



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.”*

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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**.



Convergence Programme

7 projects

Endorsement in
2012

Endorsement in 2013

Endorsement in 2014

Envisaged endorsement
in 2015

Envisaged endorsement
in 2016

CP2. Convergence of
Class headings

CP1. Harmonization of classification-
General indications

CP4. Scope of protection B&W Marks

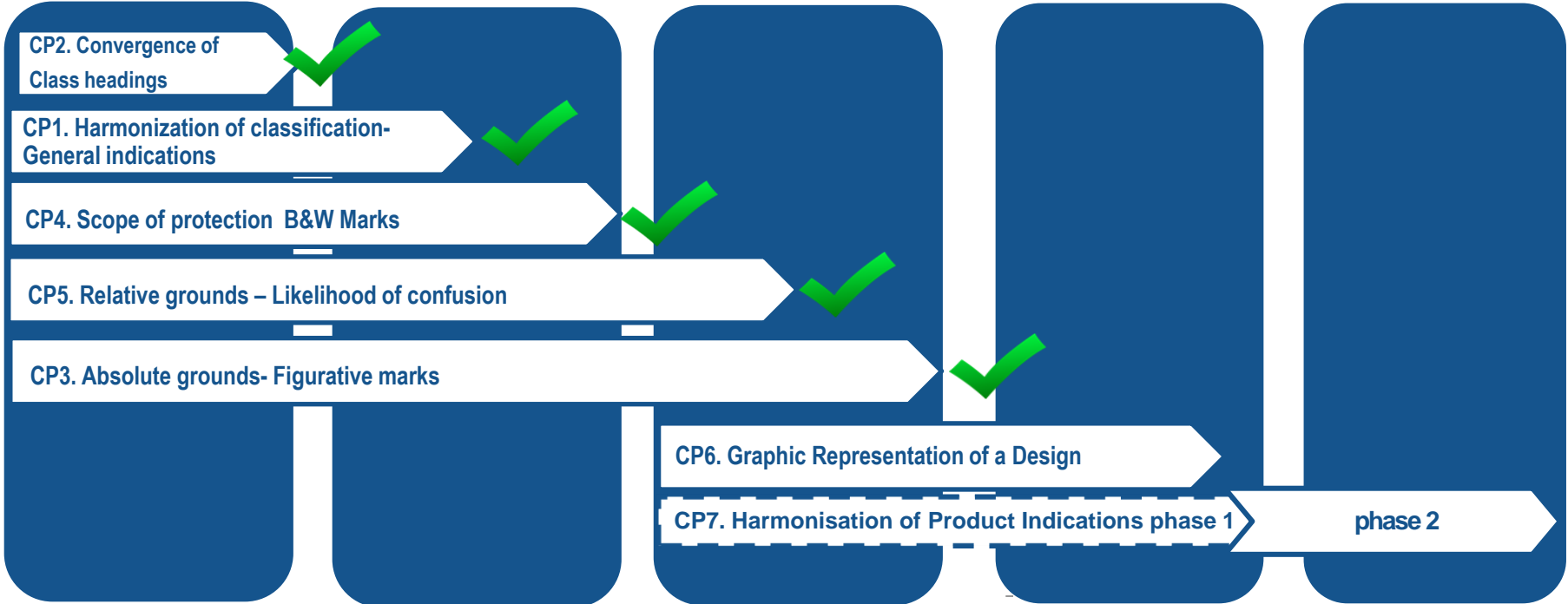
CP5. Relative grounds – Likelihood of confusion

CP3. Absolute grounds- Figurative marks

CP6. Graphic Representation of a Design

CP7. Harmonisation of Product Indications phase 1

phase 2



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. 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 12 out of 28 Offices had guidelines on this particular issue. The Common Practice will enhance legal certainty, and will serve to communicate the practice will clarity.

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. Common Practice

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.

