



THE LIKELIHOOD OF CONFUSION

Sophia Bonne | Gros Islet, SAINT LUCIA | 25-28 October 2022



CARIFORUM



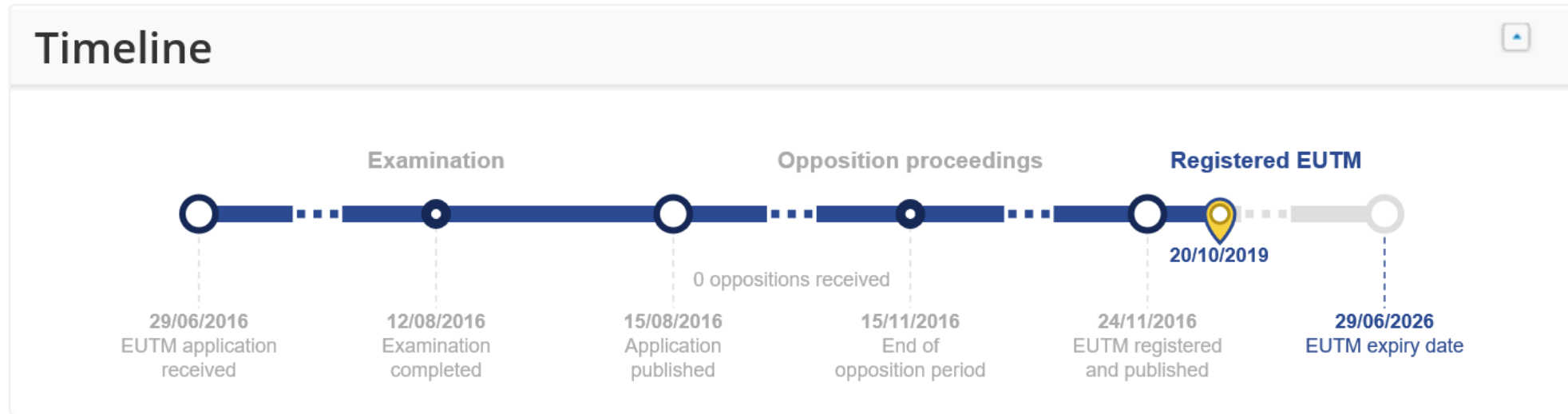
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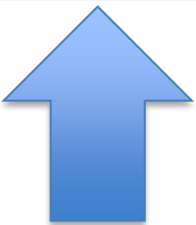
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Context :

1. Absolute grounds vs Relative grounds for refusal
2. Opposition Proceedings
3. Likelihood of confusion
 - Comparison of goods and services
 - Relevant public and degree of attention
 - Comparison of signs
 - Distinctiveness of the earlier mark
 - Overall assessment and other factors
4. Cancellation Proceedings

