

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. PRINCIPLES UNDERLYING THE COMPARISON

The same basic principles explained above under Chapter 2 B 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;

The principle is:

Signs are similar if under the assumption that the goods are identical and the earlier sign has a normal or high degree of distinctiveness, there would be likelihood of confusion in the sense that the relevant public might believe that the goods carrying the younger mark and the goods carrying the earlier mark come from the **same or economically-linked undertakings**.

When the signs are not similar, a discussion of the similarity of goods and of the overall assessment of LoC shall be skipped.

In this case, the following standard text should be used:

“According to Article 8(1)(b) CTMR, the similarity of the signs is a condition for a finding of likelihood of confusion. Since the signs are clearly dissimilar, one of the necessary conditions contained in Article 8 (1) (b) CTMR is not fulfilled, and the opposition must be rejected. This result would not alter even in case of identity of the goods or services, as signs cannot become similar because they are applied to identical goods.”

Where absolute dissimilarity of signs is less obvious and where some of the goods are identical and others similar, the following text should be used:

“As follows from the analysis above, the signs have many differences in visual, aural and conceptual respect. Taking into account the average degree of distinctiveness of the earlier mark, those differences suffice to safely exclude a likelihood of confusion in the territory in which the earlier mark is protected, i.e. ..., even for the identical goods “clothing” in class 25. Consequently, a fortiori, there can be no likelihood of confusion in respect of the remaining goods of the CTM application, which are not identical to any of the goods of the earlier mark. Therefore it is not necessary to proceed to an

analysis of the similarity of the remaining goods of the CTM application with goods of the earlier mark and the opposition must be rejected for all goods and services.”

II. CRITERIA

1. Reference basis for the comparison

When assessing the similarity of signs, in principle the signs have to be compared in the form they enjoy protection. That means that the earlier registered mark 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 to the comparison of signs.. For the effect of *disclaimers*, see Chapter 2 D, II.

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, the 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, but also other factors, such as a different graphical presentation or a different size of the various components.

However, the Court did not define 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
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 R 813/1999-1	EN	ATLANTIC	PAPETERIES DE L'ATLANTIQUE	No LoC
1303/1999 confirmed by BoA R 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.

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).

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 and ECJ	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.

3. Visual, phonetic and conceptual comparison

3.1. General principles

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

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.

309/1999	WOOKI	WALKI	LoC
1949/2001	HZ	Hazet	LoC
148/2000	COPAT	QPAT	LoC
1593/2001	INCELL	LINCEL	LoC

According to CFI case-law, for clothing, usually the visual comparison is of higher importance than the phonetic comparison as the goods are bought “on sight” and usually be chosen only after a close look at their appearance.

CFI, T-117/03, NL Sport / NL (LoC)

Similar considerations apply, although in a less pronounced way, for perfumes.

CFI T-355/02, SIR (fig.) /ZIRH (No Loc)

This should, however, not mean that the phonetic aspect can be disregarded.. Also for clothes the phonetic factor may not be neglected as also these goods may be recommended or ordered orally.

Example for a case concerning clothing where visual dissimilarities were given less weight:

851/1999 confirmed by CFI	FIFTIES	MISS FIFTIES	LoC
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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.

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 weighed. 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.

Taking all these considerations into account, even a weak similarity in all three 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 aspects.

A finding that differences exclude LoC is only possible if the relevant public is able to *perceive* the visual or conceptual difference.

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

In order to be of importance, any difference must be sufficiently remarkable.

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

The 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 because the importance of the conceptual difference was overestimated: German consumers would not understand “marca” as meaning “Marke”.

A conceptual difference can only be given weight if it exists in all the geographical areas that are relevant when comparing the signs.

611/1999 (EN) VERITÉ / 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 influence the result.

A conceptual difference is of little weight in cases where the signs are phonetically identical or highly similar as in that situation the difference in concept will not even be perceptible when the signs are **communicated orally. In this case the conceptual difference can underline any** visual differences but not attenuate the phonetic similarity and can in no case as such exclude LoC.

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

3.2. Visual comparison: practical criteria

The visual comparison is obviously decisive as regards figurative signs.

Also for word marks, the visual comparison plays an important role.
In the case of word marks, 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).


For word marks, the visual comparison is based on an analysis of the number and sequence of the letters, 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. For word marks, the visual comparison coincides with the phonetic comparison unless in the relevant language the word is not pronounced as it is written.

