

***GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)***

PART C

OPPOSITION

SECTION 2

***DOUBLE IDENTITY AND LIKELIHOOD OF
CONFUSION***

CHAPTER 4

COMPARISON OF SIGNS

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1 General Principles of the Trade Mark Comparison

1.1 Overview

This chapter deals with the comparison of signs. The purpose of comparing signs is to determine if the signs are identical (see paragraph 2 below), similar (see paragraph 3 below), or dissimilar (see paragraph 4 below).

The identity of trade marks is a prerequisite for applying the provision of Article 8(1)(a) EUTMR ('double identity'). Goods or services have to be identical too.

The similarity (or identity) of signs is a necessary condition for it to be found that there is a likelihood of confusion for the purposes of Article 8(1)(b) EUTMR (judgment of 23/01/2014, C-558/12 P, *Western Gold*, EU:C:2014:22, § 44). If the signs are dissimilar, an examination of likelihood of confusion will stop at this point.

Whether a likelihood of confusion exists depends on an assessment of several interdependent factors, including (i) similarity of the goods and services, (ii) the relevant public, (iii) **similarity of the signs**, taking into account their distinctive and dominant elements and (iv) the distinctiveness of the earlier mark.

1.2 Structure

If the signs are not identical (see point 2 below) it must be determined whether they are similar or dissimilar. A global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by them, bearing in mind their distinctive and dominant components (C-251/95, *Sabèl*, EU:C:1997:528, § 23). A comparison of trade marks must integrate, therefore, an assessment of the distinctive character and dominance of their elements, and the impact of their overall impression.

A comparison of trade marks must contain the following considerations: an assessment of the distinctive and dominant character of the coinciding and differing elements, their commonalities and differences, and a final conclusion that is reached after the assessment of the impact of distinctive/dominant elements on the overall impression of the signs.

The order of the examination at the '**comparison of signs**' stage **should not be predetermined** but rather, depending on the particular context, adjusted to provide logical coherence to the decision. Nevertheless, with the aim of having a consistent decision format that follows, where possible, a similar structure, the following order is apt for the majority of cases ~~when signs are not identical (see paragraph 2 below):~~.

i. Representation/Description of the signs

As a preliminary step, the signs should be portrayed in a table, followed by a short description of the marks (no need for word marks). The purpose of this chapter is to identify the type of signs (word marks, figurative marks) and their elements in order to establish a framework for comparison ('what is there?').

ii. Inherent distinctiveness/dominance of elements of both marks

As a second step, an assessment of **inherent distinctiveness and dominance of the components** is carried out. The purpose of this chapter is to identify the degree of relevance of the components for the comparison of signs, for example, whether the distinctiveness of the common element is limited.

Importantly, the **distinctiveness of the earlier mark as a whole (including the issue of acquired distinctiveness)** should **not** be taken into account when comparing signs. The assessment of the distinctiveness of the earlier mark **as a whole** is addressed under a separate heading¹.

iii. Comparison of signs taking into account the previously established inherent distinctiveness and the dominant character of the components and final conclusion

The third step entails the comparison of marks at a **visual, aural and conceptual** level, considering and integrating the previous findings on the distinctiveness/dominance of the components.

1.3 Three aspects: visual, aural and conceptual

Signs are compared at three levels, namely visually (see paragraph 3.4.1 below), aurally (see paragraph 3.4.2 below) and conceptually (see paragraph 3.4.3 below). This is because one can perceive signs visually, aurally and conceptually (if they evoke a concept). Only when it is not possible to compare at one level (e.g. the aural comparison when both marks are purely figurative) will this aspect be left out. ~~If there is similarity at one or more of the three levels, then the signs are similar (judgment of 02/12/2009, T-434/07, Solvo, EU:T:2009:480, § 50-53).~~

1.4 Possible outcome of the comparison

The comparison of signs leads to the finding of one of the following three outcomes: identity, similarity or dissimilarity. The result is decisive for further examination of the opposition as it has the following implications.

- A finding of **identity** between signs leads to absolute protection according to Article 8(1)(a) EUTMR if the goods and/or services are also identical.
- A finding of **similarity (or identity)** leads to the opening of the examination on likelihood of confusion in accordance with Article 8(1)(b) EUTMR.
- The finding of **dissimilarity** in all three aspects excludes the likelihood of confusion. There is no need to examine further prerequisites of Article 8(1)(b) EUTMR. If there is some degree of similarity at one or more of the three levels, then the signs cannot be declared dissimilar overall (judgment of 02/12/2009, T-434/07, Solvo, EU:T:2009:480, § 50-53).

¹ The Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark.

The comparison has to lead to a finding on the **degree of this similarity** in every aspect of the comparison ([visual, aural and conceptual](#)).

- The **finding on the level of similarity of the marks can be decisive** for the outcome of the decision. The examiner should be aware, that not ‘any similarity’ can lead to likelihood of confusion, even for identical goods and/or services (interdependence principle). The finding of the level of similarity of the marks will make the decision more understandable. For example, the final finding that there is no likelihood of confusion for identical/highly similar goods and/or services is easier to understand in the overall assessment if the marks were previously held as only ‘similar to a low degree’.
- **It is especially important to emphasise in each comparison the degree of similarity of marks if it is high (above average) or low (below average). However, even if the level of similarity is average, the decision should state this, to avoid misunderstandings.** A mere statement that ‘the marks are similar’ is not clear as it can be interpreted in two ways — either in the sense that they are similar to an average degree, or just in the general sense that there is (some) similarity allowing for further examination. If the word ‘similar’ is used without further qualification, the meaning must be explained.

The three levels of similarity are low/average/high. Synonyms can be used as far as they are clear (e.g. average = medium), however, it has to be noted that the term ‘enhanced’ is not a synonym for ‘high’. Moreover, nothing prohibits examiners from assessing the similarity further, like ‘only very low’ or ‘high degree of similarity, almost identical’ if this supports the outcome. The wording, however, must be as clear as possible. This is not the case for expressions like ‘not particularly high’, which can be understood in two ways — in this example not as high as ‘average’ or just ‘low’.

- The **level of similarity must be established for each aspect of the comparison** (visual/phonetic/conceptual) separately. ~~The~~ [since the](#) particular field (e.g. the visual or phonetic similarity) may be decisive [for the purposes of the overall assessment](#), depending on how the goods are purchased².
- After the level of similarity has been defined (individually for the visual, phonetic and conceptual comparison), a conclusion can be added (if applicable), stating that ‘since the marks have been found similar in at least one aspect of comparison’, the examination of the likelihood of confusion will proceed.

1.5 Signs to be compared and negligible elements

When assessing identity or similarity, the signs have to be compared in the form in which they are protected, that is, in the form in which they are registered/applied for. The actual or possible use of the registered marks in another form is irrelevant when comparing signs (judgment of 09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199, § 38)³.

² See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 4, Impact of the method of purchase of goods and services.

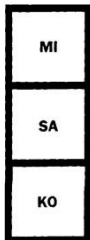


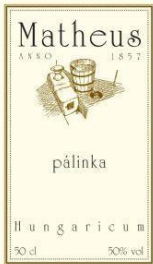
³ For the effect of disclaimers, see paragraph 3.2.3.3 below.

The comparison must **cover signs in their entirety**. Consequently, it is wrong to discard comparing elements of signs just because they are, for example, smaller than other elements in the signs (unless they are negligible as explained below) or because they are non-distinctive (judgments of 12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 41-42; 13/12/2011, T-61/09, Schinken King, EU:T:2011:733, § 46).

Exceptionally, in the event of **negligible elements**, the Office may decide not to take such elements into consideration for the purposes of the actual comparison, after **having duly reasoned** why they are considered negligible (judgment of 12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42). This is especially important where the negligible element is the common element in the signs. The notion of negligible elements should be interpreted strictly and, in the event of any doubt, the decision should cover the signs in their entirety.

The Office considers that a negligible element refers to an element that, due to its size and/or position, is not noticeable at first sight or is part of a complex sign with numerous other elements (e.g. beverage labels, packaging, etc.) and, therefore, very likely to be disregarded by the relevant public.

Examples:

Earlier sign	Contested sign	Case No
		<p>T-162/08</p> <p>The words 'by missako' are almost illegible: the size and script make them difficult to decipher.</p>
	<p>LUNA</p>	<p>R 2347/2010-2</p> <p>The element 'Rótulos Luna S.A.' was considered negligible.</p>
<p>MATHEUS MÜLLER</p>		<p>R 396/2010-1</p> <p>The Board did not assess the elements '50 cl', '50 % vol.' 'ANNO' or '1857' phonetically or conceptually.</p>

<p>MAGNA</p>		<p>R 1328/2005-2</p> <p>The Board described the contested sign in full, but negligible elements such as '70 cl' were not included in the comparison.</p>
		<p>T-472/08</p> <p>The elements other than 'cachaça'/'pirassununga' and '51', the latter written in white within a circle that is itself partially within a broad band running from one side of the sign to the other, are negligible in the overall impression created by those marks (para. 65).</p>

It should also be noted that informative indications that the mark is registered (such as the symbols '™' and '®') are not considered part of the mark⁴. Consequently, such symbols will not be taken into account in the comparison of the signs.

1.6 Relevant territory and relevant public

Similarity must be assessed for the territory in which the earlier mark is protected. The relevant territory must be indicated. Moreover, the perception of the relevant public plays an important role when comparing signs⁵.

Where the earlier mark is a national mark, the relevant criteria must be analysed for the relevant public in that particular EU Member State (or Member States in the case of Benelux trade marks). The perception of similarity may differ from one Member State to another because of differences in pronunciation and/or meaning/understanding.

When the earlier mark is an EUTM registration, the analysis must in principle extend to the **whole** EU. However, in situations where there is likelihood of confusion in **at least one Member State** a part of the EU and when justifiable for reasons of economy of procedure (such as to avoid examining specific pronunciations or meanings of marks in several languages), the Office's analysis need not extend to the whole EU but may instead focus on only one **part or parts** where there is a likelihood of confusion.

The unitary character of the EUTM means that an earlier EUTM can be relied on in opposition proceedings against any application for registration of an EUTM that would adversely affect the protection of the first mark, even if only in the perception of consumers in part of the European Union (judgment of 18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 56-57 and subsequent case-law, inter alia judgment of 18/09/2011, T-460/11, Bürger, EU:T:2012:432, § 52 and the case-law quoted therein).

⁴ [The Guidelines, Part B, Examination, Section 2, Formalities.](#)

⁵ The Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention.

If the opposition is based on an international registration, the territory for which the basic mark is protected is not to be considered as the relevant territory of the earlier international registration designating or subsequently designating other relevant territories (except if the owner has protection in the whole EU — IR designating or subsequently designating the EU where the same country of the basic registration is covered).

Where the relevant public consists of both the general and the professional consumers, the finding of a likelihood of confusion in relation to just one part of the public is sufficient to uphold the opposition. Usually it is the general public that is more prone to confusion. Consequently, if the likelihood of confusion is to be confirmed on the part of the general public, there is no need to examine it based on the perception of professionals (see Guidelines, Part C, Opposition, Section 0, Introduction, point 4).

2 Identity of Signs

2.1 The concept of identity

As indicated above, a finding of identity between signs will lead to the success of the opposition pursuant to Article 8(1)(a) EUTMR if the goods and services are also identical.

The differences between Article 8(1)(a) EUTMR and protection in the event of likelihood of confusion, pursuant to Article 8(1)(b) EUTMR, must be borne in mind in order to understand the concept of identity and the requirements attached thereto.

Protection pursuant to Article 8(1)(a) EUTMR is absolute, because registration of a later identical sign for identical goods or services would compromise the function of the earlier mark as a means of identifying commercial origin. Where identical signs or marks are registered for identical goods or services, it is impossible to conceive of circumstances in which all likelihood of confusion could be ruled out. There is no need to consider any other factors, such as the degree of attention of the public or the distinctiveness of the earlier trade mark.

However, pursuant to Article 8(1)(b) EUTMR, the earlier trade mark is protected against the likelihood of confusion: even if the trade marks differ in some elements, their similarity — in combination with further elements that have to be assessed globally — may lead to the assumption that the relevant goods and services originate from the same or an economically linked undertaking.

Due to the absolute protection conferred by Article 8(1)(a) EUTMR, the concept of identity between trade marks must be interpreted strictly. The absolute protection in the case of an EUTM application ‘which is identical with the [earlier] trade mark in relation to goods or services which are identical with those for which the trade mark is registered [pursuant to Article 8(1)(a) EUTMR] cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by [Article 8(1)(b) EUTMR]’ (judgment of 20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 50-54 in relation to the corresponding provisions of the TM Directive).

2.2 Threshold for a finding of identity

The very definition of identity implies that the two signs should be the same in all respects. There is, therefore, identity between trade marks where the EUTM application reproduces, without any modification or addition, all the elements constituting the earlier trade mark.

However, since the perception of identity between the two signs is not always the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between trade marks may go unnoticed by the average consumer.

Therefore, **the EUTM application should be considered identical to the earlier trade mark ‘where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer’** (judgment of 20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 50-54).

An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon examining the marks side by side. ‘Insignificant’ is not an objective term, and its interpretation depends on the level of complexity of the trade marks being compared. Insignificant differences are those that, because they concern elements that are very small or are lost within a complex mark, cannot be readily detected by the human eye upon observing the trade mark concerned, bearing in mind that the average consumer does not normally indulge in an analytical examination of a trade mark but perceives it in its entirety.

The finding that an element is ‘insignificant’ ~~should~~**must** be accompanied by sufficient reasoning for its lack of impact on the global perception of the trade mark.

It follows from the definition of identity above that the following conditions have to be met in order for trade marks to be considered identical in accordance with Article 8(1)(a) EUTMR.

- **Complete identity of the signs taken as a whole.** Partial identity is not sufficient under Article 8(1)(a) EUTMR; however, a coincidence in any part of the mark may lead to similarity between the signs and should be addressed when carrying out the examination of Article 8(1)(b) EUTMR.

Any additional element is sufficient for concluding that the marks are not identical; it is immaterial whether the added element is a word, a figurative device or a combination of the two.

Consequently, two word marks will not be considered identical if one is contained within the other but is accompanied by further characters (see paragraph 2.4 below) or by words — irrespective of distinctiveness or possible descriptive character.

Earlier sign	Contested sign and comments	Case No
Millenium	MILLENIUM INSURANCE COMPANY LIMITED It was found that ‘the signs at stake were obviously not identical’, even if ‘Insurance company limited’ was descriptive in English for the related services.	R 696/2011-1

INDIVIDUAL	 INDIVIDUAL	R 807/2008-4
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- **Identity on all levels of comparison.** There must be identity between the signs at all relevant levels of trade mark comparison, that is, visual, phonetic and conceptual. If the trade marks are identical in some aspects (visual, phonetic or conceptual) but not in others, they are not identical overall. In the latter case, they may be similar and, therefore, likelihood of confusion must be examined.

2.3 Identity of word marks

~~Word marks are identical if both are purely word marks and coincide exactly in the string of letters or numbers.~~ Word marks are marks consisting of letters, numbers and other signs (e.g. '+', '@', '!') reproduced in the standard typeface used by the respective office. This means that they do not claim any particular figurative element or appearance. Where both marks are registered as word marks, the typeface actually used by the respective office in the official publication (e.g. the EUTM Bulletin) is immaterial. Differences in the use of lower or upper case letters are immaterial, even if lower case and upper case letters alternate. Word marks are identical if they coincide exactly in the string of letters or numbers.

The following word marks are identical:

Earlier sign	Contested sign	Case No
MOMO	MoMo	B-1-802-233
BLUE MOON	Blue Moon	R 835/2010-1
GLOBAL CAMPUS	Global Campus	R 719/2008-2
ZEUS	Zeus	R-0760/2007-1
JUMBO	Jumbe	R-0353/2007-2
DOMINO	Domino	R 523/2008-2
Apetito	APETITO	T-129/09
<u>IDRIVE</u>	<u>iDrive</u>	<u>T-105/14</u>

In general, it should be checked whether the sign has been registered as a word mark. For example, examining only the graphic representation of the trade mark (for instance, in the Madrid System) can be misleading because, depending on the graphic representation of the signs used in the certificates, bulletins, etc., a mark *claimed* as a word mark may include figurative or stylised elements or fonts. In these cases, the claim will prevail over the exact reproduction in the certificate, bulletins, etc.

Marks in non-Latin characters must be considered as word marks in the designated jurisdictions where those characters are officially used (e.g. Cyrillic in the case of an EUTM or an IR designating Bulgaria or the EU, in accordance with the indication of category No 28.05 'inscriptions in Cyrillic characters' of the Vienna Classification of figurative elements). The following Cyrillic word marks are identical:

Earlier sign	Contested sign	Case No
ВАСИЛЪКИ	Васильки	B 1 827 537



A difference of just one letter is sufficient for a finding of non-identity. The same applies to a space or a punctuation mark (e.g. hyphen, full stop), since the presence of either may change how the sign is perceived (see the first example below). The following word marks **are not** identical:

Earlier sign	Contested sign	Case No
She, SHE	S-HE	T-391/06
TELIA	teeli	B 13 948
NOVALLOY	NOVALOY	B 29 290
HERBO-FARMA	HERBOFARM	R 1752/2010-1



2.4 Word marks and figurative marks

A **word mark and a figurative mark**, even when both consist of the same word, will not be identical unless the differences [are so insignificant that they may go unnoticed](#) by the relevant public.

In the following examples the signs are clearly **not identical**:

Earlier sign	Contested sign	Case No
	IHotel	T-277/11
	ELCO	R 803/2008-1
eClear		R 1807/2010-1
BIG BROTHER		R 932/2010-4





However, the finding that trade marks are not identical can be more difficult if the figurative trade mark is written in normal typeface. Nevertheless, in the following examples the trade marks were found **not** to be **identical**:

Earlier sign	Contested sign	Case No
	THOMSON	R 252/2008-1
	Klepper	R 964/2009-1

2.5 Identity of figurative marks

Two figurative marks are identical when both signs match in all their figurative elements (shape, colours, contrast, shadowing, etc.).

It goes without saying that use of the same word will not suffice for a finding of identity when the figurative element is not the same. The following marks **are not** identical:

Earlier sign	Contested sign	Case No
		R 558/2011-1
		R 1440/2010-1
		7078 C

However, since in the following case the difference in the presentation of the letters 'TEP' in italics would go unnoticed by the public, the marks were considered **identical**:





Earlier sign	Contested sign	Case No
		B 2 031 741

2.6 Identity of an earlier black and white (B&W) or greyscale mark with a colour mark application





In the framework of the European Trade Mark and Design Network, the Office and a number of trade mark offices in the European Union have agreed on a common practice with regard to the scope of identity of earlier B&W or greyscale marks with coloured versions of the same sign.

According to this converged practice, the **differences** between an earlier B&W or greyscale mark and a coloured version of the same sign **will normally be noticed** by the average consumer, with the consequence that the marks are not considered identical. It is only under **exceptional circumstances** that the signs will be considered identical, namely where the differences in the colours or in the contrast of shades are so **insignificant** that a reasonably observant consumer will perceive them only upon examining the marks side by side. In other words, for the finding of identity the differences in the colour of the signs in question must be hardly noticeable by the average consumer.

