

***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***

***IDENTITY AND  
LIKELIHOOD OF CONFUSION***

***CHAPTER 8***

***GLOBAL ASSESSMENT***

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## 1 Introduction

### 1.1 Nature of global assessment

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

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

The Court has also held that the global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the **overall impression** given by the marks, bearing in mind, in particular, their distinctive and dominant components (judgment of 11/11/1997, C-251/95, ‘Sabèl’, para. 23).

The Office normally examines the most salient and habitually relevant factors relating to likelihood of confusion under separate headings<sup>1</sup> before the section containing the Global Assessment. However, the Global Assessment can include and weigh up many other factors that are relevant to deciding on likelihood of confusion.

## 2 Interdependence Principle

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

The interdependence of those factors is expressly referred to in recital 8 in the preamble to the CTMR, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends on numerous elements and, in particular, on the recognition of the mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the mark and the sign and between the goods or services identified (see judgment of 10/09/2008, T-325/06 ‘CAPIO’, para. 72 and the case-law cited).

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<sup>1</sup> (i) Similarity of goods and services; (ii) similarity of the signs; (iii) the distinctive and dominant elements of the conflicting signs; (iv) the distinctiveness of the earlier mark; (v) the relevant public and the level of attention.

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

In practice, this means that the **Office will weigh up**, inter alia, the degree of similarity between the goods and services and the degree of attention paid by the relevant public to those goods and services, the degree of similarity between the signs and whether the impression produced by any one of the levels of comparison (visual/aural/conceptual) is more important. The Office will also consider whether the similarity between the signs lies in an identical or similar element and whether that element is dominant and/or distinctive, whether there are any additional dominant and/or distinctive elements which could counteract the similarities and whether the earlier trade mark is highly distinctive.

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

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

### 3 Imperfect Recollection

Although, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect, account is taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (judgment of 22/06/1999, C-342/97, 'Lloyd Schuhfabrik Meyer', para. 26).

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

The Court has stated that when evaluating the importance attached to the degree of visual, aural and conceptual similarity between the signs, it is appropriate to take into account the category of goods and the way they are marketed (judgment of 22/09/1999, C-342/97, 'Lloyd Shuhfabrik Meyer', para. 27).

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

such cases, the visual impression of signs counts more in the assessment of likelihood of confusion.

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

#### 4.1 Visual similarity

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

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

The same considerations were central to a finding of likelihood of confusion in the following cases:

Earlier sign	Contested sign	Case No
ICEBERG	ICEBREAKER	T-112/09
		R 1050/2008-4
PETER STORM	PEERSTORM	T-30/09

		T-376/09
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However, granting preferential consideration to the visual perception does not mean that identical verbal elements can be overlooked due to the presence of striking figurative elements, as can be seen in the case below where likelihood of confusion was found:

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

In a similar way, the visual impression for marks covering ‘video games’ has also been held to be particularly relevant because these goods are normally purchased after a comprehensive examination of their respective specifications and technical characteristics, firstly upon the basis of information that appears in specialist catalogues or on the internet, and then at the point of sale. For these reasons, the visual differences were key to the finding of no likelihood of confusion below (judgment of 08/09/2011, T-525/09, ‘Metronia’, paras. 38-47):

Earlier sign	Contested sign	Case No
		T-525/09

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

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

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

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

## 4.2 Aural similarity

In contrast to the cases above where visual similarity played a stronger role, similarity on the phonetic level may have more weight than similarity on the visual level when the goods at issue are traditionally ordered orally. For example, phonetic similarities can be given more weight for **pharmaceuticals** if the goods are traditionally ordered orally. This consideration came into play in the finding of likelihood of confusion in the case below, which dealt with a service relating to **motor vehicle rental contracts** – which are normally entered into by telephone.

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

Where goods are ordered orally, the phonetic perception of the sign may also be influenced by factors such as the likely presence of various other sounds perceived by the recipient of the order at the same time. Such considerations are relevant where the goods in question are normally ordered at sales points with an increased noise factor, such as **bars or nightclubs**. In such cases, attaching particular importance to the phonetic similarity between the signs at issue may be appropriate. These considerations came into play in the finding of likelihood of confusion between the marks below for certain goods in Class 33 (judgment of 15/01/2003, T-99/01, ‘Mystery’ para. 48).

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

Similarly, a particular method or customary way of ordering goods may mean increased importance being attributed to the phonetic similarity between the signs. For instance, the General Court has held that in the **wines sector** consumers usually describe and recognise wine by reference to the verbal element that identifies it, in particular in bars and restaurants, in which wines are ordered orally after their names have been seen on

the wine list (judgment of 23/11/2010, T-35/08, ‘Artesa Napa Valley’ para. 62; judgment of 13/07/2005, T-40/03, ‘Julián Murúa Entrena’ para. 56; and judgment of 12/03/2008, T-332/04, ‘Coto d’Arcis’ para. 38). Accordingly, in such cases, it may be appropriate to attach particular importance to the phonetic similarity between the signs at issue. These considerations came into play in the finding of likelihood of confusion between the marks below for wine despite their considerable visual differences.

Earlier sign	Contested sign	Case No
MURÚA		T-40/03
 <p data-bbox="341 983 485 1016">ARTESO</p>		T-35/08

Nevertheless, the broad principle above does not mean that the visual impression can be overlooked for goods normally purchased orally. Indeed, the General Court has held that although preponderant importance had sometimes been accorded to the phonetic perception of marks for beverages, the phonetic dissimilarities of the marks did not merit particular importance where the specific beverages were widely distributed and sold not only in specialist shops, where they would be ordered orally, but in large shopping centres as well, where they would be purchased visually (judgment of 03/09/2010, T-472/08. ‘61 a nossa alegria’, para. 106 referring to para. 40).

### 4.3 Conclusion

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

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

In general, a finding of similarity between the signs on one level of comparison is enough to find the signs similar and may be sufficient to cause likelihood of confusion<sup>2</sup>.

This applies in general to the conceptual similarity as well: the Court indicated that it is not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a **likelihood of confusion**. This will be the case where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.

However, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is **not sufficient to give rise to a likelihood of confusion** (judgment of 11/11/1997, C-251/95 ‘Sabèl’, paras. 24, 25).