For example, for word marks, a different assessment would apply only if either two different words are pronounced identically (example in French: dans / dent; in English: naughty / nasty These are not not pronounced identically!) or if two similar words are pronounced differently (example in English: though / through).

For figurative marks consisting of words (words written in a particular distinctive typeface), the overall impression of the image – and thus any similarities in the letters themselves, e.g. two similar letters that can easily be confused – is also of relevance.

As regards figurative marks in colour, the use of the same colour or colour pattern may increase a visual similarity of the figurative or word elements themselves. 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);

Mere coincidence of the same colour, if the figurative or word elements are not similar, in principle will not enough to lead to a relevant similarity.

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)  /  (no LoC);

or 41/1999 (ES)  (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*

When the opposition is based on earlier signs which enjoy protection in different Member States, the different pronunciations of the signs in all official languages of those Member States are to be taken into account. Local accents are not taken into account.

In principle, when word-only signs are involved, the aural impression will be of greater relevance than the visual impression.

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 should be assumed that the relevant public is either unfamiliar with that foreign language, or even if it understands the meaning in that foreign language, will still tend to pronounce it 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 (BoA and CFI: No LoC).

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).

Figurative elements of marks cannot be pronounced are not subject to a phonetic assessment. The “meaning” of what a figurative element represents, has to be assessed under the notion of conceptual similarity.

Example: There is no phonetic similarity between a star emblem and the word “STAR”.

3.4. Conceptual comparison: practical criteria

Signs are conceptually identical or similar when the two signs are perceived as having the same or a similar semantic content.

This is the case where

- (a) two words refer to the same semantic term or variations of it;
- (b) two words have the same meaning but in another language;
- (c) two different words refer to items that fall under the same category and have the same characteristics and convey the same emotional connotations;
- (d) two figurative elements would be phonetically referred to under the same term;
- (e) there is word vs a figurative element which would be phonetically referred to under the same term.
- (f) there is a colour per se vs. the verbal description of the colour.

This is not the case where

- (g) there are two words for which a generic term covering both of them exist;
- (h) the two signs fall under the same general category or sub-category of signs;
- (i) there are two different figurative representations of the same general phenomenon;

Conceptual similarity may come into play

- (j) for the two signs as a whole;
- (k) in comparing elements of composite (complex) signs).

Conceptual similarity increases the degree of overall similarity and thus increases LoC.

In contrast, a difference in concept decreases the degree of overall similarity and thus decreases LoC,

- (l) where both signs have a different semantic content (as set out above), or
- (m) to a much lesser degree, if one sign has a semantic meaning and the other none,
- (n) except where the signs remain phonetically similar to a high degree or identical, in which case any conceptual difference perceived visually is of little or no importance.

Finally,

- (o) where none of the signs conveys a semantic meaning, conceptual

similarity is of zero relevance.

As regards these individual sub-categories:

(a) Two words refer to the same semantic term or variations of it

This is the case where there are synonyms, ie where two words exist for the same semantic meaning.

Invented examples: Baggage/ Luggage; Bicycle / Bike; Male horse / Stallion.

This is also the case where the two terms are just variations of the same word.

2666/01, confirmed by CFI T- 296(02	LINDENHOF	LINDERHOF	(LoC denied for other reasons)
348/1999 confirmed by BoA 380/1999-2	LINDENER	LINDEBOOM	LoC

(Both terms refer, in different ways, to a species of trees.)

1044/1999	EN	ADVANTAGE	ADVANTA	no LoC
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(Both refer semantically to an advantage you get, the second term in a slightly allusive but still obvious manner)

359/1999	EN	KINGSTON'S	KINGSTON ESTATE	LoC
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(In both cases, the meaning is: this is the property of a certain Mr. Kingston).

Other examples:

2432/2001	ES	BILBAO BLUE	BILBAO	LoC; BoA, CTM partially accepted
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This comprises cases where the conceptual similarity consists in an antagonism:

182/2000	N	LIMMIT	NO LIMITS	LoC
1917/2000	S	MAJORICA	MINORICA	LoC

(b) Two words or terms have the same meaning but in another language:

Conceptual similarity also exists between word marks in different languages.