Invented examples of **significant** differences with the consequence of no identity:



Earlier sign	Contested sign
	
	

Invented examples of **insignificant** differences with the consequence of identity:

Earlier sign	Contested sign
	
	

In relation to the findings above, the issue as to whether a trade mark registered in B&W or greyscale should be considered to cover all colours has also been addressed

by the Court in a subsequent judgment (judgment of 09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199):

Earlier sign	Contested sign	Case No
		T-623/11
<p>The Court considered that the fact that 'the proprietor of a mark may use it in a colour or a combination of colours and obtain for it, as the case may be, protection under the relevant applicable provisions ... does not mean ... that the registration of a mark which does not designate any specific colour covers all colour combinations which are enclosed with the graphic representation' (para. 39).</p> <p>In this particular case, the Court considered that the Board was right in finding 'that one difference between the mark applied for and the first and second earlier marks lay in the fact that the mark applied for consisted, in part, of a yellow background with white vertical stripes' (para. 40).</p>		

3 Similarity of Signs

3.1 Introduction

The similarity of signs depends on the distinctiveness (see paragraph 3.2 below) and dominant character (see paragraph 3.3 below) of their components, which are defined in the opposition decision. In the comparison of marks, the visual, phonetic and conceptual similarity must be assessed by weighing up the coinciding and the differing elements, and by taking into consideration their distinctiveness and dominance (see paragraph 3.4 below) and whether and to what degree these elements coin the overall impression produced by the marks. All these considerations will lead to a conclusion on the degree of similarity in each (visual, phonetic and conceptual) aspect (see paragraph 3.5 below).

3.2 Distinctive elements of the marks

In its judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23, the Court held 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'. Therefore, the degree of distinctiveness of the various components of composite marks is an important criterion that must be considered within the trade mark comparison.

When assessing the similarity of signs, an analysis of whether the coinciding components are ~~descriptive, or otherwise~~ non-distinctive or are of a limited distinctiveness (weak) is carried out in order to calculate the extent to which these coinciding components have a lesser or greater capacity to indicate commercial origin. This recognises that the consumer is more likely to consider that a ~~descriptive, allusive or otherwise~~ non-distinctive or weak element of a mark is not being used to identify a particular undertaking, and thus to distinguish goods or services from those of other undertakings.

Consequently, although trade mark proprietors commonly use ~~descriptive, allusive or otherwise~~ non-distinctive or weak elements as part of a trade mark to inform consumers

about certain characteristics of the relevant goods or services, it may be more difficult to establish that the public may be confused as to origin due to similarities that solely pertain to [non-distinctive or](#) weak elements.

The distinctiveness of the components of both the earlier **and** of the contested mark must be examined.

It is important to distinguish between the analysis of the distinctive character of (i) the component of a mark and (ii) the earlier mark as a whole. Analysing the components determines whether the signs in conflict coincide in a component that is distinctive (and therefore important), [non-distinctive](#) or weak (therefore being of less importance in the trade mark comparison). The analysis of the earlier mark as a whole determines the scope of protection afforded to that mark, which is a separate consideration within the likelihood of confusion, independent from the comparison of the trade marks (dealt with in Chapter 5, Distinctiveness of the Earlier Mark)⁶.

If either mark consists of one element only, the decision in the part dealing with the comparison of signs will establish whether its distinctiveness is normal or lower than normal. In this case, it cannot be found that a mark lacks distinctiveness. Regarding the earlier mark, this would amount to denying its distinctive character (for details, see paragraph 3.2.3.4 below). As regards the contested sign, this would mean that a new examination on absolute grounds would have to be carried out.

3.2.1 What is a component of a sign?

The Court has not defined what is to be regarded as a ‘component’ or ‘element’ of a sign. It is easy to identify components when a sign is visually divided into different parts (e.g. separate figurative and verbal components). However, the term ‘component’ encompasses more than these visual distinctions. Ultimately, the perception of the sign by the relevant public is decisive and a component exists wherever the relevant public perceives one. For example, the relevant public will often regard one-word signs as being composed of different components, in particular, where one part has a clear and evident meaning while the rest is meaningless or has a different meaning (e.g. in the mark EUROFIRT, ‘Euro’ will be widely understood as referring to Europe whereas ‘Firt’ is meaningless, giving this word mark two components: ‘Euro’ and ‘Firt’). In such cases, the elements of one-word signs could be regarded as ‘components’ in the terminology of the Court.

However, **word marks should not be artificially dissected**. Dissection is not appropriate unless the relevant public will clearly perceive the components in question as separate elements. A case-by-case assessment is required as to whether the division of a sign into components is artificial (e.g. whether splitting the word ‘LIMEON’ for fruit into the components ‘LIME’ and ‘ON’ would be artificial or not) ([see also paragraphs 3.4.3.2 and 3.4.5.1 below](#)).

⁶ The Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark.

3.2.2 Examination of distinctiveness

3.2.2.1 What is distinctiveness?

The Court has defined distinctiveness in the following manner:

in determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (emphasis added).

(Judgment of 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 22).

Importantly, distinctive character is a matter of degree and, when analysing distinctiveness, a sliding scale applies whereby a component of a sign can lack distinctiveness entirely, be fully distinctive (to a normal degree) or be at any point in-between.

At this point, it must be noted that it is not, in principle, the Office's practice to recognise a higher than average degree of inherent distinctiveness for individual components of signs. Any higher degree of distinctiveness (enhanced distinctiveness, reputation) is related to actual recognition of the mark by the relevant public, and is eventually examined only with respect to the earlier mark (see [the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion](#), Chapter 5, Distinctiveness of the Earlier Mark). A mark will not have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services (order of 16/05/2013, C-379/12 P, H.Eich, EU:C:2013:317, § 71).

An element of a sign is **not distinctive** if it is exclusively descriptive of the goods and services themselves or of the characteristics of those goods and services (such as their quality, value, purpose, provenance, etc.) and/or if its use in trade is common for those goods and services. Similarly, an element of a sign that is generic (such as a common shape of a container or a common colour) will also lack distinctiveness.

An element of a sign may be **distinctive to a low degree (weak)** if it refers to (but it is not exclusively descriptive of) characteristics of the goods and services. If the allusion to the goods and services is sufficiently imaginative or clever, the mere fact that there is an allusion to characteristics of the goods might not materially affect distinctiveness. For example:

- 'Billionaire' for *gaming services* is allusive in a manner that would affect distinctiveness, because it implies for instance that you may become a billionaire.
- 'Billy O'Naire', which sounds identical to 'billionaire' in English, would be allusive for *gaming services* as a clever word-play on Irish names, in a manner that would not affect distinctiveness in a material way; it would be considered to have a 'normal' degree of distinctiveness.

An element of a sign that is neither non-distinctive nor weakly distinctive possesses a **'normal' degree of inherent distinctiveness**. This means that the element of a sign in question is fully distinctive, in the sense that its capacity to identify the goods and services covered by the mark as coming from a particular undertaking is not in any way diminished or impaired.

One of the most frequent arguments brought by applicants is that the earlier trade mark or one of its components has a low distinctive character given that there are many trade marks that consist of, or include, the element in question. Where this argument is supported only by the applicant referring to trade mark registrations, the Office takes the view that the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of registered data only, it cannot be assumed that all the trade marks have been effectively used.

It follows that the evidence submitted must demonstrate that consumers have been exposed to widespread use of, and become accustomed to, trade marks that include the element in question in order to prove that the element in question has a low degree of distinctive character ([judgments of 13/04/2011, T-358/09, Toro de piedra, EU:T:2011:174, § 35; 08/03/2013, T-498/10, David Mayer, EU:T:2013:117, § 77-79](#)).

3.2.2.2 Relevant point in time

The inherent distinctiveness of the components should be assessed at the time of the decision.

Establishing the precise point in time for evaluating distinctiveness is important because the degree of distinctiveness of the marks is not constant, but varies depending on the perception of the public. This perception may change not only due to the nature of the use of the specific mark, but also due to other factors (all these elements can only be considered from the evidence submitted by the parties). For instance, the public's perception may change where a mark or some component thereof has been used in the meantime in a similar way by various businesses/traders in the relevant market sector. This common use of a sign can erode the uniqueness of a sign and, consequently, its ability to indicate the origin of the goods and services. In this context, it is important to assess carefully whether the situation described exists in all the relevant geographical areas and with regard to all the relevant goods and services.

As an example, due to technological changes in the field of IT, there has been an increased number of instances where components such as 'I' (internet), 'E' (electronic) and 'M' (mobile) are used adjoined to a meaningful word. In the context of electronic communications, they are currently found to be descriptive (decision of 19/04/2004, R 758/2002-2, ITUNES, § 11), whereas previously they were considered distinctive.

3.2.2.3 Relevant goods and services

The assessment of the **inherent distinctiveness** of the components is carried out only for the goods or services that are identical or similar, that is:

- the earlier mark is assessed with respect to the registered goods and services that are identical or similar to the contested goods and services;
- the contested trade mark is assessed with respect to the contested goods or services that are identical or similar to those of the earlier mark.

3.2.2.4 General principles of examination of distinctiveness

The examination of inherent distinctiveness is carried out in two phases: first, it should be determined whether the relevant public recognises semantic content of the element at issue and, second, whether or not the semantic content perceived is related to and/or commonly used in trade for the identical or similar goods and services.

As regards the **first phase**, that is to say, whether the relevant public recognises a semantic content, ~~this is assessed in the conceptual comparison of signs, which is described in detail in paragraph 3.4.3 below, Conceptual comparison.~~

~~The~~^{the} inherent distinctiveness of the components of the marks has to be evaluated by taking into account (each of) the relevant geographical area(s) and their different linguistic and cultural backgrounds. As such, the public in some parts of the relevant territory might not understand the descriptive content that a mark may have in other parts. In these cases, the distinctiveness of the mark in one area is not affected by the fact that it may be perceived differently in other areas.

Below is an example of a case where linguistic considerations were vital to the issue of distinctiveness:

Earlier sign	Contested sign	Case No
FRUTISOL	Solfrutta	T-331/08
<p>G&S: Classes 29, 30 and 32 Territory: EU <i>Assessment of the components 'frut' and 'sol':</i> '... it is necessary to distinguish between the perception by the public in those Member States, such as Italy and Spain, where the elements "sol" and "frut" are generally recognisable and can be understood as alluding to "sun" and "fruit" respectively, and the perception by the public in those Member States, such as Hungary, Finland and Lithuania, where those elements have no such close equivalent in their national languages'. In the first category of Member States, consumers are liable to associate both marks with the notions of 'fruit' and 'sunshine'. There will consequently be a certain level of conceptual similarity between them. In Member States of the second category, consumers will not perceive any conceptual similarity between the signs since they will not attach any particular meaning to the constituent parts of either sign (paras 21-24).</p>		

The **second phase** consists of correlating any meaning that the public perceives in the components with the identical or similar goods and services in dispute. If the relevant public perceives this meaning as descriptive, laudatory or allusive (in a manner that materially affects distinctiveness), etc. for these goods and services, then its distinctiveness will be diminished accordingly. It may be necessary to distinguish between the various goods and services involved because the finding of no or limited distinctiveness might relate to only part of those goods and services.

The criteria applied to examining the inherent distinctiveness of a component of a sign are the same as the relevant principles applied when examining marks on absolute grounds⁷. However, in relative grounds disputes, the question is not merely whether a component is distinctive or not (i.e. whether it reaches the minimum distinctiveness threshold for registration), but also to what degree it is distinctive within the sliding scale previously mentioned. Therefore, for instance, a term that is not descriptive but

⁷ These are described in the Guidelines, Part B, Examination. See also Objective 2 of the Common Practice on the Impact of Non-Distinctive/Weak Components on Likelihood of Confusion agreed in the Framework of the European Trade Mark and Design Network.






merely allusive for the goods or services in question might be distinctive enough to pass the absolute grounds test, but still have less than normal distinctiveness for the purposes of relative grounds.


The outcome of the examination of inherent distinctiveness will be one of the following.

- The component has ~~less than normal or no distinctiveness because it is descriptive, laudatory of characteristics of identical or similar goods or services or because it is otherwise weak~~ no distinctiveness or has less than normal distinctiveness. See the examples below.
- The component has normal distinctiveness because it is neither non-distinctive nor weak for identical or similar goods or services.



As noted in paragraph 2.1 above, word marks consisting of a single word may still contain various components, some of which may be more distinctive than others (judgment of 27/01/2010, T-331/08, Solfrutta, EU:T:2010:23).

3.2.2.5 Examples of descriptive components



Earlier sign	Contested sign	Case No
BYLY		T-514/08
<p>G&S: Class 3 Territory: EU Assessment of the element 'products': '... the term "products" is not distinctive enough to be taken into consideration by the consumers' (para. 39).</p>		
Earlier sign	Contested sign	Case No
		T-490/08
<p>G&S: Class 36 Territory: EU Assessment of 'CAPITAL MARKETS': 'the relevant public, consisting of consumers who are very attentive, well-informed and familiar with basic English financial terminology, will attach little significance to the meaning of the words "capital" and "markets", which are descriptive of those services and which do not enable the commercial origin of the trade marks at issue to be identified' (para. 59).</p>		
Earlier sign	Contested sign	Case No
		R 834/2009-1
<p>G&S: Classes 3 and 5 Territory: EU Assessment of the earlier right: even though the signs have some similarities, the expression 'NATURAL BRONZE' is descriptive of the purpose of the goods (tanning) for the goods in Class 3 (para. 31).</p>		
Earlier sign	Contested sign	Case No

cineday_ (CINEDAY <i>et al.</i>)	CINETAIN	R 1306/2009-4
<p>G&S: Classes 38 and 41 Territory: Spain Assessment of the element 'CINE': the word 'cine' has a descriptive meaning in the sense of 'cinema (film)'. Therefore, this component has only limited relevance in the perception of the signs (para. 36).</p>		
Earlier sign	Contested sign	Case No
	NATURAL BEAUTY FROM WITHIN	R 991/2010-2
<p>G&S: Classes 3 and 5 Territory: Germany Assessment of the element 'NATURAL BEAUTY': the element 'NATURAL BEAUTY' is a plain and essential indication of the kind and quality of the goods. The German public understands the meaning of these two basic words as well as the combination thereof (paras 31-35).</p>		
Earlier sign	Contested sign	Case No
FORCE-X	FSA K-FORCE	T-558/13
<p>G&S: Classes 9 and 12 Territory: EU Assessment: the word 'force', synonymous with strength and power, can describe one of the characteristics of the goods concerned. Furthermore, for some goods in Class 12, it must be held that that word can also designate one of their purposes. Furthermore, as is apparent from the evidence adduced by the applicant, the word 'force' is commonly used, on the European market, in trade marks in the domain of cycling, thus rendering it banal (paras 38-39).</p>		

3.2.2.6 Examples of laudatory components

Earlier sign	Contested sign	Case No
	MAGIC SEAT	T-363/06
<p>G&S: Class 12 Territory: Spain Assessment of the element 'MAGIC': the word 'magic' will be perceived by the relevant public as a simple qualifier for the word 'seat' on account of its resemblance to the Spanish word 'mágico', which is purely laudatory (para. 39).</p>		
Earlier sign	Contested sign	Case No
STAR SNACKS		T-492/08
<p>G&S: Classes 29, 30 and 32 Territory: EU Assessment of the element 'STAR': the word element 'STAR' is laudatory, as it merely constitutes (together with the remaining elements of the signs) a reference to high-quality food products (para. 52).</p>		

3.2.2.7 Examples of allusive components

Earlier sign	Contested sign	Case No
EL COTO	<p>Coto D'Arcis</p> 	T-332/04
<p>G&S: Classes 33, 35 and 39 Territory: EU Assessment of distinctiveness of the image in the contested EUTM application: The figurative element of the mark evokes a vineyard; this component has little distinctive value as regards wines (para. 38).</p>		
Earlier sign	Contested sign	Case No [EN 7 — 1]
	WORLDBANK	T-325/04
<p>G&S: Class 36 Territory: EU Assessment of the element 'LINK': the element 'LINK' <u>of the earlier mark</u> is not immediately descriptive of inter alia 'banking services for the dispensing of cash; funds transfer and payment services; financial information services' (Class 36) covered by the earlier mark, but merely allusive in relation to them <u>(para. 68 and seq.)</u>.</p>		

3.2.3 Specific cases

3.2.3.1 One-letter components, numerals and short components

The Court, in its judgment of 09/09/2010, C-265/09 P, α, EU:C:2010:508, held that the distinctiveness of single-letter trade marks must be assessed according to an examination based on the facts, focusing on the goods or services concerned and the **same criteria that apply to other word marks** (paras 33-39). Although that judgment deals with absolute grounds, the Office considers that the principle established by the Court (i.e. that the application of the criterion of distinctiveness must be the same for all marks) also applies in *inter partes* cases when it comes to determining the distinctiveness of single-letter components in trade marks.

The Court, although acknowledging that it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks, held that these circumstances do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law.

In the context of analysis of distinctiveness of components of signs, the Office considers the ruling to mean that, when establishing the distinctiveness of a single letter, being a component of a sign, it is not correct to rely on assumptions such as a priori statements that consumers are not in the habit of perceiving single letters as trade marks or on generic arguments such as that relating to the availability of signs, given the limited number of letters.

The General Court has since stated in a number of cases that a trade mark containing a **single letter** or a single numeral may indeed be inherently distinctive (judgments of

08/05/2012, T-101/11, G, EU:T:2012:223, § 50; 06/10/2011, T-176/10, seven for all mankind, EU:T:2011:577, § 36; 05/11/2013, T-378/12, X, EU:T:2013:574, § 37-51).


In its judgment of 10/05/2011, T-187/10, G, EU:T:2011:202, the General Court dismissed the applicant’s argument that single letters are generally per se devoid of distinctive character and that, therefore, only their graphic representation would be protected (see paras 38-49).

The above considerations apply both to single-letter/numeral trade marks depicted in standard characters (i.e. word marks) and to stylised single-letter/numeral trade marks.

Furthermore, in accordance with the ‘α’ judgment, as regards these components, unless the letter combination itself is descriptive or otherwise related to the goods and services (e.g. ‘S’, ‘M’, ‘XL’ for goods in Class 25), these components are not necessarily limited in their distinctiveness. The same rules apply to numerals.

3.2.3.2 Commonplace and banal elements

There are instances where signs are composed of one (or various) distinctive verbal element(s) and one (or various) figurative element(s) that are perceived by the relevant public as being commonplace or banal. These figurative elements frequently consist of a simple geometrical shape (e.g. frames, labels) or of colours frequently used in the market sector (e.g. red for fire extinguishers, yellow or red or orange for the postal sector depending on the Member State concerned). For this reason, these commonplace and banal elements are considered non-distinctive.

