

***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 7***

***GLOBAL ASSESSMENT***

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## 1 Introduction

### 1.1 Nature of global assessment

A likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically-linked undertakings. If a significant part of the relevant public of the goods or services at issue may be confused as to the origin of the goods or services, this is sufficient. Therefore, there is no need to establish that all actual or potential consumers of the relevant goods or services are likely to be confused.

The Court has stated that likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case; this appreciation depends on numerous elements and, in particular, on the degree of recognition of the mark on the market, the association that the public might make between the two marks and the degree of similarity between the signs and the goods and services (judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

The Office normally examines the most salient and habitually relevant factors relating to likelihood of confusion and establishes their degrees:

- (i) similarity of goods and services;
- (ii) the relevant public and the level of attention;
- (iii) similarity of the signs taking into account their distinctive and dominant elements;
- (iv) the distinctiveness of the earlier mark.

In the last section of a decision containing the global assessment, those factors are weighed up. However, the global assessment can weigh up many other factors that are relevant to deciding on likelihood of confusion (see Chapter 6, 'Other Factors').

## 2 Interdependence Principle

The Court has set out the essential principle that evaluating likelihood of confusion implies some **interdependence between the relevant factors** and, in particular, between the previously established findings on the degree of similarity between the marks and that between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (judgment of 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17). This principle of interdependence is crucial to the analysis of likelihood of confusion.

The interdependence of those factors is expressly referred to in recital 8 in the preamble to the EUTMR, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends on numerous elements and, in particular, on the recognition of the mark on the market, the association that can be made with the used or registered sign, the degree of similarity between the mark and the sign and that between the goods or services identified (judgment of 10/09/2008, T-325/06, Capió, EU:T:2008:338, § 72 and the case-law cited).

The requirement for a global appreciation and the principle of interdependence means that where there is at least some degree of similarity between the signs and the relevant goods/services, there will be an assessment of likelihood of confusion involving an iterative process that weighs up all the relevant factors. This process takes place in the global assessment section.

In practice, this means that the **Office will weigh up**, inter alia, the degree of similarity between the goods and services and the degree of attention paid by the relevant public to those goods and services, the degree of similarity between the signs, and whether the impression produced by any one of the levels of comparison (visual/aural/conceptual) is more important, and the distinctiveness of the earlier mark

Moreover, the factors evaluated in the global assessment **will vary** according to the particular circumstances. For example, in clear-cut cases where goods/services and the signs are highly similar or identical, the Office may find a likelihood of confusion without assessing all factors – such as enhanced distinctiveness, family of marks, etc.

Importantly, it is not possible to set out in the abstract whether one factor carries more weight than another because these factors will have varying degrees of relative importance depending on the circumstances. For instance, the degree of visual similarity may weigh more heavily in connection with goods that are usually examined visually, whilst the degree of aural similarity may be more relevant to goods normally ordered orally.

### 3 Imperfect Recollection

Although, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect, account is taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (judgment of 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Even consumers with a high level of attention need to rely on their imperfect recollection of trade marks (judgment of 21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 54).

### 4 Impact of the Method of Purchase of Goods and Services

The Court has stated that, when evaluating the importance attached to the degree of visual, aural and conceptual similarity between the signs, it is appropriate to take into account the category of goods or services in question and the way they are marketed (judgment of 22/09/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 27).

The category of goods and services involved may increase the importance of one of the different aspects of similarity between signs (visual, phonetic and conceptual) because of how goods and services are ordered and/or purchased. An aural or conceptual comparison between signs may be less important in the case of goods and services that are usually examined visually or may be tried on before being bought. In such cases, the visual impression of signs counts more in the assessment of likelihood of confusion.

However, it is important to emphasise that, as with all of the factors that are relevant to likelihood of confusion, the factors are interlinked and each set of circumstances must be examined on a case-by-case basis. This means that no general rule should be applied to broad categories of goods or services.

