

***GUIDELINES FOR EXAMINATION IN THE
EUROPEAN UNION INTELLECTUAL
PROPERTY OFFICE ON EUROPEAN UNION
TRADE MARKS***

PART C

OPPOSITION

SECTION 2

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

CHAPTER 1

GENERAL PRINCIPLES

Table of Contents

1	Introduction.....	3
2	Article 8(1) EUTMR	4
2.1	Article 8(1)(a) EUTMR – double identity	4
2.3	Interrelation of Articles 8(1)(a) and 8(1)(b) EUTMR	5
3	The Notion of Likelihood of Confusion.....	5
3.1	Introduction	5
3.2	Likelihood of confusion and likelihood of association.....	6
3.3	Likelihood of confusion and enhanced distinctiveness	7
3.4	Likelihood of confusion: questions of fact and questions of law	8
3.4.1	Fact and law – similarity of goods/services and of signs	8
3.4.2	Fact and law – evidence	9
4	Evaluation of the relevant Factors for establishing a likelihood of confusion.....	9
	Where the EUTM applicant relies on a reduced scope of protection (weakness) of the earlier trade mark, only the date of the decision is relevant.	10
	Annex	11

1 Introduction

This chapter provides an introduction to and overview of the concepts of (i) double identity and (ii) likelihood of confusion that are applied in situations of conflict between trade marks in opposition proceedings under Article 8(1) of Council Regulation (EU) No 207/2009 of 26 February 2009 on the European Union trade mark (the 'EUTMR').

The paragraphs below set out the nature of these concepts and their legal underpinning as determined by the relevant laws and as interpreted by the Court of Justice of the European Union (the 'Court')¹.

The legal concepts of double identity and likelihood of confusion are used to protect trade marks and, at the same time, to define their scope of protection. It is thus important to bear in mind what aspects or functions of trade marks merit protection. Trade marks have various functions. The most fundamental one is to act as 'indicators of origin' of the commercial provenance of goods/services. This is their 'essential function'. In the 'Canon' judgment the Court held that:

... according to the settled case-law of the Court, the **essential function of the trade mark is to guarantee the identity of the origin of the marked product** to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others that have another origin (emphasis added).

(Judgment of 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 28).

The essential function of trade marks as indicating origin has been emphasised repeatedly and has become a precept of EU trade mark law (judgments of 18/06/2002, C-299/99, Remington, EU:C:2002:377, § 30; 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 23).

Whilst indicating origin is the essential function of trade marks, it is not the only one. Indeed, the term, 'essential function' implies other functions. The Court alluded to the other functions of trade marks several times (e.g. judgments of 16/11/2004, C-245/02, Budweiser, EU:C:2004:717, § 59; 25/01/2007, C-48/05, Opel, EU:C:2007:55, § 21) but addressed them directly in the 'L'Oréal' judgment, where it stated that the functions of trade marks include:

... **not only the essential function** of the trade mark, which is to guarantee to consumers the origin of the goods or services, **but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising** (emphasis added).

(Judgment of 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 58-59; 23/03/2010, C-236/08 –).

In examining the concepts of double identity and likelihood of confusion, this chapter touches upon several themes that are explained comprehensively in the chapters of

¹The Court was in fact often interpreting Articles 4 and 5 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 (the 'Directive') that for the purposes of interpretation are broadly comparable to Articles 8 and 9 EUTMR.

the Guidelines that follow. A summary of the key cases from the Court dealing with the core principles and concepts of likelihood of confusion is added in Annex.

2 Article 8(1) EUTMR

Article 8 EUTMR enables the proprietor of an **earlier right** to oppose the registration of later EUTM applications in a range of situations. The present chapter will concentrate on the interpretation of double identity and likelihood of confusion within the meaning of Article 8(1) EUTMR.

An opposition pursuant to Article 8(1) EUTMR can be based on earlier trade mark registrations or applications (Article 8(2)(a) and (b) EUTMR) and earlier well-known marks (Article 8(2)(c) EUTMR)².