Earlier sign	Contested sign	Case No
ARCO		R 1929/2010-2
<p>G&S: Class 9 Territory: EU Assessment of figurative elements: the verbal elements of the two signs coincide. Even if it is not negligible in terms of its size, the figurative element of the contested EUTM is likely to be perceived by consumers essentially as a mere decorative element, and not as an element indicating the commercial origin of the goods (para. 43).</p>		

3.2.3.3 Disclaimers

Pursuant to former Article 37(2) CTMR (deleted by the Amending Regulation), the Office could impose a disclaimer if the mark contained an element that was not distinctive and if inclusion of that element would have led to doubts as to the scope of protection. The Office also accepted disclaimers entered voluntarily. Some national trade mark systems also provide for disclaimers.

Following the entry into force of the Amending Regulation, the Office will no longer be able to request disclaimers; similarly, no requests for disclaimers entered by the EUTM applicant will be accepted.

However, disclaimers in marks registered by the Office before the entry into force of the Amending Regulation and in earlier national marks will still be binding on the Office and

must be taken into account even if the element might appear distinctive when analysed independently.

The effect of a disclaimer is:



- if the earlier mark contains a disclaimer, that the proprietor is prevented from successfully invoking rights in the disclaimed element. Therefore, similarity between two signs cannot be induced or increased because of coincidence or similarity in the disclaimed element (decision of 06/10/2008, R 21/2008-4, AUTENTICO JABUGO / FLOR SIERRA DE JABUGO JABUGO (fig.) et al., § 17, where JABUGO was disclaimed).
- If the earlier figurative mark contains two words and both are disclaimed, that the scope of protection is reduced to the precise manner and sequence in which the two words are combined.

Disclaimers in the contested EUTM application (irrespective of whether they were requested by the Office or entered voluntarily by the applicant before the entry into force of the Amending Regulation) cannot bind the owner of the earlier mark, that is to say, the applicant cannot unilaterally reduce the scope of protection of the earlier mark (decisions of 11/02/2010, R 229/2009-2, DOUGHNUT THEATER / DONUT et al., § 58; 29/03/2012, R 2499/2010-1, ACETAT Silicon 101E (fig.) / 101 et al., § 18-19).

3.2.3.4 Earlier marks ~~consisting~~, the distinctiveness of one element that which is distinctive to a low degree called into question

If the distinctiveness of the earlier mark ~~only consists of one element whose distinctiveness is put in question~~ questioned, the Office applies the practice clarified in the judgment of 24/05/2012, C-196/11, F1-LIVE, EU:C:2012:314, namely that in proceedings opposing the registration of an EUTM, the validity of earlier trade marks may not be called into question.

Consequently, the elements corresponding to the earlier mark cannot be considered as devoid of distinctive character in the trade mark comparison, but must be deemed to be endowed with some (low/minimal) degree of distinctiveness.

Earlier sign	Contested sign	Case No
		<p>R 2306/2012-1</p>
<p>G&S: Classes 29, 30 and 32 Territory: the Czech Republic Assessment: 'The Board also notes that the earlier mark "Glanc" is registered in the Czech Republic for the goods in question and, therefore, for the purpose of the present proceedings, it must be deemed to be endowed with at least some degree of distinctive character <u>character</u> [EN 7 — 2].</p>		

3.3 Dominant elements of the marks

It is the Office's practice to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean '**visually outstanding**'. For a finding that there is a dominant element within a sign, the sign should have at least two identifiable components⁸. The rules explained in paragraph 3.2.1 above apply accordingly.

The decision must identify which of the components of a sign is the dominant one.

Even though, according to the established case-law of the Court, aspects other than the visual one (such as a possible semantic meaning of part of a one-word sign) may come into play when defining the notion of the dominant element of a sign, it is the practice of the Office to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean 'visually outstanding' and to leave any other considerations for the overall assessment. As a result, the Office's practice is that the dominant character of a component of a sign **is mainly determined by its position, size, dimensions and/or use of colours**, to the extent that they affect its visual impact. As stated by the Court:

with regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.

(Judgment of 23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 35, confirmed by order of 28/04/2004, C-3/03 P, Matratzen, EU:C:2004:233).

In addition, the Court has held that:

... the weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them.

(Judgment of 13/06/2006, T-153/03, Peau de vache, EU:T:2006:157, § 32).

Consequently, the fact that a component of a mark may or may not be considered non-distinctive (or as having a low degree of distinctiveness) has no bearing on the assessment of dominant character.




As a rule of thumb, the following should be considered.

- The assessment of dominant character applies to both the signs under comparison.
- For a finding that there is a dominant component, the sign should have at least two identifiable components.



⁸ In this text the words 'component' and 'element' are used interchangeably.

- Word marks have no dominant elements because by definition they are written in standard typeface. The length of the words or the number of letters is not an issue of dominance but of overall impression⁹.
- Figurative elements may be dominant in signs where word elements are also present.
- Whether or not an element is visually outstanding may be determined in the visual comparison of the signs; if that is the case, it must be consistent with a subsequent evaluation of dominant character.
- Lastly, if it is difficult to decide which of the (at least) two components is dominant, this may be an indication that there is no dominant element or that no element is more dominant than the other (which includes cases of co-dominance). The establishment of dominant character implies that one component is visually outstanding compared to the other component(s) in the mark; if that assessment is difficult to make, it is because there is no dominant element.

Examples of cases:

Sign	Dominant component and reasoning	Case No
	<p>RPT: ‘the dominant element of the earlier marks is the acronym RPT, in which the letter “p” predominates’ (para. 33).</p>	T-168/07
	<p>Free: ‘the word “free” dominates the visual impression created by the mark of which it forms part, because it is considerably larger than the other components and, in addition, is much easier to remember and pronounce than the slogan in question’ (para. 39).</p>	T-365/09
	<p>Xtreme: ‘On the visual level, it must be concluded that in the mark applied for, the term “XTREME” occupies a central position. Indeed, the size of its typeface is bigger than that of the other verbal elements, and the word is highlighted with a white outline ... The other verbal components “RIGHT GUARD” and “SPORT”, are written in a much smaller type and are shifted to the right and towards the edge of the sign’ (para. 55).</p>	T-286/03

⁹ See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment.

	<p>GREEN by missako: ‘It must be noted, as a first point, that the representation of the sun has an important place within the mark applied for, in that it is positioned in the centre and covers almost two thirds of the area. Next, the position of the word element “green” is also important within the mark, as it is portrayed in large-typeface, stylised upper case letters in black and takes up about one third of the area. As observed by the Board of Appeal in para. 28 of the contested decision, those two elements thus occupy the major portion of the mark applied for and are, therefore, striking in the overall impression of the mark. Lastly, as regards the word element “by missako”, the Board of Appeal correctly held, in para. 28 of the contested decision, that those words were almost illegible because of their size and that the handwriting made them difficult to decipher. It follows, first, that the dominant nature of the word “green” and of the representation of the sun are thereby further reinforced and, secondly, that the word element “by missako” is negligible in nature’ (paras 37-39).</p>	<p>T-162/08</p>
	<p>BÜRGER: The dominant element of the mark applied for is undeniably the word element in upper case letters that stands out, simply because of its position and the very large size of its lettering, from all the other elements that make up the label (para. 38).</p>	<p>T-460/11</p>

3.4 Comparison of signs

In the following paragraphs the application of the principles explained above will be explained with regard to the visual (see paragraph 3.4.1 below), phonetic (see paragraph 3.4.2 below) and conceptual comparison (see paragraphs 3.4.3 and 3.4.4 below). Thereafter, the impact of distinctiveness and dominant character of the common and differing elements (see paragraph 3.4.5 below) and other principles to be taken into account in the comparison of signs (see paragraph 3.4.6 below) will be presented.

3.4.1 Visual comparison

Within the visual comparison it is important to note first that the public perceives word elements of a mark in a different way than other elements. Word elements can be read or associated with a sequence of letters. Other elements are just assessed as to their graphical or figurative characteristics. In the following, the principles of visual comparison will be presented depending on the type of trade marks involved.

3.4.1.1 Word mark v word mark

When at least one word mark is involved, the word as such is protected, not its written form.

According to the case-law, a word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element (judgments of 20/04/2005, T-211/03, Faber, EU:T:2005:135,

§ 33; 13/02/2007, T-353/04, Curon, EU:T:2007:47, § 74). The protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics which that mark might possess (judgment of 22/05/2008, T-254/06, RadioCom, EU:T:2008:165, § 43).

Therefore, it is irrelevant whether the word mark is depicted in lower or upper case letters:

Earlier sign	Contested sign	Case No
BABIDU	babilu	T-66/11 (para. 57)
BALLYMANOR	BallyM	R 391/2010-1

For word marks, the visual comparison is based on an analysis of the number and sequence of the letters/characters, the position of the coinciding letters/characters, the number of words and the structure of the signs (e.g. whether word elements are separated or hyphenated).

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.

In the following cases the marks were held to be visually similar:

Earlier sign	Contested sign	Case No (level of similarity)
MEDINETTE	MESILETTE	T-342/10 (average)
FORTIS	FORIS	R 49/2002-4 (high)
ARTEX	ALREX	T-154/03 (very high)
MARILA	MARILAN	R 799/2010-1 (high)
EPILEX	E-PLEX	T-161/10 (average)
CHALOU	CHABOU	T-323/10 (high)

The following word marks are visually dissimilar:




Earlier sign	Contested sign	Case No
CAPOL	ARCOL	C-193/09 P and T-402/07
<p>The Board held that although those marks shared the letter 'a' and the ending 'ol', they 'clearly differ[ed]' visually. The General Court agreed. It held that the same number of letters in two marks is not, as such, of any particular significance for the relevant public, even for a specialised public. Since the alphabet is made up of a limited number of letters, which, moreover, are not all used with the same frequency, it is inevitable that many words will have the same number of letters and even share some of them, but they cannot, for that reason alone, be regarded as visually similar. In addition, the public is not, in general, aware of the exact number of letters in a word mark and, consequently, will not notice, in the majority of cases, that two conflicting marks have the same number of letters (paras 81-82). The Court held that what matters in the assessment of the visual similarity of two word marks is the presence, in each of them, of several letters in the same order (para. 83). The ending 'ol' of the marks at issue constituted a common element of the marks but comes at the end and is preceded by completely different groups of letters (respectively, 'arc' and 'cap'), so the Board of Appeal correctly concluded that that this commonality does not render the marks visually similar (para. 83). The Court of Justice upheld this assessment from a visual perspective (para. 74).</p>		

3.4.1.2 Word mark v figurative mark with word elements



When figurative marks with word elements and word marks are compared visually, what matters is whether the signs share a significant number of letters in the same position and whether the word element in the figurative sign is highly stylised. Similarity may be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour.

In principle, when the same letters are depicted in the same sequence, any variation in stylisation has to be high in order to find visual dissimilarity.

The following marks were considered visually **similar** because there was no high variation in the stylisation of the word elements in the figurative marks and the word element was easily recognisable and legible:

Earlier sign	Contested sign	Case No (level of similarity)
VITAFIT		T-552/10 (average)
COTO DE IMAZ		R 409/2009-1 (high)
vendus sales & communication group		R 994/2009-4 (high)

However, where the word in the figurative mark is highly stylised, the marks should be found visually **dissimilar**, as in the following examples:





Earlier sign	Contested sign	Case No
NEFF		R 1242/2009-2
	NODUS	R 1108/2006-4

3.4.1.3 Purely figurative v purely figurative signs





When comparing signs in conflict in terms of their **purely figurative elements**, the Office considers the latter as images: if they match in one, separately recognisable,

element or have the same or a similar contour, it is likely that some visual similarity will be found.

The following purely figurative signs were found to be visually **similar**.




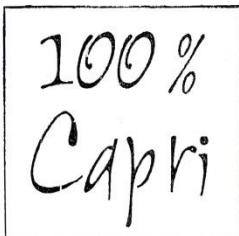


Earlier sign	Contested sign	Case No (level of similarity)
		T-379/08 (average)
		B 1 157 769 (medium)

The following purely figurative signs were deemed to be visually **dissimilar**:


Earlier sign	Contested sign	Case No
		B 1 572 059
		T-502/11

3.4.1.4 Stylised mark v stylised mark

When comparing signs in terms of their **word elements**, the Office considers signs similar insofar as they share a significant number of letters in the same position and when they are not highly stylised or when they are stylised in the same or a similar manner. Similarity may be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour (judgments of 18/06/2009, T-418/07, LiBRO, EU:T:2009:208; 15/11/2011, T-434/10, Alpine Pro Sportswear & Equipment, EU:T:2011:663; C-42/12 P, Alpine Pro Sportswear & Equipment, EU:C:2012:765, appeal dismissed). In the following examples, the marks were considered visually **similar** because they share some words or sequences of letters and the typeface was deemed not to be highly stylised:

Earlier sign	Contested sign	Case No (level of similarity)
		R 1454/2005-4 confirmed by T-418/07 (average similarity)
		R 1148/2008 (high)
		T-383/12 (high)

In the following examples, however, the marks were considered visually **dissimilar** in spite of the fact that they shared some words and/or letters and/or figurative devices, because the shared letters are highly stylised, placed differently and/or there are additional figurative devices:

Earlier sign	Contested sign	Case No
		T-390/03
		T-106/06
		R 1109/2008-1
		R 111/2010-4

When comparing figurative signs visually, it is still possible to find visual similarity when the figurative elements are different (i.e. they do not match or have the same or similar contour) and the word elements are different. Similarity will be found when the overall stylisation, structure and colour combination render the signs visually similar overall.






The following example illustrates how similar structure, stylisation and colour combination render signs visually similar:

Earlier sign	Contested sign	Case No (level of similarity)
		B 1 220 724 (high)



3.4.1.5 Word/figurative sign v figurative sign

A coincidence in a figurative element that is visually perceived in an identical or similar way may lead to a visual similarity.

The following examples are cases where there are visual similarities because of matching figurative elements:

Earlier sign	Contested sign	Case No (level of similarity)
		T-81/03, T-82/03 and T-103/03 (significant)
(i)  (ii) 		R 144/2010-2 (low)

In the following example the figurative elements were different and the signs were considered visually **dissimilar**:




Earlier sign	Contested sign	Case No
		B 134 900 The marks were considered visually dissimilar

3.4.1.6 Signs consisting of a single letter




As explained previously in this chapter (see paragraph 3.2.3.1 above), in cases of conflicting signs containing the same single letter, the visual comparison is normally of decisive importance, these signs usually being phonetically and conceptually identical.

The fact that the conflicting signs comprise the same single letter can lead to a finding of visual similarity between them, depending on the particular way the letters are depicted.

In the following examples, the signs were found to be visually similar to a high or medium degree.

Earlier sign	Contested sign	Case No
		T-115/02
<p>G&S: Classes 9, 16, 25, 35, 41 Territory: EU Assessment: as regards the visual similarity of the conflicting signs, the Board of Appeal rightly considered that both marks in question include as a dominant element the lower-case white letter 'a', of a commonplace typeface, on a black background. That dominant element makes an immediate impression and is remembered. Conversely, the graphic differences between the trade marks in question — namely the shape of the background (oval for the trade mark applied for and square for the earlier trade mark), the position of the letter on that background (in the centre in the case of the trade mark applied for and in the lower right-hand corner in the case of the earlier trade mark), the thickness of the line used to represent that letter (the trade mark applied for uses a slightly broader line than that used in the earlier trade mark) and the calligraphic details of the letters of the respective marks — are minor and do not constitute elements that will be remembered by the relevant public as effective distinguishing features. Consequently, the conflicting signs are very similar from the visual point of view.</p>		
Earlier sign	Contested sign	Case No
A		R 1508/2010-2
<p>G&S: Classes 9, 18, 24, 25, 28 Territory: Germany Assessment: the Board found the signs visually similar to a medium degree.</p>		

In the following cases, the signs were found to be visually similar to a low degree (that resulted, depending on a particular case, both in likelihood of confusion and no likelihood of confusion).

Earlier sign	Contested sign	Case No (level of similarity)
(i)  (ii) 	 G line	T-187/10

G&S: Classes 9, 18, 25
 Territory: EU, Italy
 Assessment: the signs were found to be similar to a low degree from a visual point of view (likelihood of confusion).



Earlier sign	Contested sign	Case No (level of similarity)
A		T-174/10 (appeal dismissed C-611/11 P) low degree [EN 7 — 3]

G&S: Classes 18, 25
 Territory: Germany
 Assessment: on the basis of the particular graphic design of the contested trade mark, the Court only found a low degree of visual and conceptual similarity (para. 31). A phonetic comparison was not possible, as it was found that the public would most likely not pronounce the contested trade mark given the particular graphic design (para. 32). Please note that the outcome in this case was that of no likelihood of confusion, although the Court found low visual similarity between the signs — **no likelihood of confusion**.



Earlier sign	Contested sign	Case No (level of similarity)
F		R 1418/2006-2

G&S: Class 25
 Territory: EU
 Assessment: visually, the earlier mark is an upper case letter 'F' written in a standard typeface, whereas the contested mark is a stylised letter 'F', in which the horizontal line is embellished with a distinctive drawing that amounts to a relevant visual difference. The outcome of this case was that of no likelihood confusion.

Finally, in the examples below the signs were found to be **visually dissimilar** due to the different stylisations or graphic elements of the single-letter signs. The final outcomes of these cases were those of no likelihood of confusion.

Earlier sign	Contested sign	Case No
		R 1655/2006-4

G&S: Class 25
 Territory: Spain
 Assessment: even though the marks share the presence of the letter 'm', they cannot be considered visually similar since the overall visual impression that each mark makes on the relevant public is clearly distinct. The EUTM applied for is a complex graphic device that includes a black lowercase letter 'm' and in addition, other significant figurative elements, namely a bold curved dark line placed above a background circle in which the letter 'm' is almost included. These additional elements are of particular importance since the heavy bold line echoes the form of the background circle and the dark shade of the letter 'm', which is placed over the background. In the earlier mark, the letter 'm' appears in outline font with a characteristic inclination to the right and an uneven height so that the right-hand size of the letter is lower. Consequently, these dissimilarities between the signs are sufficient for it to be held that they do not give the consumer the same visual impression (para. 18).

Earlier sign	Contested sign	Case No
		<p>R 576/2010-2 (confirmed by T-593/10)</p>
<p>G&S: Classes 25, 41, 43 Territory: Germany <i>Assessment:</i> due to the different colours, figurative element and stylisation, the marks were found to be visually dissimilar. Visually, the earlier mark can be perceived as a boomerang, accompanied by the letter 'B', which is the first letter of 'boomerang'.</p>		



It should be pointed out that the verbal representation of 'one-letter/one-digit sign' is not to be considered equivalent to the sign (e.g. 'ONE' is not equal to '1' or 'EM' to 'M'). Therefore, the aforementioned arguments are not directly applicable to such cases.



Finally, it must be noted that the above considerations also apply to signs consisting of single numbers.

3.4.1.7 Three-dimensional marks

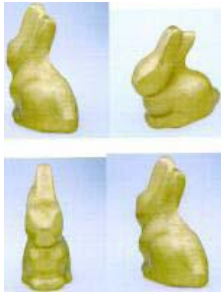

When comparing three-dimensional and two-dimensional signs, the same basic principles as for two-dimensional marks are to be applied. Although the comparative rarity of the three-dimensional sign will usually particularly affect the visual impact of the sign, this must be considered in relation to the overall impression.

