



# CP5: Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)

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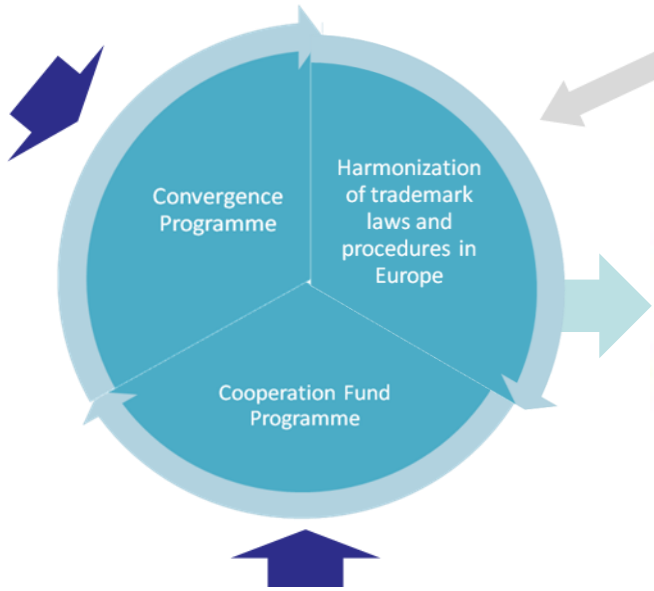
*“Harmonise the practice regarding **non-distinctive/weak components** of trade marks for the purpose of assessing likelihood of confusion, assuming that the goods and/or services are identical.”*

**Webinar - OHIM Academy**  
**16 December 2014**

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OHIM STRATEGY

OVERVIEW



**VISION 2015**  
European Trademark and Design Network

- |       |   |  |   |
|-------|---|--|---|
| Goals | 3 | Promote Convergence of Practices                       | 3 |
|       | 2 | Increase Quality and Optimise Timeliness of Operations | 2 |
|       | 1 | Build a Strong, Vibrant and Creative Organisation      | 1 |

**Pillar I**  
Organisational Excellence  
**Pillar I**

Lines of Action

- 6 Development of the European Network (Enabling International Co-operation)
- 5 Improvement & Broadening of Quality (Holistic Quality)
- 4 Establishment of the IP Academy and Knowledge Repository (Thought Leadership)
- 3 Expansion & Optimisation of the Working Environment (Building the Future)
- 2 Simplification & Modernisation of Information Systems (OHIM 3.0)
- 1 HR Reform and Cultural Renewal (Excellence through People)

