

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

*“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 - EUIPO Academy
30 May 2017

Janka Budovičová

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 EUIPO (OHIM)**;
- 03 Which will be made available in **all EU languages**.

SP 2010-2015

Convergence Programme

7 projects

Endorsement in 2012

Endorsement in 2013

Endorsement in 2014

Endorsement in 2015

Endorsement in 2016

CP2. Convergence of
Class headings

CP1. Harmonization of classification-
General indications

CP4. Scope of protection B&W Marks

CP5. Relative grounds – Likelihood of confusion

CP3. Absolute grounds- Figurative marks

CP6. Graphic Representation of a Design

CP7. Harmonisation of Product Indications phase 1

phase 2

SP 2015-2020 ECP4: Convergence Analysis Project

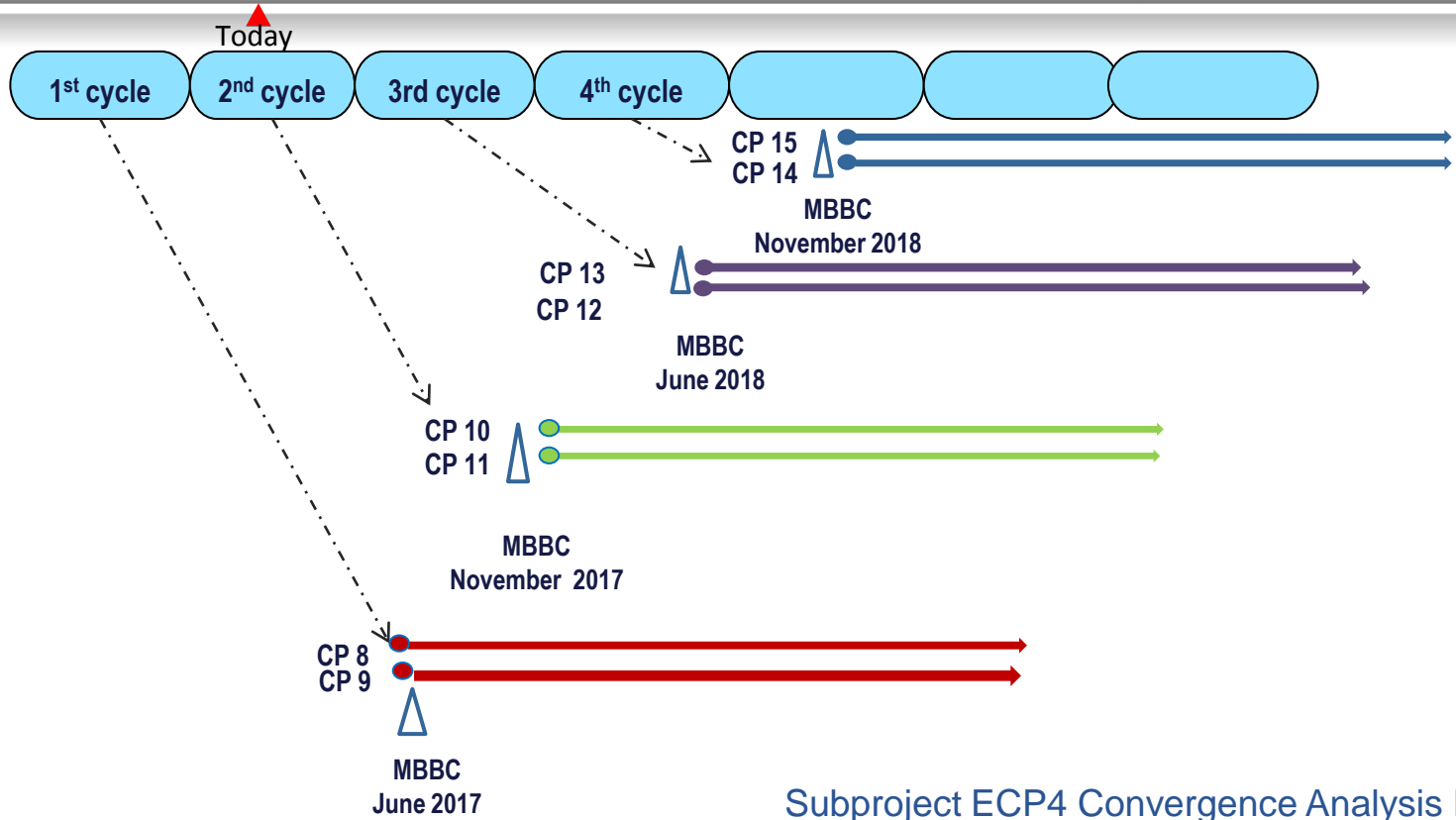
LoA4: Intensify
network
engagement

ECP4: Shared
Services and
Practices

Subproject ECP4:
Convergence
Analysis Project

VISION

“Progressively map the main areas of EU IP Offices trade mark and design practices and analyse them to identify those areas where convergence of practices can be achieved for the benefit of both EU IP Offices and users.”



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 Common Communication published under TMDN.org

Convergence of Practices

Converging Practices

The EUIPO **Convergence Programme**, launched in 2011, links EUIPO with National Offices and User Associations in an effort to reach common ground in areas where IP offices have different practices. It complements the work being done to create common IT tools taking place under the Co-operation Fund.

