

**GUIDELINES FOR EXAMINATION IN THE
OFFICE FOR HARMONIZATION IN THE
INTERNAL MARKET (TRADE MARKS AND
DESIGNS) ON COMMUNITY TRADE MARKS**

PART C

OPPOSITION

SECTION 2

**DOUBLE IDENTITY AND LIKELIHOOD OF
CONFUSION**

CHAPTER 3

COMPARISON OF SIGNS

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1 Introduction

1.1 Overview

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.

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

The first step in assessing if a likelihood of confusion exists is to establish these five factors. The second step is to determine their relevance.

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

4.1 Similarity of the 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) CTMR (judgment of 23/01/2014, C-558/12 P, ‘Western Gold’, para. 44). If the signs are clearly dissimilar, the examination of likelihood of confusion will stop at this point.

1.2 General principles

1.2.1 Objective comparison

The comparison of signs is a so-called **objective comparison**, objective meaning that all elements of the signs are taken into account, irrespective of their distinctiveness or dominance. Therefore, the step-by-step methodology employed by the Office initially keeps the objective assessment of the similarity of the signs separate from the assessments of the distinctiveness of their component parts¹.

The finding of similarity between the signs, however, should not be considered conclusive for finding a likelihood of confusion. The Office’s objective comparison establishes that there is at least ~~a prima facie case for likelihood of confusion by confirming that there is~~ some degree of similarity between the signs. ~~Such a degree will, which is necessary to trigger (and be taken into account weighed in)~~ the Global Assessment, where all factors are considered when making a global appreciation of the likelihood of confusion².

¹ The Guidelines Concerning Opposition. Part 2: Double Identity and Likelihood of Confusion. Chapter 4: Distinctiveness and Chapter 5: Dominant elements.

² The Guidelines Concerning Opposition. Part 2: Double Identity and Likelihood of Confusion. Chapter 8: Global assessment.

~~If the signs are clearly dissimilar, the examination of likelihood of confusion will be terminated at this point.~~

This contrasts with other approaches that weigh up the distinctiveness of the various elements of the marks at the same time as assessing the similarity of the signs. Although the difference is one of method only and does not affect the ultimate finding of likelihood of confusion the Office follows the method first described for reasons of consistency of format.

The same method applies to the assessment of whether the signs are identical, which finding requires an objective coincidence in all elements irrespective of whether they are distinctive and/or dominant.

1.2.2 Three aspects: visual, aural and conceptual

Signs are always compared on three levels, namely visually (Section 3.4 of this chapter), aurally (Section 3.5. of this chapter) and conceptually (Section 3.6 of this chapter). This is because one can perceive signs visually and aurally (comparison by taste, smell or touch is, for several reasons, less relevant or not possible at all), and because signs can evoke a similar image/concept. Only when it is not possible to compare on one level (e.g. the aural comparison when the mark is purely figurative) will this aspect be left out.

1.2.3 Signs to be compared

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 (see judgment of 09/04/2014, T-623/11 ‘Sobieraj (MILANÓWEK CREAM FUDGE)’ at para. 38)³.

The comparison must **cover the signs in their entirety**. Consequently, it is wrong to skip comparing elements of the 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. ~~Only in the overall assessment need value be given to the distinctive or dominant elements~~ (judgment of 12/06/07, C-334/05 P ‘Limoncello’, paras. 41, 42, judgment of 13/12/2011, T-61/09, ‘Schinken King’, para. 46).

1.2.4 Possible outcome of the comparison

Comparison of the 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 the signs leads to absolute protection according to Article 8(1)(a) CTMR if the goods and/or services are also identical.

³ For the effect of disclaimers, see The Guidelines Concerning Opposition. Part 2: Double Identity and Likelihood of Confusion. Chapter 4: Distinctiveness.

- a finding of **similarity** leads to the opening of the examination on likelihood of confusion in accordance with Article 8(1)(b) CTMR.
- the finding of **dissimilarity** excludes the likelihood of confusion. There is no need to examine further prerequisites of Article 8(1)(b) CTMR.

1.2.5 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 relevant public plays an important role when comparing the signs⁴.