Earlier sign	Contested sign	Case No
	HAI	T-33/03
<p>G&amp;S: 5, 32, 33, 35, 42  Territory: EU  Assessment: The Court affirmed the conceptual similarity of the signs, but denied the likelihood of confusion even for identical goods, since the trade marks were visually and phonetically dissimilar and on the basis that the distinctiveness of the earlier trade mark was average (para. 64) – NO LOC.</p>		
Earlier sign	Contested sign	Case No
K2 SPORTS		T-54/12
<p>G&amp;S: 18, 25, 28  Territory: Germany and the UK  Assessment: contrary to the Board’s finding that there is no conceptual similarity, the term ‘sport’, notwithstanding its descriptive character, refers to the same concept and leads to the conclusion that there is a degree of conceptual similarity. The Court concluded that this similarity was weak in the context of the overall impression of the signs and in particular of the very weak distinctive character of this term. However, the weak conceptual similarity did not offset the significant visual and phonetic differences between the signs (para. 49) – NO LOC.</p>		
Earlier sign	Contested sign	Case No
HALLOUMI	HELLIM	T-534/10
<p>G&amp;S: 29  Territory: Cyprus  Assessment: the GC stated that the conceptual similarity was not enough to give rise to LOC in view of the descriptive character of the earlier mark (the GC had found that the signs were visually and aurally dissimilar) (para. 54) – NO LOC</p>		

<sup>2</sup> See The Guidelines Concerning Opposition. Part 2: Identity and Likelihood of Confusion. Chapter 3: Comparison of Signs.

Earlier sign	Contested sign	Case No
NORMA		C-191/11P
G&S: 35, 42 Territory: Germany Assessment: The conceptual differences should be strong enough to neutralise the visual and phonetic similarities (para. 44-45) –LOC		

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

## 6 Specific Cases

### 6.1 Short signs

As indicated elsewhere in this section, the Court has stated that likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case, including the degree of similarity between the signs. The Court has also held that the global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the **overall impression** given by the marks.

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

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

#### 6.1.1 One-letter / number signs

It should be noted that the General Court held that the global assessment of the likelihood of confusion between signs consisting of a single letter (or a combination of letters not recognisable as a word) **follows the same rules** as that in respect of word signs comprising a word, a name or an invented term (see judgment of 06/10/2004, joined cases T-117/03, T-118/03 T-119/03 and T-171/03 NL SPORT, NL JEANS, NL ACTIVE, NL COLLECTION, paras 47 and 48, and judgment of 10/05/2011, T-187/10, G / G ea, para. 49).

In the assessment of the likelihood of confusion it is important to establish the degree of **inherent distinctiveness** of the earlier trade mark, and therefore its scope of protection. See in this respect The Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 4, Distinctiveness and the specific section on

short signs. In general, whilst registered earlier trade marks consisting of a single letter (or number) represented in standard characters enjoy a presumption of validity, ultimately their degree of inherent distinctiveness will have to be assessed on the basis of the goods and/or services concerned.

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

Consequently, a likelihood of confusion can be safely excluded when two conflicting signs, albeit consisting of the same single letter, are stylised in a sufficiently different way or consist of sufficiently different graphic representations, so that their different graphical characterisation eclipses the common verbal element.

In the following examples, the signs are found to cause a similar overall visual impression and **likelihood of confusion** was found:

Earlier sign	Contested sign	Case No
		R 0568/2000-2
<p>G&amp;S: 9, 16                      Territory: Spain                      Assessment: Despite these small differences, the overall impression of the signs in dispute is similar; the differences are outweighed by the predominant similar features. The goods are identical or similar – LOC.</p>		
Earlier sign	Contested sign	Case No
		T-115/02
<p>G&amp;S: 9, 16, 25, 35, 41                      Territory: EU                      Assessment: Having regard, first, to the strong similarity between the conflicting signs and, second, to the similarity between the goods concerned, limited though it may be in the case of footwear and clothing, the Board of Appeal concluded that there was a likelihood of confusion on the part of the relevant public (para. 27) – LOC.</p>		
Earlier sign	Contested sign	Case No
A		R 1508/2010-2
<p>G&amp;S: 9, 18, 24, 25, 28                      Territory: Germany                      Assessment: It must be assumed that the earlier German mark has the required distinctiveness for protection as a trade mark. The signs are similar and the goods identical (paras 18 and ff.) – LOC</p>		

Earlier sign	Contested sign	Case No
		T-187/10 (appeal C-354/11 P)
<p>G&amp;S: 9, 18, 25                      Territory: EU, Italy                      Assessment: The overall impression of the signs in dispute was considered similar. Having regard to the similarity of signs, the reputation of the earlier sign as an abbreviation of the trade mark Gucci, and the identity of the products, there was LOC</p>		

On the other hand, in the examples below **no likelihood of confusion** was found due to the different stylisations of the single-letter signs:

Earlier sign	Contested sign	Case No
		R 1655/2006-4
<p>G&amp;S: 25                      Territory: Spain                      Assessment: The letter "M" was considered to be viewed by Spanish consumers as referring to the size of an item of clothing. Its distinctive character was low (para. 21) – NO LOC.</p>		
Earlier sign	Contested sign	Case No
A		T-174/10 (appeal C-611/11 P)
<p>G&amp;S: 18, 25                      Territory: Germany                      Assessment: The Court concluded NO LOC on the basis of the particular graphic design of the contested trade mark and the fact that the public would not pronounce the contested trade mark given the particular graphic design – NO LOC.</p>		
Earlier sign	Contested sign	Case No
F		R 1418/2006-2
<p>G&amp;S: 25                      Territory: EU                      Assessment: The Board finds that the visual differences between the signs will counterbalance the identical nature of the goods (para. 26) – NO LOC.</p>		
Earlier sign	Contested sign	Case No
		R 576/2010-2 (confirmed by T-593/10)
<p>G&amp;S: 25, 41, 43                      Territory: Germany                      Assessment: The Board finds that the different visual overall impression of the signs will counterbalance the identical nature of the goods (paras 19-21) – NO LOC.</p>		

Lastly, it should be pointed out that the verbal representation of ‘one-letter / one-digit sign’ is not to be considered equivalent to the sign (e.g. ‘ONE’ is not equal to ‘1’ or ‘EM’ to ‘M’). Therefore, the aforementioned arguments are not directly applicable to such cases<sup>3</sup>.