#### 4.1 Visual similarity

A good example of where visual similarity can play a greater – but not an exclusive – role in the global assessment of the likelihood of confusion is **clothing**. Generally, in clothing shops, customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (judgments of 14/10/2003, T-292/01, Bass, EU:T:2003:264, § 55; 06/10/2004, T-117/03-T-119/03 & T-171/03, NL, EU:T:2004:293, § 50; 18/05/2011, T-502/07, McKenzie, EU:T:2011:223, § 50; 24/01/2012, T-593/10, B, EU:T:2012:25, § 47). These considerations played a role in finding no likelihood of confusion between the marks below for, inter alia, certain goods in Class 25.


Earlier sign	Contested sign	Case No
		T-502/07
		T-593/10

The same considerations were central to a finding of likelihood of confusion in the following cases also for, inter alia, certain goods in Class 25.

Earlier sign	Contested sign	Case No
		R 1050/2008-4
PETER STORM	PEERSTORM	T-30/09
		T-376/09

However, granting preferential consideration to the visual perception does not mean that identical verbal elements can be overlooked due to the presence of striking


figurative elements, as can be seen in the case below, where likelihood of confusion was found for goods in Class 25.

Earlier sign	Contested sign	Case No
	FISHBONE	T-415/09 (appeal dismissed C-621/11P)

In a similar way, the visual impression for marks covering **video games** has also been held to be particularly relevant because these goods are normally purchased after a comprehensive examination of their respective specifications and technical characteristics, firstly upon the basis of information that appears in specialist catalogues or on the internet, and then at the point of sale. For these reasons, the visual differences were key to the finding of no likelihood of confusion below (judgment of 08/09/2011, T-525/09, Metronia, EU:T:2011:437, § 38-47).

Earlier sign	Contested sign	Case No
		T-525/09

The visual similarity between signs may also have an increased importance where the goods are **ordinary consumer products (e.g. goods in Classes 29 and 30)** that are most commonly purchased in supermarkets or establishments where goods are arranged on shelves and where consumers are guided more by the visual impact of the mark they are looking for. Consequently, for such goods the visual differences were central to a finding of no likelihood of confusion in the UK between the marks below.

Earlier sign	Contested sign	Case No
	EGLÉFRUIT	T-488/07

However, the broad principle above does not mean that for goods that are normally purchased visually, the phonetic impression can be overlooked. This latter point was highlighted in a case involving the marks below where the General Court, confirming the finding of a likelihood of confusion, held that although **computers and computer accessories** are sold to consumers 'as seen' on shelves in self-service areas, the phonetic identity between the marks at issue was, in this case, at least as important as their visual similarity because an oral discussion of the characteristics of the goods and their mark is also likely to take place at the time of purchase. Furthermore, those goods could be advertised orally, on radio or by other consumers.

Earlier sign	Contested sign	Case No
CMORE		T-501/08

## 4.2 Aural similarity

In contrast to the cases above, where visual similarity played a stronger role, similarity on the phonetic level may have more weight than similarity on the visual level when the goods at issue are traditionally ordered orally. This consideration came into play in the finding of likelihood of confusion in the case below, which dealt with **vehicle rental and associated services**, which are recommended and chosen orally in a significant number of cases.

Earlier sign	Contested sign	Case No
CICAR	ZIPCAR	T-36/07

Where goods are ordered orally, the phonetic perception of the sign may also be influenced by factors such as the likely presence of various other sounds perceived by the recipient of the order at the same time. Such considerations are relevant where the goods in question are normally ordered at sales points with an increased noise factor, such as **bars or nightclubs**. In such cases, attaching particular importance to the phonetic similarity between the signs at issue may be appropriate. These considerations came into play in the finding of likelihood of confusion between the marks below for certain goods in Class 33 (judgment of 15/01/2003, T-99/01, *Mystery*, EU:T:2003:7, § 48).