Where the earlier mark is a national mark, the relevant criteria must be analysed in relation to 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 a CTM registration, the analysis must in principle extend to the *whole* EU. However, in situations where there is a likelihood of confusion in at least one Member State *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 likelihood of confusion.

The unitary character of the Community trade mark means that an earlier Community trade mark can be relied on in opposition proceedings against any application for registration of a Community trade mark which would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (judgment of 08/09/2008, C-514/06 'Armacell', paras 56-57 and subsequent case-law, inter alia judgment of 18/09/2011, T-460/11 BÜRGER', para. 52 and the case-law quoted therein).

2 Identity of Signs

2.1 The concept of identity

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

The differences between Article 8(1)(a) CTMR and protection in the event of likelihood of confusion pursuant to Article 8(1)(b) CTMR 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) CTMR 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 absolutely identical

⁴ The Guidelines Concerning Opposition. Part 2: Double Identity and Likelihood of Confusion. Chapter 6: Relevant Public and Degree of Attention.

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 level of attention of the public or the distinctiveness of the earlier trade mark.

On the other hand, pursuant to Article 8(1)(b) CTMR, 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 products originate from the same or an economically linked undertaking.

Due to the absolute protection conferred by Article 8(1)(a) CTMR, the concept of identity between the trade marks must be interpreted strictly. The absolute protection in the case of a CTM 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) CTMR] 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) CTMR]’ (judgment of 20/03/2003, C-291/00, ‘LTJ Diffusion’ (Arthur et Félicie), paras 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 the trade marks where the CTM application reproduces, without any modification or addition, all the elements constituting the earlier trade mark.

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

Therefore, **the CTM 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, ‘LTJ Diffusion’ (Arthur et Félicie), paras 50-54).

An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon ~~carefully~~ 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 which, 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 ‘~~negligible~~insignificant’ should 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) CTMR:

- **complete identity of the signs taken as a whole.** Partial identity is not sufficient under Article 8(1)(a) CTMR; 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 in respect of Article 8(1)(b) CTMR.

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 part 2.4) 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 0696/2011-1
<u>INDIVIDUAL</u>  INDIVIDUAL	 INDIVIDUAL <u>INDIVIDUAL</u>	R 0807/2008-4

- **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 Bulletin) is immaterial. Differences in the use of lower or upper case letters are immaterial, even if lower case and upper case letters alternate.

The following word marks are identical:

Earlier sign	Contested sign	Case No
MOMO	MoMo	B 1 802 233
BLUE MOON	Blue Moon	R 0835/2010-1
GLOBAL CAMPUS Global Campus	Global Campus GLOBAL CAMPUS	R 0719/2008-2
ZEUS Zeus	Zeus ZEUS	R 0760/2007-1
JUMBO Jumbo	Jumbo JUMBO	R 0353/2007-2
DOMINO	Domino	R 0523/2008-2
apetito	APETITO	T-129/09

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 a CTM 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).

Earlier sign	Contested sign	Case No
ВАСИЛЬКИ	Васильки <u>Васильки</u>	B 1 827 537

A difference in just one letter is enough 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 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	HERBOFARM HERBO-FARMA	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 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 0803/2008-1
		R 1807/2010-1
BIG BROTHER		R 0932/2010-4

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



Earlier sign	Contested sign	Case No
	THOMSON	R 0252/2008-1
	Klepper	R 0964/2009-1

2.5 Identity of figurative marks

There is identity between two figurative marks when both signs match in all their figurative elements (shape, colours, contrast, shadowing, etc.).