2.1 Article 8(1)(a) EUTMR – double identity

Article 8(1)(a) EUTMR provides for oppositions based on identity. It provides that, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) EUTMR, a EUTM application will not be registered:

if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected.

The wording of Article 8(1)(a) EUTMR clearly requires identity between **both** the signs concerned **and** the goods/services in question. This situation is referred to as ‘double identity’. Whether there is double identity is a **legal finding** to be established from a direct comparison of the two conflicting signs and the goods/services in question³. Where double identity is established, the opponent is not required to demonstrate likelihood of confusion in order to prevail; the protection conferred by Article 8(1)(a) EUTMR is absolute. Consequently, where there is double identity, there is no need to carry out an evaluation of likelihood of confusion, and the opposition will automatically be upheld.

2.2 Article 8(1)(b) EUTMR – likelihood of confusion

Article 8(1)(b) EUTMR states that, upon opposition, a EUTM application shall not be registered:

...if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks **there exists a likelihood of confusion** on the part of the public in the territory in which the earlier trade mark is protected; the **likelihood of**

² Further guidance on earlier well-known trade marks is found in the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR).

³ Comprehensive guidance on the criteria to find identity between goods and services and between signs can be found in the respective paragraphs of the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services and Chapter 4, Comparison of Signs.

confusion includes the likelihood of association with the earlier trade mark (emphasis added).

Hence, in contrast to situations of double identity as seen above, in cases of mere similarity between the signs and the goods/services, or identity of only one of these two factors, an earlier trade mark may successfully oppose a EUTM application under Article 8(1)(b) **only if** there is a likelihood of confusion.

2.3 Interrelation of Articles 8(1)(a) and 8(1)(b) EUTMR

Although the specific conditions under Articles 8(1)(a) and 8(1)(b) EUTMR differ, they are related. Consequently, in oppositions dealing with Article 8(1) EUTMR, if Article 8(1)(a) is the only ground claimed but identity between the signs and/or the goods/services cannot be established, the Office will still examine the case under Article 8(1)(b) EUTMR that requires at least similarity between signs and goods/services and likelihood of confusion. Similarity covers situations where both marks and goods/services are similar and also situations where the marks are identical and the goods/services are similar or vice versa.

Likewise, an opposition based only on Article 8(1)(b) EUTMR that meets the requirements of Article 8(1)(a) EUTMR will be dealt with under the latter provision without any examination under Article 8(1)(b) EUTMR.

3 The Notion of Likelihood of Confusion

3.1 Introduction

The assessment of likelihood of confusion is a calculus applied in situations of conflict between trade marks in proceedings before the Office, the General Court and the Court of Justice as well as in infringement proceedings before the courts of the Member States. However, neither the EUTMR nor the Directive contains a definition of likelihood of confusion or a statement as to precisely what ‘confusion’ refers to.

As shown below, it has been settled case-law for some time now that fundamentally the concept of likelihood of confusion refers to situations where:

- (1) the public directly confuses the conflicting trade marks, i.e. mistakes the one for the other;
- (2) the public makes a connection between the conflicting trade marks and assumes that the goods/services in question are from the same or economically linked undertakings (likelihood of association).

These two situations are further discussed below (paragraph 3.2). The mere fact that the perception of a later trade mark brings to mind an earlier trade mark does not constitute likelihood of confusion.

The Court has also established the principle that ‘marks with a highly distinctive character, enjoy broader protection than marks with a less distinctive character’ (see paragraph 3.3 below).

Finally, the concept of likelihood of confusion as developed by the Court must be regarded as a legal concept rather than purely an empirical or factual assessment despite the fact that its analysis requires taking into account certain aspects of consumer cognitive behaviour and purchasing habits (see paragraph 3.4 below).

3.2 Likelihood of confusion and likelihood of association

The Court considered likelihood of confusion comprehensively in ‘Sabèl’ (judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528). The Directive’s equivalents of Article 8(1)(b) EUTMR and the eighth recital of the EUTMR clearly indicated that likelihood of confusion relates to confusion about the origin of goods/services, but the Court was required to consider what precisely this meant because there were opposing views on the meaning of, and the relationship between, ‘likelihood of confusion’ and ‘likelihood of association’, both of which are referred to in Article 8(1)(b) EUTMR.

