

# **TRADEMARK LAW SEMINAR**

## **REGISTRABILITY Relative Grounds**

## **LIKELIHOOD OF CONFUSION**

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# L/C in Opposition proceedings and in infringement proceedings

- Opposition proceedings: when a new trademark application is filed, the owners of earlier trademarks that are identical or similar to the one filed can oppose to the registration of the new application. Oppositions are dealt with by the Trademarks Committee (EUIPO) and administrative courts.
- Infringement proceedings: proceedings before civil courts in case of illegitimate, unauthorized use of a registered trademark by a third party.

In both Opposition and infringement proceedings L/C is the criterion whether trademark rights were violated.

# **LEGISLATION**

## **OPPOSITION PROCEEDINGS**

**ART. 8 EUTMR (Regulation 2017/1001 EU)**

## Art. 8 par. 1 EUTMR

Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

- (a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;
- (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; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

# **LEGISLATION**

## **INFRINGEMENT PROCEEDINGS**

**ART. 9.2 EUTMR (Regulation 2017/1001 EU)**

## Art. 9.2 EUTMR

Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;

(b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

# Double Identity & L/C

- **DOUBLE IDENTITY** (*sub. par. a*)  
(L/C is presumed)
  
- **LIKELIHOOD OF CONFUSION** (*sub. par. b*)  
(L/C must be established on the evidence)

## REGULATION 2017/1001 – Recital 11:

The protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in the case of similarity between the mark and the sign and the goods or services. It is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion. The likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection.



# **TYPES OF L/C**

- **CONFUSION AS TO ORIGIN (origin function)**
- **LIKELIHOOD OF ASSOCIATION (some form of cooperation between enterprises)**

# Additional types of L/C

- **Forward confusion; this is the usual type of L/C**
- **Reverse confusion**
- **Initial interest confusion**
- **After sales confusion (see the ARSENAL judgment)**

# **METHOD TO ASSESS L/C**

- **RELEVANT PUBLIC – LEVEL OF ATTENTION**
- **SIMILARITY OF GOODS**
- **SIMILARITY OF SIGNS**
- **GLOBAL APPRECIATION (multifactor test)**

# L/C AND TRADEMARK FUNCTIONS

- L/C is established when trademark functions are frustrated
- The 4 levels methodology is destined to assist us to trace whether trademark functions were frustrated.
- The test for L/C is a **multifactor test**.

# **FACTORS**

- **LEVEL OF ATTENTION**
- **SIMILARITY OF GOODS**
- **SIMILARITY OF SIGNS**
- **DISTINCTIVENESS OF EARLIER MARK**
- **CHANNELS OF TRADE**
- **FAMILY (SERIES) OF SIMILAR MARKS**
- **ACTUAL CONFUSION**
- **PEACEFULL COEXISTENCE**
- **ANY OTHER FACTOR THAT MAY BE RELEVANT**

## **Types of L/C:**

**- Identical marks + Identical products**

(double identity → L/C presumed;

note however the Opel case where it was held that L/C has always to be proved and that there is no presumption)

**- Identical marks + Similar products**

**- Similar marks + Identical products**

**- Similar marks + Similar products**

<b>MARKS</b>	<b>PRODUCTS</b>	<b>notes</b>
<b>IDENTICAL</b>	<b>IDENTICAL</b>	Double identity Absolute protection (save for OPEL case where the ECJ held otherwise)
<b>IDENTICAL</b>	<b>SIMILAR</b>	
<b>SIMILAR</b>	<b>IDENTICAL</b>	
<b>SIMILAR</b>	<b>SIMILAR</b>	

## **L/C is assessed in view of trademark functions**

functions: origin, quality guarantee, advertising

## **The test for assessing L/C is a MULTIFACTOR TEST:**

factors: longevity of use, level of recognition, level of similarity, intent and bad faith, widespread use, channels of distribution, possible associations, etc.

Assessment in two levels:

- 1. comparison of marks**
- 2. comparison of goods/services**

***Overall impression and Global appreciation***



## WHOSE CONFUSION?

**Average consumer:** reasonably well informed and reasonably observant

- The degree of vigilance differs according to the goods in question, their price, their intended use, etc.:

Consider the degree of vigilance when:

- purchasing a “Rolex” or a “Swatch”, or when purchasing a car and a chocolate.
- purchasing stationery and pharmaceuticals on the other.

**NO DIRECT COMPARISON + IMPERFECT RECOLLECTION:** Usually an average consumer cannot make a direct comparison of the respective marks and goods. He does not have both marks or goods beforehand to make a direct comparison. He has only an imperfect recollection in his mind of the respective marks and goods. So, **INSIGNIFICANT DIFFERENCES MAY GO UNNOTICED** and may not prevent likelihood of confusion.