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

Earlier sign	Contested sign	Case No
		R 0558/2011-1
		R 1440/2010-1

		7078 C
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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

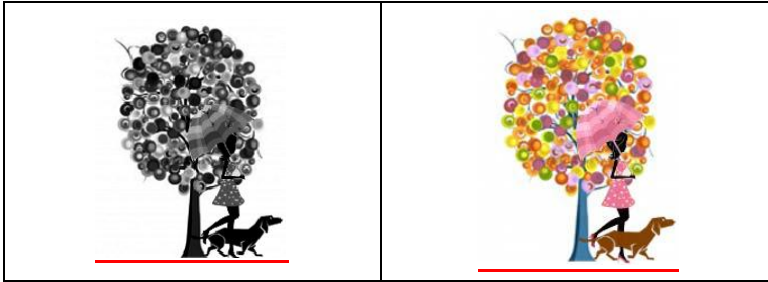
2.6 Identity of an earlier black & white (B&W) or greyscale mark with a colour mark application

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 side by side examination of the marks. In other words, for the finding of identity the differences in colour of the signs in question must be negligible and hardly noticeable by an average consumer.

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

<u>Earlier sign</u>	<u>Contested sign</u>
	



Invented examples of insignificant differences with the consequence of identity:

<u>Earlier sign</u>	<u>Contested sign</u>

In relation to the above findings, the issue whether a trade mark registered in B&W 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 ‘Sobieraj (MILANÓWEK CREAM FUDGE)’):

<u>Earlier sign</u>	<u>Contested sign</u>	<u>Case No</u>
 et al.		<u>T-623/11</u>

The Court considered that 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)

In the 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)

3 Similarity of Signs

3.1 The concept of similarity

According to the case-law, two marks are similar when inter alia, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (judgment of 23/10/2002, T-6/01, 'Matratzen', para. 30 (C-03/03 P); judgment of 12/11/2008, T-281/07, 'BLUE' para. 26).

The global assessment of the likelihood of confusion must be based, in so far as the visual, phonetic or conceptual similarity of the marks at issue is concerned, on the overall impression given by the marks, bearing in mind, inter alia, their distinctive and dominant components (judgment of 11/11/1997, C-251/95, 'SABEL' para. 23).

3.2 Threshold for a finding of similarity

If there is similarity on ~~only one~~ or more of the three levels, then the signs are similar (judgment of 02/12/2009, T-434/07, 'Volvo', para. 50-53). Whether the signs are sufficiently similar to lead to a likelihood of confusion must be dealt with in another section of the decision ('The Global Assessment') and not in the section dealing with the comparison of the signs.

A logical consequence of a low threshold is that a finding of similarity will not automatically lead to a finding of a likelihood of confusion, including the likelihood of association, even when the goods and services are similar or identical. As mentioned above, likelihood of confusion, including the likelihood of association, depends on many factors, which first have to be assessed separately⁵.

As the line between similar and dissimilar is not always easy to define, these concepts are dealt with together in each of the comparisons: the visual comparison, the aural comparison and the conceptual comparison.

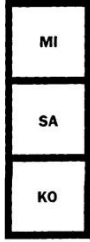




3.3 Negligible elements

As mentioned in Section 1.2.1 above, the comparison must **cover the signs in their entirety**. However, in the event of **negligible elements**, the Office may skip comparing such elements from the outset, after **having duly reasoned** why they are considered to be negligible (see judgment of 12/06/2007, C-334/05 P, 'Limoncello', para. 42). This is especially important where the negligible element is the common element in the signs. The notion of negligible elements should be strictly interpreted 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 which, 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.

⁵ The Guidelines Concerning Opposition. Part 2: Double Identity and Likelihood of Confusion. Chapter 8: Global assessment.

Examples:

Earlier sign	Contested sign	Case No
	 <p>(GREEN BY MISSAKO)</p>	<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 02347/2010-2</p> <p>The element 'Rótulos Luna S.A.' was considered negligible.</p>
<p>MATHEUS MÜLLER</p>		<p>R 0396/2010-1</p> <p>The Board did not assess the elements '30 cl' '30% 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%' were not included in the three-level 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>

3.4 Visual comparison

3.4.1 Visual comparison involving word marks

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 (judgment of 20/04/2005, T-211/03 ‘Faber’, para. 33, and judgment of 13/02/2007, T-353/04, ‘Curon’, para. 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’, para. 43).