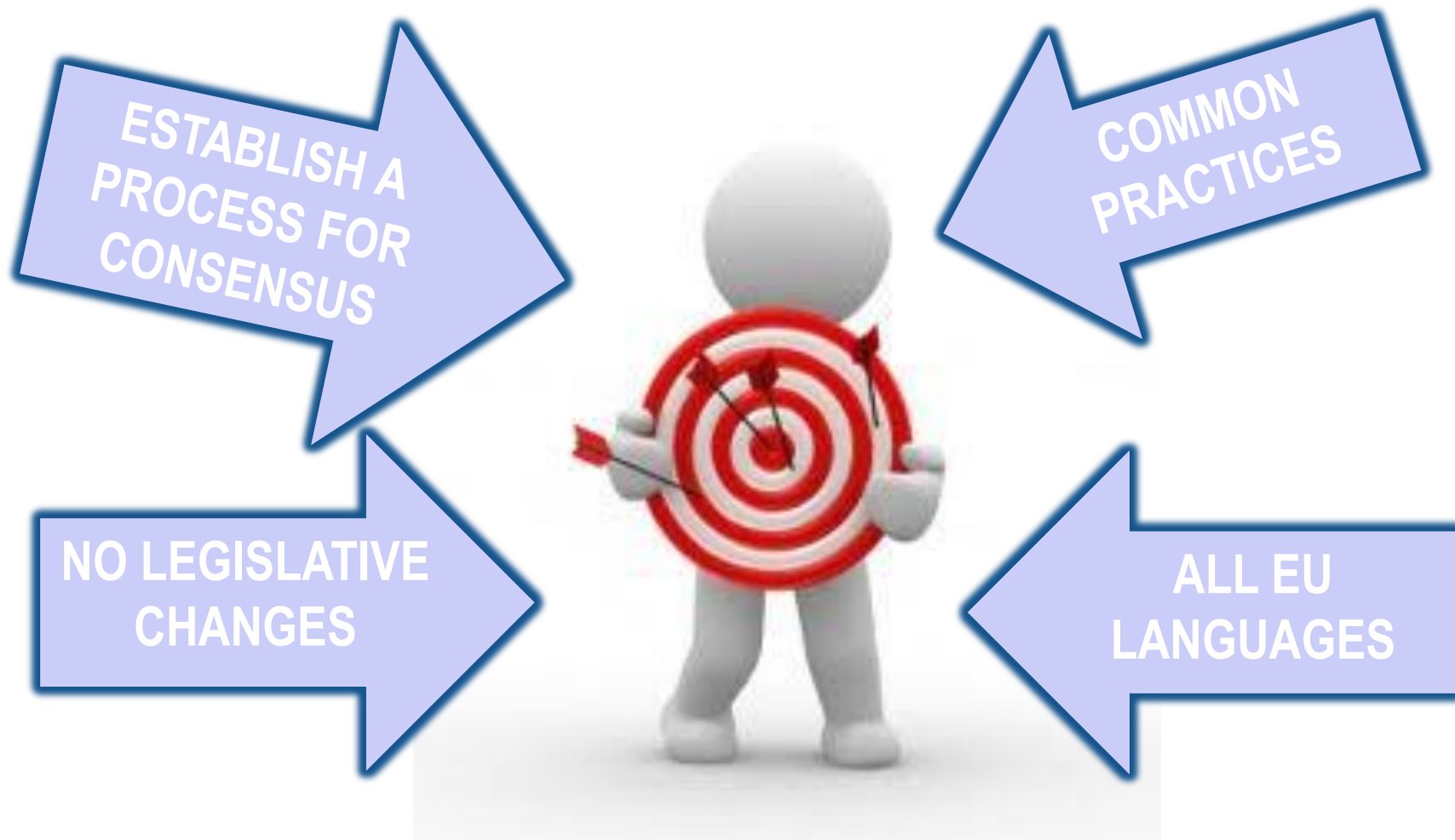
**Pillar II**  
International Cooperation  
**Pillar II**

**VISION** - “To establish and communicate clarity, legal certainty, quality and usability for both applicant and office.””

## Objectives : Develop common practices...

- 01 Which do **not** require legislative amendments;
- 02 Which will be put in practice by the **Participating National IP Offices, BOIP and OHIM;**
- 03 Which will be made available in **all EU languages.**