In contrast, there is a low degree of visual **similarity** between the following marks:

Earlier sign	Contested sign	Case No (level of similarity)
		<p>R 806/2009-4, para. 19 (low)</p>

		<p>T-24/08 (low)</p>
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The following marks are visually **dissimilar**:

Earlier sign	Contested sign	Case No
		<p>R 806/2009-4, para. 34</p>

3.4.2 Phonetic comparison

When the opposition is based on earlier signs that enjoy protection in different EU Member States, in principle, account must be taken of all the different pronunciations of the signs by the relevant public in all official languages of those Member States. Local accents are not taken into account. Nevertheless, as already mentioned, when the earlier mark is an EUTM registration, the analysis must in principle extend to the **whole EU**. However, where there is a likelihood of confusion for ~~at least one Member State~~ part of the EU and it is justifiable for reasons of economy of procedure (such as to avoid examining specific pronunciations or meanings of marks in several languages), the Office's analysis need not extend to the whole EU but may instead focus on only a **part or parts** where there is a likelihood of confusion.







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 play an important role in how signs are perceived phonetically. 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 a trade mark are the syllables and their particular sequence and stress. The assessment of common syllables is particularly important when comparing marks phonetically, as a similar overall phonetic impression will be determined mostly by those common syllables and their identical or similar combination.

The following are examples of phonetically **dissimilar** marks:

Earlier sign	Contested sign	Relevant territory	Case No
CLENOSAN	ALEOSAN	ES	R 1669/2010-2
GULAS	MARGULIÑAS	ES	R 1462/2010-2

The following are examples of phonetically similar/identical marks:

Earlier sign	Contested sign	Relevant territory	Case No (level of similarity)
CAMEA	BALEA	EU	T-195/13 (low similarity)
		PT: the part of the relevant public that has some knowledge of the English language will read and pronounce the earlier mark in the same way as the mark applied for insofar as the latter uses the English word 'forever' (para. 70). The marks at issue share the same ending 'ever'; the Board of Appeal did not err in finding that those marks were phonetically similar to an average degree for the part of the relevant public with no knowledge of the English language (para. 72).	T-528/11 (identity/average similarity)
FEMARA		EU	R 722/2008-4 (above average)
	FOR US	BX	R 166/2010-1 (identity)
		DE	R 1071/2009-1 similar to a low degree

3.4.2.1 Signs and elements in signs that must be assessed





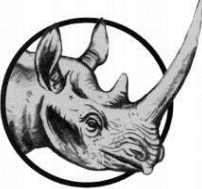

AThe Office conducts a phonetic comparison when both trade marks can be pronounced or have a sound. Accordingly, a figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally ~~(judgment of 07/02/2012, T-424/10, *Eléphants dans un rectangle*, EU:T:2012:58, § 46).~~




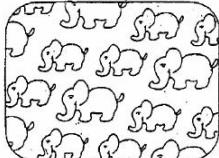
In other words, purely figurative marks (i.e. those not containing any word element) are not subject to a phonetic assessment. The ‘meaning’ that the image evokes, or its ‘description’, will be assessed visually and conceptually.

In this respect, the Office follows the case-law established by the judgments of 07/02/2012, T-424/10, *Eléphants dans un rectangle*, EU:T:2012:58, § 46; 08/10/2014^[EN 7—4], T-342/12, *Star*^[EN 7—5] ~~within a circle~~, ECLI:EU:T:2014:858, § 48; 30/09/2015, T-364/13, *KAJMAN / Device of a crocodile et al.*, ~~ECLI:EU:T:2015:738~~, § 46; 25/11/2015, T-320714, § 45-46.^[EN 7—6] The contrary position taken by the Court in the judgment of 07/05/2015, T-599/13, *GELENGGOLD / ~~Shape of a tiger~~ FORM EINES TIGERS et al*^[EN 7—7], ECLI:EU:T:2015:262, § 65 cannot be considered as prevailing trend until a clarification is made by the Court of Justice. In its decision of 09/07/2015, ~~in~~ R 863/2011-G, § 49, the Grand Board of Appeal excluded the possibility of a direct (pronunciation-based) phonetic comparison of figurative elements.

The Office does not undertake an indirect phonetic comparison, based on the description or a meaning attributed to the image by the public, given that in most cases it is difficult to define which description the public will attribute to a figurative element, and that the comparison based on such a description would lead to a subjective and arbitrary outcome. Furthermore, if the phonetic comparison is based on a description of a figurative element or on its meaning, it will only repeat the outcome of the visual or conceptual comparison respectively, where these elements have already been assessed.



The following are examples of where no phonetic comparison could be made because the marks are purely figurative:

Earlier sign	Contested sign	Case No
		T-320/14
		T-342/12
Earlier sign	Contested sign	Case No
		R-0131/2010-4

		R-0403/2009-2
		T-424/10

Furthermore, when one of the signs has elements that can be read and the other has only figurative elements ~~not subject to a phonetic assessment, the outcome should be that no phonetic comparison can be made.~~ the two signs cannot be directly phonetically compared. For example:

Earlier sign	Contested sign	Case No
		T-364/13

Earlier sign	Contested sign	Case No
		R 144/2010-2

With regard to the pronunciation of figurative elements reminiscent of a letter, it should be noted that the relevant public will tend to read these figurative elements only when they are linked to or form part of a word known to the relevant public, such as in the following examples:


Earlier sign	Contested sign	Case No
OLI SONE		B 1 269 549
ROCK		T-146/08

In the following case, however, the figurative element will not be recognised and read as 'X' and the contested sign read as 'be light':


Earlier sign	Contested sign	Case No
BECKs		T-172/12

Finally, while words, letters and numbers must always be assessed phonetically, some symbols and abbreviations give rise to uncertainty.

For example, the logogram '&' (ampersand) will generally be read and pronounced and, therefore, should be included in the phonetic comparison. However, the pronunciation of a given symbol may differ where different languages are concerned.

Earlier sign	Contested sign	Case No
	DNG	R 160/2010-2 The ampersand '&' will be pronounced in most European Union languages and is recognised as the corresponding translation of the conjunction 'and'.

The same goes for the typographic character '@', which in principle will be pronounced. Obviously, the pronunciation of a given symbol may differ where different languages are concerned.

Earlier sign	Contested sign	Case No
	VODAFONE AT HOME	R 138/2010-2 @ will be pronounced as 'at' or 'arobase' in the Benelux (para. 21).




In the above case, it cannot be denied that a part of the relevant public — in particular English speakers — would read the 'at' symbol and thus pronounce the trade mark as 'at home'. This possibility must, therefore, be taken into consideration, together with other possibilities such as 'a home' or simply 'home'. Naturally, in other languages the symbol may be read in a different way (for example 'arroba' in Spanish and Portuguese).

However, compare this with:

Earlier sign	Contested sign	Case No
<i>FERCREDIT</i>	<i>f@ir Credit</i>	R 719/2010-1 (T-220/11 dismissed, C-524/12 P dismissed) The @ will be perceived as the letter 'a' by (at least) the EN public (para. 25).


The plus (+) and minus/hyphen (-) symbols may also be pronounced by the relevant public, depending on the circumstances. The minus symbol may be pronounced when used in combination with a number, for example '-1', but it will not be pronounced if used as a hyphen (as in 'G-Star').


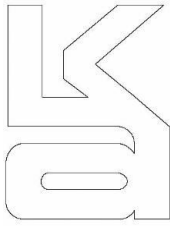



In the following examples, the symbol '+' in the contested EUTM application would be pronounced as 'plus':

Earlier sign	Contested sign	Case No
AirPlus International		T-321/07 (C-216/10 P dismissed)
		T-400/06

Currency symbols (€, \$, £, etc.), too, may be pronounced when the relevant mark is pronounced. As an example (fictional), in the United Kingdom the sign '£ 20' would be pronounced as '20 pounds'. Therefore, the signs '£ 20', '20 pounds' and 'twenty pounds' are phonetically identical.

However, sometimes the way in which symbols — or letters — are used makes it unrealistic to assume that they will be read and pronounced, for example, when in a figurative mark a symbol is repeated in order to create a pattern or is highly distorted or otherwise not clearly legible. This is illustrated by the following examples:

Mark	Explanation
	T-593/10 In this figurative mark, the letter 'B' can be read. The mark must, therefore, be assessed phonetically.

Mark	Explanation
	<p style="text-align: center;">T-593/10</p> <p>In this figurative mark the letter 'B' is so highly distorted that the Court found that for part of the public it is difficult to clearly identify if it is indeed the letter 'b' or the figure '8'.</p>
	<p style="text-align: center;">R 1779/2010-4</p> <p>It is very difficult to determine the pronunciation of the sign. An aural comparison may, therefore, lead to very different results, ranging from identity to dissimilarity.</p>
	<p style="text-align: center;">B 1 127 416</p> <p>In this figurative mark the letter 'H' can be read and, therefore, must be assessed phonetically.</p>
	<p style="text-align: center;">B 1 127 416</p> <p>In this sign, the pattern makes it unlikely that consumers will read an 'H' (or rather several 'H's). This mark cannot be assessed phonetically.</p>
	<p style="text-align: center;">T-282/12</p> <p>The Court held that, although hardly legible at first sight, the words 'FREE' and 'STYLE' in both of the signs are pronounced identically regardless of the language of the public.</p>

In summary, whether or not a given symbol/letter is pronounceable depends on the type of character in question, how it is depicted, and how it is combined with other elements of the sign.

3.4.2.2 Identical/similar sounds in different order

Where the opposing trade marks are formed of syllables or words that are identical or highly similar but in a different order, so that if just one of the syllables or words were rearranged the signs would be identical or highly similar phonetically, the conclusion should be that the signs are phonetically similar.

For example:

Earlier sign	Contested sign	Case No (level of similarity)
VITS4KIDS	Kids Vits	T-484/08 (C-84/10 P dismissed) (significant similarity)
		T-67/08 (high)

3.4.2.3 Signs consisting of or including foreign or invented words

When a sign contains foreign words, it should be assumed, in principle, that the relevant public is unfamiliar with how foreign native speakers pronounce their own language. Accordingly, the public will tend to pronounce a foreign word in accordance with the phonetic rules of their own language.

Earlier sign	Contested sign	Case No
LIDL	LIFEL	R 410/2010-1 The first two letters and the last one are the same in both marks. Aurally, the similarity is even stronger because LIDL will often be pronounced as if spelt LIDEL. For phonological reasons, 'D' and 'L' are nearly impossible to pronounce in most languages without inserting a vowel between them. Therefore, the marks would be pronounced LIFEL and LIDEL in languages like Spanish, Italian, German and French.
KAN-OPHTAL PAN-OPHTAL	BAÑOFTAL	T-346/09 The relevant territory is Germany. The Court found a phonetic similarity. The German consumer will probably pronounce the letters 'N' and 'Ñ' in the same way. Moreover, the letters 'P' and 'B' are pronounced with both lips and their sound can be confused if they are accompanied by the same vowel; the signs PAN-OPHTAL and BAÑOFTAL are aurally very similar.
GLANZ	GLÄNSA	T-88/10 The GC concluded that the umlaut would not alter the overall phonetic impression for EN, FR and ES speakers, since the languages in question do not have the letter 'ä' (para. 40).

However, this will not be the case when the relevant public is familiar with a word, for example in the following scenarios.

- When it is an established fact that a foreign language is known by the relevant public. For example, the Court has already confirmed that there is at least a basic understanding of the English language by the general public in the Scandinavian countries, the Netherlands and Finland (judgment of 26/11/2008, T-435/07, New Look, EU:T:2008:534, § 23).
- When certain terminology is clearly known by the relevant public for certain classes of goods and/or services. For example, IT professionals and scientists are generally considered to be more familiar with the use of technical and basic


English vocabulary than the average consumer, irrespective of territory (judgments of 27/11/2007, T-434/05, Activy Media Gateway, EU:T:2007:359, § 38, 48 for the IT field (C-57/08 P dismissed); 09/03/2012, T-207/11, Isense, EU:T:2012:121, § 21-22 for German professionals in the medical field).

- When very basic words will be understood in all Member States, such as the English words ‘baby’, ‘love’, ‘one’, ‘surf’, the Italian word ‘pizza’, which has also entered the English language, etc.

Earlier mark	Contested sign	Case No
Babylove Baby Love		R 883/2010-2

- Finally, when any one of the parties provides compelling evidence that a word is known by a significant portion of the relevant public.

Where a significant part of the relevant public pronounces the foreign word correctly, but another significant part applies the rules of their mother tongue, any assessment of phonetic similarity should mention both pronunciations and provide reasoning. For example:

Earlier sign	Contested sign	Case No
WRITE	RIGHT	(example only) English: highly similar aurally Spanish: dissimilar aurally
	ZIRH	T-355/02 (appeal C-206/04 P dismissed.) Similar in English-speaking countries and Spain.

As regards **invented or fanciful words** (words that do not correspond to any existing word in the EU), the relevant consumer might pronounce them not only as they would sound according to the rules of pronunciation of their mother tongue but also as they are written.

Earlier sign	Contested sign	Case No
BAMIX	KMIX	T-444/10 The GC noted that the word element ‘kmix’ does not correspond to any existing word in the European Union and that it may be pronounced by part of the relevant public as it is written, as a single syllable. However, it also considered it possible that the mark applied for would be pronounced as a two-syllable word, namely ‘ka’ and ‘mix’. In certain languages of the European Union (in particular French and German), the letter ‘k’ is pronounced as ‘ka’ and the pronunciation ‘km’ is not usual (para. 32).

3.4.2.4 Single letter signs

Marks consisting of a single letter can be compared phonetically. The following marks are phonetically identical insofar as they both reproduce the letter 'A':

Earlier mark	Contested sign	Case No
		T-115/02

3.4.3 Conceptual comparison: practical criteria

Two signs are identical or similar conceptually when they are perceived as having the same or analogous semantic content (judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24). The 'semantic content' of a mark is what it means, what it evokes or, when it is an image or shape, what it represents. In this text the expressions 'semantic content' and 'concept' will be used indiscriminately.

If a mark consists of various elements (for example, a word and a figurative element) the concept of each of the elements must be defined. However, if the mark is a meaningful expression (made up of two or more words), what matters is the meaning of the expression as a whole and not of each of the words in isolation.

Not every concept has to be defined: only those concepts likely to be known by the relevant public, as defined by the relevant territory, matter. For example, if the relevant territory is Spain, the fact that the word has a meaning in Polish is normally irrelevant.

As a rule, the conceptual comparison is not influenced by the relevant goods and services. However, if a term has many meanings, one of which is of particular significance to the relevant goods and services, the conceptual comparison may focus on this meaning. In any event, what matters is how the term is perceived by the relevant public. A link between the goods and services and what the sign means, evokes or represents must not be forced or artificially constructed. For example, if the relevant goods relate to *lighting* and the sign is or contains the element 'LED', 'light-emitting diode' is one of the various possible meanings of 'LED'. Therefore, the conceptual comparison may focus on this meaning.

3.4.3.1 The semantic content of words

When the mark consists of or contains a word, the first step for an examiner is to look up the explanation of that word in dictionaries and/or encyclopaedias in the language(s) of the relevant territory. If the word is in the dictionary/encyclopaedia, the described meaning will be its semantic content.

As a starting point, it should be noted that the relevant public in the various Member States of the EU mainly speak the languages predominant in their respective territories (judgment of 23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 27). These languages are normally the official languages of the relevant territory.

Earlier mark	Contested sign	Case No
HALLOUMI	HELLIM	T-534/10
<p>'Hellim' is the Turkish translation of 'Halloumi' (Greek) (a type of cheese). The relevant territory was Cyprus. The Court held that while Turkish is not an official language of the EU, it is one of the official languages of the Republic of Cyprus. Therefore, Turkish is understood and spoken by part of the population of Cyprus (para. 38). Therefore, the Court found that the average consumer in Cyprus, where both Greek and Turkish are official languages, will understand that the words HALLOUMI or HELLIM both refer to the same specialty cheese from Cyprus. Consequently, there is some conceptual similarity between these words (para. 41).</p>		




However, the Court has made equally clear that this rule only concerns the primary linguistic understanding of the public in those territories. This is not an inflexible rule. The relevant public should not automatically be considered as having as its mother tongue the language that is predominant in the Member State concerned, or to have no particular knowledge of other languages (order of 03/062009, C-394/08 P, Zipcar, EU:C:2009:334, § 51).

For instance, in the following scenarios, languages other than the predominant one are to be taken into account.

- When the word in another language is very close to the equivalent word in the official language of the relevant territory. For example, the English word 'bicycle' will be understood in Spain because it is very close to the Spanish equivalent word, 'bicicleta'.
- When the word in a foreign language is commonly used in the relevant territory. For example, the Spanish word 'bravo' is commonly used as a term denoting praise, in the sense of 'well done' in Germany.
- When it is known that the relevant public is familiar with a foreign language. For example, the Court has already confirmed that the general public, in the Scandinavian countries, the Netherlands and Finland, has at least a basic understanding of the English language (judgment of 26/11/2008, T-435/07, New Look, EU:T:2008:534, § 23).
- When it is known that the relevant public is familiar with a certain language for certain classes of goods and/or services. For example, English IT terms are normally understood by the relevant public for IT goods, irrespective of territory.
- Very basic words, which will be understood in all Member States because they have become internationally used, such as 'baby', 'love', 'one', 'surf', the Italian word 'pizza', which has also entered the English language, etc.
- Finally, when any one of the parties provides evidence that a word is known by a relevant portion of the relevant public.

The following are **examples** of concepts behind words:

Mark	Territory	Concept	Case No
Mirto	ES	[in EN: myrtle] in Spanish describes a shrub of the family <i>Myrtaceae</i> , two to three metres high.	T-427/07
Peer	EN	Lord	T-30/09

Storm	EN	Bad weather	T-30/09
 --- STAR SNACKS	EU	The terms 'star snacks' and 'star foods' will be understood as referring to quality food not only by English speakers, but also by most of the relevant public.	T-492/08 (Star foods I) T-333/11 (Star Foods II)
 - 	EU	There is some degree of conceptual similarity, based on 'Mc' and the words 'baby' and 'kids' that both refer to children (para. 42).	T-466/09

As shown in some of the examples above, it is not always necessary to give a complete dictionary definition of what a word means. It is sufficient to use a synonym, such as Peer=Lord or Storm=Bad weather.

Additionally, when part of the public will perceive the concept while another part either will not or will perceive a different meaning, a distinction should be made accordingly.

When the mark conveys a **meaningful expression**, the meaning of the expression as a whole, as long as it is understood as such by the relevant public, and not that of the individual words, is the one that is relevant for the conceptual comparison (however, note the exception below concerning expressions in foreign languages). Fictional example: 'KING'S DOMAIN' v 'KING SIZE'.

Incorrect assessment: 'KING' means 'a male sovereign', 'DOMAIN' means 'a territory over which rule or control is exercised' and 'SIZE' means 'the physical dimensions, proportions, magnitude, or extent of an object'. The marks are conceptually similar insofar as they share the notion of 'king'.