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

Earlier sign	Contested sign	Case No
BABIDU	babilu	T-66/11 (para 57)
BALLYMANOR	BallyM	R 0391/2010-1

3.4.1.1 Word mark vs word mark



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
CIRCULON	CIRCON	T-542/10
MEDINETTE	MESILETTE	T-342/10
FORTIS	FORIS	R 0049/2002-4
ARTEX	ALREX	T-154/03
BALLYMANOR	BallyM	R 0391/2010-1
MARILA	MARILAN	R 0799/2010-1
EPILEX	E-PLEX	T-161/10
CHALOU	CHABOU	T-323/10

The following word marks are visually dissimilar:






Earlier sign	Contested sign	Case No
		C-193/09 P and T-402/07
<p>HALLOUM! 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 and 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 Comparison between a word mark and a 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 represented 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
VITAFIT		T-552/10
Hella		T-522/10
vitafresh		R 0399/2009-1
COTO DE IMAZ		R 0409/2009-1
vendus sales & communication group		R 0994/2009-4

	OPENDOOR	R1309/2008-4
VITESSE	vitises	R 0636/2008-4
EMERGEA		T-172/04

However, in cases 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

3.4.2 Visual comparison not involving word marks

When neither of the signs to be compared is a word mark, a differentiation must be made between the purely figurative elements of the marks and the word elements:

- When comparing the 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.
- When comparing the signs in terms of their **word elements**, the Office considers the 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 represented in different typefaces, in italics or bold, in upper or lower case or in colour (judgment of 18/06/2009, T-418/07 ‘LiBRO’ and judgment of 15/11/2011, T-434/10 ‘ALPINE PRO SPORTSWEAR AND EQUIPMENT’, appeal C-42/12 P dismissed).

Generally speaking, three types of visual comparison exist:

- *Purely figurative v purely figurative signs*: the signs are visually similar if any of their elements match;
- *Figurative sign with word elements v figurative sign with word elements*: the signs are visually similar if their figurative elements match and/or if they share words

and/or letters written in the same/similar typeface or one that is not highly stylised;

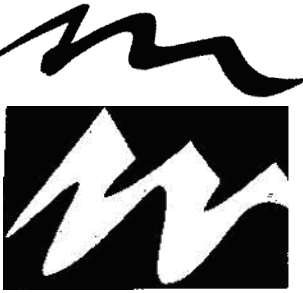



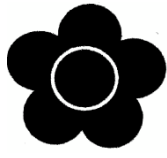

- *Figurative signs with word elements v purely figurative sign* (or vice-versa): the signs are visually similar if any of their figurative elements match.

These three scenarios are dealt with in detail below, with some special situations being described at the end.



3.4.2.1 Purely figurative v purely figurative signs



As explained above, the signs may be visually similar when they match or have a similar contour.

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

Earlier sign	Contested sign	Case No
		T-379/08
		B 1 157 769
		T-523/08

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













Earlier sign	Contested sign	Case No
		B 1 572 059



		R-1904/2010-4 (appeal pending , T-502/11)
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3.4.2.2 Visual comparison between two word/figurative marks





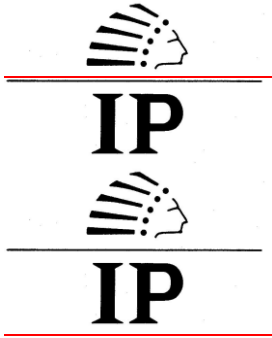

As already mentioned, in the event that both signs contain word elements, similarity will be found if these elements coincide in a sequence of letters that are not highly stylised. This is true even if the letters are graphically represented in different, but still not highly stylised, typefaces, whether in italics or bold, in upper or lower case, or in colour (judgment of 18/06/2009, T-418/07 ‘LIBRO’ and judgment of 15/11/2011, T-434/10 ‘ALPINE PRO SPORTSWEAR & EQUIPMENT’, appeal C-42/12 P 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
		T-418/07
		T-434/10 (appeal dismissed)
		R 1148/2008
		B-921-934
		T-460/09
		T-204/09

		<p>R-1025/2010-4T-383/12</p>
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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
		<p>T-390/03</p>
		<p>T-106/06</p>
		<p>R 448/20091109/2008-1</p>
		<p>R 0576/2010-2 (confirmed by T-593/10)</p>
		<p>R 0111/2010-4</p>