## **COMPARISON OF MARKS**

- VISUAL
- ORAL
- CONCEPTUAL COMPARISON

## **COMPARISON OF GOODS/SERVICES**

- RAW MATERIAL (SUBSTANCE MADE OF/IN)
- INTENDED USE
- GROUP OF CONSUMERS ADDRESSED TO

## **RAW MATERIAL (SUBSTANCE)**

milk – yogurt

*not directly competing one another*

beer – wine

*sales of the first do not cut sales of second*

chocolate – ice cream

clothing - shoes

## **INTENDED USE**

foodstuffs (milk, chocolate, ice creams, bread, biscuits)

beverages (alcoholic + juices)

human consumption (foodstuffs + pharmaceuticals)

clothing - shoes

## **GROUP OF CONSUMERS**

fashion clothing, fashion shoes, perfumes and cosmetics, jewellery

## COMPARISON OF MARKS

- Double identity → absolute protection. Identity interpreted strictly  
*(Diffussion vs. Sadas)*
- **Comparison is based on the dominant components (*Sabel vs. Puma, Matrazen*)**
- Likelihood of association is part of likelihood of confusion; not a different concept  
*(Sabel vs. Puma)*
- L/C assessed in view of origin function (*Canon vs. Cannon*)
- **The more distinctive the earlier mark, the greater the likelihood of confusion**  
*(Canon vs. Cannon + Sabel vs. Puma)*
- **Similarity in indistinctive or descriptive elements does not establish L/C.**
- **Comparison is based on the overall impression created by each mark; we do not compare individual elements of each mark as such.**
- **It is only negligible elements that go unnoticed that can be disregarded.**
- **There is no presumption for or against L/C.**
- **Conceptual comparison is more important than visual and oral.**
- **Word elements are usually more important than figurative (very controversial)**

**OVERALL IMPRESSION**  
**GCEU, T-112/17**



***Pelikan*** 

**COMMONALITIES IN DESCRIPTIVE ELEMENTS**  
**GCEU T-608/13**

**EASYAIR**

**v**

**AIRTOURS**

## **L/C when the earlier mark is incorporated as such in the later**

ARTHUR / ARTHUR ET FELICIE , (LC found) Diffusion v. Sadas

LIFE / THOMSON LIFE , (LC found)

FLEX / FLEXI AIR , (LC found)

## **1 WORD / 2 WORD**

ATHUR / ARTHUR ET FELICIE (LC found) Diffusion v. Sadas

## **WORD / WORD (conceptually different)**

PICASO / PICARO

Visual and oral similarity can be counteracted by conceptual difference

## **WORD / WORD (greatest part similar)**

ARMAFOAM / NOVAFOAM (LC found)

## **1 WORD / many WORDS (dominant elements similar)**

LIMONCHELO / LIMONCHELO DELLA COSTIERA AMALFITANA

## **WORD / WORD & DEVICE (device rendered the marks dissimilar)**

SAINT HUBERT 41 / HUBERT & device (NO LC)

ZIHR / SIR & device (NO LC)

QUIK and QUIKIES / QUICKY & device (LC established)

## **DEVICE / WORD & DEVICE**

Puma device / puma device + word SABEL Sabel v. Puma

# Likelihood of confusion - word marks

## Visual / Sound Similarity

ARROW – AIR-O

AVEDA – AVIDA

BEE WEAR – B WEAR

BEEP – VEEP

BELLOWS – FELLOWS

CALOGNAC – COGNAG

CAT TRAC – KATRAK

YAMAHA - MAKAHA



Likelihood of confusion - word marks

Conceptual similarity

AQUA CARE – WATER CARE

BLACK CAT – CHAT NOIRE

PALOMA – DOVE

SUN – EL SOL

ARISE - AWAKE


CYCLONE - TORNADO

CITY GIRL – CITY WOMAN

MOUNTAIN KING – ALPINE EMPEROR

**European Court of Justice**

**Difussion v. Sadas, C-291/00**

A handwritten signature of the word "Arthur" in black ink, written in a cursive style with a prominent dot on the first letter.A logo consisting of the words "Arthur" and "Félicie" in a white, bold, sans-serif font, with "et" in a smaller font size between them, all set against a black rectangular background.

**Likelihood of confusion is established when the prior mark is reproduced as such in the latter without any modifications or addition, or when the differences are so insignificant that they may go unnoticed**

# The Arthur – Arthur et Felice rule

**LIFE - THOMSON LIFE**

**FLEXI - FLEXI AIR**

**KIAPMOU – MOU**

**PINOCIDE - DELTA PINOCIDE**

**SUN - SUNSOFT**

**MODELO - NEGRA MODELO**

**FIFTIES – MISS FIFTIES**

**BUD - BUDMEN**

**DALI - DALI'S FEMALE**

**POLAR - AQUAPOLAR**

**Likelihood of confusion is established**

Note that there would be no LC if the marks were i.e. **Arthur & John / Arthur & Felicie**.