# OBJECTIVES



## THE CONVERGENCE PROGRAMME EFFORT

109

Individuals  
working  
from 27  
EU offices

12

User  
associations  
as observers

4

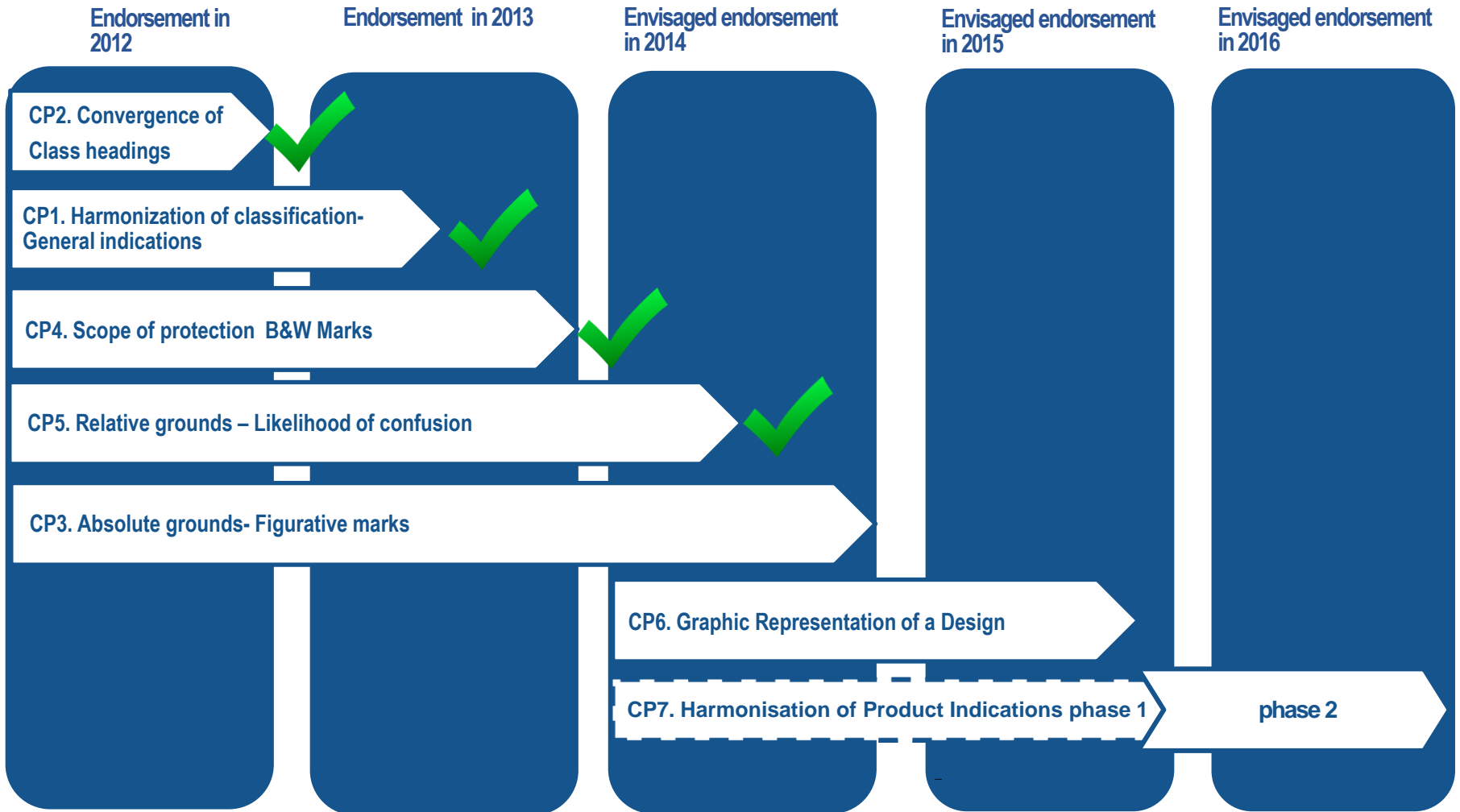
Non EU  
offices  
as observer

&



# Convergence Programme

# 7 projects



# CP5. Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)

## Common Practice Document

## Common Communication

2 October 2014



## CP5. Stakeholders

- **IMPLEMENTING OFFICES**

AT, BG, BX, CY, CZ, DE, DK, EE, ES, FR, GR, HR, HU, IE, IS, LT, LV, MT, NO, OHIM,  
PL, PT, RO, SE, SI, SK, TR, UK (28)