Earlier sign	Contested sign	Case No
MIXERY		T-99/01

Similarly, a particular method or customary way of ordering goods may mean increased importance being attributed to the phonetic similarity between the signs. For instance, the General Court has held that in the **wines sector**, consumers usually describe and recognise wine by reference to the verbal element that identifies it, in particular in bars and restaurants, in which wines are ordered orally after their names have been seen on the wine list (judgments of 23/11/2010, T-35/08, *Artesa Napa Valley*, EU:T:2010:476, § 62; 13/07/2005, T-40/03, *Julián Murúa Entrena*, EU:T:2005:285, § 56; 12/03/2008, T-332/04, *Coto d'Arcis*, EU:T:2008:69, § 38). Accordingly, in such cases, it may be appropriate to attach particular importance to the phonetic similarity between the signs at issue. These considerations came into play in the finding of likelihood of confusion between the marks below for wine despite their considerable visual differences.

Earlier sign	Contested sign	Case No
<p>MURÚA</p>		<p>T-40/03</p>
 <p>ARTESO</p>		<p>T-35/08</p>

Nevertheless, the broad principle above does not mean that the visual impression can be overlooked for goods normally purchased orally. Indeed, the General Court has held that although preponderant importance had sometimes been accorded to the phonetic perception of marks for beverages, the phonetic dissimilarities of the marks did not merit particular importance where the specific beverages were widely distributed and sold not only in specialist shops, where they would be ordered orally, but in large shopping centres as well, where they would be purchased visually (judgment of 03/09/2010, T-472/08, 61 a nossa alegria, EU:T:2010:347, § 106).

### 4.3 Conclusion



The circumstances set out above demonstrate that in certain situations the Office should grant preferential consideration to the visual or aural perception of marks depending on how the goods and services at issue are ordered or purchased. However, even in these situations identical or highly similar visual or aural elements cannot be entirely overlooked because all the relevant factors are interlinked and interdependent, and each set of circumstances must be examined on a case-by-case basis.

## 5 Impact of the Conceptual Similarity of the Signs on Likelihood of Confusion


A conceptual **similarity** between signs with **analogous** semantic content may give rise to a likelihood of confusion where the earlier mark is particularly distinctive (judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24, where the signs shared the broader concept of a 'bounding feline', but did not evoke the same animal: a puma in the earlier mark and a cheetah in the contested mark).



However, exceptionally, where the signs have the **same** distinctive concept in common accompanied by visual similarities between the signs, this may lead to a likelihood of confusion even in the absence of a particularly high distinctiveness of the earlier mark, as illustrated by the following example.

Earlier sign	Contested sign	Case No
		<p>Joined Cases T-81/03, T-82/03 and T-103/03</p>
<p>G&amp;S: Classes 32, 33  <i>Territory:</i> Spain (where 'venado' means 'deer')  <i>Assessment:</i> The Court found that the signs had the same concept and that there was significant visual similarity. In the absence of a clear semantic link between a deer or a deer's head and alcoholic or non-alcoholic beverages, the Court found it impossible to deny that the concept of a deer's head portrayed facing forward inside a circle had at least average distinctive character for designating beverages (para. 110.). Enhanced distinctiveness was not considered – likelihood of confusion (for the Spanish public).</p>		

A conceptual similarity between the signs may not be sufficient to outweigh the visual and phonetic differences, where the concept in common is non-distinctive.

Earlier sign	Contested sign	Case No
<p>K2 SPORTS</p>		<p>T-54/12</p>
<p>G&amp;S: Classes 18, 25, 28  <i>Territory:</i> Germany and the UK  <i>Assessment:</i> Contrary to the Board's finding that there is no conceptual similarity, the term 'sport', notwithstanding its descriptive character, refers to the same concept and leads to the conclusion that there is a degree of conceptual similarity. The Court concluded that this similarity was weak in the context of the overall impression of the signs and in particular of the very weak distinctive character of this term. However, the weak conceptual similarity did not offset the significant visual and phonetic differences between the signs (para. 49) – no likelihood of confusion.</p>		

According to case-law, the conceptual differences between signs may counteract their visual and phonetic similarity (judgment of 12/01/2006, C-361/04, PICARO, ECLI:EU:C:2006:25, § 20). According to Office practice, when a similarity is found in one aspect (visual/phonetic/conceptual), the examination of likelihood of confusion must continue<sup>1</sup>. Therefore, the question whether the conceptual dissimilarity is sufficient to counteract the visual and/or phonetic similarity between the marks has to be examined in the global assessment of the likelihood of confusion. Furthermore, as explained above in Chapter 4, 'Comparison of signs', paragraph 3.4.4, the conceptual

<sup>1</sup> See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 1.3.

dissimilarity can be found only if each trade mark has a clear concept that may be immediately grasped by the public and these concepts are different.