### 6.1.2 Two-letter / number signs

Unless the letter combination as such is intrinsically weak for the goods and services (e.g. ‘XL’ for goods in Class 25), two-letter/number signs are not necessarily distinctive to a low degree. However, it must nevertheless be taken into account that consumers frequently encounter abbreviations and letter combinations of all kinds in everyday life and in business.

The abovementioned rules for single letters/numbers marks apply to two-letter/number signs: aural and conceptual identity is relevant so in general, **no likelihood of confusion** will arise between two-letter/number signs that are stylised in a different way or consist of different graphic representations of the same letters/numbers so they cause a **sufficiently different visual impression**.

Consequently a likelihood of confusion can be safely excluded when two conflicting signs, albeit consisting of the same combination of two-letters, consist of a different graphical characterisation which eclipses the common verbal elements.

If the two-letter combination creates a similar visual impression, **likelihood of confusion** will be found:

Earlier sign	Contested sign	Case No
		B 61 046
<p>G&amp;S: 36                      Territory: Spain                      Assessment: The overall visual impression of the conflicting marks is that they consist of two letters in an arbitrary figurative design which conveys the same impression. The trade marks are considered similar and the services identical – LOC.</p>		
Earlier sign	Contested sign	Case No
GE		R 0020/2009-4 (appeal pending T-520/11)
<p>G&amp;S: 6, 7, 9, 11, 17                      Territory: UK                      Assessment: The goods are identical, the trade marks are phonetically identical and a certain visual similarity between the marks exists. The differences, consisting mainly of the slight stylisation of the letters ‘GE’ in the contested application, which however present a similarity with the usual way on which the letters ‘GE’ are written in upper case, are insufficient to safely exclude likelihood of confusion. This conclusion is true even when the goods at issue address an informed public, because consumers could think of the contested CTMA as a redesigned version of the earlier word mark (para. 27) – LOC.</p>		

<sup>3</sup> See The Guidelines Concerning Proceedings Before the Office, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 3, Comparison of Signs.

In the following example, **no likelihood of confusion** was found due to the different graphic representation of the same letters:

Earlier sign	Contested sign	Case No
  et al		R 0082/2011-4
G&S: 33 Territory: EU Assessment: The graphical design in which the letter combinations appear strongly influences the consumer's perception. The distinctive character of the conflicting marks to a large extent rests on their specific graphic elements (para. 16) – NO LOC.		

Differences in one of the letters will normally lead to **no likelihood of confusion**:

Earlier sign	Contested sign	Case No
 CX	KX	R0864/2010-2
G&S: 7 Territory: EU Assessment: In terms of the overall impression and applying the interdependence principle, the Board confirmed that the difference in the first letter is sufficient to exclude LOC on the part of the public concerned, taking into account that the relevant public is particularly attentive (para. 28) – NO LOC.		
Earlier sign	Contested sign	Case No
KA		T-486/07
G&S: 9, 11, 12 Territory: EU Assessment: While the relevant consumer only rarely has the chance to make a direct comparison between the different signs and must rely on an imperfect recollection of them, as the applicant has submitted, in the present case, given the important visual differences between the marks at issue, the fact that the goods at issue are generally purchased after they have been seen and the high level of attention of the relevant consumer, it must be held that the relevant consumer will not confuse the marks at issue despite the lack of direct comparison between the different marks (para. 95) – NO LOC.		

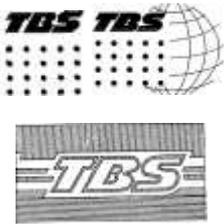
### 6.1.3 Three-letter / number signs

When the signs in conflict are three-letter/number signs, there seems to be a tendency to find **likelihood of confusion** where the only difference lies in **one phonetically similar letter** so that the overall impression of the signs is still similar.

In the following cases, the outcome was **likelihood of confusion**:

Earlier sign	Contested sign	Case No
	ELS	T-388/00
<p>G&amp;S: 16, 35, 41                      Territory: Germany                      Assessment: Two of the three letters are identical and in the same sequence; the difference in a single letter does not constitute a significant visual and aural difference. The letters “E” and “I” in Germany are pronounced similarly (paras 66-71) – LOC.</p>		
Earlier sign	Contested sign	Case No
Ran	R.U.N.	T-490/07
<p>G&amp;S: 35, 38, 42                      Territory: EU, Germany                      Assessment: The Court held that the signs in the mind of the relevant consumer, having a good command of the English language, are similar (para. 55) and that, due to the similarity between the signs and between certain products and services, there exists a likelihood of confusion in the mind of the relevant public (para. 71) – LOC.</p>		

In contrast, in the following cases the outcome was **no likelihood of confusion**:

Earlier sign	Contested sign	Case No
BRU		B 224 057 R 0541/2001-1 (takes note of withdrawal application)
<p>G&amp;S: 32                      Territory: Benelux, EU                      Assessment: In the present case the goods are identical. Nevertheless, the visual and phonetic dissimilarities between the marks is of such a level that a likelihood of confusion, including the likelihood of association, can be excluded on the part of the public in the relevant territory, that is the Community – NO LOC.</p>		
Earlier sign	Contested sign	Case No
		R 0393/1999-2
<p>G&amp;S: 25                      Territory: Benelux, Germany, Spain, France, Italy, Portugal, Austria                      Assessment: When trade marks are composed of only three letters, with no meaning, the difference in one letter may be sufficient to render them not similar, especially when the first letter is different and the marks in dispute include figurative elements that appear visually different. In this case the pronunciation of the first letters of the marks in dispute, i.e. J and T, is different in all relevant languages. These letters are also visually dissimilar. Further, the figurative elements of the compared marks do not resemble each other (paras 17 and 18) – NO LOC.</p>		

Earlier sign	Contested sign	Case No
	COR	T-342/05
<p>G&amp;S: 3                      Territory: Germany                      Assessment: The GC considered that the signs were only aurally lowly similar (para. 47, 50). The relevant public in Germany will certainly notice the differences in the beginning of the signs – NO LOC.</p>		

## 6.2 Name/Surnames

### 6.2.1 Names

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

### 6.2.2 Business names in combination with other components

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

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

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

Earlier sign	Contested sign	Case No
		T-43/05
<p>G&amp;S: 25                      Territory: Denmark, Finland, Sweden                      Assessment: The dominant element is the term BROTHERS, which represents over 60% of the mark applied for. Furthermore, the position of the words BY CAMPER, together with the smaller size of their typeface, reinforces the dominance of BROTHERS. Therefore, the relevant consumer will focus its</p>		

attention on the word 'BROTHERS' and might attribute a common origin to the goods concerned (paras. 65 and 86) – LOC.