- **PARTICIPATING BUT NOT IMPLEMENTING OFFICE**

CH

- **NON-PARTICIPATING OFFICES**

IT, FI

- **USER ASSOCIATIONS (observers)**

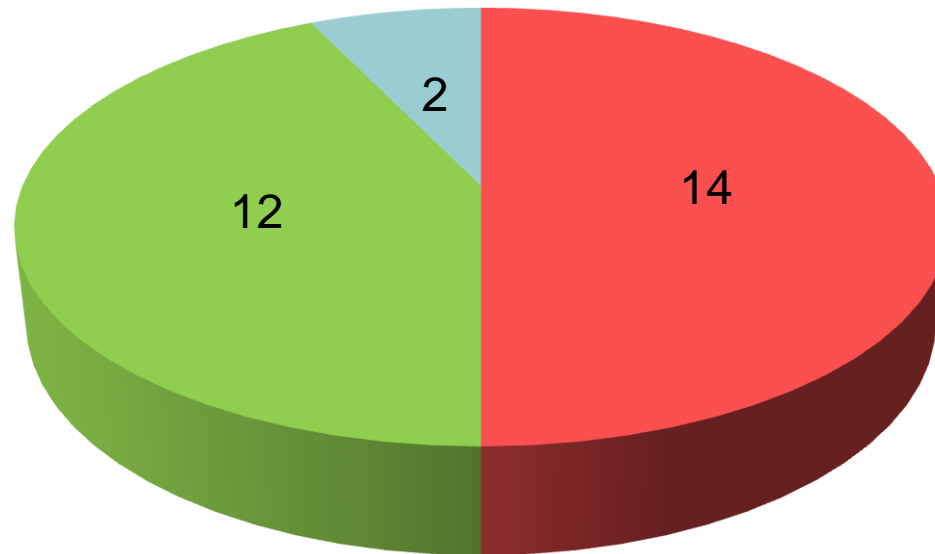
AIM / BUSINESS EUROPE, EFPIA, GRUR





## CP5. Results of the initial survey (February 2012)

*Do you have any guidelines for examiners on how to deal with non-distinctive/weak components of marks in the context of the examination of relative grounds for refusal (Likelihood of Confusion)?*



■ No    ■ Yes    ■ N/A

## CP5. OBJECTIVES

### 4 different objectives:

#### Objective 1

- Define what marks are subject to assessment of distinctiveness
  - The earlier mark and/or parts thereof?
  - The later mark and/or parts thereof?

#### Objective 2

- Determine the criteria to assess the distinctiveness of the mark (and/or parts thereof)

#### Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

#### Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

## CP5. OBJECTIVES

### Out of scope

- **Assessment of enhanced distinctiveness** and/or **acquired** distinctiveness through use and/or reputation.
- **Other factors** that are considered when assessing the likelihood of confusion.
- **Interdependencies** between assessment of distinctiveness and other factors considered when assessing LOC.
- **Language issues** assume that words in English are understood by the national offices.

## CP5. RECAP: Steps taken

- 01 Kick-off meeting **February 2012**
- 02 Work Package meeting **October 2012** – start of drafting common practice, finding the legal grounds
- 03 Work Package meetings **7 June 2013** and **22 October 2013** – further work on the common practice. Final agreement on the four objectives.
- 04 **WP1, WP2 and WP3 documents sent and approved by working group**
- 05 **Liaison Meeting April 2014** sub-title was added for further clarification of the Project Scope

## CP5. RECAP: Steps taken

- 06 **Unanimous endorsement** at the Administrative Board Meeting: **May 2014**  
3 deliverables: Principles of the New Common Practice Document, Communication Plan Document, Implementation Strategy Document
- 07 Working Group Implementation meeting **30 June 2014**
- 08 **Common Communication** published on **2 October 2014**
- 09 Implementation by **2 January 2015**

**Objective 1**

- **Define what marks are subject to assessment of distinctiveness**
  - **The earlier mark and/or parts thereof?**
  - **The later mark and/or parts thereof?**

**When evaluating likelihood of confusion:**

01

- ✓ The distinctiveness of the earlier mark as a whole is assessed.
- ✓ The distinctiveness of all elements of the earlier mark and of the later mark is also assessed, prioritising the coinciding elements.

## Objective 2

- Determine the criteria to assess the distinctiveness of the mark (and/or parts thereof)

When assessing the distinctiveness of the components of the marks:

Same criteria that are used in absolute grounds are used:

02

- a) to determine a minimum threshold of distinctiveness
- b) to consider the varying degrees of distinctiveness.