It is necessary that the perception of a common meaning of the signs is shared by a significant part of the relevant public in the territory where the earlier mark is protected and, when the earlier mark is a CTM, in the same part of the EC, ie in the same Member State. This evaluation has to be carried out as regards (each of) the relevant area(s).

In rare cases this tips the balance to LoC, namely where the terms coincide in one element anyway or are already presenting visual or phonetic similarities anyway.

131/1999	CINCO OCEANOS	5 OCEANS	LoC
476/1999	NUTRIFORM	NUTRAFERM	LoC
482/1999	CHAIN MASTER	MASTER Cadena	LoC
3111/2000	RED BARON	BARON ROJO	LoC
2962/2001	OPERATION SOURIRE	OPERATION SMILE	LoC
1121/1999	DAS GOLDENE BLATT	GOLDEN PAGES	LoC

Two different language versions of a term are conceptually equivalent, provided that both meanings are understood by the same relevant public. In practice, these cases are limited to situations where the earlier mark is protected in a part of the Community which has two official languages, or where a word in a foreign language has almost become part of the other language. In most cases there will be no Loc. The mere fact that one term is a translation of the other term is not sufficient. On the one hand, the perfect understanding of the meaning of the sign which is in the native language of the relevant public, and, therefore, its better recollection will enable the relevant public to perfectly recollect the differences of the signs. On the other hand, the meaning of the word in the foreign language will not that easily be understood or remembered or brought into connection with the other sign.

CFI T-33/03, HAI/SHARK (No LoC)

(It cannot be established that in Germany, the English word “shark” is widely used instead of the German term “Hai”.)

(c) Two different words refer to items that fall under the same category and have the same characteristics and convey the same emotional connotations;

This is the case for 2 aspects of well-defined semantic meanings:

113/1998 (EN) SUNRISE / SUNSET (LoC);

Or where the same emotional or subliminal connotation is conveyed:

495/1999 (EN) SECRET PLEASURES / PRIVATE PLEASURES (LoC), confirmed by BoA 616/1999-1;

Or when the other term appears as a “small edition” of the first term:











Focus / Micro Focus LoC, pending before CFI

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.

(d) Two figurative elements would be phonetically referred to under the same term:

As regards figurative signs, the Court (*Puma/Sabel*, paragraphs 24-26) has stated that “it is not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public. However, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.

The mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion.” The mere common association between two images in semantic terms is therefore not enough. The signs must, in the first place, represent visual (graphical) similarity. This means that some differences in the graphic representation of common elements and symbols will usually (and absent reputation of the earlier mark) 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

LoC will be found if the conceptual similarity of the graphic elements just reinforces the existing visual similarity,

146/1999 (EN)  /; (LoC);

1499/2000 (EN)  / (LoC).

1202/2000 (EN)  / (LoC).

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


all the more so if the earlier sign has an enhanced distinctiveness through use.

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

(e) There is word vs a figurative element which would be phonetically referred to under the same term.

In principle, conceptual similarity also exists between a word and an image showing what the word represents (invented example: Word mark “TIGER” against figurative mark depicting a tiger).

Example, where conceptual similarity was found between the word “Macarena” which refers to a well known apparition of the Virgin Mary in Seville and a composite mark which includes the word Macarena and a picture showing that scenery:

248/2002		MACARENA	LoC
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(f) There is a colour per se vs. the verbal description of the colour.

There is conceptual similarity between a word mark “orange” and a mark claiming the colour orange per se, because the consumer will always orally exclusively refer to the colour per se trade mark as the “orange” trade mark. Also, in his memory the recollection of a colour shade will always be closely associated with the verbal description “orange”.

(g) There are two words for which a generic term covering both of them exist, and

(h) the two signs fall under the same general category or sub-category of signs.

The mere fact that the two words or terms can be grouped under a common generic term, or belong to the same type of mark, is not at all a case of conceptual similarity.

Invented examples: “Jaguar” vs “Elephant”, the fact that both are animals is irrelevant. “TDI” vs. “LNF”, the fact that both are three-letter abbreviations is irrelevant.

The fact that both word marks are personal names neither constitutes conceptual similarity, nor can it detract from LoC. (Rather, the criteria under 5.3 for “names” apply, see the examples there).