On the other hand, where as a result of the overall assessment the business name is the dominant element and the signs coincide in a term with a low degree of distinctiveness, the differences between the signs might be sufficient to exclude a likelihood of confusion.

Earlier sign	Contested sign	Case No
		R 9/2011-5 T-386/12 (pending)
<p>G&amp;S: 32, 38, 39, all related to mineral water. Territory: UK Assessment: MONDARIZ is the distinctive and dominant element in the contested application because it is the most eye-catching due to its length and to the fact that it is printed in bold letters, which makes it stand out (para. 32). The distinctiveness of ELITE is low, as it is used as a qualifying adjective meaning 'of superior quality' (para. 37). ELITE BY MONDARIZ forms a logical and conceptual unit, meaning 'the top range of mineral waters produced by MONDARIZ' (para. 32), whereas ELITE on its own refers to a group of people or the members of that group. When ELITE is of an adjectival nature, the public will focus its attention on the name that it qualifies (para. 35) – NO LOC.</p>		

### 6.2.3 First and family names

The perception of signs made up of personal names may vary from country to country within the European Union. Family names have, in principle, a higher intrinsic value as indicators of the origin of goods or services than first names. This is because common experience shows that the same first names may belong to a great number of people that have nothing in common, whereas the presence of the same surname (provided it is not common in the relevant territory) could imply the existence of some link between them (identity of the persons or a family link). In determining whether, in a particular country, the relevant public generally attributes greater distinctiveness to the surname than the forename, the case-law of that country, although not binding on the OHIM and the Community courts, may provide useful guidelines (judgment of 01/03/2005, T-185/03, 'Enzo Fusco', para. 52).

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

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

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

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

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

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

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

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

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

A further exception applies in those cases where the public would take/use the **first name of a famous person** as a synonym for the complete name and where the goods/services relate to the field of activity of that person, or where the earlier mark, consisting of a first name only, **has acquired a high degree of distinctiveness**.

Earlier sign	Contested sign	Case No
KENZO	KENZO TAKADA	R 643/2003-1 (T-468/04)
<p>G&amp;S: 3, 25, 42  Territory: EU  Assessment: The average consumer, who will remember the word 'KENZO', which is particularly distinctive because it is so well known, will tend, on coming across goods or services designated by the mark 'KENZO TAKADA', to attribute to them the same commercial origin as the goods or services sold under the 'KENZO' mark. This likelihood is all the more real since it is common in the fashion, cosmetics and perfumes sector for the same mark to be configured in various different ways according to the type of product that it designates (p. 22) – LOC.</p>		

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

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

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

However, when the overall impression created by the signs is one of clear similarity, i.e. the differences between the signs are lost in the overall perception caused by the signs, then, applying the normal criteria, the outcome will be that there is **likelihood of confusion**.

Earlier sign	Contested sign	Case No
 (Emidio Tucci fig.)		T-8/03 and joined cases R 700/2000-4 and R 746/2000-4 Confirmed by C-104/05 P
G&S: 3, 18, 24, 25 Territory: Spain Assessment: Both marks consist of the combination of a first name and a surname and make a similar overall impression – LOC.		

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

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

Earlier sign	Contested sign	Case No
ANTONIO FUSCO	ENZO FUSCO	T-185/03
G&S: 18, 25 Territory: Italy Assessment: Since it was contested that 'Fusco' was not one of the most common surnames in Italy, the Court considered that since the Italian consumer generally attributes greater distinctiveness to the surname than the forename, it will keep in mind the (neither rare nor common) surname 'Fusco' rather than the (common) forenames 'Antonio' or 'Enzo'. Therefore, a consumer faced with goods bearing the trade mark applied for, ENZO FUSCO, might confuse it with the earlier trade mark, ANTONIO FUSCO, so that there is a likelihood of confusion (paras. 53 and 67) – LOC.		
Earlier signs	Contested sign	Case No
CARMEN MARCH	Tila March	T-433/09
G&S: 3, 18, 25 Territory: Spain Assessment: Although 'March' is a known surname in Spain, it is uncommon. As to the term 'Tila', it is more original (as a name) than the common name 'Carmen'; however, it also has a meaning in Spanish. The surname 'March', given its Anglo-Saxon sound and unusual ending, is the element that will most focus the consumers' attention (paras. 31, 32 and 59) – LOC.		

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

Earlier sign	Contested sign	Case No
VITTORIO ROSSI	CHRISTIAN ROSSI	R 0547/2010-2
G&S: 18, 25 Territory: EU Assessment: Not only are consumers throughout the Community aware of the fact that people share the		

same surname without being necessarily related, but they will also be able to distinguish the Italian surname 'ROSSI' bearing two different first names in the fashion field (paras. 33-35) – NO LOC.

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

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

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

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

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

Earlier sign	Contested sign	Case No
MURÚA		T-40/03
<p>G&amp;S: 33                      Territory: Spain                      Assessment: It is common ground that the Spanish public will perceive the verbal element making up the trade mark applied for as a proper name (first name plus surnames) and the earlier trade mark as a surname. It is quite likely that the relevant public will regard the addition, in the trade mark applied for, of the first name 'Julián' and the surname 'Entrena' merely as a way of distinguishing a range of wines produced by the undertaking that owns the earlier trade mark or, at least, an undertaking economically linked to the intervener (paras. 42 and 78) – LOC.</p>		
Earlier signs	Contested sign	Case No
BRADLEY	VERA BRADLEY	R 1918/2010-1

G&S: 11  
 Territory: EU  
 Assessment: The sign for which the CTM applied for seeks protection consists of the term 'Vera Bradley', which will most probably be seen as the name (forename and family name) of a person, fictitious or real. It is composed of the first name 'VERA', which is a common name for women in many EU countries such as, e.g. in the Czech Republic, Germany, Ireland, the Netherlands, Austria, Slovenia, and the United Kingdom, and the surname 'BRADLEY', which is an English family name. The latter surname is not a common family name, neither in English-speaking countries nor in any other countries within the European Union. Even if consumers might be able to distinguish between the signs due to the element 'Vera', which has no counterpart in the earlier trade mark, they will see a specific line of products or an extended form of the mark. Consequently, consumers might believe that the trade marks belong to the same undertakings or economically linked undertakings (paras. 36-37 and 52) – LOC.