Correct assessment: 'KING'S DOMAIN' means 'a territory under the control of a king'; 'KING SIZE' means 'larger or longer than the usual or standard size'. The marks are conceptually dissimilar even though they share the word 'KING'.

This is illustrated by the following examples where the marks were found to be conceptually dissimilar:

Earlier sign	Contested sign	Case No
MOUNTAIN BIKER	MOUNTAIN	B 1 950
Goldband	GoldGips	R 975/2009-4
ALTA FIDELIDAD	ALTA	B 112 369

The abovementioned rule on meaningful expression has the following **exception**: when signs are in a foreign language, a significant part of the relevant public may have only a limited command of the relevant foreign language and, therefore, might not be able to distinguish the difference in meaning between two expressions. In these instances it

may be that the meaning of an expression as such is not perceived; only the meanings of the individual elements. This may, therefore, lead to a finding of similarity insofar as the public understands only the common part. In the example above, if it is found that (part of the) public will understand only KING, the finding should be that the signs are conceptually similar.

Earlier mark	Contested sign	Case No
ICEBERG	ICEBREAKER	T-112/09
<p>The GC considered that 'icebreaker' would be understood only by that part of the Italian public with command of the English language. However, 'iceberg' is a common word with an immediately obvious meaning to the relevant public. Therefore the earlier mark ICEBERG will have a clear meaning for the Italian public, whereas the mark applied for ICEBREAKER would be devoid of any clear meaning for that public.</p> <p>The GC further indicated that the marks at issue have the prefix 'ice' in common. The GC considered that this is a basic English word, understandable for most of the relevant public. It concluded that since the prefix 'ice' had a certain evocative force, it must be regarded as limiting the conceptual difference between the marks at issue, acting as a 'semantic bridge' (paras 41-42).</p>		

Similar considerations apply to expressions that include a combination of technical words understood by only part of the relevant public (e.g. Latin words, words belonging to highly specialised language) and commonly used words. In these cases, it may be that only the meaning of the commonly used words is perceived, and not the meaning of the expression as such.

3.4.3.2 The semantic content of parts of words


In this regard, the Court has held that, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, they will break it down into elements which, for them, suggest a specific meaning or which resemble words known to them (judgment of 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 57).

Consequently, while the rule is that marks are perceived as a whole, the exception to the rule is that, under certain circumstances, consumers could break them down into smaller parts. Since this is an exception, it has to be applied restrictively.

It will be applied in the following cases:

- when the sign itself is broken down visually into various parts (e.g. through the use of [a special character, hyphen or other punctuation mark](#)); **however, it must be noted that word marks must not be dissected based on the presence of a combination of cases, since the use of lower and upper case letters, ~~as in AirPlus~~; is irrelevant;**
- when all the parts suggest a concrete meaning known to the relevant public (e.g. Ecoblue); or
- when only one part has a clear meaning (e.g. Dermaclin).


Examples of signs visually broken down:

Sign	Territory	Concept	Case No
VITS4KIDS	EU	The mark contains VITS (allusive of 'vitamins') and KIDS.	T-484/08
	EU	AGRO: reference to agriculture HUN: reference to Hungary UNI: reference to universal or union.	T-423/08
RNAiFect	EU	The relevant public, particularly the specialist public, will perceive the first three letters as a reference to the English abbreviation for ribonucleic acid.	T-80/08
nfon	EU	The relevant public will isolate the syllable 'fon' in the sign 'nfon', and perceive this term as relating equally to the words 'telephone' or 'phone.' (para. 60).	T-283/11 (C-193/13 P dismissed)

Examples of cases that are not broken down visually but where all the parts suggest a concrete meaning known to the relevant public:

Sign	Territory	Concept	Case
Ecoblue	EU	The word element 'eco' is a common prefix or abbreviation in many languages spoken in the European Union, while the word 'blue' is English for the colour blue and part of the basic English vocabulary known to the relevant public.	T-281/07 (C-23/09 P dismissed)
Solfrutta/ FRUTISOL	EU	The elements 'sol' and 'frut' are generally recognisable and can be understood as alluding to 'sun' and 'fruit' respectively.	T-331/08
RIOJAVINA	EU	The term 'riojavina' in the mark applied for refers directly, so far as the relevant public is concerned, to grapevine products and, more particularly, Rioja wine.	T-138/09 (C-388/10 P rejected)

Finally, cases where only one part has a clear meaning are usually ones where there is a common prefix or suffix, for example:

Sign	Territory	Concept	Case
	DE	'DERMA' may be perceived as referring to goods of a dermatological nature.	B 1 249 467
RNAiFect	EU	The relevant public, particularly the specialist public, will perceive the first three letters as a reference to the English abbreviation for ribonucleic acid.	T-80/08
nfon	EU	The relevant public will isolate the syllable 'fon' in the sign 'nfon', and perceive this term as relating equally to the words 'telephone' or 'phone.' (para. 60).	T-283/11 (C-193/13 P dismissed)

As explained above, all three exceptions have to be construed narrowly; therefore, where it is not obvious that a part or parts suggest(s) a concrete meaning known to the





relevant public, examiners should refrain from looking for these meanings *ex officio*. In the examples below, no concept was found in the signs:


Sign	Territory	Concept	Case
ATOZ	DE, ES, FR, IT, AT	The TM will not be perceived as 'from A to Z'. The letters 'to' (corresponding to an English preposition) do not stand out in any way from the letters 'a' and 'z'.	T-100/06 (C-559/08 P dismissed)
SpagO	BX	The word 'SpagO' is an invented word that has no meaning in any of the official languages of Benelux countries. It should not be perceived as a combination formed by SPA + GO.	T-438/07
CITRACAL --- CICATRAL	ES	The word elements 'cica' and 'citra' do not have any concrete meaning, any more than the endings 'tral' and 'cal'. The signs at issue are, therefore, not likely to be broken down by the public into word elements that have a concrete meaning or resemble words known to it and that, together, would form a coherent whole giving a meaning to each of the signs at issue or to any one of them.	T-277/08

3.4.3.3 The semantic content of misspelled words

It is not necessary for a word to be written properly for its semantic content to be perceived by the relevant public. For example, while the written word 'XTRA' is visually not the same as the 'correct' word 'EXTRA', because it is aurally identical to it, the concept of the 'correct' word (extra) will normally be transferred to the misspelled word (xtra).

The following examples illustrate this point:

Sign	Territory	Concept	Case
	EU	Part of the relevant public will regard it as a reference to the English word 'store', meaning 'shop, storage'.	T-309/08
CMORE	EN	CMORE will, in view of the common practice of sending text messages, probably be associated by a significant part of the general public in Denmark and Finland with an abbreviation or misspelling of the verb 'to see' in English, with the concept being perceived as 'see more'.	T-501/08 'SEE MORE/CMORE'
	EN	The word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public.	T-488/07
	EU	The term contained in the mark will bring to consumers' minds the idea of 'yogurt', i.e. 'a semi-solid, slightly sour, food prepared from milk fermented by added bacteria'.	B 1 142 688
	ES	The words 'KARISMA' and 'C@RISMA' refer to 'charisma' or 'charism', i.e. a special personal quality or power of an individual, making him/her capable of influencing or inspiring large	B 1 012 857

Sign	Territory	Concept	Case
		numbers of people.	

Examiners should take care when attaching meaning to a misspelled word: the meaning is not likely to be transferable when the words are not (aurally) identical and/or when the misspelled element cannot be perceived independently:

Mark	Territory	Concept	Case
Bebimil	EU	The mark applied for does not contain the word 'baby' but a fanciful word, which is further removed and without any clear and specific meaning, i.e. 'bebi'.	T-221/06

3.4.3.4 The semantic content of names and surnames

The General Court has accepted that names have a concept. Therefore, a conceptual comparison must be made when conflicting signs are composed of names (see examples below).

Nevertheless, there are few situations where the fact that a trade mark contains a family name has conceptual significance. In particular, conceptual similarity cannot result from the mere fact that both trade marks contain a name, even the same kind of name (Celtic family name, Dutch name, etc.).

Mark	Territory	Concept	Case No
MCKENZIE/ McKINLEY	EU	The relevant public recognises the prefix 'Mc', signifying 'son of', as a prefix to many Scottish or Irish family names. That public will, therefore, regard the word elements of the marks at issue as Celtic family names of no conceptual significance, unless the name is particularly well known as that of a famous person.	T-502/07
VANGRACK/ VAN GRAF	DE	The fact that both marks may be perceived as lower German or Dutch surnames is on its own neutral for comparison purposes.	R 1429/2010-4

The mere fact that two names can be grouped under a common generic term of 'names' does not constitute conceptual similarity. For example, if FRANK and MIKE are compared: the fact that both are names would not lead to a finding of conceptual similarity; this is because the public is not likely to make the conceptual link between the two words. By contrast, the fact that FRANK and FRANKIE are the same name but the latter is the diminutive of the former is relevant and should lead to a finding of conceptual similarity.


Marks	Territory	Concept	Case No
SILVIAN HEACH (FIG.)/ H. EICH	Italy and other territories	Whereas 'HEACH' would be perceived as a surname of Anglo-Saxon origin, the element 'EICH' would be perceived as a surname of German origin (para. 66). In view of this, the consumers would realise that these surnames distinguish different persons. The signs are conceptually different (para. 69).	T-557/10

The fact that a trade mark contains a name may have an impact on conceptual comparison in the following situations:

- (a) When it is the name/surname of a well-known person (CERVANTES, MARCO POLO, PICASSO):

Mark	Territory	Concept	Case No
PICASSO	EU	The word sign PICASSO has a clear and specific semantic content for the relevant public. The reputation of the painter Pablo Picasso is such that it is not plausible to consider, in the absence of specific evidence to the contrary, that the sign PICASSO as a mark for motor vehicles would, in the perception of the average consumer, override the name of the painter.	T-185/02 (C-361/04 P dismissed)

- (b) Where the two marks represent the same name but in different versions (FRANK, with FRANKIE as a diminutive) or languages, such as in the following examples:

Marks	Territory	Concept	Case No
 --- ELISE	EU	The relevant public is certain to regard these as highly similar female names derived from the same root. In certain Member States, notably the United Kingdom, Ireland, Germany and Austria, they will certainly be perceived by the relevant public as diminutives of the full forename Elizabeth.	T-130/09
PEPEQUILLO/PE PE	ES	The Spanish public will understand 'Pepequillo' as a diminutive of 'Pepe', leading to conceptual identity.	T-580/08
JAMES JONES/JACK JONES	EU	Both trade marks may be understood as referring to the same person.	T-11/09

- (c) When both trade marks can be understood as referring to the same person, especially when the earlier trade mark is composed solely of a family name. This could be the case when one name is more important than the other:

Mark	Territory	Concept	Case No
EUTM application: Julián Murúa Entrena Earlier mark: MURUA,	ES	The EUTM application contains a Spanish name (a forename and two surnames). The first surname, which for the Spanish public is the more important one, coincides with the earlier TM.	T-40/03
EUTM application: MANSO DE VELASCO	ES	Velasco is a Spanish surname. The EUTM application can be understood as being composed of two surnames.	T-259/06




Earlier mark: VELASCO			
EUTM application: Antonio Basile Earlier mark: BASILE	IT	The signs are conceptually similar in that they share the same surname (para. 60).	T-133/09 and T-134/09

- (d) If the name contained in the trade marks is meaningful in some language, the coincidence in this meaning may lead to conceptual similarity:


Mark	Territory	Concept	Case No
peerstorm/PETER STORM	EU, UK	English-speaking consumers will associate the surname Storm with bad weather (para. 67).	T-30/09



3.4.3.5 The semantic content of figurative signs, symbols, shapes and colours

The concepts of marks consisting of or containing figurative elements and marks consisting of shapes (three-dimensional marks) will be what those figurative elements or shapes represent, such as in the following examples:

Mark	Territory	Concept	Case No
	BX, DE, ES, FR, IT, AT, PT	The representation of a red mug on a bed of coffee beans.	T-5/08 to T-7/08
	DE	Part of the relevant public may recognise a peacock.	T-361/08
	BX	The contested trade mark will be described as a businessman playing football.	R 403/2009-2

Consequently, when a mark has both words and images, all concepts have to be assessed.


Mark	Territory	Concepts	Case No
	EN	The word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public. A bulldog with a citrus fruit in front of it.	T-488/07

	EU	The term 'Rioja' in the earlier mark, which is itself conceptually strengthened by the representation of a bunch of grapes and a vine leaf, refers directly to grapevine products and, more particularly, to Rioja wine.	T-138/09 (C-388/10 P rejected)
	BL, BX, CY, DE, ES, FR, HU, RO, SK, IT	The mark depicts a type of fish (a shark). The majority of the relevant language speakers will understand the term SPAIN in the contested mark as referring to that country. The word 'Tiburón' means 'shark' in Spanish but will not be understood by the rest of the relevant public. The remaining term, SHARK, will probably be understood by English-speaking consumers in the relevant territories.	B 1 220 724

Finally, the semantic content (concept) of colour marks *per se* is that of the colour they reproduce.


3.4.3.6 The semantic content of numbers and letters

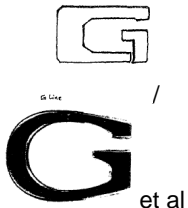
The concept of a word representing a number is the figure it identifies, such as in the example below:

Mark	Territory	Meaning	Case No
	DE	The word zero evokes the cardinal number 0.	T-400/06
TV2000 (fig.)/TV1000	LT	The signs are conceptually similar to the extent that they both share the idea of 'television' combined with a round four-digit number, that furthermore correlate in the order of thousands (para. 47).	R 2407/2011-2
7 (fig.)/7 (fig.)	EU	The BoA found that '7' had a meaning (para. 25).	R 782/2011-2

The concept of a figure is the number it identifies, unless it suggests another concept such as a specific year.

The Office follows the approach that single letters can have an independent conceptual meaning. The Court has confirmed this approach (judgment of 08/05/2012, T-101/11, G, EU:T:2012:223, § 56, appealed as C-341/12 P, G, EU:C:2013:206), finding conceptual identity where both trade marks can be seen as the same letter:


Mark	Territory	Meaning	Case No
	DE	For the part of the relevant public that interprets the signs as the letter 'e' and the part of the relevant public that interprets them as the letter 'c', the signs are conceptually identical (para. 99).	T-22/10 EU:T:2011:651

	EU	The signs were considered conceptually identical (paras 60-61).	T-187/10
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3.4.3.7 The semantic content of geographical names

The names of cities, villages, regions and other geographic areas evoke a concept that may be relevant for conceptual comparison if it is likely that the relevant public will recognise them as such. Usually, the general public in Europe is familiar with the names of capitals and bigger cities as well as holiday or travel destinations. If the perception of the public in a particular Member State is relevant, knowledge of the names of small cities and towns in that country can also be assumed.

A lack of evidence or indication that the relevant public recognises the geographical name does not influence the conceptual comparison. See the following example:

Mark	Territory	Concept	Case No
	DE	The result of conceptual comparison is neutral. It is not possible to infer from the appellant's argument that the name Chtaura designates an agricultural area in Lebanon renowned for its agricultural products that this meaning will also be familiar to trade circles in Germany.	R 1213/2008-4

3.4.3.8 The semantic content of onomatopoeias

The analysis of the semantic content of onomatopoeias follows the general rules for conceptual comparison: their concept will be that depicted by the onomatopoeia in question, provided it can be established that it will be recognised as such by the relevant public. For instance, 'WOOF WOOF' represents the bark of a dog for English speakers; 'MUUU' represents the mooing of a cow for Spanish speakers.

Mark	Territory	Concept	Case No
CLICK	DE	Conceptually, the contested mark 'CLICK' is an English onomatopoeia that expresses a short, sharp sound. This word will be readily understood in Germany given its close equivalent in German, 'Klick' (para. 45).	R 1394/2006-2

In some cases, the context in which the onomatopoeia will be used can be decisive for establishing whether the relevant public will recognise its meaning. For instance, in the following case, the Board considered that the relevant public would not interpret the sign 'PSS' as onomatopoeia in the context of information technology services:

Mark	Territory	Concept	Case No
PSS	ES	The applicant's argument that the earlier mark could also be pronounced as an onomatopoeia	R 1433/2007-2

		[prompting another to be quiet] is far-fetched in view of the relevant information technology services at issue and the relevant public, who is accustomed, as noted by the applicant itself, to acronyms in this field (para. 42).	
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3.4.4 How to make a conceptual comparison

In essence, when making a conceptual comparison, ~~the examiner has it~~ first has to ~~determine~~ be determined if the signs have a concept in accordance with the principles described in the previous paragraph.

~~If none of the signs have any concept, the outcome will be that a conceptual comparison is not possible.~~

~~If only one of the signs evokes a concept, the outcome will be that the signs are not conceptually similar.~~

When (i) _____ If both signs have a concept, the ~~concept(s) will be compared~~ conceptual comparison can lead to ~~establish whether~~ three possible outcomes:

- if the signs are conceptually identical or similar (i.e. they refer to the same or similar concepts) or dissimilar (i.e. concept, they are conceptually identical);

- if the signs refer to similar concepts, they are conceptually similar;

The

- if both signs have a meaning and those refer to different concepts, they are conceptually dissimilar/not similar. [EN 7 — 8]

(ii) If only one of the signs evokes a concept, the signs are not conceptually similar.

On this point, the Office follows the judgment of 12/01/2006, C-361/04 P, Picaro, EU:C:2006:25. Although there are two words for is some case-law, such as the judgment of 22/10/2015, T-309/13, ELMA / ELMEX, EU:T:2015:792, which came to the conclusion that 'it was not possible to make a conceptual comparison', even though only one of the signs evoked a concept, these cases cannot be considered as a prevailing trend.

It follows that the term 'not similar' encompasses two scenarios, namely, when both signs have a concept albeit distinct or when only one of them has a concept. However, the term 'dissimilar' is reserved only for the case where both signs have a concept albeit distinct.

(iii) If none of the signs has any concept, a conceptual comparison is not possible (judgment of 13/05/2015, T-169/14, Koragel / CHORAGON, EU:T:2015:280, § 68-69). The conceptual aspect does not influence the assessment of the similarity of the signs.

The signs cannot be considered conceptually similar on the sole ground that a generic term covering both of them exists and/or they fall under the same general category of




signs. If the semantic meanings are too different, the signs may share a general concept, but one so broad that the conceptual relationship is not relevant. ~~In these cases no conceptual similarity will be found.~~ For example:



- The mere fact that the two words or symbols can be **grouped under a common generic term** by no means constitutes a case of conceptual similarity. For example, in the case of ‘Jaguar’ v ‘Elephant’, the fact that both are animals would not lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words. In fact, because the words refer to different animals, they should be considered conceptually dissimilar.
- The same happens when two signs belong to the **same general category or type of mark or word**: the fact that ‘~~TDL~~TDL’ and ‘LNF’ are both three-letter abbreviations is conceptually irrelevant. ~~The signs should be considered conceptually dissimilar and therefore, a conceptual comparison is not possible.~~
- Another example of signs ‘belonging to the same category’ concerns **names** and surnames that have a similar semantic content (see paragraph 3.4.3.4 above). If FRANK and MIKE are compared, the fact that they are both names is conceptually irrelevant (since they are on completely different levels); by contrast, the fact that FRANK and FRANKIE are the same name but the latter is the diminutive of the former is relevant and should lead to a finding of conceptual similarity in that case.