AG / RG landscape



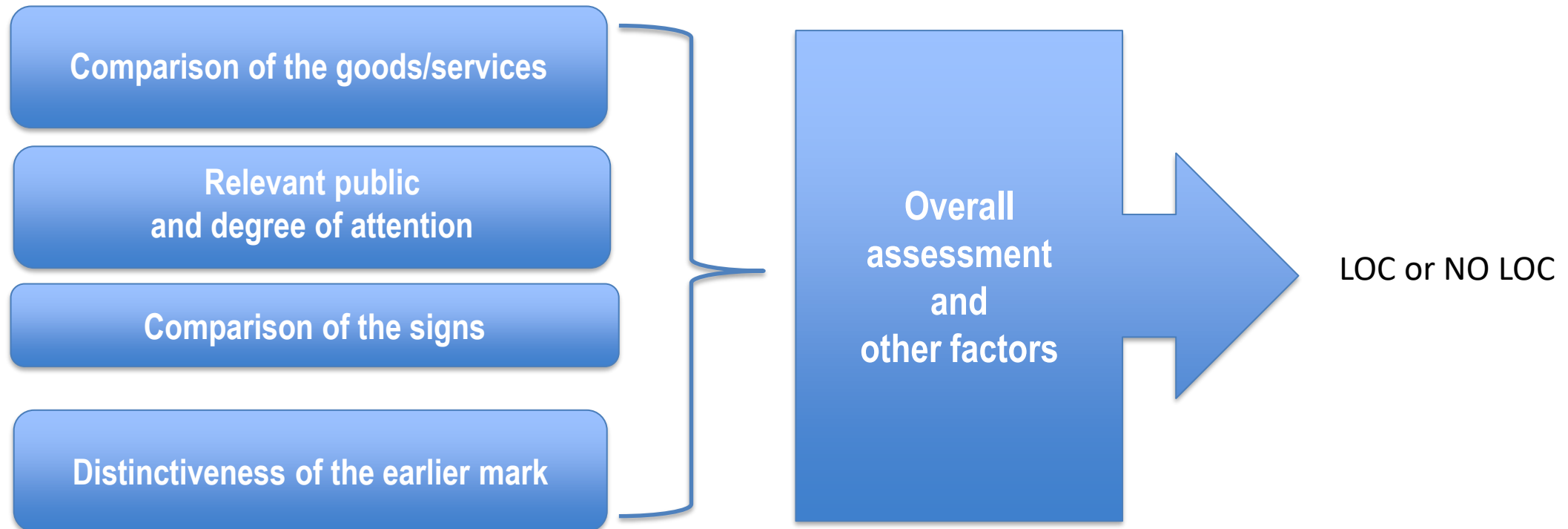

AG examination


Opposition


Cancellation

LIKELIHOOD OF CONFUSION

(b) 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.



1. COMPARISON OF GOODS AND SERVICES

11th edition available [here](#)
