



Promoting Intellectual
Property Rights in the
ASEAN Region

LIKELIHOOD OF CONFUSION

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LIKELIHOOD OF CONFUSION - GENERAL

Article 8.1.b) EUTMR: *“if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark”*

➤ **EU Courts:** likelihood of confusion = the risk that the public might believe that the goods or services in question come from the same undertaking (direct confusion) or, as the case may be, from economically-linked undertakings (indirect confusion) (CJEU 29 September 1998, C-39/97, Canon, par. 29)

Notion of Likelihood of Confusion

The concept of likelihood of confusion refers to situations where:

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

LIKELIHOOD OF CONFUSION - GENERAL

- step 1: identity or similarity between goods and services
 - step 2: identity or similarity between the signs
- no similarity between G & S or signs: **GAME OVER**

This finding would still be valid even if the earlier trade mark were to be considered as enjoying a high degree of distinctiveness. Given that the dissimilarity of the gg/ss cannot be overcome by the highly distinctive character of the earlier trade mark

Other factors:

- Relevant public and degree of attention
- Distinctiveness of the earlier mark
- Global assessment of the likelihood of confusion

Similarity of goods/services

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

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

Goods and services similarity harmonized database <https://euipo.europa.eu/sim/>

Relevant public and degree of attention

The level of attention is likely to vary according to the category of goods or services in question (ordinary mass consumer goods vs goods of high value / exceptional goods)

Expensive purchases (e.g. Cars, financial services, real estate services, business management, business administration)

Brand loyalty (tobacco products)

Pharmaceuticals goods as they affect the state of health

SIMILARITY BETWEEN SIGNS – OBJECTIVE COMPARISON

The unitary character of the European Union trade mark.

The similarity of signs depends on the **distinctiveness** and **dominant character** of their components, and on other possible relevant factors. When comparing signs, their visual, phonetic and conceptual similarity must be assessed by weighing up the coinciding and the differing elements, and by taking into consideration their distinctiveness and dominance as well as whether and to what extent these elements determine the overall impression conveyed by the marks.

SIMILARITY BETWEEN SIGNS – OBJECTIVE COMPARISON

The relevant consumers, when perceiving a verbal sign, will break it down into elements that suggest a concrete meaning, or that resemble words that they already know (13/02/2007, T-256/04, *Respicur*, EU:T:2007:46, § 57; 13/02/2008, T-146/06, *Aturion*, EU:T:2008:33, § 58).

The relevant public will understand the foreign word:

- It is very close to the equivalent word in the official language in the relevant territory;
- Basic English word, which will be understood in all Member States;
- The relevant public is familiar with the foreign language concerned (Scandinavian countries).

SIMILARITY BETWEEN SIGNS – OBJECTIVE COMPARISON

Dominant element (the most eye-catching/visually outstanding)

Beginning of the signs, consumers generally pay more attention to the beginnings of marks rather than to the ends

Verbal component of the sign usually has a stronger impact on the consumer than the figurative component

Short signs the public is more easily able to perceive all of its single elements

SIMILARITY BETWEEN SIGNS – OBJECTIVE COMPARISON

Visually

Aurally

Conceptually

Degree of similarity according to the distinctiveness/dominance of the elements of the signs

SIMILARITY BETWEEN SIGNS – OBJECTIVE COMPARISON - Examples

BOHEME



BOHEMATIC

SPIRIT OF TIME

Earlier trade mark

Contested sign

The relevant territory is the European Union.

SIMILARITY BETWEEN SIGNS – OBJECTIVE COMPARISON - Examples

CASA RIVAS



CASA RELVAS

Earlier trade mark

Contested sign

The relevant territory is the European Union.

SIMILARITY BETWEEN SIGNS – OBJECTIVE COMPARISON - Examples



Earlier trade mark



Contested sign

The relevant territory is the European Union.

Examples

Ecogel



Examples



Olitalia!



Distinctive character of the earlier mark

The distinctive character of the earlier mark determines the protection afforded to that mark

The Court has defined distinctiveness in the following manner: the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings.

The distinctive character is a matter of degree.

Inherent and enhanced distinctiveness.

Earlier registered trade marks are presumed to have at least a minimum degree of inherent distinctiveness.

Global assessment

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.

1. similarity of the goods and services;
2. the relevant public and its degree of attention and sophistication;
3. similarity of the signs taking into account their distinctive and dominant elements;
4. the distinctiveness of the earlier mark.

Interdependence Principle

A lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17). This principle of interdependence is crucial to the analysis of likelihood of confusion.

The finding of a likelihood of confusion may be justified when the signs are identical or highly similar, despite a low degree of similarity between the goods/services and vice versa.

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 degree of attention is likely to vary according to the category of goods or services in question.

Even consumers with a high degree of attention need to rely on their imperfect recollection of trade marks.

Impact of the Method of Purchase of Goods and Services

➤ Visually similarity

Generally, in clothes shops, customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff.

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.

➤ Aural similarity

Goods normally ordered at sales points with an increased noise factor, such as bars or nightclubs (beverages)



Impact on Likelihood of Confusion of Components Non-Distinctive or Distinctive Only to a Low Degree

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

Examples

T-169/10 TORO XL / XL

Class 33 Alcoholic beverages

No LOC. The coinciding letters 'XL' have a low degree of distinctiveness for the goods in question.

'XL' is an abbreviation of extra-large size used within the whole EU.

Examples

T-123/14 waterPerfect/AquaPerfect

Goods in Class 7.

LOC. While the element ‘Perfect’ has a laudatory character, the fact remains that none of the other elements in the signs can be considered to have a greater distinctive character or be dominant.

The elements ‘aqua’ and ‘water’ also have a weak distinctive character

Examples

T-605/11

BIOCERT/BIOCEF

Goods in Class 5.

LOC. Although the element 'BIO' is descriptive for the goods in question, the trade marks coincide not only in these three letters, but also in their fourth and fifth letters, 'c' and 'e'. the differences does not counteract the similarities.



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