In particular, the marks will be conceptually identical or similar in the following situations.







3.4.4.1 Both marks share a word and/or expression

When the two marks share the same word or expression, the marks will be conceptually similar, as in the following examples:

Earlier sign	Contested sign	Opposition No
		B 1 209 618 (ES)
Similar: the marks share the concept of SOL (= sun: ‘the star that is the source of light and heat for the planets in the solar system’).		
Earlier sign	Contested sign	Case No
BLUE	ECOBUE	T-281/07 (C-23/09 P dismissed) (EU)
The marks at issue are conceptually similar because they both refer to the colour blue.		
Earlier sign	Contested sign	Opposition No
T-MUSIC		B 1 081 167 (EU)
The marks above are conceptually similar because both refer to the concept of MUSIC (= ‘the art of arranging sounds in time so as to produce a continuous, unified, and evocative composition, as through melody, harmony, rhythm, and timbre’).		

Earlier sign	Contested sign	Opposition No
		B 1 220 724 (BL, BX, CY, CZ, DE, ES, FR, HU, RO, SK and IT)
The marks above are conceptually similar because both signs have an image of the same fish (a shark) and a reference to the word SHARK (= 'any of numerous chiefly marine carnivorous fishes of the class <i>Chondrichthyes</i> (subclass <i>Elasmobranchii</i>) ...').		
Earlier sign	Contested sign	Case No
EL CASTILLO	CASTILLO	T-85/02 (ES)
The Court found that the signs were almost identical conceptually.		
Earlier sign	Contested sign	Case No
Servus et al.	SERVO SUO	T-525/10 (EU, IT in particular)
The signs are conceptually similar from the point of view of the average Italian consumer insofar as both signs share a reference to 'servant'. The Court confirmed the BoA finding that the Italian public was likely to perceive the meaning of the Latin word 'SERVUS', given its proximity to the Italian word 'SERVO'.		

As already mentioned, misspellings may also have a semantic content and in such cases can be compared, as in the following examples:

Earlier mark	Contested sign	Case No
		T-485/07 (ES)
For the relevant Spanish public both signs invoke the concept of an olive. There is no evidence that the relevant Spanish consumer will understand the English word 'live'.		
Earlier sign	Contested sign	Opposition No
		B 1 142 688 (EU)
Both marks refer to the word yogurt and consequently share the concept of 'a dairy product produced by bacterial fermentation of milk'.		
Earlier sign	Contested sign	Opposition No
		B 1 012 857 (ES)

The above marks are conceptually similar because they both refer to the concept of ‘charisma’ (= ‘the ability to develop or inspire in others an ideological commitment to a particular point of view’).


3.4.4.2 Two words or terms have the same meaning but in different languages

It is possible for the relevant public to assign a conceptual similarity or even identity in cases of marks with elements in different languages, as long as the meanings of the words in those languages are known to that public.

In the following example, it was found that the marks were conceptually identical because a substantial part of the Portuguese public would understand the words constituting the marks at issue given (i) the close proximity of the English word ‘vitamin’ to the Portuguese equivalent term ‘vitamina’, (ii) ‘water’ is a basic English word likely to be understood by that part of the Portuguese public that has sufficient knowledge of the English language (iii) that ‘aqua’ is a widespread Latin expression and resembles the Portuguese equivalent term ‘água’ (paras 56-60):

Earlier mark	Contested sign	Case No
VITAMINWATER (relevant territory Portugal)		T-410/12

As it is the actual understanding of the relevant public that matters, the mere fact that one term is objectively the foreign-language equivalent of the other may not be relevant at all in the conceptual comparison.


Earlier mark	Contested sign	Case No
	LE LANCIER	T-265/09

The relevant territory is Spain. ‘El lancero’ (in Spanish) means ‘le lancier’ in French. Conceptually, the GC concluded that the average Spaniard only had a limited knowledge of French and that the expression ‘le lancier’ did not belong to the basic vocabulary of that language. Conceptually, the signs are not similar.

3.4.4.3 Two words refer to the same semantic term or variations thereof

There is conceptual identity where synonyms are involved, that is to say where two words exist for the same semantic meaning (invented examples where English is the reference language: baggage/luggage; bicycle/bike; male horse/stallion).


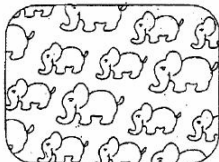




Conceptual similarity was found in the following cases:

Earlier mark	Contested mark	Case No
SECRET PLEASURES	PRIVATE PLEASURES	R 616/1999-1
	ORPHAN INTERNATIONAL	R 1142/2009-2



3.4.4.4 Two figurative signs, symbols and/or shapes represent the same object or idea

When two marks consist of or contain figurative elements and/or shapes and they represent the same or similar objects or ideas, the signs will be conceptually identical or similar.



The following are cases where conceptual identity or similarity was found:

Earlier mark	Contested mark	Case No
		T-424/10 (identity)
		R 703/2011-2 (identity)
		R 1107/2010-2 (identity)

However, the fact that both signs contain the same object does not lead to a finding of conceptual similarity if the way in which the object is depicted in the conflicting trade marks is different.



Earlier mark	Contested mark	Case No
		T-593/10
<p>The GC considered that the Board was right in finding that the signs are conceptually different given that the earlier mark, due to its figurative element and the way in which the letter 'b' is depicted, could evoke a boomerang whereas this is not the case for the mark applied for (para. 36).</p>		

Furthermore, even if both signs contain the same element, they may be found **dissimilar** if they evoke different concepts due to their overall impression:

Earlier mark	Contested mark	Case No
		T-143/11
<p>The mark applied for resembles an armorial emblem recalling the distinctive symbol associated with nobility or guilds used to identify people or professions, whereas the earlier marks are more akin to a seal indicating the mark of a sovereign authority such as that of the State and are designed to certify, or even seal, a particular object. (para. 48).</p>		

3.4.4.5 When there is a word v a figurative sign, symbol, shape and/or colour representing the concept behind the word

Conceptual identity also exists between a word and an image showing what the word represents (fictional examples: word mark 'TIGER' compared with a figurative mark depicting a tiger; or word mark 'orange' and a mark for the colour orange per se).

Earlier mark	Contested mark	Case No
		T-389/03 (EU, identity for part of the public that perceives a pelican in the contested mark)

3.4.4.6 When the signs have a meaningful word in common that is distinctive, and one of them contains an additional word or figurative element without any meaning

Where the signs have a meaningful word in common that is distinctive, and one or both of them contains an additional word element without any meaning (a fanciful word or one that will not be understood in the relevant language area), the signs are considered conceptually highly similar, and not identical. In such a case, even if not understood, the relevant public will note the presence of the additional term that prevents the signs from being perceived as conceptually totally identical.

<u>Earlier mark</u>	<u>Contested mark</u>	<u>Case No</u>
<u>VIKING</u>	<u>VIKING PRUX</u>	<u>Invented example</u>
<u>VIKING DREMBL</u>	<u>VIKING PRUX</u>	<u>Invented example</u>
<u>The relevant territory is the European Union. The goods at issue are <i>cosmetics</i> in Class 3. The word 'VIKING' is understood throughout the European Union and is distinctive for the goods at issue. The words 'PRUX' and 'DREMBL' have no meaning. The signs are conceptually highly similar.</u>		

However, where the word that the signs have in common is accompanied by additional figurative elements that lack any particular concept (such as a background, colours or a particular typeface), the signs are considered conceptually identical. In such a case, the additional figurative elements have no impact on the conceptual perception of the signs.

<u>Earlier mark</u>	<u>Contested mark</u>	<u>Case No</u>
<u>VIKING</u> 		<u>Invented example</u>
<u>The relevant territory is the European Union. The goods at issue are <i>cosmetics</i> in Class 3. The word 'VIKING' is understood throughout the European Union and is distinctive for the goods at issue. The additional figurative elements do not introduce any concept capable of altering the conceptual perception of the signs. The signs are conceptually identical.</u>		

3.4.5 Impact of the distinctive and dominant character of the components on the similarity of signs

At each level (visual, phonetic and conceptual) the comparison of signs will lead to a decision as to whether the marks are similar and if so, to what degree. In general, the more commonalities there are between marks, the higher their degree of similarity. However, this finding depends, first, on whether the coincidence is recognisable or rather remains unnoticed in the overall impression of both marks (paragraph 3.4.5.1 below), and furthermore, on the distinctiveness and dominant character of the common elements (paragraph 3.4.5.2 below), and also the impact of the remaining elements in the overall impression of the marks (paragraph 3.4.5.3 below).

3.4.5.1 Identifiable common element/coincidence

Two marks are similar when, from the point of view of the relevant public, they are at least partly identical as regards one or more relevant aspects (judgment of 23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 30). The coincidence must be, therefore, 'relevant' from the perspective of the consumer who usually perceives a mark as a whole and does not proceed to analyse its various details (judgment of 13/02/2008, T-146/06, Aturion, EU:T:2008:33, § 58).

The coincidence is clearly perceived when the commonality forms an independent word element or when it is separated in the way of writing (use of ~~an upper case letter~~, a special character, hyphen or other punctuation mark):

Earlier sign	Contested sign	Reason	Case No
BEYOND VINTAGE	BEYOND RETRO	Coinciding first word	T-170/12
SCHUHPARK	JELLO SCHUHPARK	The earlier TM is identical to the second word of the EUTM application.	T-32/03
ip_law@mbp	MBP	The sign '@' separates the earlier mark in 'ip-law' and 'mbp' (para. 53).	T-338/09

As regards word marks, it should be recalled that they should not be dissected visually based on the alternation of upper case and lower case letters, since in the case of word marks the use of mixed cases is irrelevant.

Sometimes the graphical representation allows the separation of different elements of the mark and identification:

Earlier sign	Contested sign	Reason	Case No
		The letters 'FŁK' have an independent role in the EUTM application due to the red colour (para. 48).	T-19/12
<u>TRONIC</u>		<u>The common element 'TRONIC' is separated visually due to its white letters (para. 28).</u>	<u>R 2060/2013-1</u>

Furthermore, the common word can be identified as such in an isolated manner because of its clear meaning. An average consumer perceiving a word sign will break it down into elements that suggest a concrete meaning or resemble known words (judgment of 06/10/2004, T-356/02, Vitakraft, EU:T:2004:292, § 51, confirmed by C-512/04 P). In the following examples, the common element is a part of a word, but could be identified since the public will logically split the word according to the meaning of its elements:

Earlier sign	Contested sign	Reason	Case No
MARINE BLEU	BLUMARINE	The part 'marine' in the EUTM application will be understood as a reference to the sea and 'blu' as a misspelling of 'blue'.	T-160/12
CADENACOR	COR	The Spanish-speaking public will identify the elements 'cadena' and 'cor' in the earlier TM (para. 47) — likelihood of confusion.	T-214/09

BLUE	ECOBUE	The relevant public will split the EUTM application into the commonly used prefix 'eco' and the word 'blue' (para. 30) — likelihood of confusion.	T-281/07 confirmed by C-23/09 P)
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On the contrary, if it remains unnoticed, the mere coincidence in a string of letters is not enough for a finding of similarity. The rule remains that the public compares the marks as a whole and will not artificially dissect them. In the following cases **the similarity of the marks was denied** despite an overlap in some letters (see also paragraph 4 below, 'Dissimilarity of signs', especially paragraph 4.2.4, 'Overlap in other irrelevant aspects').

Earlier sign	Contested sign	Reason	Case No
AAVA MOBILE	JAVA	The resemblances that result from the presence of the common letters 'ava' are completely offset by the significant differences between those signs (para. 45).	T-554/12
CS	CScreen	The contested sign will probably be broken down into the elements 'C' and 'Screen', which is has a meaning highly relevant for computers and their peripherals. It will not be perceived as containing the separate entity 'CS' corresponding to the earlier mark.	R 545/2009-4

3.4.5.2 Distinctiveness and dominant character of the common elements

For the conclusion of similarity, the **degree of distinctiveness of the common element** (or elements) must be taken into account. The more distinctive the common element is, the higher the degree of similarity in each aspect of the comparison (visual, phonetic and conceptual). A finding that the common element has a limited distinctiveness will lower the similarity, with the consequence that if the only common element of both marks is non-distinctive, the degree of similarity at all levels of comparison will be low or that even — depending on the impact of the elements that differentiate the marks — the similarity will be entirely denied¹⁰.



In the following examples, the common element was considered descriptive or otherwise non-distinctive, with the consequence that the level of similarity was considered low:


Earlier sign	Contested sign	Case No
FSA K-FORCE.	FORCE-X	T-558/13
The element 'force' has a weak distinctive character for the goods concerned. Low visual, phonetic and conceptual similarity — no likelihood of confusion.		

¹⁰ See paragraph 4.2.5 below, Overlap in a non-distinctive element.

Earlier sign	Contested sign	Case No
ACTU+	News+	T-591/13
<p>The presence of the '+' sign in both signs cannot generate a visual similarity as this is a mathematical symbol that implies a concept of increase, so it only enjoys a weak distinctive character (para. 29). The signs share a weak similarity on the phonetic side because of the presence of the '+' sign (paras 35-36) — no likelihood of confusion.</p>		

Earlier sign	Contested sign	Case No
VISCOPLEX	VISCOTECH	T-138/13
<p>As regards the common initial part of the marks 'visco', it is descriptive for the German public with relation to one of the main characteristics of the relevant goods (oils, greases and fuels), namely its viscosity (para. 57). The marks are only vaguely similar visually and phonetically — no likelihood of confusion.</p>		

Earlier sign	Contested sign	Case No
		T-60/11
<p>The word premium is laudatory (para. 44). The coincidence leads only to a low visual and phonetic and an average conceptual similarity — no likelihood of confusion.</p>		

Earlier sign	Contested sign	Case No
	ULTIMATE GREENS	R-1462/2012-G
<p>The word 'ultimate' is a promotional word used to indicate the superior quality of the latest goods available on the market and, has no distinctive character at all (para. 22). Even if both trade marks share this element, there is only a low visual and phonetic similarity (paras 47-48). No conceptual similarity overall (para. 49) — no likelihood of confusion.</p>		

The fact that the coinciding element is a non-distinctive element, does not, however, suffice to deny any similarity between the marks, unless there are further factors differentiating them (see paragraph 4.2.5 below). If the public will notice the overlap, it must be taken into account in the comparison. The fact that an element is descriptive or otherwise non-distinctive is not on its own sufficient to conclude that that word is negligible in the overall impression produced by that mark (judgment of 08/02/2011, T-194/09, Líneas aéreas del Mediterráneo, EU:T:2011:34, § 30).

(For the impact of common weak or non-distinctive components on likelihood of confusion see [the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion](#), Chapter 7, Global Assessment).

The conclusion on visual similarity has to be taken further into account **if the common element is dominant** (visually outstanding) or at least co-dominant in the overall impression of the marks. As explained above (see paragraph 3.3) within the assessment of the dominant character of one or more components, the intrinsic qualities (size, striking graphical representation, etc.) of each of those components have to be compared with the intrinsic qualities of the other components. In addition

and accessorially, account may be taken of the relative position of the various components within the arrangement of the composite mark ([judgment of 23/09/2014, T-341/13, So'bio etic, EU:T:2014:802, § 67](#)).

The distinctiveness and dominant character of the common element(s) are separate but co-related terms. According to the Court:

It should also be noted that where some elements of a trade mark are descriptive or non-distinctive, they are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them.



(Judgment of 31/01/2013, T-54/12, Sport, EU:T:2013:50, § 24 and the case-law cited).

3.4.5.3 Importance of additional (not common) elements



Within the comparison of trade marks as a whole, the impact of the non-common elements in their overall impression also has to be taken into account in order to reach a conclusion on similarity. The more differences the remaining elements of the marks present, the lower would be the similarity resulting from the common element.

It cannot be generally assumed that the elements of difference between the marks would tend to become less marked in the consumer's memory in favour of the elements of similarity. In accordance with settled case-law, the extent of the similarity or difference between the signs at issue may depend, in particular, on the inherent qualities of the signs (13/05/2015, T-169/14, Koragel / CHORAGON, EU:T:2015:280, § 84).

The distinctiveness and dominant character of the differentiating elements has to be, therefore, taken into account. If these elements are the distinctive ones and dominate the overall impression of the marks, the level of similarity will decrease:

Earlier sign	Contested sign	Case No
		T-338/12
<p>As regards the visual comparison, the figurative element representing a dog in the earlier mark constitutes the dominant one. Given that the respective graphic elements are different, the coincidence in the word element 'K9' leads to a visual similarity only to a low degree. The marks are phonetically similar to a high degree. As to the conceptual comparison, the contested mark does not contain any figurative element conveying the concept of a dog, the marks are not conceptually similar (paras 27-34).</p>		

On the contrary, if the element in which the marks differ is of less inherent distinctiveness than the common element, this will increase the level of similarity:

Earlier sign	Contested sign	Case No
	 (NEGRA MODELO)	R-0536/2001-3 (confirmed: T-169/02)
The earlier TM was a Portuguese registration. 'Negra' is descriptive for the relevant goods in Class 33, since it may be used in Portuguese to designate brown beer, i.e. the type of beer sold under the trade mark NEGRA MODELO. The attention of the average Portuguese consumer will be focused on the coinciding word 'modelo'. Low visual, average phonetic and strong conceptual similarity — likelihood of confusion.		

3.4.6 Other principles to be taken into account in the comparison of signs


3.4.6.1 Impact of word elements v figurative elements on the visual and conceptual comparison

When signs consist of both verbal and figurative components, in principle, the verbal 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 more easily refer to the signs in question by their verbal element than by describing their figurative elements (judgment of 14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; decisions of 19/12/2011, R 233/2011-4, Best Tone, § 24; and 13/12/2011, R 53/2011-5, Jumbo, § 59).

However, the verbal element of a sign does not automatically have a stronger impact (judgment of 31/01/2013, T-54/12, Sport, EU:T:2013:50, § 40) and in certain cases, the figurative element of a composite mark may, owing to, inter alia, its shape, size, colour or position within the sign, rank equally with the word element (judgment of 23/11/2010, T-35/08, Artesa Napa Valley, EU:T:2010:476, § 37). In addition, when the earlier mark is a word mark, the figurative elements of the contested sign may even play a decisive role in differentiating the signs (see the first example in the table below).

Moreover, in assessing the impact of the verbal element of a composite trade mark, account should be taken of the distinctiveness of this element.

