ACTOS. Nevertheless, the earlier trade mark was pronounced as |ak|-|tos|, whereas the CTMA was NOT |ent|-|ak|-|tos| but |en|-|tak|-|tos|; (No LoC).

Furthermore, in some cases, consumers could be aware that the opposing trade marks are formed of the same syllables in a different order, so that if one of the words were rearranged it would be the same as the other. A clear example of this is where marks are composed of two transposed syllables, e.g. HOTPOT / POTHOT.

Nevertheless, the consideration of such a transformation exclusively depends on the perception consumers will have of the signs. Only in cases where it will be evident to consumers that the application sign is an inversion of the syllables of the earlier trade mark (or vice versa), can the link be taken into consideration.

In particular, when the signs are perceived as formed by two known elements, an inversion of these elements would be clearly noticeable. 1852/2002 (EN) SAT-COM / COM S.A.T (LoC).

On the other hand, if the perception the relevant consumers have of the signs is that they are completely fancy terms, a *syllable inversion* will not be noticeable and, therefore, will not contribute to a conclusion of similarity.

5. “Composite” signs – signs that are partly or wholly included in the other sign

In these cases, an element or the whole of a sign is totally or partially included in the other sign.

Before reaching a conclusion on similarity it is important to establish whether or not common component is predominant in relation to the other components of the signs. The approach on how to evaluate distinctiveness and dominance of components of signs has been discussed above under subpoint 1. The public perceives the sign as a whole and, in general, does not tend to split them up into parts. Therefore, assuming that all components have a similar degree of distinctiveness, it is *not* appropriate to focus only on the common component of the signs at issue.

Particular attention should be paid to the distinctiveness of the earlier sign. As always, all the further circumstances of each specific case have to be carefully evaluated.













5.1. Signs containing figurative and word components

When signs consist of both word and figurative components, the principle has been established that the word 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 most readily refer to a sign by its verbal component.

It follows from this that a similarity of signs is probable in cases where the signs contain an identical or very similar *word component*, but different figurative components. The same principle applies to signs which consist of different figurative components, but also of a component showing an identical *number*.

64/1998	ES	SSI USA		LoC
28/1999	EN			LoC
296/1999	EN			LoC
1134/1999	ES	911		LoC
1001/1999	FR			LoC
845/2000	EN			LoC
1432/2001	EN	KALMA		LoC

On the contrary, in general the identity or similarity of the *figurative component* of the signs is insufficient to establish similarity in cases where at least one of the signs contains a further word component which is not shared by the other sign.

692/1999	EN			No LoC
885, 886/1999	EN			No LoC
1224/1999	EN			No LoC
2576/2000	EN			No LoC
539/2001	EN			No LoC
688/2001	EN			No LoC

As always, the outcome depends on the particular circumstances in each individual case. The finding may be different, in particular, due to the predominant character of the common figurative component or due to the limited distinctiveness of the word component.



583/1999 (EN) ISDN / ISDN (No LoC);



2637/2000 (EN)  / LA MAISON DE LA FAUSSE FOURBURE (LoC).

In other cases, the device element may “cooperate” with the word part in defining a particular concept and may even help the understanding of words that, in principle, might not be widely known to consumers.



679/2001 (ES)  /  (LoC). The signs were considered sufficiently similar for LoC based on the identity of goods as the device of a moon, present in both signs, made the equivalence between the Spanish and English words “LUNA” and “MOON” clearer to Spanish consumers.

5.2. “Multi-part” word signs

In these cases the whole sign or just one of its components is fully incorporated in the other sign. The issues raised in the context of these cases are very complex. Particular attention should be paid to the criteria below.

5.2.1. Predominant character of the common component

The finding as to the predominance of the common component in the “multi-part” sign(s) plays the most important role when judging on the similarity of such marks. This question has to be evaluated bearing in mind all the relevant geographical areas and taking into account all the relevant goods and services (see subpoint IV.2.).