Nice Classification



45 classes = 34 of goods + 11 of services

OVERLAP

Components and spare parts for land vehicles
versus
vehicle seats



Overlap in:
seats for land vehicles

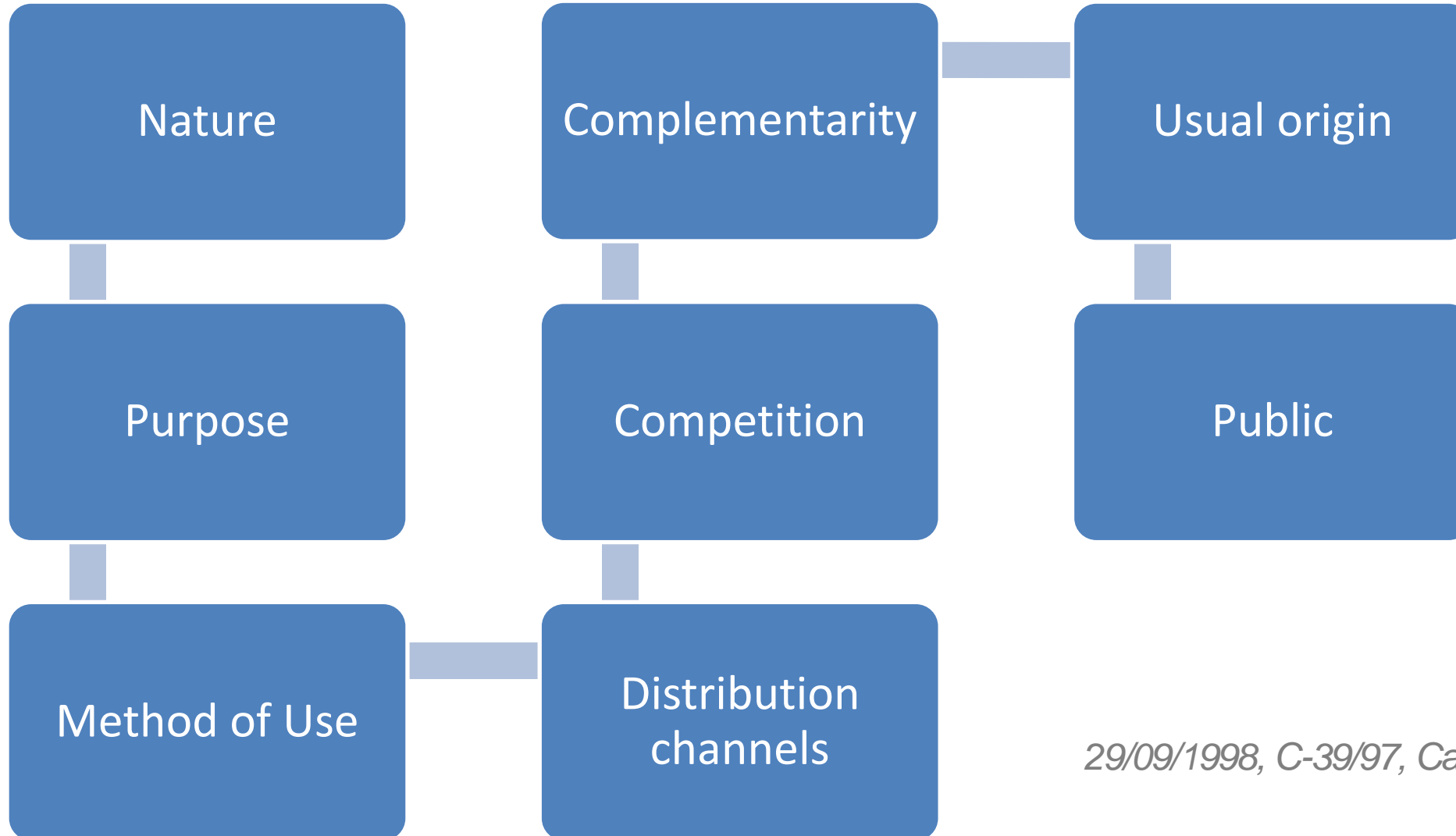
Outdoor clothing for men
versus
clothing made of leather