CP5. Common Practice

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

03

Objective 3

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

NO LOC

EXAMPLE
Irish Patents Office
(IE)



vs

CORONAS

(Class 33)

No LOC: The only common element between them is the word CORONA, which does not, in fact, appear as a stand-alone element in either mark. The most prominent element of the Applicant's mark is the word MEZZACORONA, which is dissimilar to the Opponent's mark CORONAS both in appearance and pronunciation. Also, the Applicant's mark contains a figurative element that is not insignificant in terms of its overall appearance while the Opponent's mark is a word only

03

Objective 3

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

NO LOC

EXAMPLE
Irish Patents Office
(IE)



Vs.



(Class 29 & 30)

No LOC: While there are, undoubtedly, a number of conceptual similarities between the respective marks, they are sufficiently different, on an overall assessment, to obviate the possibility of confusion.

03

Objective 3

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

**EXAMPLE
EPO (EE)**

LOC

VEROPHARM

Vs.

VIROPHARMA

(Pharmaceutical and medical goods and services in Classes 5, 10, 42 and 44)

LOC: The marks coincide in a weak element “PHARM(A)”, but contain other elements which are similar and the overall impression of the marks is highly similar.

03

Objective 3

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

LOC

EXAMPLE
HIPO (HU)

ST. TRÓPEZ
SZOLÁRIUM

Vs.

ST. TROPEZ

(Class 11. Solarium appliances)

LOC: The name of the sunny city, St. Tropez has low distinctive character for solarium appliances. The overall impression of the marks is highly similar with a very similar font.

03

Objective 3

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

EXAMPLE
HIPO (HU)

LOC



Vs.



(Class 3. Laundry detergents)

LOC: Although the word “Silky” has low distinctive character for the relevant goods (refers to the smoothness of clothes after washing), the overall impression of the signs is highly similar because of the identical lila colour and the similar type fonts.

03

Objective 3

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

LOC

EXAMPLE
Irish Patents Office
(IE)

QUELOR

Vs

QUELORA

(Class 5: Pharmaceuticals)

LOC: The prefix “QUEL”-is common in relation to pharmaceuticals. The marks are clearly similar, with the first 6 letters identically arranged. While the cited mark ends in a letter “a”, the fact that the first 2 syllables are identical ...This, together with the fact that there is also a significant aural similarity arising from the shared first and second syllables leads to a clear similarity 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
EPO (EE)

NO LOC



Vs.



(Transport, education, entertainment, providing food and drink, temporary accommodation services in Classes 39, 41, 43)

NO LOC: The marks coincide in the non-distinctive element VIP (describes the target group and/or quality of the service), and the marks do not contain other elements which are similar; neither is the overall impression of the marks highly similar.

04

Objective 4

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

EXAMPLE
HIPO (HU)

NO LOC



vs.



(Class 5: Pharmaceuticals)

API means „Active Pharmaceutical Ingredient”, which has no distinctive character regarding pharmaceuticals. Due to the figurative elements, the overall impression is different.

04

Objective 4

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

EXAMPLE
OEPM (ES)

NO LOC



Vs.



((Class 41: Discotheque services)

NO LOC: Marks coincide in non-distinctive element (disco) but contain other elements which aren't similar (like the figurative elements), and the overall impression of the marks is dissimilar.

04

Objective 4

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

**EXAMPLE
COMMON
PRACTICE**

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.

CP5. Implementing the common practice. OHIM Language considerations

Weak/non-distinctive element for a significant part of the relevant public?

→ Primary linguistic understanding:

- 23 official languages to be taken into account in case of an earlier CTM

→ Possible further factors:

- equivalent words in the relevant territory
- familiarity with very basic vocabulary
- familiarity with certain languages for certain classes/sectors

Objective 3

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

03
EXAMPLE
OHIM
B 2 259 722

NO LOC

AQUADES

Vs.



(Class 1)

AQUA: understood in entire EU as reference to "water", possible component of goods
→ lowly distinctive element, which will not, "on its own", lead to LoC;
Overall impression is NOT (highly) similar/identical

03

Objective 3

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

EXAMPLE
OHIM
R 349/2013-2

LOC

BANKY

(earlier mark PT)

Vs.