The predominant character of the common component can be based on its more distinctive content or its special figurative presentation in comparison with the other components of the sign(s) but, in most of the cases, it is the joint combination of both features that produces the impression of predominance in the sign. The distinctiveness of each of the different components has to be evaluated and compared with the others. The location of the common component at the beginning of the sign is relevant in this respect, but as such is not sufficient to establish its predominant character.

66/1999	EN	DINOKIDS	DINO	No LoC
114/1999	FR	DELI	DELIBORI	No LoC
512/1999	EN	MAXTECH	MAXDATA	No LoC
905/1999	FR	Arthur	ARTHUR ET FELICE	No LoC
1322/1999	EN	PLANET	PLANET SOCCER	No LoC
1425/1999	EN	SIMPLE	SIMPLE LIFE	No LoC
1537/1999	EN	ORIGINS	ORIGINE WORLD	No LoC
1407/2001	EN	IBUTOP	IBUSOL	No LoC

Furthermore, the predominance of the common component may also be acquired through use. The finding of acquired distinctiveness through use depends on numerous factors which are set out below (subpoint IV.2.).

1000/1999 (ES) CRISTAL / CRISTAL CASTELLBLANCH (LoC).

If a sign as a *whole* is fully incorporated in the other sign, the finding of its predominance in the other sign (compared to its further components) is generally sufficient to establish similarity of signs.

44/1998	EN	SIMPLE	SIMPLE D’ANVERS	LoC
397/1999	EN	STITCHES	Broken Stitches	LoC
425/1999	EN	ILUSION	SMOOTH ILLUSIONS	LoC
430/1999	EN	STONES	PRECIOUS STONES	LoC
1137/1999	ES	MAS & JOVER	JOVER	LoC
625/2000	EN	SUN	SUNPLUS	LoC

However, if the “fully incorporated sign” does not constitute the dominant component of the other sign (e.g. because it is placed at the end of the mark and/or because it is not particularly distinctive), in principle it is concluded that the marks are not similar overall.

1968/2000 (EN) JAFFA SUNRISE / SUNRISE (No LoC);
2768/2000 (EN) KALISTARLITE / STARLITE (No LoC).

Where *both* signs contain further elements to the common component, the predominance of the common component in only one sign is generally insufficient in itself for establishing similarity of signs. It rather has to be evaluated whether the predominance of the common element can be established in respect of *both* signs.

972/1999 (EN) SCRUMPY JACK / CIDER JACK (LoC);
1020/1999 (EN) ONE TOUCH / CLEAN TOUCH (LoC).

5.2.2. Distinctiveness of the earlier sign

The distinctive character of the earlier sign (or of an element or elements of it) is a further element which plays an important role when judging on the similarity of “multi-part” signs. This approach is in line with the finding of the Court that the distinctiveness of the earlier sign increases the likelihood of confusion. It follows that when the differences between components of signs consist in their most distinctive elements, the overall impression they give will be different. (See Part B.I *likelihood of confusion*, point 3.4.1. *degree of distinctiveness of the earlier mark*).

5.3. Names

A special approach is justified in relation to signs which contain (business) names, since the public may perceive and evaluate the function of their representation differently from other components of signs.

5.3.1. (Business) names in combination with other components

If a sign contains both a (business) name and another word component, there is the tendency to evaluate *this further component* as predominant. This is because in general the public understands the further component as the prime indicator of origin in respect of the specific goods and services. The (business) name is regarded by the public as of subsidiary nature in such cases.

364/1999 (FR) GATSBY BY GAT / GATSBY (LoC);
396/1999 (FR) GALA DE LOEWE / G GALA PERFUMERIES (LoC);
449/1999 (DE) DOCKERS / DockerS by Gerli (LoC);
290/2001 (EN) SPINNING made in Italy by Milena / SPINNING (LoC).

Such an assumption requires that the relevant public *perceive* the nature of this component as a (business) name. This has to be evaluated as regards all the relevant geographical areas.

177/1999 (DE) Plastoclean / PlastiClean Thyssen Schulte (No LoC);
131/2000 (EN) PEPE / PEPE CABALLERO (LoC).

The applicability of this approach has to be carefully assessed in each individual case. In particular, the perception of the public may be different in cases where the further component of the mark is less distinctive or where the use of a (business) name as indicator of origin is common in the particular market sector.