The conceptual difference between the signs may not be sufficient to neutralise the visual and phonetic similarities.

Earlier sign	Contested sign	Case No
MUNDICOLOR	MUNDICOR	Joined Cases T-183/02 and T-184/02
<p>G&amp;S: Class 2                      Territory: Spain                      Assessment: Whilst 'MUNDICOLOR' is to a certain extent evocative of 'colours of the world' or 'the world in colours' for the Spanish public, it cannot be regarded as having any clear and specific meaning. In the mark applied for, the same prefix is accompanied by the suffix 'cor', a term which has no meaning in the Spanish language. Therefore, notwithstanding the evocative nature of the prefix 'mundi' (world), the latter is ultimately devoid of any concept for that public. As neither of the signs has a clear and specific meaning likely to be grasped immediately by the public, any conceptual difference between them is not such as to counteract their visual and aural similarities (paras 90-99) – likelihood of confusion.</p>		

The finding of conceptual similarity must therefore be followed by a careful assessment of the inherent and acquired distinctiveness of the earlier trade mark.

## 6 Impact on Likelihood of Confusion of Components that are Non-distinctive or Distinctive only to a Low Degree

When assessing the similarity of the signs, an analysis of whether the coinciding components are descriptive, allusive or otherwise 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. 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 elements.<sup>2</sup>

The Office and a number of trade mark offices of the European Union have agreed on a **Common Practice** under the European Trade Mark and Designs Network with regard to the impact on likelihood of confusion of components that are non-distinctive or Distinctive only to a low degree.


### 6.1 Common components with low distinctiveness

According to the Common Practice, when the marks share an element with **low distinctiveness**, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks. The assessment will take into account the similarities/differences and distinctiveness of the non-coinciding components.

<sup>2</sup> See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the earlier mark.

A coincidence in an element with a low degree of distinctiveness **will not normally on its own lead to likelihood of confusion**. However, there may be likelihood of confusion if the other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar. There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.

The following are examples agreed in the context of the Common Practice, where the common component(s) is/are considered to possess a low degree of distinctiveness<sup>3</sup>.

Earlier mark	Contested mark	Goods/services	Outcome
MORELUX	INLUX	Class 44: Beauty Treatment	No likelihood of confusion
DURALUX	VITALUX	Class 44: Beauty Treatment	No likelihood of confusion
		Class 32: Fruit juices	No likelihood of confusion
		Class 9: Credit cards	No likelihood of confusion
		Class 32: Fruit juices	No likelihood of confusion
		Class 30: Tea	No likelihood of confusion
		Class 9: Credit cards	No likelihood of confusion
COSMEGLOW	COSMESHOW	Class 3: Cosmetics	Likelihood of confusion
		Class 11: Refrigerators	Likelihood of confusion

<sup>3</sup> For the purposes of the Common Practice, all the other factors that may be relevant for the global appreciation of likelihood of confusion are deemed not to affect the outcome. It is also considered that the goods and services are identical.






		Class 43: Holiday accommodation services	Likelihood of confusion
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## 6.2. Common components with no distinctiveness



According to the Common Practice, when marks share an element with **no distinctiveness**, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks. The assessment will take into account the similarities/differences and distinctiveness of the non-coinciding components.

A coincidence only in non-distinctive components **does not lead to likelihood of confusion**. However, when marks also contain other figurative and/or word elements that are similar, there will be likelihood of confusion if the overall impression of the marks is highly similar or identical.

The following are examples agreed in the context of the Common Practice, where the common component(s) is/are considered to possess no distinctiveness<sup>4</sup>.