## CP5. Common Practice

03

### Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

A coincidence in an element with a **low degree** of distinctiveness will not on its own lead to LOC

**However, there may be LOC if:**

1) There are other elements that are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar

**OR**

2) The overall impression of the marks is highly similar or identical



## CP5. Common Practice

**For the  
examples in  
this  
presentation**

- *The goods and services are considered to be identical.*
- *All the other factors which may be relevant for the global appreciation of likelihood of confusion are deemed not to affect the outcome.*

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

EXAMPLE  
COMMON  
PRACTICE

NO LOC



VS.



(Class 32: Fruit juices)

NO LOC: Marks coincide in weak figurative elements (the sun and the drinks); the other elements in the marks (“JUICE”, “FRESH” and “SUN”) are of lower degree of distinctiveness (non-distinctive), but the overall impression of the marks is dissimilar.

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

EXAMPLE  
IPO (UK)

NO LOC



Vs.



(Foodstuffs and services related thereto in Classes 30, 35 and 43)

No LOC: The common element is a well-known expression and has a low degree of distinctiveness. The differences in the overall visual impressions and the additional '99' are quite striking.

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

NO LOC

EL 9 TV

Vs.



(Telecommunications services in Class 38)

NO LOC: due to the weak distinctiveness of the common elements which is overcome by the overall differences.

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

NO LOC

EXAMPLE  
IPO (UK)



Vs.

CANADIAN ICE

(Jewellery in Class 14)

NO LOC: Due to low degree of distinctiveness of the common term 'ICE' for diamond jewellery ('ICE' is, amongst others, a slang term for diamonds). The other elements have an average level of distinctiveness and the differences between the marks as a whole are too great to go unnoticed.

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

NO LOC

KFP FIVE STAR CONFERENCE SERVICE

Vs

FIVE STAR SHOPPING CENTER

(Printed matter, organisation of exhibitions, advertising and telecommunication services in Classes 16, 35, 38, 39 and 41)

NO LOC: The marks coincide in the common element 'FIVE STAR', which has a low distinctive character. The identity in this element is neutralized by the differences in the number of words, of syllables and letters and its conceptual and aural impact in the overall impression. The overall impression is dissimilar.

EXAMPLE  
BOA (OHIM) R  
526/2013-5

Objective 3

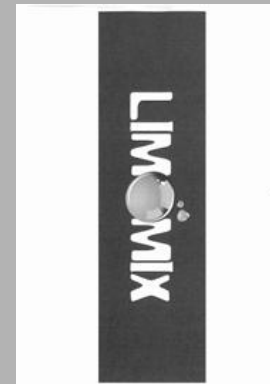
- Determine the impact on LOC when the common components have a low degree of distinctiveness

EXAMPLE BOA  
(OHIM)  
R 1829/2010-4

NO LOC



Vs.



(Beers, non-alcoholic drinks and alcoholic beverages in Classes 32 and 33)

NO LOC: The common element 'LIMO' has a low inherent distinctive character in any of the European Union's languages. This understanding is reinforced by the depiction of lemons within the mark. The distinctiveness relies on the fanciful arrangement (...). The distinctive elements of each mark do not coincide and leads to the conclusion of no likelihood of confusion.

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

DN

EXAMPLE  
IRPV (LV)

NO LOC

PREDUCTAL

Vs.

TRIMDUCTAL

(Pharmaceutical preparations in Class 5)

NO LOC: The marks coincide in the weak element –DUCTAL, which has a meaning in medicine. The other elements in the marks PRE- and 'TRIM' are not of lower distinctiveness and not similar. The overall impression is not similar.



03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

LOC

EXAMPLE  
COMMON  
PRACTICE



vs.



(Class 43: Holiday accommodation services)

LOC: The marks coincide in weak figurative elements “SUN”, the umbrella and the beach ball are of equally low degree of distinctiveness and the overall impression of the marks is similar.