5.3.2. First and family names

Arguments of the parties about the right to use one's own (business) name 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, it should be noted that the registration of trade marks does not hinder the use of personal names due to the special protection which is provided for in Article 12(a) CTMR and in the relevant national trade mark laws according to Article 6(1)(a) of the Trade Mark Directive.

177/2000 (EN) GIORGI / GIORGIO (LoC).

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 great number of people that do not have anything in common, whereas the presence of the same surname could imply the existence of some link between them (a family link). Therefore, consumers tend to pay more attention to family names than to first names.

Nevertheless, this rule should not be applied automatically without having previously assessed what would be the consumers' perception of the signs, in particular, and amongst other considerations, whether the public identify them as name+surname or whether the name or the surname are common or unusual. Only in this case could it be assumed that where two signs contain the same *family* name, there will be a finding of similarity of signs despite the presence of additional first names either in one or in both trade marks.

704/1999 (EN) REDAELLI / Giorgio Redaelli (LoC);
820/1999 (ES) Renoir / IVES RENOIR (LoC);
1477/1999 (EN) CLAUDIA BAKER / TED BAKER (LoC);
803/2000 (EN) BELTRAN / DARIO BELTRAN (LoC).

The situation is different in cases where such signs share the same *first name* but there is no common *surname*. In general, this consideration leads to a finding that there is no similarity of signs.

1326/1999 (EN) LAURA / LAURA MERCIER (No LoC), confirmed by BoA R95/2000-2.

On the contrary, in cases where the signs are not recognised as name+surname but rather considered as fancy terms, no consideration as regards surnames would be appropriate and, therefore, the conclusion would usually be the opposite, namely, that the signs are similar because one of them identically reproduces the totality of the other.

131/2000 (EN) PEPE / PEPE CABALLERO (LoC).

It has to be carefully assessed whether the above-mentioned general principle about the different value of first and family names as indicators of origin really fits the specific case. A different evaluation may be appropriate in cases where, in the relevant area, the surname is quite common or the first name is very distinctive due to its rare appearance in the relevant area or its reputation acquired through use.

467/1999	FR	ROSY	ROSY O'GRADY	LoC
1074/1999	EN	AAXEL DAVID	HELEN DAVID	No LoC
1193/1999	EN	JOHN SMITH	PAUL SMITH	No LoC
130/2000	ES	PEPE	PEPE CABALLERO	LoC
2264/2001	DE	Michael Schumacher	Sabine Schumacher	No LoC

As always, the special graphic representation of the components may play an important role when assessing the effect of first and family names in the overall impression of the signs.

II. CONCLUSION ON SIMILARITY OF SIGNS

The finding of likelihood of confusion always depends on *all aspects of similarity and includes all other circumstances as well (similarity of goods or services, particular circumstances, etc.)*. The similarities or differences in the different (visual, phonetic and conceptual) aspects of similarity have to be evaluated and compared. It may be important to specify in this context the *strength* (degree) of the similarity in the different aspects.

The final question on similarity of signs is whether, after an assessment of the various aspects of similarity of signs, the signs in conflict have sufficient elements in common, visually, orally, or conceptually, that, where the goods or services would be identical, it seems likely that the public will think that the goods or services marked with the signs at issue come from the same or economically linked undertakings.

For practical reasons, it may be appropriate not to come to an overall conclusion on similarity of signs at this stage and evaluate this question *together with the overall assessment on the finding on likelihood of confusion*. This approach avoids repeating the assessment and weighing up of the different aspects of similarity. In particular, it should also be borne in mind that the outcome might be influenced by the other factors of likelihood of confusion.

Therefore, when a decision of *dissimilarity* of signs is taken, due account must be taken of the principle that all factors of likelihood of confusion are interrelated with each other. This means that a conclusion of dissimilarity of signs, without taking into account the other factors of likelihood of confusion in the specific case, can only be arrived at if the same conclusion would have been reached even if the goods and services were identical and the earlier mark was highly distinctive. This has to be expressly mentioned in the decision.