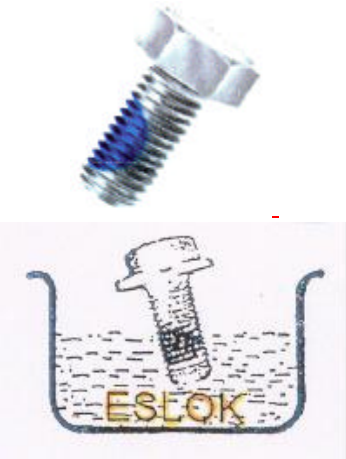

3.4.2.3 Visual comparison between a word/figurative sign and a figurative sign

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
		<p>T-81/03, T-82/03 and T-103/03</p>
<p>and</p>  <p>(two different earlier signs)(i)</p>  <p>(ii)</p> 		<p>R 0144/2010-2</p>
		<p>R 1022/2009-2</p>

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

Earlier sign	Contested sign	Case No
		<p>B 134 900</p> <p>The marks were considered to be visually dissimilar</p>

3.4.2.4 Particular scenarios when comparing figurative signs

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
		<p>B 1 220 724</p> <p>The signs were held to be visually similar.</p>

3.4.2.5 Visual comparison of 'colour per se' marks

When comparing pure colour marks, there will be visual similarity insofar as they contain the same colours/colour combinations or similar shades.

Example:





Earlier sign	Contested sign	Case No
 <p>Indication of colour: Curry (ochre) yellow RAL 6003--HR/olive green RAL 1027--HR.</p>	 <p>Indication of colour: Yellow, Pantone PMS_142, green RAL 6001</p>	<p>B 1 229 790</p>

The signs were considered to be visually similar insofar as both contain similar shades of green and yellow.

3.4.2.6 Visual comparison of 3D marks

When comparing three-dimensional and two-dimensional signs, the same basic principles as for 2D 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
		R 0806/2009-4
		T-24/08

The following marks are visually **dissimilar**:

Earlier sign	Contested sign	Case No
		R 0806/2009-4, para. 34

3.5 Phonetic comparison

3.5.1 Practical criteria

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 a CTM 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 *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 plays 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
CAPOL ARCOL	ARCOL GAPOL	EU	C-193/09
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
FEMARA		EU	R 0722/2008-4
	FOR US	BX	R 0166/2010-1
	HELI-COIL	DE	R 1071/2009-1 similar to a low degree

<u>HELI-COIL</u>	<u>HCOIL</u>		
		<p><u>PT: 'A significant part of the general public in Portugal has at the very least a basic knowledge of that language which enables it to understand and to pronounce English words as basic and everyday as "forever" or to pronounce numbers below 10 in English.'</u> (68) <u>Due to widespread use of 'SMS language', the number 4 combined with an English word will generally be read in English.</u> (69)</p>	<p><u>T-528/11</u></p>

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

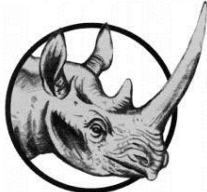



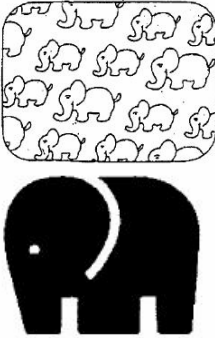
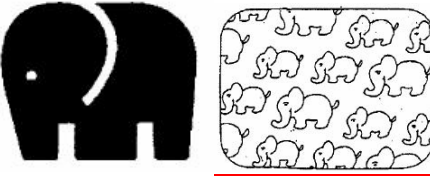
Earlier mark	Contested sign	Case No
		<p>T-115/02</p>

3.5.2 Signs and elements in the signs that must be assessed



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, 'Device of a rectangle with elephants', para. 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 has to be assessed only visually and conceptually.

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

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. For example:


Earlier sign	Contested sign	Case No
		R 0144/2010-2

With regard to the pronunciation of figurative elements reminiscent of a letter, it should be noted that the relevant public will tend to read such figurative elements only when they are linked to or 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

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 0160/2010-2 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 T-Mobile@Home	R 1421/2010-4 @ will be pronounced as ‘at’ or ‘arrobas’ in Benelux (para. 21).