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

EXAMPLE  
IPRL (PL)

LOC

GESTROL

Vs

GESTROLTEX

(Pharmaceutical preparations in Class 5)

LOC: The marks coincide in the weak element GESTROL, which alludes to the pharmaceutical 'megestrol'. Both marks will be associated with a very specified medicine for cancer. The additional element -TEX is even less distinctive.

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

LOC

EXAMPLE  
IRPV (LV)

CAL-C-VITA

Vs

(Pharmaceutical preparations in Class 5)

LOC: The marks coincide in weak element CAL-, but the elements 'VITA' and 'C' are of equally low degree of distinctiveness and the overall impression is similar.

03

Objective 3

- Determine the impact on LOC when the common components have a low degree of distinctiveness

LOC

EXAMPLE  
DZIV (HR)

LATE NIGHT SHOPPING

Vs.

**SHOPPING NIGHT**

(Services in Class 35)

LOC: The marks coincide in the weak element 'NIGHT SHOPPING'. The word 'LATE' is equally weak and the element 'best shop' is hardly visible. The overall impression of the marks is similar.

03

Objective 3

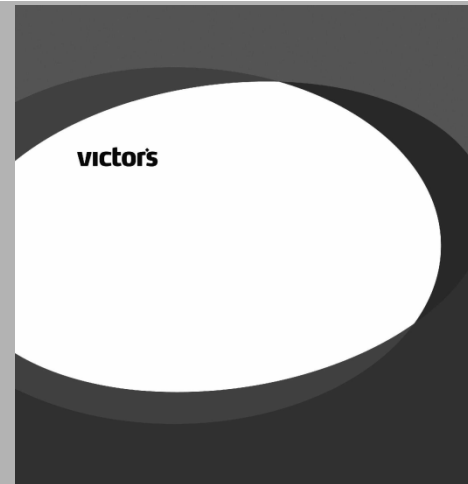
- Determine the impact on LOC when the common components have a low degree of distinctiveness

LOC

EXAMPLE  
DKPTO (DK)



Vs.



(Foodstuffs in Class 30)

LOC: The word elements (Witor's and Victor's) are distinctive and similar. The figurative elements are considered weak and do not confer a different overall impression between the marks.

## CP5. Common Practice

04

### Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

- A coincidence only in a non-distinctive element will **not lead to LOC**
- When marks also contain other figurative and/or word elements which are similar, **there will be LOC**, if the overall impression of the marks is highly similar or identical.

04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

EXAMPLE  
COMMON  
PRACTICE

NO LOC



vs.



(Class 36: Financial services)

Marks coincide in non-distinctive elements “BANCO INVEST”, marks do not contain other elements which are similar (the figurative elements are not similar), neither the overall impression of the marks is highly similar.

04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

EXAMPLE  
IRPV (LV)

NO LOC



Vs.



(Bar services, restaurants in Class 43)

NO LOC: The marks coincide in the non-distinctive element ROOMS, and the marks do not contain other elements which are similar, neither the overall impression of the marks is highly similar.



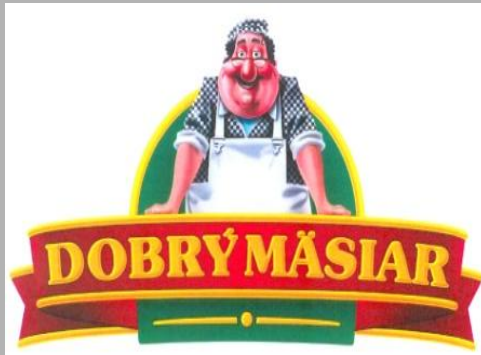
04

Objective 4

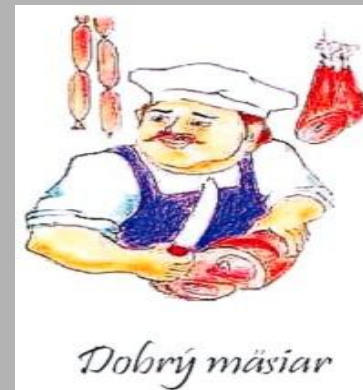
- Determine the impact on LOC when the common components have no distinctiveness

NO LOC

EXAMPLE  
INDPROP (SK)



Vs.