BANKIA

(Class 36)

BANK = understood in PT („banco“) → weak distinctiveness for financial services → No LoC “on its own”
BUT: other similar elements („Y“/„I“) and highly similar overall impression.

04

Objective 4

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

NO LOC

EXAMPLE
(OHIM)
B 2 234 337

BIG FASHION

earlier CTM (cl. 25)

Vs.



CTMA (cl. 25)

FASHION: widely used in the market sector, understood in entire EU → Non-distinctive for clothing Overall impression highly similar?

(-): Different length, concept, graphic representation

04

Objective 4

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

NO LOC

EXAMPLE
R-2304/2012-1
(pending)



(Earlier CTM, Cl. 11)

Vs.



(CTMA, Cl. 11, 42)

PRIMA = laudatory in DE, NL, CY; Laudatory also in FR, PT, UK, LT...?

BoA (+): Latin origin („first“); similar equivalent words in national languages (*primaire, primeiro, primary, pirmais...*) → non-distinctive

Other similar elements which lead to a highly similar overall impression?

(-): Differences in GAZ/ PRIMA, figurative elements, architecture

04

Objective 4

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

LOC

EXAMPLE
OHIM
B 2 398 306

CACAOLAT

earlier ES mark (cl. 30)

vs.



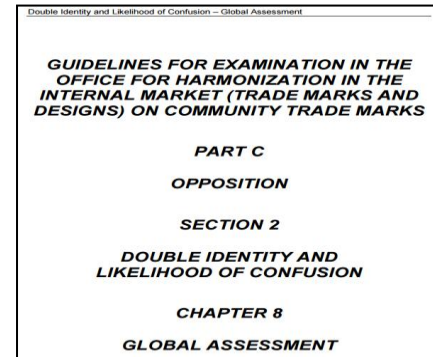
CTMA (cl. 30)

CACAO = non-distinctive in the relevant territory (ES) → no
LoC? Overall impression highly similar?
(+): Other similar elements (-LAT / -LAB), same length

CP5. Application of the Common Practice OAMI

OAMI – guidelines:

Part C: Opposition: Section 2: double identity and
likelihood of confusion : Chapter 8: Global
assessment, p. 10:



CP5. APPLICATION OF THE COMMON PRACTICE : BOARDS OF APPEAL OHIM

NO LOC



ULTIMATE GREENS



R-1462/2012-G (18/09/2013)

CP5. Case-law of the Court : trends

1. Risk of confusion between marks composed of weak / non distinctive elements

LOC



W MICRO



micro



T-149/12 (16/01/2014)

Goods in Class 9

CP5. Case law of the Court : trends

2. Existence of a likelihood of confusion when there is a coincidence in the weak / descriptive element and similarity between the rest of the elements.

LOC

CLORALEX

CLOROX

C-422/12 (30/01/2014)

Goods in Classes 3 and 5

CP5. case law of the Court: trends

3. No likelihood of confusion when only the weak parts of the signs are coinciding.

NO LOC

VISCOTECH

VISCOPLEX

T-138/13 (19/11/2014)

Goods in Classes 1,4

CP5. case law of the Court : trends

3. No likelihood of confusion when only the weak parts of the signs are coinciding.

NO LOC

M&Co.

MAX&Co.

T-272/13 (3/12/2014)

Goods in Class 25

CP5. the case law of the Court : trends

3. No likelihood of confusion when only the weak parts of the signs are coinciding

NO LOC

ACTU+

NEWS+

T-591/13 (12/12/2014)

Services in Classes 35,38,41

CP5. case law of the Court: trends

3. No likelihood of confusion when only the weak parts of the signs are coinciding.

NO LOC

TPG POST

POST

T-102/14 (13/05/2015)

Goods in Classes 9,14,18,25



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Thank You