See also:

55/1998	IT	UNCLE WILLIAM	UNCLE BEN'S	No LoC
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(i) There are two different figurative representations of the same general phenomenon

Figurative marks are protected the way they are actually depicted, not as regards the general category of phenomena they are about.

ECJ “Puma/Sabel” must not be interpreted as meaning that two figurative signs are protected against a common association of representing e.g. a particular type or species of animal unless there are commonalities in the figurative representation itself, and this applies irrespective of reputation.

There is no protection against association unless there is also LoC, and no protection of a motto or concept as such (no Motivschutz).

For example, the following marks are absolutely dissimilar although they both depict a young lady before an Andalusian landscape scenery:



(j) Conceptual similarity may come into play for the two signs as a whole

Usually, when the conceptual similarity refers to the two signs as a whole, there are visual and phonetic dissimilarity, and although it is not excluded that the conceptual similarity alone can lead to LoC, this will rarely be the case.

(see, again, the case HAI/SHARK, T-33/03)

(k) Conceptual similarity may come into play in comparing elements of composite (complex) signs

Much more weight is to be given to conceptual similarities of elements of composite (complex) signs which are visually different, if the other elements of the signs are visually similar/identical.

482/1999	EN	CHAIN MASTER	MASTER Cadena	LoC
2962/2001	EN	OPERATION SOURIRE	OPERATION SMILE	LoC

In conceptually comparing a one word mark with a composite mark, the analysis must be made towards the composite mark as a whole and not with respect to the coinciding word element, which would be identical. The result will frequently be one of conceptual difference.

286/1999	EN	MOUNTAIN	MOUNTAIN BIKER	No LoC
373/1999		ALTA	ALTA FIDELIDAD	No LoC
370/2000		PLANET		No LoC
276/2001		PLANET	MIKADO PLANET	No LoC

However, if the common element is weak (of little inherent distinctiveness, or even plainly descriptive), the conceptual similarity of that common element is of no weight and cannot compensate the low degree of distinctiveness of the earlier mark.

1424/1999		VIFIT	VIVITA	No LoC
1784/2001		TEQUILA	(label including the word Tequila)	No LoC

66/1999		DINOKIDS	DINO	No LoC
1043/1999		NEOLUX	NEOLITE	No LoC
1159/1999		EUROPA / T	Europa	No LoC
1139/2000		SILBERQUELL E	SILVER SPRING CLEAR	No LoC
937/2001		VITAL	PHYTO-VITAL	No LoC

(l) A difference in concept decreases the degree of overall similarity and thus increases LoC, where both signs have a different semantic content

It is a strong, although never automatically decisive, factor against LoC if both marks, although representing some visual similarities, have a clearly understandable conceptual difference in the sense that each word refers to a different concept. This is all the more so if one of the meanings is descriptive or allusive for the goods.

960/1999	GUESS?	GLISS	No LoC
1443/1999	METRO	MAESTRO	No LoC
CFI	BASS	PASH	No Loc
256/2000	GOLDMARK	GOLD BLOCK	No LoC
1175/1999	NEPAL	HEPAL	No LoC
1316/1999	ODOL	IDOLE	No LoC

LoC may still be found to the extent that the conceptual difference is not perceived aurally so that it cannot overcome the aural similarity:

CFI	DE	Mixery	MYSTERY	LoC
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(m) To a much lesser degree, if one sign has a semantic meaning and the other none.

Much less is the weight of conceptual dissimilarity if only one of the marks has a meaning. This may, in some instances where the other mark is clearly recognizable, constitute a factor against LoC – in the sense that it helps distinguishing the two marks - but it must not be forgotten that the fact that the younger mark does not represent the same concept as the earlier mark would just be the consequence of the fact that the younger mark is not identical.

It is quite problematic that some CFI decisions have used a conceptual meaning present only for one of the two marks as a shortcut for denying LoC.

CFI, T-292/01, “BASS/PASH”, par. 54,
CFI T- 35/03, “Carpo/Harpo Z”, par. 27,

We should refrain from such reasoning in our decisions. A quasi-automatism that lack of realising the same concept as the earlier mark excludes LoC would be incorrect.

(n) Except where the signs remain phonetically similar to a high degree or identical, in which case any conceptual difference perceived visually is of little or no importance.

Where the words are pronounced identically or in a similar way, any conceptual difference will not be perceived and cannot attenuate the phonetic similarities. In this case any conceptual difference perceived visually is of little or no importance. So, LoC would still be found to the extent that the conceptual difference is not perceived aurally.