This issue needed to be resolved because it was argued that likelihood of association was broader than likelihood of confusion as it could cover instances where a later trade mark brought an earlier trade mark to mind but the consumer did not consider that the goods/services had the same commercial origin⁴. Ultimately, the issue in ‘Sabèl’ was whether the wording ‘the likelihood of confusion includes the likelihood of association’ meant that ‘likelihood of confusion’ could cover a situation of association between trade marks that did not give rise to confusion as to origin.

The Court found that likelihood of association **is not an alternative** to likelihood of confusion, but that it merely serves to define its scope. Therefore, a finding of likelihood of confusion requires that there be confusion as to origin.

In ‘Canon’ (paras 29-30), the Court clarified the scope of confusion as to origin when it held that:

... the risk that the public might believe that the goods and services in question come **from the same undertaking or, as the case may be, from economically linked undertakings**, constitutes a likelihood of confusion ... there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings (emphasis added).

As seen above, likelihood of confusion relates to confusion as to commercial origin including economically-linked undertakings. What matters is that the public believes that the **control** of the goods or services in question is in the hands of a single undertaking. The Court has not interpreted **economically-linked undertakings** in the context of likelihood of confusion, but it has done so with respect to the free movement of goods/services. In ‘Ideal Standard’ the Court held:

... A number of situations are covered: products put into circulation by the same undertaking, by a licensee, by a parent company, by a subsidiary of the same group, or by an exclusive distributor.

⁴The concept came from Benelux case-law and applied inter alia to non-reputed marks.

... In all the cases mentioned, control [is] in the hands of a single body: the group of companies in the case of products put into circulation by a subsidiary; the manufacturer in the case of products marketed by the distributor; the licensor in the case of products marketed by a licensee. In the case of a licence, the licensor can control the quality of the licensee's products by including in the contract clauses requiring the licensee to comply with his instructions and giving him the possibility of verifying such compliance. The origin that the trade mark is intended to guarantee is the same: it is not defined by reference to the manufacturer but by reference to the point of control of manufacture.

(Judgment of 22/06/1994, C-9/93, Ideal Standard, EU:C:1994:261, § 34 and 37).

Consequently, economic links will be presumed where the consumer assumes that the respective goods or services are marketed under the control of the trade mark proprietor. Such control can be assumed to exist in the case of enterprises belonging to the same group of companies and in the case of licensing, merchandising or distribution arrangements as well as in any other situation where the consumer assumes that the use of the trade mark is normally possible only with the agreement of the trade mark proprietor.

Therefore, the likelihood of confusion covers situations where

- (i) the consumer directly confuses the trade marks themselves or where
- (ii) the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically-linked undertakings.

Hence, if the perception of a later trade mark merely brings to mind an earlier trade mark, but the consumer does not assume the same commercial origin, then this link does not constitute likelihood of confusion despite the existence of a similarity between the signs⁵.

3.3 Likelihood of confusion and enhanced distinctiveness

The distinctiveness of the earlier trade mark has been held by the Court to be an important consideration when assessing likelihood of confusion, since:

- the more distinctive the earlier trade mark, the greater will be the likelihood of confusion (see `Sabèl`, para. 24);
- trade marks with a highly distinctive character enjoy broader protection than trade marks with a less distinctive character (see in this regard `Canon`, para. 18).

One consequence of these findings is that the enhanced distinctiveness of the earlier mark may be a decisive factor towards establishing a likelihood of confusion when the similarity between the signs and/or the goods and services is low (judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

⁵Although such a situation could take unfair advantage of, or be detrimental to, the distinctive character or the reputation of an earlier mark under Article 8(5) EUTMR, see the Guidelines Part C, Opposition, Section 5, Trade marks with reputation Article 8(5) EUTMR.