Earlier mark	Contested mark	Goods/services	Outcome
GREENGRO	GREENFLUX	Class 19: Building materials Class 37: Construction services	No likelihood of confusion
BUILDGRO	BUILDFLUX	Class 19: Building Materials Class 37: Construction Services	No likelihood of confusion
	SMARTPHONES.NET	Class 9: Mobile phones	No likelihood of confusion
		Class 36: Financial Services	No likelihood of confusion
		Class 29: Fish	No likelihood of confusion

<sup>4</sup> For the purposes of the Common Practice, all the other factors that may be relevant for the global appreciation of likelihood of confusion are deemed not to affect the outcome. It is also considered that the goods and services are identical.

CRE-ART	PRE-ART	Class 41: Art gallery services	Likelihood of confusion
TRADENERGY	TRACENERGY	Class 9: Solar energy collectors for electricity generation	Likelihood of confusion
		Class 9: Solar energy collectors for electricity generation	Likelihood of confusion

## 7 Specific Cases

### 7.1 Short signs

As indicated before, the Courts have not exactly defined what a short sign is. However, signs with three or fewer letters/numbers are considered by the Office as short signs.

It should be noted that the General Court held that the global assessment of the likelihood of confusion between signs consisting of a single letter (or a combination of letters not recognisable as a word) **follows the same rules** as that in respect of word signs comprising a word, a name or an invented term (judgments of 06/10/2004, T-117/03-T-119/03 and T-71/03, NL, EU:T:2004:293, § 47-48, and 10/05/2011, T-187/10, G, EU:T:2011:202, § 49).

In the assessment of the likelihood of confusion it is important to establish the degree of **inherent distinctiveness** of the earlier trade mark, and therefore its scope of protection. See in this respect Chapter 5 of this Section, Distinctiveness of the earlier mark, and the specific section on short signs.

As to the overall assessment of likelihood of confusion, the Court made it clear that the fact that two trade marks consisting of the same letter (or of the same sequence of letters) are found to be identical from an aural and a conceptual point of view is relevant when it comes to assessing the existence of a likelihood of confusion. In such cases, it is only when the later trade mark causes a **sufficiently different visual impression** that a likelihood of confusion can be safely ruled out (judgment of T-187/10, G, EU:T:2011:202, § 60).

Consequently, a likelihood of confusion can be safely excluded when two conflicting signs, albeit containing or consisting of the same single letter or a combination of letters not recognisable as a word, 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.

Where the opponent has successfully proven that its earlier mark has acquired enhanced distinctiveness through intensive use or reputation, the impact thereof on the final outcome has to be carefully assessed. Firstly, enhanced distinctiveness on the part of an earlier mark containing or consisting of a single letter or a combination of letters cannot justify a finding of a likelihood of confusion if the overall visual impression of the signs is so different as to safely set them apart. Secondly, if the evidence shows

use of a single letter or combination of letters stylised or accompanied by additional figurative elements, the benefit of the resulting broader scope of protection accrues to the form in which it was used and not to the single letter as such or any other stylised variation.

## 7.2 Name/Surnames

### 7.2.1 Names



In principle, there are no specific criteria to be taken into account when likelihood of confusion between names is assessed. However, because of the very nature of names and surnames, there are certain aspects that come into play (as we shall see below), such as whether a given name and/or surname is common or not in the relevant territory, that have to be carefully considered and balanced.

### 7.2.2 Business names in combination with other components

When assessing likelihood of confusion in relation to composite signs that contain several verbal elements, one of which might be seen as being a business name, i.e. indicating the company ‘behind’ the trade mark, an overall assessment must be done in order to identify which element functions as the trade mark of the goods and services concerned. Factors to be taken into account include the distinctiveness of each element as well as the size and/or space they occupy in a figurative mark, which determine the dominant element of the conflicting signs.