Note that in the case of **Saint Hubert / Huber & device (2004)**, the Court found no LC among Saint Hubert (earlier mark) and Hubert & device (later mark).

**Identical marks:** a sign is identical to an earlier mark, if it **reproduces without any modification or addition**, all the elements constituting the mark, or where, viewed as a whole, the differences are so insignificant that they go unnoticed.

The concept of identical marks should be interpreted strictly.

*However:* The perception of identity should be assessed globally.

## Sabel v. Puma, 1997

- ***Likelihood of association is part of LC and not an alternative to LC***
- ***Comparison of marks: Visual, oral, conceptual similarity – dominant components***
- ***Overall impression***
- ***The more distinctive the earlier mark is, the greater the likelihood of confusion will be***
- ***LC to be appreciated globally taking into account all factors relevant to each case***

*Facts: PUMA had registered a figurative mark consisting of a “puma”. On the basis of this registration it objected SABEL’s mark for leather products consisting of the picture of a “puma” accompanied by the word SABEL.*

- Likelihood of association is part of likelihood of confusion; likelihood of association is not alternative or additional to likelihood of confusion.
- Comparison of marks is made on the basis of visual, oral and conceptual similarity. Comparison is made on the basis of the dominant components.
- The more distinctive the earlier mark is, the greater the likelihood of confusion will be.

## LLOYD / LOINT'S, 1999

- *No direct comparison of marks available*
- *Average consumer*
- Consumers do not usually have the opportunity to make a direct comparison of the marks side by side.
- The average consumer is reasonably well informed, reasonably observant, reasonably circumspect.
- The attention of consumers will vary according to the type of goods/services

## CANON / CANNON, 1998

- *Multifactor test*
- *Interrelated factors*
- *The more distinctive the earlier mark is, the greater the likelihood of confusion will be*
- *Comparison of goods: nature, intended use, end users, competition*
- *LC as to origin*
- The test for likelihood of confusion is a multifactor test.
- The several factors are interrelating.
- *The more distinctive the earlier mark is, the greater the likelihood of confusion will be.*
- Comparison of goods is based on their nature, their intended use, their end users and whether they are in competition with each other.
- LC is assessed in view of the trademark function and particularly on the basis of the origin function.

## MARCA MODE V. ADIDAS, 2000

- *No presumption for LC in case of famous marks*

*Facts: Adidas owned its well-known mark consisting of three stripes and accused Marca for infringement because it was trading clothing with two stripes.*

- There is no presumption for likelihood of confusion.
- Likelihood of confusion cannot be presumed from reputation
- In famous mark LC is not presumed.



- **PICASSO / PICARO, 2006**

*Facts: Picasso heirs owned a trademark registration of the word mark PICASSO for several goods including cars and they objected an application by Daimler-Chrysler for the mark PICARO for cars.*

- Visual and aural similarity may be counteracted by a conceptual difference.

- **Pharmaceuticals**
- **The case of CFI Sanofi – Avantis**
- ATURION / URION
- In pharmaceuticals the attention of consumers is higher due to the importance of such products.
- The intermediation of doctors (professionals) who are experts in pharmaceuticals and are difficult to be confused does not necessarily prevents LC, since it is consumers who deal with the product at the end.

- **OPEL, 2007**
- ***Double identity: LC still needed (not presumed, not absolute protection)***
- Even in cases of double identity (identical marks used in identical goods) LC must be proved and established. In double identity cases LC is not presumed and protection is not absolute (i.e. irrespective of LC).
- Note, however, that Recital 11 of Dir. 2008/95 provides for absolute protection (i.e. even in the absence of LC in case of double identity of both marks and respective goods).

## ARMAFOAM / NOMAFOAM – LC found

- Linguistic considerations
- The application of TM law in the EU is under the influence of linguistic barriers; is LC even in one member state only due to linguistic particularities can prevent registration of a CTM.
- The term FOAM was considered to be a common vocabulary word in England, but not in other non-English speaking member states; hence the marks ARMAFOAM and NOMAFOAM were considered to be dissimilar in the UK, but confusingly similar in other member states. The Court reasoned that in case of a CTM application, LC in one member state was an adequate reason to object to registration.