### 6.3 Beginning of marks

In predominantly word signs, the first part is generally the one that primarily catches the consumer's attention and therefore will be remembered more clearly than the rest of the sign. This means that in general the beginning of a sign has a significant influence on the general impression made by the mark (judgment of 15/12/2009, T-412/08 'Trubion', para. 40, judgment of 25/03/2009 T-109/07 'Spa Therapy', para. 30).

Nevertheless, the concept 'beginning of the sign' is undetermined, as there is no particular indication of what forms the beginning, what is the end or even if there is or is not a middle part of the sign. Again, this perception mostly depends on the circumstances of the case (length of sign, syllabic distribution, use of typeface, etc.) and not on a set rule. It could even be that a sign is perceived as having a short beginning and ending and a proportionally much bigger middle or central part. Consequently, depending on the circumstances, the rule of the relevance of the beginning of the sign could have less weight to the benefit of a more relevant central part.

As it is usually the beginning of a sign which catches consumers' attention, where signs only differ in their endings, this difference is often insufficient to exclude similarity. However, this is not a fixed rule and the outcome depends on the circumstances of the case. Moreover, this rule only applies when the sign contains a verbal element (which would explain the reading from left to right) and when this verbal element is not very short (otherwise the sign will be perceived immediately in its entirety). Very short signs are signs consisting of three or fewer letters/numbers (see paragraph 6.1 above).

In the following examples, **likelihood of confusion** was found:

Earlier sign	Contested sign	Case No
ALENTIS	ALENSYS	R 1243/2010-1
G&S: 42 Territory: Spain Assessment: The trade marks are visually and phonetically highly similar, in particular because they coincide in their first four letters 'ALEN'. It is generally accepted that people pay more attention to the first part of a trade mark, at least when they perceive the mark visually (para. 33) – LOC.		
Earlier sign	Contested sign	Case No
AZURIL	AZULIB	R 1543/2010-1
G&S: 5 Territory: Greece Assessment: The signs share five of their six letters and the first two syllables are identical. There is a		

certain degree of visual similarity. Aurally the signs are highly similar as the initial part, which is normally the most important, is identical. Neither sign has a meaning in Greek, The similarity of the signs, combined with the identity or similarity of the 'pharmaceutical products', leads to confusion (paras. 35-36) – LOC.

In the following examples, the outcome was **no likelihood of confusion** despite identical beginnings. In some of these cases, the identical beginnings were in fact a weak element in the signs; in others, despite identical beginnings, the conceptual differences outweigh the similarities for a finding of no likelihood of confusion.

Earlier sign	Contested sign	Case No
CALSURA	CALSORIN	R 0484/2010-2
G&S: 5 Territory: EU Assessment: The initial 'CALC' (bringing to mind 'calcium') is not particularly distinctive, but must be considered as a weak trade mark element in relation to the goods at issue (para. 24) – NO LOC.		
Earlier sign	Contested sign	Case No
NOBLESSE	NOBLISSIMA	R 1257/2010-4
G&S: 30 Territory: Denmark, Finland, Sweden Assessment: The signs differ in the fifth letter and in their ending. They are visually similar to an average degree. In view of the length of the CTMA, the signs differ in rhythm and intonation and are thus aurally similar to a low degree. The earlier signs 'NOBLESSE' do have a clear connotation in both Finland and Sweden. In these territories, the word 'NOBLISSIMA' lacks any meaning. They are therefore conceptually dissimilar. The earlier marks are laudatory in nature and to a certain extent descriptive of the characteristics of the goods 'chocolate', namely describing their superior character. The distinctive character is below average. Taking into account the low level of similarity between the goods 'chocolate' and 'edible ices' (Class 30), the low level of aural similarity and the conceptual dissimilarity, there exists no LOC (para. 36) – NO LOC.		
Earlier sign	Contested sign	Case No
ALBUMAN	ALBUNORM	R 0489/2010-2
G&S: 5 Territory: EU Assessment: Visually, phonetically and conceptually the signs are similar in so far as they have the prefix 'ALBU' (abbreviation of 'albumin' or 'albumen') in common. But this similarity is of little significance because the prefix is generic and so devoid of distinctiveness. The second and dominant element of the earlier mark 'MAN' is visually, phonetically and conceptually completely different from the second, dominant element 'NORM' of the contested CTM. Taking into account how highly attentive and well informed consumers being guided by professionals in the medical field are supposed to be, even if applied to the identical goods in Class 5, there is no LOC. (para. 41) – NO LOC.		

## 6.4 Composite signs

For 'composite' signs (signs composed of more than one element e.g. verbal and figurative elements, multi-part word signs), the general rule should be to compare these signs in their entirety, taking into account primarily the overall impression conveyed. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (judgment of 12/06/2007, C-334/05 P 'Limoncello', para. 35).

This rule applies when an element or the whole of a sign is totally or partially included in the other sign:

... assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with

another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (C-334/05 P, 'Limoncello', para. 41).

Still, the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components.

In addition, the distinctive character of the overlapping/common elements has a decisive impact on the similarity of the signs as a part of the general assessment of the likelihood of confusion.

#### 6.4.1 Signs containing figurative and verbal components

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (judgment of 14/07/2005, T-312/03 'Selenium-Ace', para. 37; decision of 19/12/2011, R 0233/2011-4, 'Best Tone' para. 24; decision of 13/12/2011, R 0053/2011-5 'Jumbo', para. 59).

However, the verbal element of a sign does not automatically have a stronger impact (see judgment of 31/01/2013, T-54/12, 'K2 SPORTS', para. 40). The visual impression of a sign may play an important role in its perception by the relevant public, for example when Class 25 goods are at issue.

Besides, the fact that the verbal element may have a stronger impact is a different issue from dominance. The verbal element of a complex sign is not systematically dominant. It is dominant if it is visually outstanding.<sup>4</sup>

Moreover, in assessing the impact of the verbal element of a complex trade mark, account should be taken of the distinctiveness of this element<sup>5</sup>.

- ***Signs with an identical or very similar verbal element and different figurative elements***

A finding of **likelihood of confusion** is normally reached when the verbal elements are identical or similar and the figurative element has neither semantic meaning nor striking stylisation. In this scenario, the figurative element will be considered not to have a significant influence in the relevant public's perception of the sign.