Overlap in:
outdoor men's clothing, made of leather

COMPARISON OF GOODS AND SERVICES

SIMILARITY



'Canon Criteria'
29/09/1998, C-39/97, Canon, EU:C:1998:442

COMPARISON OF GOODS AND SERVICES

WEIGHT OF FACTORS

Class 32



STRONGER

nature

purpose

in competition

complementary

(usual) origin

WEAKER

methods of use

distribution channels

relevant public

Class 33



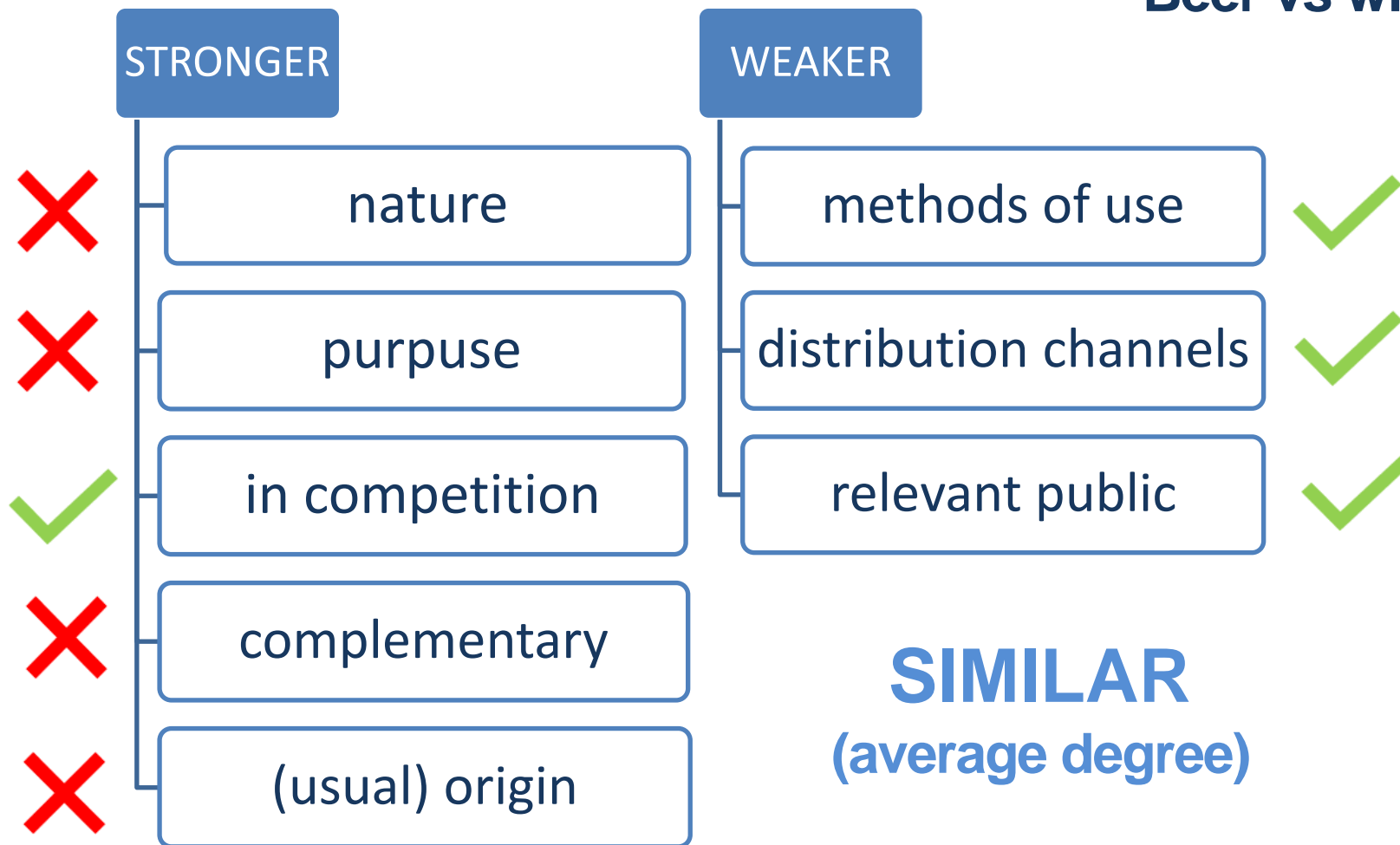
COMPARISON OF GOODS AND SERVICES

Beer vs wine challenge

Class 32



Class 33



COMPARISON OF GOODS AND SERVICES

BINDING RESOURCES

Similarity Tool <http://euipo.europa.eu/sim/>

Similarity

Home Compare terms Compare list of terms

My List: No pairs selected. View

Similarity » Compare terms

Search language: English (en) | Results language: English (en) | Term: beer | Nice Class: 32

vs

Term: wine | Nice Class: 33

* Advanced criteria

Results

Download as Excel file

Show 100 entries

Pair ID	Office	Class 1	Term 1	Similarity	Class 2
0040447-0016148	EUIPO (EM)	32	Beer	Similar	33

Wine in Class 33 is/are similar to a Beer in Class 32 as they usually coincide in relevant public, distribution channels and method of use. Furthermore they are in con

Showing 1 to 1 of 1 entries

The EUIPO Guidelines
<https://guidelines.euipo.europa.eu/1922895>

Check **ODIN 12**:
Comparison of Goods and Services in RG Decisions

EU IPO

Complete Edition | beer | Trade mark guidelines | Edition 2021 | English

Degree of Similarity: Any | Select Offices: Office - | Pair ID: 123-456 | * EUIPO

- 5.4 Fashion and Textile Industries
- 5.5 Food, Beverages and Restaurant Services
 - 5.5.1 Ingredients of prepared food
 - 5.5.2 Main ingredient
 - 5.5.3 Non-alcoholic beverages
 - 5.5.4 Beers (Class 32), alcoholic beverages (except beers) (Class 33)
 - 5.5.5 Provision of food and beverages
- 5.6 Services to Support Other Industries
- 5.7 Retail Services
- 5.8 Financial Services
- 5.9 Transport, Packaging and Distribution
- 5.10 Information Technology

Trade mark guidelines

4 > 5.5 Food, Beverages and Restaurant Services

Show modifications

5.5.4 Beers (Class 32), alcoholic beverages (except beers) (Class 33)

There is a similarity between different alcoholic beverages in Class 33, as well as between the broad category of *alcoholic beverages* and *beer* in Class 32. Although their production processes are different, these goods all belong to the same category of alcoholic drinks (nature) intended for the general public. They can be served in restaurants and in bars and are on sale in supermarkets and grocery stores. These drinks can be found in the same area of supermarkets, even if some distinction according to their respective subcategory can be made. Furthermore, some alcoholic beverages may originate from the same undertakings.