In the above case it cannot be denied that a significant part of the relevant public – in particular English speakers – would read the ‘at’ symbol and thus say 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 readable in a different way (for example ‘arroba’ in Spanish and Portuguese).

However, compare this with:

Earlier sign	Contested sign	Case No
		R 0719/2010-1 (T-220/11 dismissed, C-524/12 P pending) The @ will be perceived as the letter ‘a’ by (at least) the EN public (para. 25).



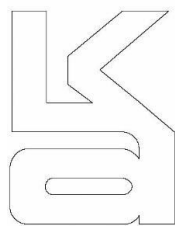


The plus (+) and minus/hyphen (-) symbols may, depending on the circumstances, also be pronounced by the relevant public. The minus symbol may be pronounced when used in combination with a number, e.g. ‘-1’, but will not be pronounced if used as a hyphen (as in ‘G-Star’).


In the following examples, the symbol ‘+’ in the contested CTMA 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 spoken. As a (fictional) example, 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 **contrasting** examples:

Mark	Explanation
	T-593/10 In this figurative mark, the letter 'B' can be read. The mark must therefore be assessed phonetically.
	T-593/10 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'.
	R 1779/2010-4 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.
	B 1 127 416 In this figurative mark the letter 'H' can be read and therefore must be assessed phonetically.
	B 1 127 416 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 style="text-align: center;"><u>T-282/12</u></p> <p><u>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.</u></p>
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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.

3.5.3 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.

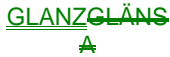

For example:

Earlier sign	Contested sign	Case No
SAT-COM	COM S.A.T	B 361 461
		T-484/08 (C-84/10 P dismissed)
		T-67/08

3.5.4 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 0410/2010-1 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.
		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 ~~at least~~ in the Scandinavian countries, the Netherlands and Finland (judgment of 26/11/2008, T-435/07 'NEW LOOK', para. 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 (judgment of 27/11/2007, T-434/05, 'ACTIVY Media Gateway', paras 38 and 48 for the IT field (C-57/08 P dismissed) and judgment of 09/03/2012, T-207/11, 'EyeSense', paras 21 and 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', ~~'snack'~~, 'surf', 'pizza' etc.

Earlier mark	Contested sign	Case No
		R 0883/2010-2

- Finally, when any one of the parties provides compelling evidence that such 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.

		<p>ZIRH</p>	<p>T-355/02 (appeal C-206/04 P dismissed.) Similar in English speaking-countries and Spain.</p>
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As regards **invented or fanciful words** (words which 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	<p>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).</p>

3.6 Conceptual comparison: practical criteria

3.6.1 Definition of semantic content

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', para. 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 consists of 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.

3.6.1.1 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 is deemed to mainly speak the languages predominant in their respective territories (judgment of 23/10/2002, T-6/01, 'MATRATZEN', para. 27). These languages are normally the official languages of the relevant territory.



Earlier mark	Contested sign	Case No
HALLOUMI	HELLIM	T-534/10
<p><u>Hellim</u> 'Hellim' is the Turkish translation of <u>Halloumi</u> 'Hallowumi' (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', para. 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, at least 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', para. 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 'love', 'one', '~~snack~~', 'surf', 'pizza', 'baby', etc.
- Finally, when any one of the parties provides evidence that such 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 Myrtaceae, two to three meters 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)
Mc. Baby - 	EU	There is some degree of conceptual similarity, based on "Mc" and the words "baby" and "kids" which 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 consists of 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 which is relevant for the conceptual comparison (but note the exception below concerning expressions in foreign languages). Fictional example: 'KING'S DOMAIN' vs. 'KING SIZE'.