In the following examples, **likelihood of confusion** was found since the verbal elements were identical or similar and the figurative elements were weak or not particularly elaborated.

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<sup>4</sup> See The Guidelines Concerning Opposition. Part 2: Identity and Likelihood of Confusion. Chapter 5: Dominant Elements.

<sup>5</sup> See The Guidelines Concerning Opposition. Part 2: Identity and Likelihood of Confusion. Chapter 4: Distinctiveness.

Earlier sign	Contested sign	Case No
NORMA		T-213/09 (confirmed C-191/11P)
<p>G&amp;S: 35, 42                      Territory: EU                      Assessment: The GC considered the figurative element of the contested sign as non-negligible. However, given that its stylisation is not excessively elaborated and it does not have semantic content, it was concluded that it was not capable of substantially influencing the consumer's overall impression (paras. 67-68) – LOC.</p>		
Earlier sign	Contested sign	Case No
COTO DE IMAZ EL COTO		T-276/10 (invalidity proceedings)
<p>G&amp;S: 33                      Territory: EU                      Assessment: The GC considered that the figurative element of the contested sign was weak for the relevant goods and therefore did not have a strong impact on the overall perception of the sign (para. 45) – LOC.</p>		
Earlier sign	Contested sign	Case No
	PUKKA	T-483/10
<p>G&amp;S: 18                      Territory: Spain, EU                      Assessment: The figurative elements of the earlier Community trade mark – namely, the oval and the geometric shape vaguely recalling a five-point star superimposed thereon – do not convey any identifiable conceptual content. Consequently, it is highly unlikely that these figurative elements will hold the attention of the relevant consumer. By contrast, although the verbal element does not convey any conceptual content either, the fact remains that it may be read and pronounced and that it is, therefore, likely to be remembered by consumers. Therefore, the verbal element of the earlier Community trade mark must be considered to dominate the visual impression made by that mark (para. 47) – LOC.</p>		

In contrast, when the common verbal elements are (even) less distinctive than the figurative elements, the differences in the figurative elements will tip the balance for **no likelihood of confusion**:

Earlier sign	Contested sign	Case No
		T-60/11
<p>G&amp;S: 30, 31, 42                      Territory: EU                      Assessment: The word element 'premium' in this case does not lead to a finding of likelihood of confusion, even where the goods are identical. The similarity of the marks is based solely on a word that</p>		

<p>has no distinctive character and would not be remembered by consumers as the key element of the marks at issue. (para. 53) – NO LOC.</p>		
 <p>THE NATURAL CONFECTIONERY CO.</p>		<p>R 1285/2009-1 (invalidity)</p>
<p>G&amp;S: 29 (sweets and sugar confectionery) Territory: EU Assessment: Although the word 'NATURAL' occupies a substantial part of the marks, consumers will not see it as a distinctive element (para. 25) Although the goods at issue are identical, the overall impression given by the marks at issue would not give rise to a likelihood of confusion in the minds of the relevant public. Faced with the two signs at issue it would be absolutely impossible for the relevant public to establish a link between them giving rise to a likelihood of confusion based on the presence in both of the descriptive word 'NATURAL' causing the public to believe that the goods concerned came from the same undertaking or from economically-linked undertakings (para. 33) – NO LOC.</p>		
Earlier sign	Contested sign	Case No
 		<p>R 0745/2009-2</p>
<p>G&amp;S: 3, 9, 35 Territory: Spain Assessment: The conceptual differences outweigh the visual and aural similarities. Moreover, the BoA considered the term 'AROMA' to be generic for the relevant goods (para. 31) – NO LOC.</p>		
Earlier sign	Contested sign	Case No
		<p>R 1321/2009-1</p>
<p>G&amp;S: 19, 35 Territory: EU Assessment: The weakness of the verbal element 'PreTech' of the earlier mark and the significant visual differences between the two conflicting signs attenuate the effect of the aural similarity. Furthermore, the degree of aural similarity between two signs is of less importance where the relevant public sees the name of a mark on the goods and services which it buys, as can be expected in the present case (para. 27) – NO LOC.</p>		
Earlier sign	Contested sign	Case No
		<p>R 1357/2009-2</p>
<p>G&amp;S: 5, 29, 30, 32 Territory: EU Assessment: The BoA took into account the non-distinctive and descriptive character of the word</p>		

'Lactofree' for the relevant goods. The Board found that the notable visual and conceptual differences between the signs would counterbalance the partially identical and partially similar nature of the goods (para. 98) – NO LOC.

- **Signs with an identical or very similar figurative element and different verbal elements**

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

In the following examples, due to the aural and conceptual differences **no likelihood of confusion** was found despite the visual similarities of the signs.

Earlier sign	Contested sign	Case No
	 (IBIZA REPUBLIC)	T-311/08
<p>G&amp;S: 25, 41, 43                      Territory: France                      Assessment: Taking into account the phonetic and conceptual dissimilarities and low degree of visual similarity between the signs, the lack of enhanced distinctiveness for the earlier mark and the dominant character of the verbal element in the mark applied for, the Board was not mistaken in considering that there was not a likelihood of confusion even in the presence of identical goods (para. 58) – NO LOC.</p>		
Earlier sign	Contested sign	Case No
		R 0280/2009-4
<p>G&amp;S: 16, 36, 41                      Territory: Germany                      Assessment: The only thing the two signs have in common is that they depict a cross with eight characteristic points, known as a 'Maltese cross', referring to the Order of Malta. Even in the area in question, 'charitable fundraising; education, periodicals; medical services' (Classes 16, 36, 41, 45), the specific Maltese cross shape is not used exclusively by the appellant. The CTMA contains the unreservedly distinctive word sequence 'Pro concordatia populorum' and cannot be reduced to its figurative element. The signs are also dissimilar phonetically, as the opposing sign has no verbal elements. There is no conceptual similarity, as the CTMA means 'for the understanding of the peoples', a phrase that has nothing in common with the earlier sign. Therefore, there can be no LOC, even in the case of the identical goods found only in Class 16 – NO LOC.</p>		
Earlier sign	Contested sign	Case No
		R 1373/2009-2
<p>G&amp;S: 9, 12, 14, 18, 22, 25, 28                      Territory: EU                      Assessment: In the Board's view, bearing in mind the low distinctive power of the similar figurative</p>		

components of the marks, and the main distinctive role played by the verbal component in the applicant's sign, there is no LOC despite the identity or similarity of the contested goods in Classes 9, 12, 14, 18, 22, 25 and 28 – NO LOC.