Examples

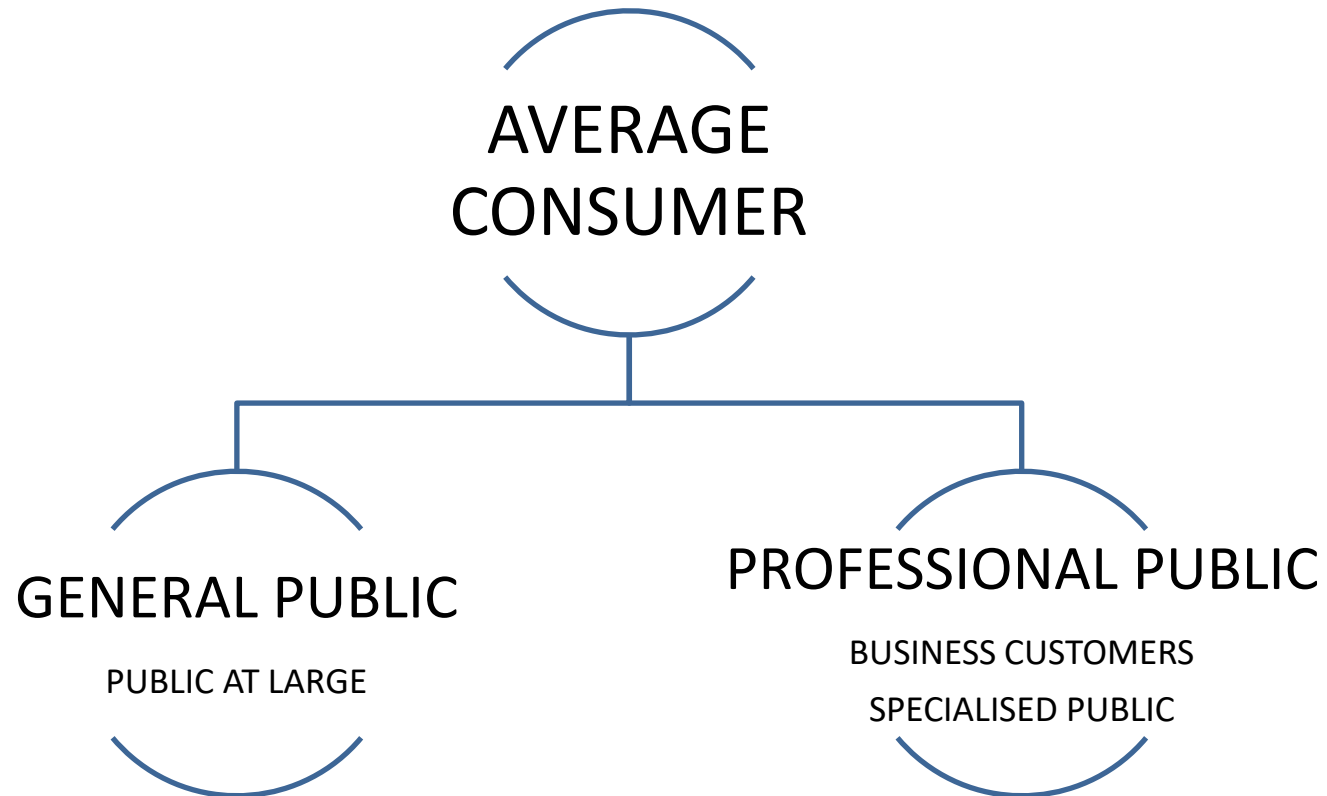
- Beers are similar to *alcoholic beverages (except beers)*
- Wines are similar to *alcoholic beverages (except wines)*

Parent topic: 5.5 Food, Beverages and Restaurant Services

Version: 1.0 | Entry into force: 01/03/2021 | FINAL

2. RELEVANT PUBLIC AND DEGREE OF ATTENTION

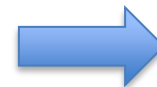
*The average consumer of the products concerned is deemed to be **reasonably well informed** and **reasonably observant and circumspect**, and that the relevant public's degree of attention is likely to vary according to the category of goods or services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26)*



RELEVANT PUBLIC AND DEGREE OF ATTENTION



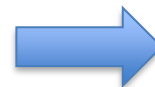
Class 25: *Clothing; footwear; headgear*



General public
Average degree of attention



Class 5: *Pharmaceuticals*



General + professional public
High / higher than average

3 COMPARISON OF SIGNS

IDENTITY

The EUTM application should be considered **identical** to the earlier trade mark ‘where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer (20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 50-54). An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon examining the marks side by side.