3.4 Likelihood of confusion: questions of fact and questions of law

The concept of likelihood of confusion is a legal concept rather than a mere factual evaluation of the rational judgments and emotional preferences that inform the consumer's cognitive behaviour and purchasing habits. Therefore, assessment of likelihood of confusion depends on both legal questions **and** facts.

3.4.1 Fact and law – similarity of goods/services and of signs

Determining the relevant factors for establishing likelihood of confusion and whether they exist is a question of law, that is to say, these factors are established by the relevant legislation, namely, the EUTMR and case-law.

For instance, Article 8(1) EUTMR establishes that the identity/similarity of goods/services is a condition for likelihood of confusion. The identification of the relevant factors for evaluating whether this condition is met is also a question of law.

The Court has identified the following factors for determining whether goods/services are similar:

- their nature
- their intended purpose
- their method of use
- whether they are complementary or not
- whether they are in competition or interchangeable
- their distribution channels/points of sale
- their relevant public
- their usual origin.

(See C-39/97 'Canon').

All these factors are legal concepts and determining the criteria to evaluate them is also a **question of law**. However, it is a **question of fact** whether, and to what degree, the legal criteria for determining, for instance, 'nature', are fulfilled in a particular case.

By way of example, *cooking fat* does not have the same nature as *petroleum lubricating oils and greases* even though both contain a fat base. *Cooking fat* is used in preparing food for human consumption, whereas *oils and greases* are used for lubricating machines. Considering 'nature' to be a relevant factor in the analysis of similarity of goods/services is a matter of **law**. On the other hand, it is a matter of **fact** to state that cooking fat is used in preparing food for human consumption and that oils and greases are used for machines.

Similarly, when it comes to the comparison of signs, Article 8(1) EUTMR establishes that the identity/similarity of signs is a condition for likelihood of confusion. It is a **question of law** that a conceptual coincidence between signs may render them similar for the purposes of the EUTMR, but it is a **question of fact**, for instance, that the word 'fghryz' does not have any meaning for the Spanish public.

3.4.2 Fact and law – evidence

In opposition proceedings, the parties must allege and, where necessary, prove the facts in support of their arguments. This follows from Article 76(1) EUTMR, according to which, in opposition proceedings, the Office shall be restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought.

Therefore, it is up to the opponent to state the facts on which the claim of similarity is based and to submit supporting evidence. For instance, where *wear-resistant cast iron* is to be compared with *medical implants*, it is not up to the Office to answer the question of whether *wear-resistant cast iron* is actually used for *medical implants*. This must be demonstrated by the opponent as it seems improbable (decision of 14/05/2002, R 0684/2000-4, Tinnox).

An admission by the applicant of legal concepts is irrelevant. It does not relieve the Office from analysing and deciding on these concepts. This is not contrary to Article 76(1) EUTMR that is binding on the Office **only** as regards the facts, evidence and arguments and does not extend to the legal evaluation of the same. Therefore, the parties may agree as to which facts have been proven or not, but they may not determine whether or not these facts are sufficient to establish the respective legal concepts, such as similarity of goods/services, similarity of the signs, and likelihood of confusion.

Article 76(1) EUTMR does not prevent the Office from taking into consideration, on its own initiative, facts that are already notorious or well known or that may be learned from generally accessible sources, for example, that PICASSO will be recognised by EU consumers as a famous Spanish painter (judgments of 22/06/2004, T-185/02, Picaro, EU:T:2004:189; 12/01/2006, C-361/04 P, Picaro, EU:C:2006:25). However, the Office cannot quote *ex officio* new facts or arguments (e.g. reputation or degree of knowledge of the earlier mark, etc.).

Moreover, even though certain trade marks are sometimes used in daily life as generic terms for the goods and services that they cover, this should never be taken as a fact by the Office. In other words, trade marks should never be referred to (or interpreted) as if they were a generic term or a category of goods or services. For instance, the fact that in daily life part of the public refers to 'X' when talking about *yoghurts* ('X' being a trade mark for *yoghurts*) should not lead to using 'X' as a generic term for *yoghurts*.