A finding of **likelihood of confusion** is possible, however, in cases of a clear dominant character of the common figurative component and negligible consideration of the dissimilar verbal element or due to the limited distinctiveness of the verbal component:

Earlier sign	Contested sign	Case No
		Joint R 0068/2001-4 and R 0285/2001-4
<p>G&amp;S: 18, 24, 25, 28                      Territory: Benelux, Germany, Spain, France, Italy, Austria                      Assessment: The respective trade marks coincide in that one consists of an animal's paw print and the other includes an animal's paw print. There are differences between the devices, e.g. the opponent's registrations include claws. However, the overall impression is of a paw print in black. The verbal element of the contested application is not present in the opponent's trade mark. In a French linguistic context, the verbal element of the contested application will be seen to mean, as stated by the applicant, 'the fake fur house'. As such it is an element with inherently very limited distinctiveness – LOC.</p>		

In other cases, the figurative element may 'cooperate' with the verbal part in defining a particular concept and may even help with the understanding of words that, in principle, might not be widely known to consumers. Therefore, in the following examples, **likelihood of confusion** was found despite the verbal element being present only in one of the signs:

Earlier sign	Contested sign	Case No
		B 210 379
<p>G&amp;S: 3                      Territory: Germany, Spain                      Assessment: The signs were considered sufficiently similar for LOC based on identity of goods as the figure of a moon, present in both signs, made the equivalence between the Spanish and English words 'LUNA' and 'MOON' clearer to Spanish consumers – LOC.</p>		
Earlier sign	Contested sign	Case No
		R 1409/2008-2
<p>G&amp;S: 18, 25, 35                      Territory: EU                      Assessment: Visually, the trade marks are highly similar. An aural comparison is not possible. Conceptually, the word 'horse' means 'cheval' in the language of the case (French). This element will be understood by English-speaking consumers as a direct reference to the figurative element of the contested CTM. Therefore, the marks are conceptually identical. Considering the fact that the average consumer does not, as a rule, have the chance to make a direct comparison between the marks and given the principle of interdependence of the factors, there is a likelihood of confusion between the signs when applied to the identical goods in Classes 18 and 25 – LOC.</p>		

#### 6.4.2 ‘Multi-part’ word signs

In these cases the whole sign or just one of its components is fully incorporated in the other sign, i.e. the earlier sign (or a component thereof) is fully included in the contested sign or vice-versa.

The most frequent and problematic type of case concerns one word against two words. This may lead to a similarity of the trade marks and result, together with other factors, in a likelihood of confusion, as stated by the Courts in the following cases:

... the fact that [a mark] consists exclusively of the earlier ... mark, to which another word ... has been added, is an indication that the two trade marks are similar.

(See judgment of 04/05/2005, T-22/04 ‘Westlife’, para. 40.)

... where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar.

(See judgment of 25/11/2003, T-286/02, ‘KIAP MOU’, para. 39.)

In the following judgment a further criterion (an independently distinctive role of the common element) was mentioned:

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

(See judgment of 06/10/2005, C-120/04 ‘Thomson Life’, para. 37.)

When assessing whether the coincidence in a verbal element may lead to a similarity of the signs and (together with further relevant factors) to likelihood of confusion, two factors are of importance: whether the common element is (a) recognisable and (b) has an independent distinctive role.

- ***Recognisable element***

It is of particular importance whether the common word can be identified in an isolated manner in the composite mark, either because it is separated by a space or hyphen, or is otherwise (because of its clear meaning) identified as an individual element.

An average consumer perceiving a word sign will break it down into elements which suggest a concrete meaning or resemble known words (judgment of 06/10/2004, T-356/02 ‘Vitakraft’, para. 51, confirmed by C-512/04 P).

On the other hand, mere coincidence in a string of letters is not enough for similarity. Decisions should not be based on the mere fact that one sign is ‘contained’ in the other.

In the following examples the coincidence is clearly perceived since the common part is a separate word:

Earlier sign	Contested sign	Reason	Case No
CENTER	CENTER SHOCK	The earlier TM corresponds to the first word of the CTMA.	C-353/09
SCHUHPARK	JELLO SCHUHPARK	The earlier TM is identical to the second word of the CTMA.	T-32/03
FLEX	FLEXI AIR	The CTMA consists essentially of the word “flex” (para. 64).	T-112/03 (confirmed by C-235/05P)

In the following examples the common element is a part of a word, but could be identified since the public will logically split the word according to the meaning of its elements:

Earlier sign	Contested sign	Reason	Case No
CADENACOR	COR	Spanish-speaking public will identify the elements ‘cadena’ and ‘cor’ in the earlier TM (para. 47).	T-214/09
BLUE	ECOBBLUE	The relevant public will split the CTMA into the commonly used prefix ‘eco’ and the word ‘blue’ (para. 30).	T-281/07 confirmed by C-23/09 P)

In the following examples the coincidence was not recognisable:

Contested sign	Earlier sign	Reason	Case No
PARAVAC	ARAVA	Mere coincidence in a string of letters, when the first and the last letter of the CTMA change its overall impression.	R 1398/2006-4
LUXINIA	LUX	Mere coincidence in a string of letters	R 347/2009-2
CS	CScreen	The earlier sign will probably be broken down into the elements ‘C’ and ‘Screen’, which is highly relevant for computers and their peripherals. It will not be perceived as containing the separate distinctive entity ‘CS’.	R 545/2009-4
VAL DO INFERNO	VALDO	The elements VAL and DO are separate.	R 1515/2008-4

Although more attention is usually paid to the beginning of a word, it generally does not matter much whether the common element constitutes the first or second element of the composite mark. In particular, where the contested trade mark is the composite mark, it should not matter too much whether the contested trade mark incorporates the earlier mark as its first or second element. The protection against likelihood of confusion applies in both directions: the owner of the earlier mark is protected not only against the contested trade mark being understood as referring to its goods/services, but also against its mark being taken as referring to the applicant’s goods/services.