Earlier sign	Contested sign	Case No
BLUE MOON	Blue Moon	R 835/2010-1
GLOBAL CAMPUS	Global Campus	R 719/2008-2
DOMINO	Domino	R 523/2008-2
Apetito	APETITO	T-129/09

The Court has held that the global appreciation of the visual, aural and 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’, EU:C:1997:528, § 23)

Three aspects of the comparison:

- **Visual** – what the consumer sees
- **Aural** – how the consumer pronounces the elements
- **Conceptual** – the concept(s) that the sign evoke

In the relevant territory

Taking into account:

- **Distinctive elements: may vary depending on G&S or language**
- **Dominant elements: visually outstanding**

COMPARISON OF SIGNS

DOMINANT ELEMENTS

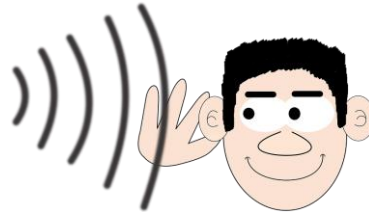
- Determined by its **position**, **size**, **dimensions** and/or use of **colours**, to the extent that they affect its visual impact.
- Weak distinctive character of an element of a complex mark **does not necessarily imply** that that element cannot constitute a dominant element.
- Word marks have no dominant elements (it is the word as such that is protected and not its written form).



COMPARISON OF SIGNS

AURAL COMPARISON

- EU territory: account must be taken of **all the different pronunciations** of the signs by the relevant public in all official languages of these states.
- The overall phonetic impression produced by a sign is particularly influenced by the **number** and **sequence of its syllables**. The common **rhythm** and **intonation** of signs play an important role in how signs are perceived phonetically.
- Purely figurative marks (i.e. not containing any word element) are **not subject** to a phonetic assessment.
- If one sign has elements that can be read and the other has only figurative elements, the outcome is that **no phonetic comparison can be made**.
- Figurative elements reminiscent of a letter are read only if they are linked to or form part of a word known to the relevant public.

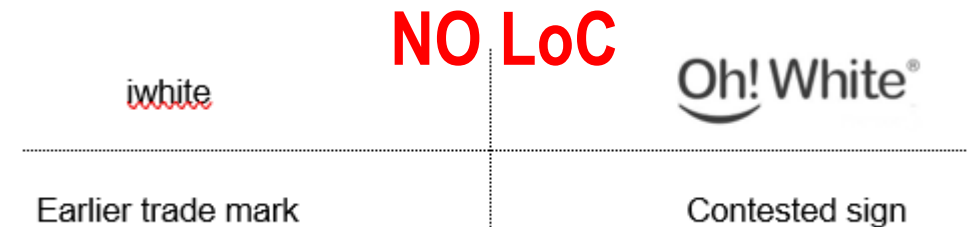


COMPARISON OF SIGNS

CONCEPTUAL COMPARISON

Two signs are identical or similar conceptually when they are perceived as having the same or analogous semantic content.

- Dictionary meaning(s).
- Words close to equivalent words in the official language ('bicycle' in EN and 'bicicleta' in ES).
- Words commonly used in a certain territory or industry ('white' for *teeth whitening products* in Class 3)



B 3 051 112

- Well-known fact that the language is understood (case-law confirming that English is understood in the Scandinavian countries, the Netherlands and Finland).
- Specific groups (English known in IT, financial sectors, etc.).
- Basic EN & internationally recognised words ('love', 'VIP', 'pizza', 'snack', 'baby', 'blue', etc.).
- Evidence provided by the parties that a word is known by a relevant portion of the relevant public.

INTERDEPENDENCE PRINCIPLE

*The likelihood of confusion on the part of the public must be assessed **globally**, according to the relevant public's perception of the signs and of the goods and services in question, and taking into account all factors relevant to the circumstances of the case, in particular the similarity of the marks and the similarity of the goods and services, which are **interdependent criteria** in the sense that **a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa** (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).*

GLOBAL ASSESSMENT AND OTHER FACTORS

INTERDEPENDENCE PRINCIPLE

Similarity of the G&S

Similarity of the signs

Degree of attention

Relevant public

Distinctiveness of
the earlier mark



Other Factors

Market
peculiarities

Family of
marks

Cases of actual
confusion

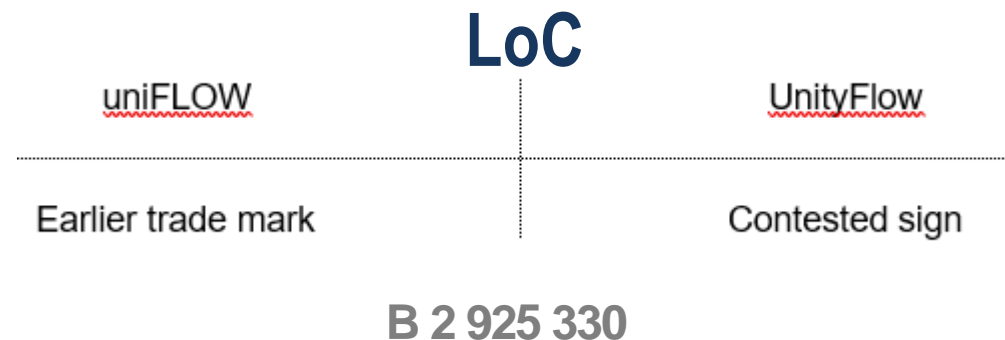
Co-existence

Prior cases

IMPERFECT RECOLLECTION

Average consumers rarely have the chance to make a direct comparison between different marks, but must trust in their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26)