4 Evaluation of the relevant Factors for establishing a likelihood of confusion

4.1 The relevant point in time

The relevant moment in time for assessing a likelihood of confusion is the date the opposition decision is taken.

Where the opponent relies on *enhanced distinctiveness* of an earlier trade mark, the conditions for this must have been met on or before the filing date of the EUTM application (or any priority date) and must still be fulfilled at the point in time the decision is taken. Office practice is to assume that this is the case, unless there are indications to the contrary.

Where the EUTM applicant relies on a reduced scope of protection (weakness) of the earlier trade mark, only the date of the decision is relevant.

4.2 List of factors for assessing the likelihood of confusion

The likelihood of confusion is assessed in the following steps, taking into account multiple factors:

- Comparison of goods and services
- Relevant public and degree of attention
- Comparison of signs
- Distinctiveness of the earlier mark
- Any other factors
- Global assessment of likelihood of confusion

A separate chapter of the Guidelines is dedicated to each of the above factors and its specifics.

Annex

General principles coming from case-law (these are not direct citations)

Judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528
<ul style="list-style-type: none">- The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case (para. 22).- The appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, on the association that the public might make between the two marks and on the degree of similarity between the signs and the goods (para. 22).- 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 their distinctive and dominant components (para. 23).- The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (para. 23).- The more distinctive the earlier mark, the greater will be the likelihood of confusion (para. 24).- It is not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character (para. 24).- However, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion (para. 25).- The concept of likelihood of association is not an alternative to likelihood of confusion, but serves to define its scope (para. 18).- The mere association that the public might make between two marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion (para. 26).
Judgment of 29/09/1998, C-39/97, Canon, EU:C:1998:442
<ul style="list-style-type: none">- The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion (para. 29).- By contrast, there can be no such likelihood where the public does not think that the goods come from the same undertaking (or from economically-linked undertakings) (para. 30).- In assessing the similarity of the goods and services, all the relevant factors relating to those goods or services themselves should be taken into account (para. 23).- Those factors include, inter alia, their nature, the purpose for which they are used (the translation 'end users' in the official English language version is not correct) and their method of use, and whether they are in competition with each other or are complementary (para. 23).- A global assessment of the likelihood of confusion implies some interdependence between the relevant factors and in particular a similarity between the marks and between these goods or services. A lesser degree of similarity between the goods may be offset by a greater degree of similarities between the marks and vice versa (para. 17).- Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (para. 18).- Registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive (para. 19).- The distinctive character of the earlier mark and in particular its reputation must be taken into account when determining whether the similarity between the goods and services is enough to give rise to the likelihood of confusion (para. 24).- There may be a likelihood of confusion, even if the public thinks that these goods have different places of production (para. 30).

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

- The level of attention of the average consumer, who is deemed to be reasonably well-informed and reasonably observant and circumspect, varies according to the category of the goods and services in question (para. 26).
- However, account should be 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 his trust in the imperfect picture of them that he has kept in his mind (para. 26).
- When assessing the degree of visual, phonetic and conceptual similarity it can be appropriate to evaluate the importance attached to each by reference to the category of goods and the way they are marketed (para. 27).
- It is possible that mere aural similarity could lead to likelihood of confusion (para. 28).
- In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, an overall assessment needs to be made of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking (para. 22).
- In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public who, because of the mark, identifies the goods and services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (para. 23).
- It is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character (para. 24).

Judgment of 22/06/2000 C-425/98, Marca, EU:C:2000:339

- The reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense (para. 41).
- Article 5(1)(b) of the Directive cannot be interpreted as meaning that where:
 - a trade mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public, and
 - a third party, without the consent of the proprietor of the mark, uses, in the course of trade in goods or services that are identical with, or similar to, those for which the trade mark is registered, a sign that so closely corresponds to the mark as to give the possibility of its being associated with that mark,the exclusive right enjoyed by the proprietor entitles him to prevent the use of the sign by that third party if the distinctive character of the mark is such that the possibility of such association giving rise to confusion cannot be ruled out (emphasis added) (para. 42).

Judgment of 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594

- Where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark that has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (para. 37).