(Meats and meat products in Class 29)

NO LOC: 'Dobry Masiar' means 'Good butcher'. Despite the figurative element is related with the goods at issue, the figurative elements are distinctive enough and the overall impression of the marks is dissimilar.

04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

NO LOC

EXAMPLE BOA  
(OHIM) R-  
495/2011-2

Rock  
MASTERROCK  
FIXROCK  
FLEXIROCK  
COVERROCK  
CEILROCK

Vs.



(Building materials in Class 19)

NO LOC: The common descriptive element 'ROCK' will be associated to a stone, i.e. to raw materials used as building materials. The other initial elements of the earlier marks belong also to basic English and will be associated with possible characteristics (flexibility 'FLEXI', quickly affixed 'FIX', superior quality 'MASTER', use for covering 'COVER'). The fact that the word 'ROCK' is combined with other descriptive elements do not increase the inherent distinctive character.


04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

NO LOC

EXAMPLE  
DZIV (HR)

 Reduced Smoke Smell

Vs.



(Tobacco products in Class 34)

NO LOC: The marks coincide in the non-distinctive element 'SMOKE SMELL'. They differ in the other elements, except for the letters 'SS'. They are visually dissimilar due to the position of the elements and the figurative elements. The overall impression of the marks is not similar.

04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

EXAMPLE  
OEPM (ES)

NO LOC



Vs.



(Retail services and sales through internet in Class 35)

NO LOC: The common element 'MI TIENDA' ('my shop') is devoid of distinctiveness character. The additional figurative elements are distinctive and give a different overall impression between the marks.

04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

NO LOC

EXAMPLE  
DKPTO (DK)



Vs.



(Diapers for babies in Class 5)

NO LOC: The word elements 'BIO BABY' are non-distinctive words. The figurative elements are different and give a different overall impression between the marks.

04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

EXAMPLE  
DKPTO (DK)

NO LOC



Vs.



(Advertising and financial services in Classes 36 and 37)

NO LOC: The figurative elements are considered weak and the other word elements are non-distinctive elements. The overall impression of the marks is not similar.

- Determine the impact on LOC when the common components have no distinctiveness

LOC

**TRADEENERGY**

VS.

**TRACENERGY**

(Class 9: Solar energy collectors for electricity generation)

LOC: The marks coincide in non-distinctive element “ENERGY”, but contain other elements which are similar (TRADE is aurally and visually similar to TRACE), and the overall impression of the marks is highly similar.

**EXAMPLE  
COMMON  
PRACTICE**

04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

EXAMPLE  
OEPM (ES)

LOC



Vs.



(Goods for electrical depilation in Class 9 vs. Depilation services with laser in Class 42)

LOC: The marks coincide in non-distinctive element DEPI, but contain other elements which are similar (VELL is aurally and visually highly similar to WELL).



04

Objective 4

- Determine the impact on LOC when the common components have no distinctiveness

LOC

EXAMPLE  
INDPROP (SK)

**Karat Club** £

Vs.

**Karat Club** €

(Costume jewellery, jewellery made of precious metals in Class 14)

LOC: The element 'Karat' means the measure of the purity of gold or its proportion in an alloy. The element 'Club' is also considered as non-distinctive. The additional elements (£ and €) are not distinctive enough for avoiding likelihood of confusion.

## CP5. Implementing the common practice

### Common practice: what has changed?

- ❖ The common practice does not mean any change on the existing practice in the implementing Offices.
- ❖ The first survey that was conducted at the beginning of the Project showed that only 14 out of 28 Offices had guidelines on this particular issue. The Common Practice will enhance legal certainty, and will serve to communicate the practice with clarity.

## CP5. Implementing the common practice

### Common Communication Document





## CP5. Implementing the common practice: Common Communication

Implementation date:

Publication date (02/10/2014) + max. three months



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IN THE INTERNAL MARKET  
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Thank You