Even consumers who pay a high degree of attention need to rely on their imperfect recollection of trade marks (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 54)



GLOBAL ASSESSMENT AND OTHER FACTORS

IMPACT OF THE METHOD OF PURCHASE

Class 25: Clothing

the visual aspect plays a greater role



NO LoC

<i>Contested mark</i>	<i>Earlier mark</i>
	Chiara

GLOBAL ASSESSMENT AND OTHER FACTORS

IMPACT OF THE METHOD OF PURCHASE



Class 33: Alcoholic beverages

It should be borne in mind that the relevant goods are beverages and, since these are frequently ordered in **noisy establishments** (bars, nightclubs), the phonetic similarity between the signs is particularly relevant.

Oral elements play a bigger role

GLOBAL ASSESSMENT AND OTHER FACTORS

CONCEPTUAL DIFFERENCE

NO LoC

PICASSO

PICARO

Earlier trade mark

Contested sign

NO LoC

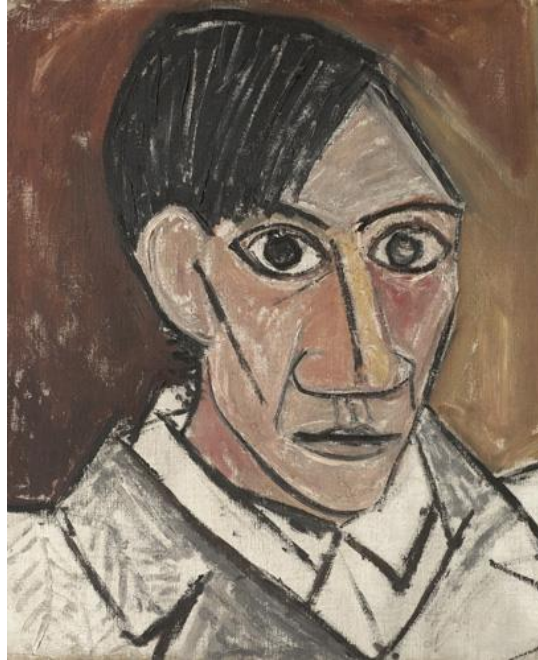
MASSI



MESSI

Earlier trade marks

Contested sign



Picasso

QUIZ – Article 8(1)(b)

Earlier marks:

42 BELOW



Class 33: Alcoholic beverages (except beers), including vodka, vodka-based and vodka-flavoured beverages.

EUTM application:

BLEND



VODKA

Class 33: Alcoholic beverages (except beers); vodka.

Decision:

- **GOODS:** Identical
- **SIGNS:** Visually: average degree
Aurally & conceptually: at least low
- **CONCLUSION:** **LoC**

QUIZ – Article 8(1)(b)

Earlier marks:

(ES)



(IR)

PHB

Class 21: *Toothbrushes; Tooth cleaning toothbrushes and dental floss*

EUTM application:



Class 21: *Brushes.*

Decision:

- **GOODS:** Identical
- **SIGNS:** Low degree (short marks)
- **CONCLUSION:** **NO LOC**

Cancellation action – RELATIVE GROUNDS



- Article **60(1) EUTMR** – the same as in opposition → Article 8(1) (b)
- Article **60(2) EUTMR** – EUTM shall be declared invalid where the use of such trade mark may be prohibited pursuant to **another earlier right** under the Union legislation or national law governing its protection

→ **not an exhaustive list** ←

- A right to a name → R 134/2009-2 → TELESIS (*right to a name under Austrian law*)
- A right of personal portrayal → R 878/2012-2 → Personality rights of Michael Jackson
- A copyright → R 1925/2011-4 →
- An industrial property right



0-2 →

Earlier right	Contested sign
 <p>(earlier RCD)</p>	 <p>(shape of a teabag)</p>

thank you 😊



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