- **Independent distinctive role**

The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression conveyed by the composite sign is **dominated** by the part of it represented by the earlier mark (judgment of 11/12/2008; C-57/08 P ‘ACTIVY Media Gateway’, para. 53; judgment of 06/10/2005, C-120/04 ‘Thomson Life’, para. 32).

On the other hand, a coincidence in a **weak or visually negligible element** will usually not result in likelihood of confusion. The fact that the sign making up the earlier mark is reproduced in the mark applied for and holds therein an independent role does not lead to likelihood of confusion if that common element is not distinctive or if additional elements outweigh this common element.

For the analysis of composite signs vs. one-word signs **the level of distinctiveness** of the common or differing elements is of particular significance. Coincidence in a weak element will not lead to likelihood of confusion:

Earlier sign	Contested sign	Case No
GATEWAY,  et al	ACTIVY Media Gateway	T-434/05 (confirmed by C-57/08 P)
G&S: 9, 35, 38, 42 Territory: EU Assessment: “ ... both the element ‘media gateway’ and the element ‘gateway’ in the trade mark applied for directly evoke, in the mind of the relevant consumer, the concepts of a media gateway and a gateway, which are commonly used in the computing sector. Those elements of the trade mark applied for are therefore highly descriptive of the goods and services covered by that trade mark” (para. 48) – NO LOC.		
Earlier sign	Contested sign	Case No
	P&G PRESTIGE BEAUTE	T-366/07
G&S: 3 Territory: Italy Assessment: The Court considered that the element ‘prestige’ of the mark applied for was laudatory in nature and to a certain extent descriptive of the claimed characteristics and intended use of the goods at issue (para. 65) – NO LOC.		

However, the Court speaks in favour of **likelihood of confusion** if the element in which the marks differ is of less inherent distinctiveness than the common element:

Earlier sign	Contested sign	Case No
	 (NEGRA MODELO)	T-169/02
G&S: 25, 32, 42 Territory: Portugal Assessment: ‘Negra’ is a descriptive component, since it may be used in Portuguese to designate brown		

beer, i.e. the type of beer sold under the trade mark NEGRA MODELO. The attention of the average Portuguese consumer will be focused on the word 'modelo' (paras. 36-37) – LOC.

The higher degree of distinctiveness of the common element may also be acquired through use:

Earlier sign	Contested sign	Case No
CRISTAL		R 0037/2000-4 T-29/04 (C-131/06 P)
<p>G&amp;S: 33                      Territory: France                      Assessment of the earlier mark 'CRISTAL': As regards the claim that 'Cristal' is a descriptive word for the goods at issue (sparkling wines with crystalline character), the Board cannot accept it. On the one hand, it is an evocative indication which suggests the crystalline character of wines, but which in no way describes the product. On the other hand, [the Board] considers that a highly distinctive character of the mark CRISTAL on the French market had been shown (para. 31) – LOC.                      The Court confirmed LOC but found renown of CRISTAL only for a part of the relevant public (professionals) (para. 67).</p>		

- **Importance of additional (not common) elements**

The next factor to be taken into account in the analysis is the importance and weight of the additional (not common) elements in the overall impression of both signs. Elements like length, structure and configuration of the signs played a role in the following examples:

Earlier sign	Contested sign	Case No
LOFT	ANN TAYLOR LOFT	T-385/09
<p>G&amp;S: 18, 25, 35                      Territory: France                      Assessment: The word 'loft' is not the distinctive element in the mark applied for. Furthermore, it is also apparent from the same findings that it is the 'ann taylor' element, because it lacks meaning for the target public, that must be considered more distinctive than the word 'loft' in the mark applied for, as the latter word has a specific meaning for that public (paras. 43-49) NO LOC.</p>		
Earlier sign	Contested sign	Case No
	P&G PRESTIGE BEAUTE	T-366/07
<p>G&amp;S: 3                      Territory: Italy                      Assessment: The trade marks both contain the word 'prestige' (which is represented in the earlier mark in a special font without any other figurative element). However, this coincidence is offset in particular by the different length and configuration of the signs overall. The CTMA is longer than the earlier TM, and the element 'p&amp;g' at the beginning will attract the attention of the public. 'Prestige' is also laudatory by nature (paras. 62-68) – NO LOC.</p>		

- **Practical suggestions**

As a rule, when one of the conflicting trade marks or a part thereof is reproduced in the other mark, there will be a similarity of signs, which together with other factors may lead to **likelihood of confusion**, unless:

- the common element is no longer recognisable as such in the other mark (PARAVAC / ARAVA);
- the elements added in the other mark are clearly preponderant (P&G PRESTIGE BEAUTE / Prestige);
- through the addition of other elements, the other mark becomes conceptually different (invented example: Line / Skyline)<sup>6</sup>;
- the common element has a low degree of inherent distinctiveness or is close to a descriptive term (ACTIVY Media Gateway / GATEWAY).

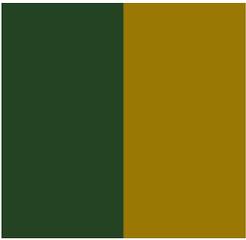
In all other cases the general rule of thumb is that if a sign as a whole is fully incorporated in the other sign, the signs are similar. In addition, when the goods are identical or highly similar, in the absence of other specific factors, there will be **likelihood of confusion**.

As seen, both these rules apply where both signs contain elements in addition to the common component. The coincidence in one word is, however, generally not sufficient in itself for establishing likelihood of confusion: the impact of the common element on the overall impression of both signs has to be compared with the impact of the differing parts. In this context the existence of an additional element in each of the signs under comparison is more likely to outweigh the coincidence in a common component than where a one-word mark is contained in another word mark.

## 6.5. Colour marks *per se*

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

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

Earlier sign	Contested sign	Case No
		R 0755/2009-4
<p>G&amp;S: 8                      Territory: EU                      Assessment: In the case at hand, the colour combinations, identified by different colour codes, are not sufficiently close to lead to a likelihood of confusion, taking into account that the inherent distinctiveness</p>		

<sup>6</sup> See The Guidelines Concerning Opposition. Part 2: Identity and Likelihood of Confusion. Chapter 3: Comparison of Signs. Conceptual Comparison.

is limited (para. 18). The BoA referred to ECJ judgments and public interest in ensuring that colours remain available to competitors (para. 19). The opponent did not prove enhanced distinctive character (para. 25) – NO LOC.