CFI	DE	Mixery	MYSTERY	LoC
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(Contrary to CFI, Hooligan / Olli Gan).

(o) Where none of the signs conveys a semantic meaning, conceptual similarity is of zero relevance.

If none of the marks has a semantic meaning (i.e. if the two word marks are

invented words), the decision should either state that a conceptual comparison cannot be made, or refrain from any discussion of conceptual similarity.

In those cases there is neither conceptual similarity nor a conceptual difference. That is, the notion of conceptual similarity has zero impact on the case.

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	NUTRAFERM	LoC
852/1999	EN	EVERGREEN	EVERDEEN	LoC
2044/2000	EN	RESVIN	RESVERIN	LoC
727/2001	EN	GERALDINO	GHERARDINI	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 of 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.













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 PAISSE FOURRURE (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 most frequent and problematic type of cases concerns one word against two words.

5.2.1. Similarity

In assessing similarity (not the degree of distinctiveness, see following paragraph !), the priority situation is of little relevance as the public does not or would not know which mark is earlier on the Register.

The length and meaning of the signs are of importance.

Next, it is of particular importance whether the common word can be identified in an isolated manner in the two-word mark, either because it is separated by a backspace or hyphen, or is otherwise (because of its clear meaning) identified as such.

The mere coincidence in a string of letters is not enough for similarity. Decisions should not be based on the mere fact that one sign is “contained” in the other one.

Invented example: ANT / Fantastic, no similarity.

In comparing a mark consisting of two words with equal length with a mark which consists of only one of those two words, generally speaking, there is similarity of the signs (and in many cases, depending of course of other factors and in particular the degree of distinctiveness of the earlier mark, LoC for identical goods).

The Office does not follow the theory that in these cases there is only LoC if the common element clearly dominates the composite mark.

Rather, in such cases, LoC will generally be excluded only if:

- if the earlier mark is no longer recognizable as such in the younger mark (see above, ANT / Fantastic);
- if the elements added in the younger mark are clearly preponderant (invented example: LIFE / Thomson – helps you create a better life)
- if through the addition of other elements the younger mark becomes conceptually different (invented example: New Line / Skyline);
- if the earlier mark has a low degree of inherent distinctiveness or is close to a descriptive term.

Practical cases:

1322/1999	PLANET	PLANET SOCCER	No LoC
1425/1999	SIMPLE	SIMPLE LIFE	No LoC

In all other cases the general rule of thumb is that if a sign as a whole is fully incorporated in the other sign, the signs are similar and, when the goods are identical or highly similar and absent other specific factors, there will also be likelihood of confusion.

ECJ, C-120/04, “Thomson Life/Life”

This is in line with the CFI judgments (each time, LoC was confirmed):

- T-286/02, „KIAP MOU/MOU“
- T-169/02, „NEGRA MODELO/MODELO“
- T-112/03, „Flexiair/Flex“, -
- T-32/03, „JELLO SCHUHPARK/SCHUHPARK“
- T-356/02, „VITAKRAFT/KRAFFT“
- T-104/01, „MISS FIFTIES/FIFTIES“

Examples of OD decisions:

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

In **1198/2002**, "MICRO FOCUS/FOCUS", LoC was found, the contrary decision of the BoA, R-542/2002-2, has been appealed to the CFI.

Although usually more attention is placed to the beginning of a word, it generally does not matter much whether the common element constitutes the first or the second element of the composite mark.

In particular, where the younger mark is the composite mark, it should not matter too much whether the younger mark incorporates the earlier mark as its first or second element. The protection against LoC applies in both directions: the owner of the earlier mark is protected not only against that the younger mark will be understood as referring to his goods, but also that his mark will be taken as referring to the junior party's goods.

See the following CFI judgements where the composite mark is the younger mark and the common element appears in second position (LoC was found):

T-32/03, „JELLO SCHUHPARK/SCHUHPARK“
T-286/02, „KIAP MOU/MOU“
T-169/02, „NEGRA MODELO/MODELO“
T-317/03, “DERBIVARIANT/Variant”

The previous practice according to which the common element, if appearing as the second part of the composite mark, must be predominant in order to conclude similarity of the signs, shall no longer be followed.