The Convergence Programme encompasses the following projects within its portfolio :

- CP1. Harmonisation of trade mark classification practice of goods and services.
- CP2. Convergence of Class Headings
- CP3. Absolute grounds for refusal for figurative trade marks with purely descriptive words or expressions.
- CP4. Scope of protection of trade marks exclusively in black, white and/or shades of grey.
- CP5. Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)
- CP6. Convergence on graphic representations of Designs.
- CP7. Harmonisation of Product Indications.
- Implementation and continuity of Common Practices

Documents currently open for comments

Implementation and continuity of Common Practices

The Central Team is the body tasked with helping National Offices with the implementation and maintenance of the agreed common practices

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.

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:

- ✓ 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:

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

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**

Objective 3

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

Common Practice

NO LOC

DURALUX

vs

VITALUX

Earlier mark

Contested mark

(Class 44: Beauty Treatment)

Objective 3

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

Common Practice

NO LOC



Earlier mark

vs



Contested mark

(Class 32: Fruit juices)

Objective 3

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

NO LOC

ECJ judgement
T-495/15



Earlier mark

vs



Contested mark

(Classes 29, 31 and 39)

Objective 3

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

NO LOC

*ECJ judgement
T-608/13*

airtours
Ticket Factory

vs

easyAir-tours

Earlier mark

(Classes 38, 39, 43)

Contested mark

(Classes 16, 36, 39, 43)

Objective 3

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

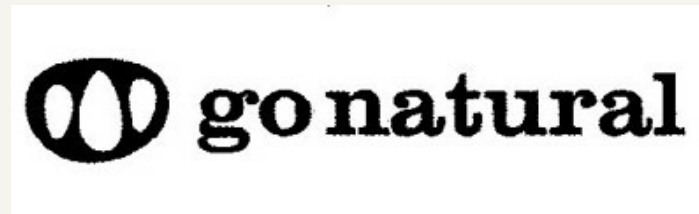
NO LOC

BoA decision
R 470/2014-2



Earlier mark

vs



Contested mark

(Class 29, 30, 31 and 32)

Objective 3

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

NO LOC

French Office (INPI)



Earlier mark

vs



Contested mark
(classes 29, 30 and 43)

(Classes 29, 30 -Food products)

Objective 3

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

Lithuanian Office

NO LOC

HYPNOGEN

Earlier mark

vs.

HYPNOZAN

Contested mark

(Class 5: pharmaceuticals)

Objective 3

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

Slovak Office

NO LOC



Earlier mark
(class 19, 30, 35)

vs.



Contested mark
(class19, 37, 40)

“DREVODOM/DREVODOMY” – house/houses made from wood

Objective 3

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

NO LOC

Croatian Office



Earlier mark

vs.



Contested mark

Class 16

Objective 3

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

LOC

Common Practice

COSMEGLOW

vs.

COSMESHOW

Earlier mark

Contested mark

(Class 3: Cosmetics)

Objective 3

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

LOC

Common Practice



Earlier mark

vs.



Contested mark

(Class 43: Holiday accommodation services)

Objective 3

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

LOC

*ECJ judgement
T-123/14*

waterPerfect

vs.

AquaPerfect

Earlier mark
Class 7

Contested mark
Class 7

Objective 3

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

LOC

French Office (INPI)

TERMIFILM

vs.

TERMIPLAST

Earlier mark

Contested mark

Products for wood treatment

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.

Objective 4

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

Common Practice

NO LOC



Earlier mark

vs.

SMARTPHONES.NET

Contested mark

(Class 9: mobile phones)

Objective 4

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

BoA R1313/2015-2

NO LOC



Earlier mark
(Classes 21, 31, 39, 44)

vs.



Contested mark
(Class 31)

Objective 4

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

Estonian Office

NO LOC



Earlier mark

vs.



Contested mark

(Class 35, 37, 44)

Objective 4

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

Bulgarian Office

NO LOC



Earlier mark

vs.



Contested mark

(Class 5: pharmaceuticals)

Objective 4

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

Spanish Office

NO LOC

GRUPAUTO

vs.



Earlier mark

Contested mark

(Class 39)

Objective 4

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

Lithuanian Office

NO LOC

MEET LOVERS

vs.

I LOVE MEAT

Earlier mark

Contested mark

(Class 29: meat)

Objective 4

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

LOC

Common Practice

TRADENERGY

vs.

TRACENERGY

(Class 9: Solar energy collectors for electricity generation)

Objective 4

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

LOC

*ECJ judgement
T-160/15*



vs.

MINI

Earlier mark
Class 12

Contested mark
Class 12

Objective 4

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

BoA decision
R0987/2015-2

LOC



Earlier mark
(Classes: 29, 30, 32, 41, 43)

vs.



Contested mark
(Class 43)

Objective 4

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

LOC

**EUIPO decision
B 2398 306**

CACAOLAT

vs.

The logo for Cacao-lab, featuring the word "Cacao" in a large, elegant, cursive script font, followed by "-lab" in a smaller, simpler sans-serif font.

Earlier mark
Class 30

Contested mark
(Class 30)

Objective 4

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

LOC

French Office (INPI)

ARGANE

vs.

ARGANA

(Cosmetics)

Thank you for your attention



www.euipo.europa.eu



@EU_IPO



EUIPO

Thank you