Wrong 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 <u>BIKER</u>	MOUNTAIN- <u>BIKER</u>	B 1 950
<u>Goldband</u> GoldGips	<u>GoldGips</u> Goldband	R 0975/2009-4
ALTA <u>FIDELIDAD</u>	ALTA- <u>FIDELIDAD</u>	B 112 369

The above-mentioned 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 such instances it may be that the meaning of an expression as such is not perceived; only the meanings of the individual elements are. 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, 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' (para. 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 such cases, it may be that only the meaning of the commonly used words is perceived, and not the meaning of the expression as such.

3.6.1.2 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, he will break it down into elements which, for him, suggest a specific meaning or which resemble words known to him (judgment of 13/02/2007, T-256/04, 'RESPICUR', para. 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 capital letters, as in AirPlus);

- 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
AirPlus	EU	There are two meanings, Air and Plus, which can be perceived visually because the word Plus is written with a capital letter.	T-321/07 (C-216/10P dismissed)
	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
<u>nfon</u>	<u>EU</u>	<u>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.'</u> (60)	<u>T-283/11</u> <u>(C-193/13 P dismissed)</u>

Examples of cases which 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-23/09P 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-388/10P 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 products of a dermatological nature.	B 1 249 467





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 such meanings *ex officio*. In the examples below, no concept was found in the signs:


Sign	Territory	Concept	Case
ATOZ	DE, ES, FR, IT, A	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-559/08P dismissed)
SpagO	BX	The word 'SpagO' is an invented word, which has no meaning in any of the official languages of the 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

3.6.1.3 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	B 1 012 857

		capable of influencing or inspiring large numbers of people.	
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In any case, 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

3.6.1.4 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.)	Italy and other territories	Whereas 'HEACH' would be perceived as a surname of Anglo-Saxon origin, the element 'EICH' would be	T-557/10

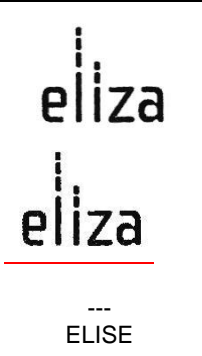
H. EICH		perceived as a surname of German origin (para. 66). In view of this, the consumers would realise that these surnames distinguish different persons. The signs are conceptually different (para. 69).	
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The fact that a trade mark contains a name 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
	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 / PEPE	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
CTMA: Julián Murúa Entrena	ES	The CTMA contains a Spanish name (a forename and two surnames). The first surname, which for the Spanish public is the more important one,	T-40/03




Earlier mark: MURUA,		coincides with the earlier TM.	
CTMA: MANSO DE VELASCO Earlier mark: VELASCO	ES	Velasco is a Spanish surname. The CTMA can be understood as being composed of two surnames.	T-259/06
CMTA: 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

3.6.1.5 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 (3D 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 business man playing football.	B-1-202-852R 0403/2009-2


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, <u>CY</u> , DE, ES, FR, HU, RO, <u>SK</u> , 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.


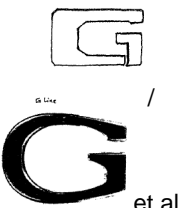
3.6.1.6 The semantic content of numbers and letters

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, which 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 0782/2011-2

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/G+', para. 56, appealed as C-341/12 P), 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	The signs were considered conceptually identical (paras 60-61)	T-187/10

3.6.1.7 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

3.6.1.8 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 represented 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 which expresses a short, sharp sound. This word will be readily understood in Germany given its close	R 1394/2006-2

		equivalent in German, 'Klick' (para. 45).	
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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 [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).	R 1433/2007-2

3.6.2 How to make a conceptual comparison

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

If none of the signs has 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**.

~~Only when~~When both signs have a concept, ~~the concept(s) will a conceptual comparison be carried out~~compared to establish whether the signs are conceptually **identical** or **similar**, ~~if (i.e. they refer to the same or similar concepts,) or dissimilar, if (i.e. the signs refer to different concepts.)~~.

The signs will be conceptually dissimilar where there are two words for which a generic term covering both of them exists and ~~/ /~~ or when the two signs 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' vs '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 type of mark or word**: the fact that 'TDI' and 'LNF' are three-letter abbreviations is conceptually irrelevant. The signs should be considered conceptually dissimilar.
- Another example of signs 'belonging to the same category' concerns **names** (and this ties in with what is stated in Section 3.6.1.4 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.