Obsolete:

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 coincidence in a common component is generally insufficient in itself for establishing similarity of signs. In those cases it constitutes a factor against similarity if both signs have a meaning on their own.

5.2.2. Distinctiveness of the earlier sign

The degree of distinctiveness of the earlier mark (not of the younger mark) is normally assessed at the level of the overall analysis of LoC, and not (yet) at the level of establishing similarity of the signs. However, it is recalled that for the analysis of composite signs vs. one-word signs the level of distinctiveness

of the common or differing elements is of particular significance.

This approach is in line with the finding of the Court that the distinctiveness of the earlier sign increases the likelihood of confusion. When the differences between components of signs consist in their most distinctive elements, the overall impression they give will be different.

It speaks in favour of LoC if the element in which the marks differ is of less inherent distinctiveness than the common element.

Examples:

1198/2002, "MICRO FOCUS/FOCUS",
for goods in class 9, "Micro" is of little distinctiveness.
CFI, T-169/02, „NEGRA MODELO/MODELO“,
„negra“ stands for dark beer.

The higher degree of distinctiveness of the common element may also be acquired through use.

1000/1999 CRISTAL / CRISTAL CASTELLBLANCH (LoC).

5.3. Names

In principle, there are no specific criteria to be taken into account when names are compared. However, when assessing likelihood of confusion, 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, which may have an impact on the distinctiveness of a trade mark.

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).

The perception of the public may be different where the use of a (business) name as indicator of origin is common in the particular market sector. Yet, a junior applicant should not be allowed to file somebody else's mark by just adding his own business name. A different conclusion might be reached if the common element is weak (less distinctive).

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 (identity of the persons or a family link). Therefore, its distinctiveness is higher.

The application of these sub-rules require that the relevant public would indeed recognise the signs as name plus surname of a natural person, rather than as fancy terms.

In some cases, a word will not necessarily be perceived as a first name if used alone:

467/1999	FR	ROSY	ROSY O'GRADY	LoC
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The similarity of signs that consist of names should be analysed in the traditional way, taking into account the visual and phonetic similarities:

789/2000 EN Emilio Tucci Emidio Pucci (LoC, confirmed by CFI T-8/03)

Usual or phonetically irrelevant variations of the same name will lead to a finding of high similarity of the signs:

1452/1999	FR	IVONNE	YVONNE (fig)	Signs highly similar
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If names are different, the fact that both are Christian or Italian names is not relevant. In particular, it is not correct to consider this as case of conceptual similarity. A name is not a "concept".

The special circumstances concerning the distinctiveness of names referred to above apply when comparing composite signs:

- First name against identical first name plus surname:

There are so many persons having an identical first name that the mere coincidence in a first name will in general not lead to a relevant likelihood of confusion.

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

An exception would only apply if the public would use the first name of a famous person as a synonym for the complete name and where the goods relate to the field of activity of that person. Or where the earlier mark, consisting of a first name only, has acquired a high distinctiveness.

1919/2003	FR	KENZO	KENZO TAKADA	Loc, confirmed by BoA
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Invented example:

Boris / Boris Becker for tennis rackets

- First name plus surname against identical first name plus different surname:

There is less similarity of the signs and thus less likelihood of confusion if the surnames are different.

Invented example:

Michael Schumacher / Michael Ballack (No LoC)

- First name plus surname against different first name plus identical surname:

Where the surname is identical but the first name is different, the rule that the family name is more relevant must be attenuated, taking into account the length and frequency of the two elements, as well as whether the first name has the same gender.

The signs should still be considered similar in view of the common element so as not to preclude reliance on reputation.

2688/2000	EN	JOHN SMITH	BETTY SMITH	LoC (in view of reputation)
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If the first name is "normal" in the respective language, more emphasis is generally placed on the surname:

2375/2001	IT	ENZO FUSCO	ANTONIO FUSCO	LoC, confirmed by CFI T-185/03
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Surname vs. first name plus identical surname

Where two signs contain the same surname, there will be a finding of similarity of signs despite the presence of additional first names either in one or in both trade marks. Reason: The surname alone will be perceived as the short version of the full name, thus identifying the same origin.

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

This is attenuated, and the result might be different, if the surname is frequent in the territory concerned.

2805/2004	DE	KAISER DESIGN SOFT LINE	MICHAEL KAISER	No LoC
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