

***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 5

DOMINANT CHARACTER

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1 General remarks

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.

The purpose of this chapter is to explain how to assess whether or not any of the signs in conflict have dominant component(s).

2 Assessment of dominant character

It is the Office's practice to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean '**visually outstanding**'.

For a finding that there is a dominant element within a sign, the sign should have at least two identifiable components¹. Therefore, the **first step** is to identify the components in a sign.

The European Court of Justice (the 'Court') has not defined what is to be regarded as a 'component' of signs but has given indications. Visual indications such as a dash or the use of different font sizes and/or typefaces or colours could be regarded as 'components'². Rather than depending on whether a sign can be visually divided into different parts, it is the relevant public's perception of the sign which is decisive.

The **second step** is to identify which of the components of a sign is the dominant one. As the Court has stated:

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

(See judgment of 23/10/2002, T-6/01 'MATRATZEN', para. 35, judgment confirmed by order of 28/04/2004, C-3/03 P.)

Even though, according to the established case-law of the Court, aspects other than the visual one (such as a possible semantic meaning of part of a one-word sign) may come into play when defining the notion of the dominant element of a sign, it is the

¹ In this text the words 'component' and 'element' are used interchangeably.

² For some examples see The Guidelines Concerning Opposition. Part 2: Double Identity and Likelihood of Confusion. Chapter 3: Comparison of Signs

practice of the Office to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean ‘visually outstanding’ and to leave any other considerations for the overall assessment. As a result, the Office’s practice is that the dominant character of a component of a sign is mainly determined by its position, size, dimensions and/or use of colours, to the extent that they affect its visual impact.

In addition, the Court has held that:

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


(See judgment of 13/06/2006, T-153/03 ‘Representation of a cowhide in black and white’, para. 32.)

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





As a rule of thumb the following should be considered:

- The assessment of dominant character applies to both the signs under comparison.
- For a finding that there is a dominant component, the sign should have at least two identifiable components.
- Word marks have no dominant elements because by definition they are written in standard typeface. The length of the words or the number of letters is not an issue of dominance but of overall assessment³.
- Figurative elements may be dominant in signs where word elements are also present.
- Whether or not an element is visually outstanding may be determined in the visual comparison of the signs; if that is the case, it must be consistent with a subsequent evaluation of dominant character.
- Lastly, if it is difficult to decide which of the (at least) two components is dominant, this may be an indication that there is no dominant element. The establishment of dominant character implies that one component is visually outstanding compared to the other component(s) in the mark; if that assessment is difficult to make, it is because there is no dominant element.

Examples of cases:

| Sign | Dominant component and reasoning | Case No |
|--|---|-----------------|
|  <p>Registro Profesional de Tenis, S.L.</p> | <p>RPT: ‘the dominant element of the earlier marks is the acronym RPT, in which the letter “p” predominates’ (para. 33).</p> | <p>T-168/07</p> |

³ See The Guidelines Concerning Opposition. Double Identity and Likelihood of Confusion. Part 8. Global Assessment. Short signs.

| Sign | Dominant component and reasoning | Case No |
|---|--|----------|
|  | <p>Free: 'the word "free" dominates the visual impression created by the mark of which it forms part, because it is considerably larger than the other components and, in addition, is much easier to remember and pronounce than the slogan in question' (para. 39).</p> | T-365/09 |
|  | <p>Xtreme: 'On the visual level, it must be concluded that in the mark applied for, the term 'XTREME' occupies a central position. Indeed, the size of its typeface is bigger than that of the other verbal elements, and the word is highlighted with a white outline... The other verbal components 'RIGHT GUARD' and 'SPORT', are written in a much smaller type and are shifted to the right and towards the edge of the sign' (para. 55)</p> | T-286/03 |
|  | <p>GREEN by missako: 'It must be noted, as a first point, that the representation of the sun has an important place within the mark applied for, in that it is positioned in the centre and covers almost two thirds of the area. Next, the position of the word element "green" is also important within the mark, as it is represented in large-typeface, stylised capital letters in black and takes up about one third of the area. As observed by the Board of Appeal in paragraph 28 of the contested decision, those two elements thus occupy the major portion of the mark applied for and are therefore striking in the overall impression of the mark... Lastly, as regards the word element "by missako", the Board of Appeal correctly held, in paragraph 28 of the contested decision, that those words were almost illegible because of their size and that the handwriting made them difficult to decipher. It follows, first, that the dominant nature of the word "green" and of the representation of the sun are thereby further reinforced and, secondly, that the word element "by missako" is negligible in nature' (para. 37 and 39)</p> | T-162/08 |
|  | <p>BÜRGER: The dominant element of the mark applied for is undeniably the word element in capital letters which stands out, simply because of its position and the very large size of its lettering, from all the other elements which make up the label (para. 38).</p> | T-460/11 |