Examples:

<u>Earlier sign</u>	<u>Contested sign</u>	<u>Case No</u>
<p><u>GIOVANNI</u></p>	 <p>GIOVANNI GALLI</p>	<p><u>T-559/13</u></p>
<p><u>G&S: Class 3</u> <u>Territory: EU</u> <u>Assessment:</u> The figurative element of the mark applied for is as important as the word elements and has a significant impact on the overall visual impression given by that mark. It is positioned above the word elements and occupies more space than both of those elements combined. Furthermore, it is distinctive for the goods at hand, as a duck has no connection with cosmetic or cleaning preparations. In addition, the drawing of the duck is quite elaborate. Even if the element 'GIOVANNI' is placed before the element 'GALLI', there is only a low degree of visual similarity between the marks at issue, in view of the significant impact of the figurative element of the mark applied for on the overall impression given by that mark (paras 62-64, 72, 74).</p>		



G&S: Classes 32 and 33



Territory: Poland



Assessment. The figurative element of the mark applied for, consisting of the stylised representation of a bovine animal viewed in profile looking to the left and that may be perceived as a European bison, is of a similar size to that of the verbal element 'wisent' and occupies a comparable space in that mark. As a result of its shape, its size, its colour and its position, that representation of a bison [...] helps clearly to establish the image of the contested mark which the relevant public will retain in their mind, with the result that **it cannot be discounted in the perception of that mark** [...].


As regards the earlier mark, a naturalistic representation of a bison standing on four legs in a circle against a background of trees, coloured green, brown and black, is clearly perceptible in that mark. That representation of a bison occupies a central position and is of a slightly larger size than the only perceptible verbal element, the term 'żubrówka', represented in yellow and black and placed above that representation. Therefore **the figurative element** consisting of a naturalistic representation of a bison **cannot be discounted in the overall impression created by the earlier mark** [...]. Despite the presence of different verbal elements, as a whole the marks are **visually similar to a low degree** given the fact that they both contain a bison, the image of which will easily be retained by consumers in their memory as a result of their position within the marks at issue and their size (paras 76-77, 82, 85-86, 111, 113).

- (a) Signs with an identical or very similar verbal element and different figurative elements





When the verbal elements are identical or similar and the figurative element has neither semantic meaning nor striking stylisation, the signs are usually similar. In this scenario, the figurative element will be considered not to have a significant influence in the relevant public's perception of the sign:

Earlier sign	Contested sign	Case No (level of similarity)
<p>(i)</p>  <p>(ii)</p> 	<p>PUKKA</p>	<p>T-483/10 (high visual and phonetic similarity. No conceptual similarity)</p>
<p>G&S: Class 18 Territory: Spain, EU Assessment: The figurative elements of the earlier EUTM — namely, the oval and the geometric shape vaguely recalling a five-point star superimposed thereon — do not convey any identifiable conceptual content. Consequently, it is highly unlikely that these figurative elements will hold the attention of the relevant consumer. By contrast, although the verbal element does not convey any conceptual content either, the fact remains that it may be read and pronounced and that it is, therefore, likely to be remembered by consumers. Therefore, the verbal element of the earlier EUTM must be considered to dominate the visual impression made by that mark (para. 47).</p>		

Earlier sign	Contested sign	Case No (level of similarity)
		<p>T-216/11 (average visual and high phonetic similarity. No conceptual comparison possible)</p>
<p>G&S: Class 29 Territory: EU Assessment: Visual similarity results from the fact that both have a unique verbal element very similar only differing in the final letter. Both figurative signs had the representation of a bird, an element that added to the similarity of the signs. The signs have little and minor differences only. On the aural comparison both signs have a high degree of aural similarity having only one final letter difference. The conceptual comparison is not relevant as the verbal element of the signs had no meaning in some parts of the European Union (para. 38).</p>		





Earlier sign	Contested sign	Case No
CINEMA 4D		R 1691/2014-2
<p>G&S: Class 9 Territory: EU Assessment: 'In respect of the figurative elements of which the sign is comprised, the Board considers that there is nothing in these elements that adds anything different to the contested sign other than some elements of decoration. The mere addition of banal figurative elements will not affect the perception of the sign by the relevant public' (para. 24).</p>		

In contrast, when the common verbal elements are likewise weak or even less distinctive than the figurative elements, the coincidence in the verbal elements leads to only low similarity, if there are differences in the figurative elements:

Earlier sign	Contested sign	Case No (level of similarity)
		T-60/11 (low visual and phonetic and average conceptual similarity)
<p>G&S: Classes 30, 31, 42 Territory: EU Assessment: The similarity of the marks is based solely on a word that has no distinctive character and would not be remembered by consumers as the key element of the marks at issue (para. 53).</p>		
Earlier sign	Contested sign	Case No (level of similarity)
		R 1357/2009-2 (no visual or conceptual similarity, remote phonetic similarity)
<p>G&S: Classes 5, 29, 30, 32 Territory: EU Assessment: The BoA took into account the non-distinctive and descriptive character of the word 'Lactofree' for the relevant goods. The Board found the notable visual and conceptual differences between the signs (para. 98).</p>		

(b) Signs with an identical or very similar figurative element and different verbal elements

In general, the identity or similarity of the figurative component of signs will not lead to a considerable level of similarity where at least one of the signs contains a further verbal component that is not contained in the other sign. The outcome will however depend on the particular circumstances in each individual case.





Earlier sign	Contested sign	Case No (level of similarity)
	 (IBIZA REPUBLIC)	T-311/08 (low visual similarity, phonetic and conceptual dissimilarity)
<p>G&S: Classes 25, 41, 43 Territory: France Assessment: Taking into account the dominant character of the verbal element in the mark applied for, there is no phonetic and conceptual similarity and only a low degree of visual similarity between the signs (para. 58) — no likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No (level of similarity)
		R 280/2009-4 (visual, phonetic and conceptual dissimilarity)
<p>G&S: Classes 16, 36, 41 Territory: Germany Assessment: The only thing the two signs have in common is that they depict a cross with eight characteristic points, known as a 'Maltese cross', referring to the Order of Malta. Even in the area in question, 'charitable fundraising; education, periodicals; medical services' (Classes 16, 36, 41, 45), the specific Maltese cross shape is not used exclusively by the appellant. The EUTM application contains the unreservedly distinctive word sequence 'Pro concordatia populorum' and cannot be reduced to its figurative element. The signs are also dissimilar phonetically, as the opposing sign has no verbal elements. There is no conceptual similarity, as the EUTM application means 'for the understanding of the peoples', a phrase that has nothing in common with the earlier sign. Therefore, there can be no likelihood of confusion, even in the case of the identical goods found only in Class 16.</p>		

This rule does not apply to the cases where the verbal element is of limited distinctiveness and not dominant:

Earlier sign	Contested sign	Case No (level of similarity)
		Joint R 68/2001-4 and R 285/2001-4 (high visual similarity)
<p>G&S: Classes 18, 24, 25, 28 Territory: Benelux, Germany, Spain, France, Italy, Austria Assessment: the wording 'La Maison de la Fausse Fourrure' is not sufficient to reduce the impression of similarity between the conflicting marks. In addition to its possibly descriptive nature, the Board notes that the wording is given, relative to the footprint device, a secondary position (it is placed under the device), a relatively limited size (four times smaller) and a conventional writing style (para. 22).</p>		

- (c) Signs with figurative elements corresponding to the meaning of the verbal elements

The figurative element may ‘cooperate’ with the verbal part in defining a particular **concept** and may even help with the understanding of words that, in principle, might not be widely known to consumers. This will strengthen the conceptual similarity:

Earlier sign	Contested sign	Case No
		B 210 379
<p>G&S: Class 3 Territory: Germany, Spain Assessment: The figure of a moon, present in both signs, made the equivalence between the Spanish and English words ‘LUNA’ and ‘MOON’ clearer to Spanish consumers.</p>		
Earlier sign	Contested sign	Case No
		R 1409/2008-2
<p>G&S: Classes 18, 25, 35 Territory: EU Assessment: Visually, the trade marks are highly similar. An aural comparison is not possible. Conceptually, the word ‘horse’ will be understood by English-speaking consumers as a direct reference to the figurative element of the contested EUTM. Therefore, the marks are conceptually identical.</p>		

3.4.6.2 Beginning of the signs in the visual and phonetic comparison

In word signs or in signs containing a verbal element, 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 general the beginning of a sign has a significant influence on the general impression made by the mark (judgments of 15/12/2009, T-412/08, Trubion, EU:T:2009:507, § 40; 25/03/2009 T-109/07, Spa Therapy, EU:T:2009:81, § 30).

Nevertheless, 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 is not a middle part of the sign. Again, this perception mostly depends on the circumstances of the case (length of sign, syllabic distribution, use of typeface, etc.) and not on a set rule. It could even be that a sign is perceived as having a short beginning and ending and a proportionally much larger 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.

As it is usually the beginning of a sign that catches consumers’ attention, where signs only differ in their endings, this difference is often insufficient to exclude similarity. However, this is not a fixed rule and the outcome depends on the circumstances of the case. Moreover, this rule only applies when the sign contains a verbal element (which would explain the reading from left to right) and when this verbal element is not very

short (otherwise the sign will be perceived immediately in its entirety). The Office considers signs consisting of three or fewer letters/numbers as very short signs (see in more detail paragraph 3.4.6.3 below).

In principle, coincidences at the beginning of signs increase their similarity more than in the middle or at the end:

Earlier sign	Contested sign	Case No
ALENTIS	ALENSYS	R 1243/2010-1
<p>G&S: Class 42 Territory: Spain Assessment: While both marks do not have any meaning and, thus, no conceptual comparison can be made, the trade marks are visually and phonetically highly similar, in particular because they coincide in their first four letters 'ALEN'. It is generally accepted that people pay more attention to the first part of a trade mark, at least when they perceive the mark visually (para. 33).</p>		
Earlier sign	Contested sign	Case No
AZURIL	AZULIB	R 1543/2010-1
<p>G&S: Class 5 Territory: Greece Assessment: The signs share five of their six letters and the first two syllables are identical. There is a certain degree of visual similarity. Aurally the signs are highly similar as the initial part, which is normally the most important, is identical. Neither sign has a meaning in Greek (paras 35-36).</p>		

However, the degree of similarity will usually be lower, despite identical beginnings, if those are the weak elements in the signs or if the remaining elements have a clearly different meaning:

Earlier sign	Contested sign	Case No
CALSURA	CALSORIN	R 484/2010-2
<p>G&S: Class 5 Territory: EU Assessment: Visually, the marks share some similarity due to the coinciding letters 'C', 'A', 'L', 'S' and 'R' placed in the same order. Aurally, there is a low degree of similarity. Conceptually, the marks are similar insofar as they both contain the component 'CAL'. However, since this element clearly alludes to the kind of goods (containing 'calcium'), not much weight can be given to this conceptual similarity (paras 21-23) — no likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
NOBLESSE	NOBLISSIMA	R 1257/2010-4
<p>G&S: Class 30 Territory: Denmark, Finland, Sweden Assessment: The signs differ in the fifth letter and in their ending. They are visually similar to an average degree. In view of the length of the EUTM application, the signs differ in rhythm and intonation and are thus aurally similar to a low degree. The earlier signs 'NOBLESSE' do have a clear connotation in both Finland and Sweden. In these territories, the word 'NOBLISSIMA' lacks any meaning. They are, therefore, conceptually dissimilar. The earlier marks are laudatory in nature and to a certain extent descriptive of the characteristics of the goods 'chocolate', namely describing their superior character. The distinctive character is below average.</p>		

Earlier sign	Contested sign	Case No
ALBUMAN	ALBUNORM	R 489/2010-2
<p>G&S: Class 5 Territory: EU Assessment: Visually, phonetically and conceptually the signs are similar insofar as they have the prefix 'ALBU' (abbreviation of 'albumin' or 'albumen') in common. But this similarity is of little significance because the prefix is generic and so devoid of distinctiveness. The second element of the earlier mark, 'MAN', is visually, phonetically and conceptually completely different from the second element, 'NORM', of the contested mark.</p>		

3.4.6.3 Short signs

The comparison of signs must be based on the **overall impression** given by the marks.

The length of signs may influence the effect of the differences between them. In principle, the shorter a sign, the more easily the public is able to perceive all its single elements. In contrast, the public is usually less aware of differences between longer signs. **However, each case must be judged on its own merits, having regard to all the relevant factors.**

The Courts have not exactly defined what a short sign is. However, signs with three or less than three letters/numbers are considered by the Office as short signs. The paragraphs below thus analyse the impact on the overall impression, and thus, on the similarity of the respective signs for one-, two- and three-letter/number signs.

The comparison between signs consisting of a single letter or a combination of three or less than three letters not recognisable as a word, **follows the same rules** as that for word signs comprising a word, a name or an invented term (judgments of 06/10/2004, T-117/03 to T-119/03 and T-171/03, NL, EU:T:2004:293, § 47-48; 10/05/2011, T-187/10, G, EU:T:2011:202, § 49).





(a) Single-letter/Single-number signs

It follows from the case-law of the Court that in the assessment of likelihood of confusion between signs comprising the same single letter, **visual comparison** (see paragraph 3.4.1.6 above) is, in principle, decisive. The aural and conceptual identity may be overridden, in the assessment of likelihood of confusion, by sufficient visual differences between the signs (see [the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion](#), Chapter 7, Global Assessment, paragraph 7.1, 'Short ~~signs~~ signs').


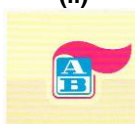

(b) Two-letter/number signs

The over-mentioned rule on the importance of visual comparison applies to two-letter/number marks accordingly. The comparison of these signs depends on their stylisation and, especially, on whether the letters are recognisable as such in the sign. Consequently, the visual overall impression of the signs may be different when two conflicting signs, albeit containing or consisting of the same combination of two-letters, are stylised in a sufficiently different way or contain a sufficiently different figurative element, so that their different overall graphical representation eclipses the common verbal element.



In the following examples, the **marks were found visually similar** due to the graphic representations/visual similarities of the same two-letter combinations:

Earlier sign	Contested sign	Case No
<p>(i)</p>  <p>(ii)</p> 		B 61 046
<p>G&S: Class 36 Territory: Spain Assessment: The overall visual impression of the conflicting marks is that they consist of two letters in an arbitrary figurative design that conveys the same impression. The trade marks are considered similar.</p>		
Earlier sign	Contested sign	Case No
<p>GE</p>		T-520/11
<p>G&S: Classes 6, 7, 9, 11, 17 Territory: UK Assessment: It cannot be excluded that part of the relevant public will interpret the contested mark as the letter combination 'GE' (paras 33-35). The marks are phonetically identical and visually similar to a medium degree. As regards the conceptual comparison, it cannot be excluded that part of the relevant public will interpret the contested mark as the letter combination 'GE'.</p>		

In the following example, **the signs were found visually and phonetically dissimilar** due to the different graphic representation and the fact that they may not be read as the same letters.


Earlier sign	Contested sign	Case No
<p>(i)</p>  <p>(ii)</p> 		R 82/2011-4
<p>G&S: Class 33 Territory: EU Assessment: From a visual point of view, the graphic stylisation of the earlier marks is very different compared with the contested mark. The mere fact that one or both letters of the marks are identical is not enough to render the marks visually similar. There is no aural similarity if the contested mark will be pronounced as 'B' or 'PB' as in short signs differences have a higher impact on the overall impression than in longer marks. Conceptually, the contested mark and the earlier marks with no additional elements to the letter combination 'AB' do not have a meaning in any of the relevant languages: the conceptual comparison remains thus neutral (paras 17-19).</p>		

As to the difference in one of the letters see the following examples:

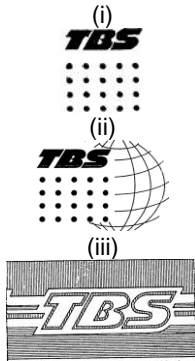


Earlier sign	Contested sign	Case No
(i) CX (ii) 	KX	R 864/2010-2
G&S: Class 7 Territory: EU Assessment: Visually, the initial letters 'K' and 'C' show a clearly different shape and can be considered only visually similar to a low degree. The same degree of similarity — low — applies for the phonetic comparison. Aurally, the signs will be pronounced 'K-X' and 'C-X' respectively, and not as words. Neither of the marks has a conceptual meaning (paras 25-27).		
Earlier sign	Contested sign	Case No
KA		T-486/07
G&S: Classes 9, 11, 12 Territory: EU Assessment: It must be concluded that, for each of the possible perceptions by the relevant public of the mark applied for, that public will perceive significant visual differences for each of the earlier marks (para. 65). Some degree of phonetic similarity between the marks at issue must be recognised, but it is not very high. Without making an error, the Board of Appeal, therefore, could find that the phonetic similarity between the marks at issue was not 'notable' (para. 71). As both marks have no meaning, no conceptual comparison can be made (para. 72).		

(c) Three-letter/number signs

When the signs in conflict are three-letter/number signs, a difference of one letter does not exclude similarity, especially if this letter is phonetically similar.

Earlier sign	Contested sign	Case No
	ELS	T-388/00
G&S: Classes 16, 35, 41 Territory: Germany Assessment: Two of the three letters are identical and in the same sequence; the difference in a single letter does not constitute a significant visual and aural difference. The letters 'E' and 'I' in Germany are pronounced similarly (paras 66-71).		
Earlier sign	Contested sign	Case No
Ran	R.U.N.	T-490/07
G&S: Classes 35, 38, 42 Territory: EU, Germany Assessment: The Court held that the signs in the mind of the relevant consumer, having a good command of the English language, are visually, aurally and conceptually similar (para. 55).		

In contrast, when trade marks are composed of only three letters, with no meaning, the difference of one letter may be sufficient to render them not similar:

Earlier sign	Contested sign	Case No
		R 393/1999-2
<p>G&S: Class 25 Territory: Benelux, Germany, Spain, France, Italy, Portugal, Austria Assessment: In this case the pronunciation of the first letters of the marks in dispute, i.e. 'J' and 'T', is different in all relevant languages. These letters are also visually dissimilar. Furthermore, the figurative elements of the compared marks do not resemble each other (paras 17-18).</p>		
Earlier sign	Contested sign	Case No
	COR	T-342/05
<p>G&S: Class 3 Territory: Germany Assessment: The GC considered that the signs were only aurally similar to a low degree (paras 47 and 50). The relevant public in Germany will certainly notice the differences in the beginning of the signs.</p>		

3.5. Conclusion on similarity

Each aspect of (visual, phonetic and conceptual) the comparison of signs leads to a decision as to whether the marks are similar and if so, to what degree. In general, the more commonalities that exist between marks, the higher the degree of similarity.

An assessment of similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components.

The conclusion as to the degree of similarity of the signs at each of the three levels is the result of an evaluation of all of the relevant factors. The main factors that may impact on an assessment of similarity have been explained in the previous paragraphs of this chapter. It should be borne in mind that in an assessment of similarity, the relevant factors (dominance, distinctiveness, etc.) are considered not only for the purpose of determining the common elements of marks, but also to establish any differing and/or additional elements in conflicting signs.

It must also be borne in mind that since the assessment of similarity is based on the overall impression of the signs, once signs have been found to be similar, it would not be consistent to find later, in the global assessment of the likelihood of confusion, that 'the overall impression of the signs is different' in order to support an outcome of no likelihood of confusion.

In general, the following should be considered when assessing similarity and degrees of similarity:



- impact of the distinctiveness of the elements.

The greater or lesser degree of distinctiveness of the elements is common to signs, and is one of the relevant factors in assessing the similarity between signs.

For example, if the coincidences between the signs ~~of each~~ on any of the three aspects of comparison derive from an element with limited distinctiveness, the established degree of visual, aural and/or conceptual similarity, respectively, will be lower than where the elements in common have a normal distinctiveness.