Where the business name is not the dominant element, although each of the elements making up the sign might have their own independent distinctive role, consumers are likely to focus more on the element that would be seen as identifying the specific product line rather than on the element that would be perceived (because it is preceded by ‘by’ or another equivalent term) as identifying either the company who has control of the products concerned or the designer who created the product line.

Therefore, whenever there is a sufficient degree of similarity between the component that would be perceived as the trade mark and a conflicting sign, in principle there will be likelihood of confusion (provided the other relevant factors are met).

Earlier sign	Contested sign	Case No
		T-43/05
<p>G&amp;S: Class 25                      Territory: Denmark, Finland, Sweden                      Assessment: ‘The element “by CAMPER” will be perceived as subsidiary, also due to the fact that the relevant public will perceive it as a mere indication of the undertaking producing the goods in question.’ Therefore, the relevant consumer will focus their attention on the word ‘BROTHERS’ and might attribute a common origin to the goods concerned (paras 65 and 86) – likelihood of confusion.</p>		

### 7.2.3 First and family names


The perception of signs made up of personal names may vary from country to country within the European Union. Family names have, in principle, a higher intrinsic value as

indicators of the origin of goods or services than first names. This is because common experience shows that the same first names may belong to a great number of people who have nothing in common, whereas the presence of the same surname (provided it is not common in the relevant territory) could imply the existence of some link between them (identity of the persons or a family link). In determining whether, in a particular country, the relevant public generally attributes greater distinctiveness to the surname than the forename, the case-law of that country, although not binding on the Office or the EU courts, may provide useful guidelines (judgment of 01/03/2005, T-185/03, Enzo Fusco, EU:T:2005:73, § 52).

There are instances where the applicants invoke, as a defence, their right to use their name. However, such arguments are not valid in opposition proceedings, since it does not influence the issue of whether there will be likelihood of confusion on the part of the public. Furthermore, the registration of trade marks does not hinder the use of names of natural persons, due to the special protection provided by Article 12(a) EUTMR and the relevant national trade mark laws according to Article 6(1)(a) of the Trade Mark Directive.

- **First name against the same first name or slight variations thereof**

The rule of thumb is that when two conflicting signs consist exclusively of the same first name, consumers are likely to perceive the similar/identical goods/services marketed under those marks as coming from the same source. It is clear that in the absence of any differentiating element, **likelihood of confusion** is the necessary conclusion.

Earlier sign	Contested sign	Case No
GIORDANO	GIORDANO	T-483/08
<p>G&amp;S: Classes 18, 25                      Territory: Portugal                      Assessment: The two word marks at issue are identical, which increases the likelihood that consumers might perceive the goods marketed under those marks as coming from the same source. Moreover, the applicant has not shown that the Italian first name 'Giordano' which makes up both trade marks is common in Portugal (para. 32) – likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
ELISE		T-130/09
<p>G&amp;S: Classes 9, 42                      Territory: Portugal                      Assessment: The Court considers that even if it is not certain that the relevant public throughout the European Union will necessarily perceive the signs at issue as being specifically diminutives of the name 'Elizabeth', the relevant public will certainly regard them 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 being diminutives of the full forename Elizabeth (para. 36) – likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
GISELA	GISELE	R 1515/2010-4
<p>G&amp;S: Class 25                      Territory: EU                      Assessment: The marks compared are both variations of the female first name Giselle of old German and French origin and are overall very similar, so that a likelihood of confusion exists (paras 14, 15 and 20) – likelihood of confusion.</p>		

- **First name against identical first name plus surname**

Whenever two signs share the same first name and one of the two also contains a surname, and when the **first name** is likely to be perceived as a **common** (let alone very common) name in the relevant territory, the rule of thumb is that there will be **no likelihood of confusion**, since consumers will be aware that there are many people with that name.

Earlier sign	Contested sign	Case No
LAURA	LAURA MERCIER	R 0095/2000-2
G&S: Class 3 Territory: Spain Assessment: In the Board's view, the average Spanish consumer who is familiar with the trade mark 'LAURA' for perfumes will not be confused. Conceptually, 'LAURA' will be seen as a common first name in Spain. It is highly unlikely that the average Spanish consumer would consider linking the more specific name 'LAURA MERCIER' with 'LAURA' (para. 16) – no likelihood of confusion.		