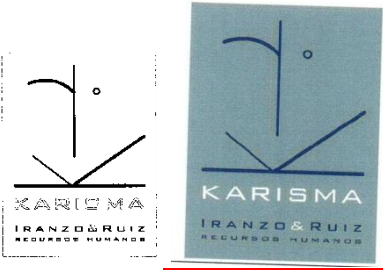

In particular, the marks will be conceptually identical or similar when:

3.6.2.1 Both marks share a word and/or expression

When the two marks share the same word or expression, the marks will be conceptually similar, such 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
		T-281/07 (C-23/09P 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 Chondrichthyes (subclass Elasmobranchii)...').		
Earlier sign	Contested sign	Case No
		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 <u>(ES)</u>
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 <u>(EU)</u>
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 <u>(ES)</u>
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').		

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

~~There may also be~~ It is possible for the relevant public to assign a conceptual similarity between word or even identity in cases of marks with elements in different languages, as long as the meaning of the words in those languages are known to that public.



In the following example it was found that the marks were conceptually ~~similar~~ identical because ~~the German and Finnish~~ 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 'Hai' will likely to be understood by the relevant public as 'shark':

Earlier mark	Contested sign	Case No
 <i>(relevant territory inter alia)</i>	Hai	T-33/03


Germany and Finland)		
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~~This will be the case in particular where the earlier mark is protected in a part of the European Union that part of the Portuguese public~~ which has the different languages as official languages.

~~Another scenario is where the perception of a common meaning of the signs is shared by a significant part of the relevant public in the territory where sufficient knowledge of the earlier mark is protected and, when English language (iii) that 'agua' is a widespread Latin expression and resembles the earlier mark is a CTM, in the same part of the EU, i.e. in the same Member State. This has to be evaluated for (each of) the relevant area(s). With regard to understanding of foreign languages see Section 3.6.1.1. Portuguese equivalent term 'áqua' (paras. 56-60):~~

Earlier mark	Contested sign	Case No
OLYMP		T-203/09 and T-204/09
The signs are conceptually similar for the Spanish public since the word 'olymp' can be perceived by the relevant Spanish public as a derivative of the word 'olympo'. VITAMINWATER (relevant territory Portugal)		T-410/12

~~If neither~~As it is the actual understanding of the above two scenarios applies relevant public that matters, the mere fact that one term is a translation objectively the foreign language equivalent of the other term may not be sufficient for finding relevant at all in the conceptual identity/similarity comparison.

Earlier mark	Contested sign	Case No
CORONA		
CORONA means crown in Spanish and KARUNA means crown in Lithuanian. In Russian, 'корона'/'korona' means crown.		
The Court held that even if the relevant public [Baltic countries] knew that the Russian word 'корона' meant 'crown', there was no evidence to show that the relevant public would associate 'корона' in the Cyrillic alphabet — or 'korona', the equivalent term in the Latin alphabet — with the word element 'corona' of the sign applied for, which is a foreign word without meaning in Estonian, Latvian or Lithuanian (para 35)		
	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.		


~~In the following example the marks were considered conceptually identical because it was maintained that the relevant public in Germany would also understand the expression 'land of leather':~~

Earlier mark	Contested mark	Case No
		B-1-233-842

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

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





~~As an example of the above,~~ Conceptual similarity was found in the following ~~two expressions were found conceptually similar~~ cases:



Earlier mark	Contested mark	Case No
SECRET PLEASURES	PRIVATE PLEASURES	R 0616/1999-1
	ORPHAN INTERNATIONAL	R 1142/2009-2

3.6.2.4 Two figurative signs, symbols and ~~/ /~~ or ~~shparesshapes~~ represent the same object ~~of~~ 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-168/04 (confirmed C-488/06) <u>(similar)</u>
		R0703R_0703/2011- -2 <u>(identity)</u>





		R4407R 1107/2010- -2 (identity)
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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
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 represented, could evoke a boomerang whereas this is not the case for the mark applied for (para. 36).		

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

Conceptual similarity/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)