For example, if the marks coincide in a descriptive or weak figurative component but also share a distinctive verbal element, the level of aural similarity is not affected. In addition, the impact of a coinciding figurative dominant element is clearly something that affects the visual comparison.

In the following examples the signs involved weak/descriptive elements but with different outcomes:

<u>Earlier sign</u>	<u>Contested sign</u>	<u>Case No</u>
		<p><u>T-277/11</u> <u>(LOC)</u></p>
<p><u>G&S: Classes 35, 39, 41, 42 and 43</u> <u>Territory: EU</u> <u>Assessment: the Court found the signs visually highly similar, and identical phonetically and conceptually (paras 86, 88, 91 and 93).</u></p>		

<u>Earlier signs</u>	<u>Contested sign</u>	<u>Case No</u>
  	<p><u>TRIDENT PURE</u></p>	<p><u>T-491/13</u> <u>(No LOC)</u></p>
<p><u>G&S: Class 30</u> <u>Territory: Inter alia EU</u> <u>Assessment: with respect to the first earlier right, the Court established a low degree of visual similarity given that the coinciding element 'PURE', despite being descriptive for part of the public, was not on its own sufficient to conclude that the word is negligible in the overall impression produced by the mark (para. 70). They were deemed phonetically similar to a low degree for those who understood 'PURE' but aurally similar to an average degree for the remaining part of the public. On a conceptual level, they were similar for those understanding 'PURE' as a reference to the purity of the goods at issue and to the purity of breath' (para. 93). It was also stated that the fact that the word 'pure' is descriptive of the characteristics of the goods in question does not alter the conceptual content of those marks. With respect to the remaining earlier rights the degree of similarity was no greater.</u></p>		

- Impact of the dominant elements



The conclusion on visual similarity has to be taken further into account if the common element is dominant (visually outstanding) or at least co-dominant in the overall impression of the marks.

It should also be noted that where some elements of a trade mark are descriptive or non-distinctive, they are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them.

It should be emphasised that the abovementioned factors may not be applicable to all cases and the assessment of similarity is always undertaken on a case-by-case basis and a consideration of further factors may be necessary. Furthermore, it should be noted that the above factors and principles do not call into question the principle that the examination of the similarity of trade marks must take into account the overall impression produced by them on the relevant public.

- Impact of word v figurative elements

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. Therefore, if the coincidences between composite signs (signs comprising word and figurative elements) lie within the verbal elements and the differences arise out of the figurative elements, the degree of visual and aural similarity is likely to be higher than average. [\(see example below\)](#).

Earlier sign	Contested sign	Case No
		T-149/12 (LOC)
<p>G&S: Class 9 Territory: Spain Assessment: the signs were found visually highly similar and phonetically identical, notwithstanding the descriptive character of the element 'MICRO' (paras 54, 55 and 60) and taking into account that the differences were limited to banal graphical elements.</p>		

In general, the identity or similarity of the figurative component of the signs is insufficient to establish a considerable level of similarity where at least one of the signs contains a further verbal component that is not contained in the other sign.



However, although the word elements of a mark may have a greater impact, this is not necessarily the case where the figurative element visually dominates the overall impression made by the mark [\(see paragraph 3.4.6.1 above, Impact of word elements v figurative elements on the visual and conceptual comparison\)](#).

- Beginning of signs

In principle, coincidences at the beginning of signs increase their similarity more than coincidences in the middle or at the end of signs.

Therefore, consumers attach less importance to the end of the mark and coincidences located at the end of signs would lead to a finding of a lower degree of visual similarity than common elements at the beginning of signs [\(see first example below\)](#). Likewise, the position of the coinciding/similar phonemes or syllables at the beginning of the conflicting signs would increase the degree of aural similarity.

However, the degree of similarity will usually be lower, despite identical beginnings, if those are the weak elements in the signs or if the remaining elements have a clearly different meaning ([see second example below](#)).

Earlier sign	Contested sign	Case No
OXYGESIC	Maxigesic	T-328/12
<p>G&S: Class 5 Territory: EU Assessment: The signs were found visually similar to a low degree due to the descriptive character of the suffix 'GESIC', given that it refers to pain killers (paras 35 and 47), as well as the different beginnings (para. 49). Phonetically, they were found similar to an average degree (para. 51) and conceptually dissimilar, the latter again due to the descriptive content of 'GESIC' and the differing associations that could be made with the respective prefixes of the signs ('OXY' refers to oxygen/oxycodon and 'MAXI' to maximum (para. 53)), with the result that a likelihood of confusion was excluded.</p>		
Earlier sign	Contested sign	Case No
		T-33/13
<p>G&S: Class 35, 36 and 42. Territory: Austria, Benelux, Bulgaria, the Czech Republic, Cyprus, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Latvia, Lithuania, Poland, Portugal, Slovakia, Slovenia, Spain, Sweden and the United Kingdom. Assessment: Visually, the signs were deemed to have at least a certain degree of visual similarity, even if the coincidence in 'bonus' related to an element of a weak distinctive character (paras 32 and 41). Phonetically, the signs were found similar to an average degree due to the identical pronunciation of the first two syllables (para. 34). Conceptually, there is at least a certain degree of similarity for a significant part of the public for whom the common element 'bonus' conveys an identical meaning (para. 42).</p>		

- Short signs

The length of the signs may influence their overall impression and thus the effect of the differences between them. In principle, the shorter a sign, the more easily the public is able to perceive all its single elements. In contrast, the public is usually less aware of differences between longer signs.

The application of the abovementioned principles and factors should not be automatic. The decision has to explain their relevance for the particular case and weigh them up.

However, the rules explained in this chapter have a general character and the particularities of a specific case may justify different findings. However, in such cases it is of even greater importance to provide a clear and thorough reasoning in the decision.

4 Dissimilarity of Signs

4.1 Introduction

The similarity of signs is a necessary condition for a finding of a likelihood of confusion under Article 8(1)(b) EUTMR. An assessment of the similarity between two marks must be based on the **overall impression** created by them, in particular, by their distinctive and dominant components (judgment of 23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 32 and the case-law cited therein). Where the overall impression is that the signs are dissimilar, this excludes the likelihood of confusion.

The finding as to whether signs are similar or dissimilar overall is the result of a combined assessment of (i) the visual, phonetic, conceptual overlaps and differences and (ii) the significance of the overlaps and differences in the perception of the relevant public.

Where the signs at issue are dissimilar,

- the general rule is that the goods and services do not need to be compared. Only the signs are compared and the examination stops upon concluding on the dissimilarity of the signs.

Nevertheless, reasoning strategy may justify a comparison of some of the goods and services and continue the assessment of the similarity of signs for the remaining goods and services only, where the signs are otherwise dissimilar due to an overlap exclusively in a descriptive or non-distinctive element (see paragraph 4.2.5 below). For example, in the case of long lists of goods and services, it may prove more efficient to first rule on the dissimilarity of some of the goods and services, and continue to the comparison of the signs (including the assessment of distinctive components in several languages) only for the remaining, shorter list of goods and services.

- any claim of enhanced distinctiveness is not examined. If the signs are dissimilar, the opposition under Article 8(1)(b) EUTMR must be rejected regardless of any enhanced distinctiveness of the earlier mark. Where the marks in question are not similar, there is no need to take account of the reputation of the earlier mark, since it does not fall within the scope of the test of similarity and cannot serve to increase the similarity between those marks (order of 14/03/2011, C-370/10 P, EDUCA Memory game, EU:C:2011:149, § 50-51 and the case-law cited therein).
- there is no global assessment of factors. The decision concludes that in the absence of one of the conditions, the opposition under Article 8(1)(b) EUTMR must be rejected.

4.2 Scenarios for dissimilarity

4.2.1 No element in common

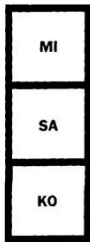


The signs are obviously dissimilar if they have nothing in common in any of the three aspects of comparison. This is more a hypothetical scenario as the signs at issue in an opposition under Article 8(1)(b) EUTMR normally have something in common. What is rather debated by the parties is the significance of the overlap in an element.

4.2.2 Overlap in a negligible element

The signs are dissimilar if the only element they have in common is **negligible** in one or both of the marks in the sense that, due to its size and/or position, it will be likely to go **unnoticed** or **disregarded** by the relevant public. Negligible elements, after **having duly reasoned** why they are considered negligible, will not be compared (judgment of 12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42). The notion of negligible elements should be strictly interpreted and, in the event of any doubt, the assessment should cover all the elements of the sign (see paragraph 1.5 above).

Concerning the assessment as to whether an element is negligible, the test is not whether the Office can, in a meticulous side-by-side examination of the signs, decipher the element concerned. The question is rather whether, in the overall impression of the sign, the element is noticeable by the average consumer who normally perceives a sign as a whole and does not proceed to analyse its various details.

Examples:


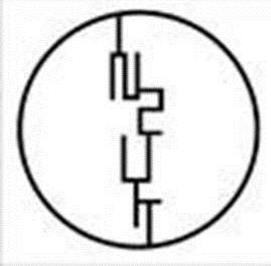
Earlier sign	Contested sign	Case No
		<p>T-162/08</p> <p>The words 'by missako' are almost illegible: the size and script make them difficult to decipher</p>
	<p>LUNA</p>	<p>R 2347/2010-2</p> <p>The element 'Rótulos Luna S.A.' was considered negligible</p>

4.2.3 Overlap in a verbal element not noticeable due to high stylisation

The signs are dissimilar if the verbal element, which would give rise to similarity, is not discernible due to its high stylisation. Sometimes the way in which letters or symbols are used makes it unrealistic to assume that they will be read and pronounced, for example, when in a figurative mark a symbol or letter is repeated in order to create a pattern or is highly distorted or otherwise not clearly legible. If the verbal element is not recognisable in the overall impression of the sign, thus, not legible and not pronounceable, it will not be taken into account in the comparison.

Again, the test is not whether the Office can, in a meticulous side-by-side examination of the signs, identify the verbal element concerned. It is irrelevant if the verbal element is recognised only with the help of the other mark, as the consumer normally does not have the opportunity to compare signs side by side. Furthermore, it is irrelevant that the party refers to its mark by a particular verbal element in its submissions or if the particulars of the mark indicate a verbal element, because the consumer will not be assisted by that information on encountering the sign as registered or applied for.

Examples:

Earlier sign	Contested sign	Case No
KA		R 1779/2010-4
intuit		R 164/2015-2


The question whether the verbal element is indeed ‘lost’ in the stylisation must be carefully assessed. The consumer intuitively looks for pronounceable elements in figurative signs by which the sign can be referred to. The high stylisation of one or more letters of a word may not prevent the consumer from identifying the verbal element as a whole, particularly, if it suggests a concrete meaning. It should also be emphasised that if the complex stylisation of the verbal element of a sign does not make it totally illegible, but merely lends itself to various interpretations, the comparison must take into account the different realistic interpretations. Thus, it is only in the — rather rare — case where the legibility of the sign is truly unrealistic, without being assisted by a mark description or the other mark, that the verbal element will be disregarded in the comparison.

4.2.4 Overlap in other irrelevant aspects



The fact that there is some coincidence between the signs does not necessarily lead to a finding of similarity. This is in particular the case when the overlapping part is not perceived independently within the overall impression of the marks. The Court considered the following signs dissimilar despite the overlap in a sequence of letters:

Examples:

Earlier sign	Contested sign	Case No
AAVA MOBILE StoCretec	JAVA CRETEO	T-554/12640/13
<p>The resemblances that result from the presence of the common letters ‘ava’ are completely offset by the significant differences between those signs (para. 45). The conflicting signs are dissimilar (para. 87). In the visual impression created by the marks, the beginnings ‘sto’ and ‘cre’ and the endings ‘tec’ and ‘o’ play a more important role than the syllables ‘cre’ and ‘te’, which are placed in the middle of the signs and are less perceived by the relevant public. Therefore, it is concluded that there is no visual similarity between the signs (para. 71). The marks are not phonetically similar, in particular on account of their different beginnings and endings (para. 72). The conceptual comparison remains neutral, as ‘StoCretec’ and ‘CRETEO’ are coined terms without any meaning in German (para. 73).</p>		

Earlier sign	Contested sign	Case No
ALDI		T-240/13

~~The conflicting signs are visually different.~~ The figurative elements and the additional word 'foods' must not be disregarded when comparing the signs (paras 54-55). The overall visual impression of the conflicting signs is clearly ~~different~~ **dissimilar** (paras 59-61). The signs are ~~also not~~ **also not** phonetically ~~different~~ **similar** bearing in mind, in particular, the additional element 'foods' of the contested mark (para. 64 ~~paras 65-66~~). Finally, the marks are also conceptually not similar (para. 73).



Earlier sign	Contested sign	Case No
		T-524/11

The figurative elements of the earlier figurative marks further distinguish those marks from the mark applied for (para. 36). The signs at issue have a different rhythm of pronunciation (paras 43-44). The words have no meaning; it is not possible to carry out a conceptual comparison (para. 54).

The same applies to similarities in the figurative elements that are of minor impact:

Earlier sign	Contested sign	Case No
		T-36/13

The figurative elements of the signs have the same outline, but will be perceived as different by the relevant public (paras 45-47). The word elements are visually different since they have only two letters in common, which are also placed in distinct positions.

Earlier sign	Contested sign	Case No
		B 1 837 106

The marks coincide only in that the verbal elements are written in white on a contrasting grey background and the white frame that separates the verbal and the landscape elements in equal parts. These are commonplace figurative elements, omnipresent in marks in virtually all fields of trade. The consumer's attention is not caught by any of these details, but rather by the fanciful term 'tukaş' in the earlier mark and by the word 'Ekonomik' in the contested mark. As the signs visually overlap only in irrelevant aspects and have nothing in common aurally and conceptually, they are dissimilar overall.

The decision must contain a thorough reasoning, in the comparison of signs, as to why the overlap in particular aspects is considered irrelevant.

4.2.5 Overlap in a non-distinctive element

If the signs overlap exclusively in an element that is **descriptive** or otherwise **non-distinctive** for the relevant goods and services in all parts of the relevant territory, and they **contain other distinctive element(s) capable of differentiating** between the signs, they can be considered dissimilar.

It follows that [two conditions have to be fulfilled in order to find dissimilarity in this context:](#)

- [the coinciding element must be non-distinctive \(if the coinciding element has some, even very low distinctiveness, the signs cannot be found dissimilar\);](#)
- [other elements are distinctive and capable of differentiating the marks.](#)


[Therefore](#), two signs may be dissimilar for part of the goods and services but not for others. If in part of the relevant territory the overlapping element is not perceived as descriptive or non-distinctive (e.g. due to non-understanding of the term), the signs cannot be considered dissimilar.

Invented examples:

[The following, invented examples illustrate cases where the coincidence in one element cannot lead to any similarity because that element is non-distinctive and the other elements, which are clearly different, allow the public to differentiate sufficiently between the marks:](#)



Earlier sign	Contested sign
HOTEL FRANCISCO	HOTEL PARIS ZENITH
G&S: provision of accommodation Territory: European Union	
CASA ENRIQUE	CASA RACHEL
G&S: provision of restaurant services Territory: Spain (where 'casa' has also the meaning 'bar', 'restaurant')	
MARKET.COM	FITNESS.COM
G&S: telecommunications services Territory: European Union	

Examples from case-law:

Earlier sign	Contested sign	Case No
	CARBON CAPITAL MARKETS	T-563/08 (paras 39-61)
<p>G&S: Class 36 Territory: European Union (relevant public considered to be familiar with basic English financial terminology) The Assessment. the common element 'capital markets' directly describes the services.</p>		
MAX&Co.	M&Co.	T-272/13
<p><i>Goods and services: Classes 25 and 35</i> <i>Territory: European Union</i> Assessment: The common element '&Co.' is non-distinctive and always used in the same position — after the distinctive part of the company name.</p>		

However [According to the rules established on the beginning](#), despite a lack of distinctive character of the elements in common, it would not be appropriate to conclude on dissimilarity, where:

- the particular combination of the elements confer distinctiveness on the signs (i.e. the combination would be protected);

Earlier sign	Contested sign	Case No
		T-60/11
<p>G&S: Classes 30, 31, 42 Territory: EU Assessment: there is some similarity between the marks. The earlier mark consists of two elements that are non-distinctive for the goods in question — the image of a corn (descriptive for bakery products) and the laudatory word element 'PREMIUM'. The combination of these elements is arbitrary (unlike the word combination 'Capital markets' in the example above, which is an established expression). The coincidences between the marks are therefore not limited to non-distinctive elements but extend to their particular combination.</p>		

- the other element that is supposed to distinguish between the signs is (i) perceived as an insignificant figurative detail, or is (ii) otherwise non-distinctive;

Earlier mark	Contested sign	Case No
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	<p>iHotel</p>	<p>T-277/11</p>
<p>G&S: Class 43 and others related to travelling and hotel services Territory: EU Assessment: the visual differences between the marks (e.g. the orange background) do not distract from the common element, the marks are visually highly similar (paras 85, 87); there is phonetic and conceptual identity (paras 89, 93).</p>		

Earlier sign	Contested sign	Case No
<p>waterPerfect</p>	<p>AquaPerfect</p>	<p>T-123/14 (paras 39-61)</p>
<p>G&S: Class 7 Territory: European Union: Assessment: while the element 'Perfect' has a laudatory character, the fact remains that none of the other elements making up the same signs can be considered to have a greater distinctive character or be dominant. The elements 'aqua' and 'water' also have a weak distinctive character owing to the fact that they will be perceived by the relevant public as meaning 'water' and the goods covered all involve, in one way or another, water (para. 42). The signs were found visually, phonetically and conceptually similar to an average degree.</p>		

- the non-distinctive elements constituting (forming exclusively) the sign are entirely incorporated in the other sign.

Earlier mark	Contested sign	Case No
<p>POST</p>	<p>TPG POST</p>	<p>T-102/14</p>
<p>G&S: Class 39 and others related to postal services Territory: Germany, EU Assessment: although the element 'post' as such is non-distinctive for postal services, it corresponds to the earlier mark, which should be attributed with a minimum degree of distinctiveness (para 43).</p>		

In summary, the finding of 'dissimilar overall' on account of an overlap exclusively in non-distinctive elements should be limited to evident cases where the other element serves to safely distinguish between the signs.

Less

[In less evident cases, low similarity should not be attributed to the marks. The examination will then proceed and the cases will be solved at the stage of ~~the comparison of signs, but rather in~~ the global assessment \(see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 7, Global Assessment, paragraph 6, Impact of weak or non-distinctive elements on likelihood of confusion, subparagraph 6.2, Common elements with no distinctiveness\).](#)

[It must also be borne in mind that a finding of dissimilarity in the context of Article 8\(1\)\(a\) or \(b\) EUTMR is also binding for other grounds of refusal on which the opposition is based. It applies especially to Article 8\(5\) EUTMR, with the result that if the marks are found dissimilar, the protection on this ground is excluded \(see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation \(Article 8\(5\) EUTMR\), paragraph 3.2, Similarity of the signs\).](#)

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