An **exception** applies when a given first name is likely to be perceived as **uncommon** in the relevant territory. In such cases, the presence of this uncommon element is likely to focus the consumers' attention and they could be misled into attributing a common origin to the goods/services concerned.

Earlier sign	Contested sign	Case No
AMANDA	AMANDA SMITH	R 1892/2007-2
G&S: Classes 29, 30 Territory: Spain Assessment: The term 'SMITH' in the trade mark application will be perceived by the Spanish consumers as a common Anglo-Saxon surname and will have less weight than the first name 'AMANDA' (which is less common in Spain) (para. 31) – likelihood of confusion.		
Earlier sign	Contested sign	Case No
ROSALIA	ROSALIA DE CASTRO	T-421/10 (appeal dismissed C-649/11P)
G&S: Classes 32, 33, 35 Territory: Spain Assessment: The signs are visually and conceptually similar, and aurally very similar. The products are identical. The services are similar. Neither the name ROSALIA nor the surname DE CASTRO is common in Spain. None of these elements has a higher distinctive character than the other (paras 50-51) – likelihood of confusion.		

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



When two conflicting signs contain the same first name but are followed by clearly different surnames, the rule of thumb is that there is **no likelihood of confusion**. Consumers will realise that they distinguish goods/services of different, unconnected undertakings.

Invented example: 'Michael Schumacher'/'Michael Ballack' (no likelihood of confusion).

However, when the overall impression created by the signs is one of clear similarity, i.e. the differences between the signs are lost in the overall impression created by the



signs, then, applying the normal criteria, the outcome will be that there is **likelihood of confusion**.

Earlier sign	Contested sign	Case No
 (Emidio Tucci fig.)		T-8/03 and joined cases R 0700/2000-4 and R 0746/2000-4 Confirmed by C-104/05 P
G&S: Classes 3, 18, 24, 25 Territory: Spain Assessment: Both marks consist of the combination of a first name and a surname and make a similar overall impression – likelihood of confusion.		

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

When the conflicting signs contain the same surname preceded by different first names, the outcome will very much depend on the perception of the surname in the relevant territory. The less common a surname is, the more likely it is that it will attract the consumers' attention (regardless of whether the first names are common or not).

Earlier sign	Contested sign	Case No
ANTONIO FUSCO	ENZO FUSCO	T-185/03
G&S: Classes 18, 25 Territory: Italy Assessment: Since it was contested that 'Fusco' was not one of the most common surnames in Italy, the Court considered that, since the Italian consumer generally attributes greater distinctiveness to the surname than the forename, it will keep in mind the (neither rare nor common) surname 'Fusco' rather than the (common) forenames 'Antonio' or 'Enzo'. Therefore, a consumer faced with goods bearing the trade mark applied for, ENZO FUSCO, might confuse it with the earlier trade mark, ANTONIO FUSCO, so that there is a likelihood of confusion (paras 53 and 67) – likelihood of confusion.		

In contrast, when two marks have the same surname and this is likely to be perceived as common (let alone very common) in the relevant territory, consumers will not normally be misled into attributing a common origin to the goods/services concerned (judgments of 01/03/2005, T-169/03, Sissi Rossi, EU:T:2005:72, § 82-83; and 24/06/2010, C-51/09 P, Barbara Becker, EU:C:2010:368, § 36). Consumers are used to trade marks that contain common surnames and will not blindly assume that every time a common surname occurs in two conflicting signs the goods/services in question all emanate from the same source.

Earlier sign	Contested sign	Case No
VITTORIO ROSSI	<b>CHRISTIAN ROSSI</b>	R 0547/2010-2
G&S: Classes 18, 25 Territory: EU Assessment: Not only are consumers throughout the EU aware of the fact that people share the same surname without being necessarily related, but they will also be able to distinguish the Italian surname 'ROSSI' bearing two different first names in the fashion field (paras 33-35) – no likelihood of confusion.		


- **First name plus surname against different first name plus identical surname conjoined in a single word**

In cases where one of the conflicting signs consists of a name and surname and the other of a single word that will however be broken down into separate components by at least part of the relevant public, due to the recognisable presence of a name and surname combined to form the one word making up that sign, the result will be one of likelihood of confusion whenever the overall impression created by the marks is one of similarity.

Earlier sign	Contested sign	Case No
PETER STORM	Peerstorm	T-30/09
<p>G&amp;S: Class 25                      Territory: EU                      Assessment: Both of the marks at issue are made up of a first name and a surname. It is common ground that the element 'storm' in the two marks at issue can be a surname. The elements 'peer' and 'peter' in the mark applied for and the earlier mark respectively are first names. In particular in the Nordic countries and in Germany, Peer is a first name. The fact that the mark applied for is written as one word cannot cast doubt on the finding that the two marks at issue are made up of a first name and a surname (para. 66) – likelihood of confusion.</p>		

- **Surname against first name plus identical surname**

When two signs contain the same surname but only one of them also contains a given first name, the rule of thumb is that normally there will be **likelihood of confusion**. Consumers might be misled and attribute a common origin to the goods/services concerned. The presence of a first name in one of the conflicting signs will not suffice to safely distinguish the signs in the minds of the consumers. The surname alone will be perceived as the short version of the full name, thus identifying the same origin.



Earlier sign	Contested sign	Case No
MURÚA		T-40/03
<p>G&amp;S: Class 33                      Territory: Spain                      Assessment: It is common ground that the Spanish public will perceive the verbal element making up the trade mark applied for as a proper name (first name plus surnames) and the earlier trade mark as a surname. It is quite likely that the relevant public will regard the addition, in the trade mark applied for, of the first name 'Julián' and the surname 'Entrena' merely as a way of distinguishing a range of wines produced by the undertaker that owns the earlier trade mark or, at least, an undertaking economically linked to the intervener (paras 42 and 78) – likelihood of confusion.</p>		
Earlier signs	Contested sign	Case No
BRADLEY	VERA BRADLEY	R 1918/2010-1
<p>G&amp;S: Class 11                      Territory: EU                      Assessment: The sign for which the EUTM applied for seeks protection consists of the term 'Vera Bradley', which will most probably be seen as the name (forename and family name) of a person, fictitious or real. It is composed of the first name 'VERA', which is a common name for women in many</p>		

EU countries such as, e.g. the Czech Republic, Germany, Ireland, the Netherlands, Austria, Slovenia and the United Kingdom, and the surname 'BRADLEY', which is an English family name. The latter surname is not a common family name, neither in English-speaking countries nor in any other countries within the European Union. Even if consumers might be able to distinguish between the signs due to the element 'Vera', which has no counterpart in the earlier trade mark, they will see a specific line of products or an extended form of the mark. Consequently, consumers might believe that the trade marks belong to the same undertakings or economically linked undertakings (paras 36-37 and 52) – likelihood of confusion.

### 7.3 Colour marks per se

When likelihood of confusion of two colour marks per se is assessed, a phonetic or conceptual comparison of the signs cannot be made and the visual similarities will depend on the colour of the signs.

In the overall assessment, the Office takes into account the fact that there is a 'public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought' (judgments of 24/06/2004, C-49/02 Blau/Gelb, EU:C:2004:384, § 41, and 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 52-56). The inherent distinctiveness of colour marks per se is limited. The scope of protection should be limited to identical or almost identical colour combinations.

Earlier sign	Contested sign	Case No
		<p>R 0755/2009-4</p>
<p>G&amp;S: Class 8                      Territory: EU                      Assessment: In the case at hand, the colour combinations, identified by different colour codes, are not sufficiently close to lead to a likelihood of confusion, taking into account that the inherent distinctiveness is limited (para. 18). The BoA referred to CJEU judgments and public interest in ensuring that colours remain available to competitors (para. 19). The opponent did not prove enhanced distinctive character (para. 25) – no likelihood of confusion.</p>		