## **LEVI STRAUSS V. CASSUCI**

- ***LC is assessed at the time when the later mark begun to be used and not at a later stage.***
- ***Assessing LC at a later stage might give the user of the sign an unfair advantage derived from his own unlawful behavior.***
- ***TM protection is reserved to those proprietors who are vigilant and oppose any unauthorized use early enough.***

## MATRATZEN v. OHIM

- **MATRAZEN & device / MATRATZEN (word mark) – LC found**
- Similarity should be assessed on the basis of the ***overall impression*** of the marks, taking into account their respective ***distinctive*** and ***dominant*** components.

## PRAKTIKER 2005

- ***Retail services (different test ?)***
- One of the legal issues raised was whether a different test for comparison of services should apply in the case of Retail Services.
- The Court in effect refused to deal with this matter.
- It only mentioned that retail services can be applied for TM registrations and that the specific goods to which such services were addressed should also be mentioned.

## EL CORTE INGLE

- **Comparison of Goods / Services**
- ***Classification***
- Classification is for administrative purposes and does not have an impact on the assessment of similarity among goods/services.

## LIMONCHELO

- *Composite marks*
- *Dominant elements / Overall assessment*
- *There is no strict rule that the overall impression may be determined by a single dominant element only or that only a visual analysis is important.*
- Earlier registration: “LIMONCHELO” word mark
- Opposed application: “Limonchelo della Costiera Amalfitana”
- LC found
  
- OHIM refused registration considering that, on the basis of an overall impression, the word LIMONCHELO in both mark resulted to LC. In this context OHIM paid attention to the conceptual and aural impact of the term LIMONCHELO that was common in both marks. The ECJ approved this approach.
- Note that the CFI had annulled the decision considering that in complex marks that are visual in nature, overall assessment and determination of the dominant elements should be based on a visual analysis; hence the CFI downgraded the conceptual and aural impact of the term LIMONCHELO in both marks. However, the ECJ disapproved this approach.



## QUICKY

- *Dominant elements*
- *Overall assessment*
- *Word – Word & device*
- Earlier marks: QUICK, QUICKIES
- Opposed application: QUICKY & device
- Although the registration was initially rejected, due to common word elements, the ECJ overruled the decision for violation of the overall assessment principle. In the context of an overall assessment, the figurative elements could render the two marks dissimilar.
- Elements that are not dominant are not necessarily negligible in terms of LC.
- The existence of common word elements does not necessarily mean that the device is insignificant in terms of LC.
- In the context of an overall assessment figurative elements should be taken into account and could possibly overcome similarities due to common word elements.

# Likelihood of confusion established

European Court of Justice, C-498/07

Coosur v. Koipe



**Figurative elements are dominant in comparison to word elements**

**European Court of Justice**  
**Vedial v. OHIM, C-106/03**



SAINT HUBERT 41

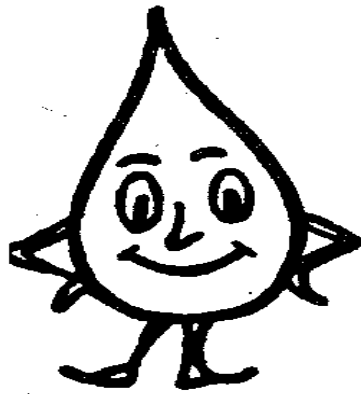
**No likelihood of confusion**

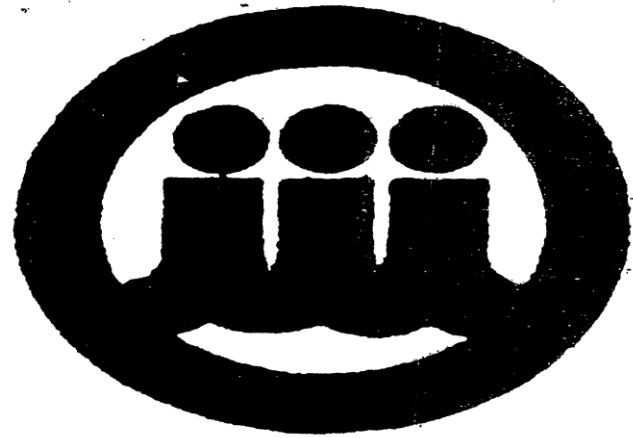
**The respective marks are not similar from an oral and visual perspective**

# No likelihood of confusion because of different goods

- **FERRO – FERRERO** (ECJ C-108/07)  
biscuits - sweets
- **MEZZOPANE – MEZZO – MEZZOMIX** (T-175/06)  
wine – non alcoholic drinks
- **O STORE – THE O STORE** (T-116/06)  
clothing retail services - clothing

# Likelihood of confusion established Figurative marks







**VOGUE**  
**HATS**  
*NEW YORK*



## Dilution - Look alike products





# Dilution – Look alike products



# Dilution – Look alike products



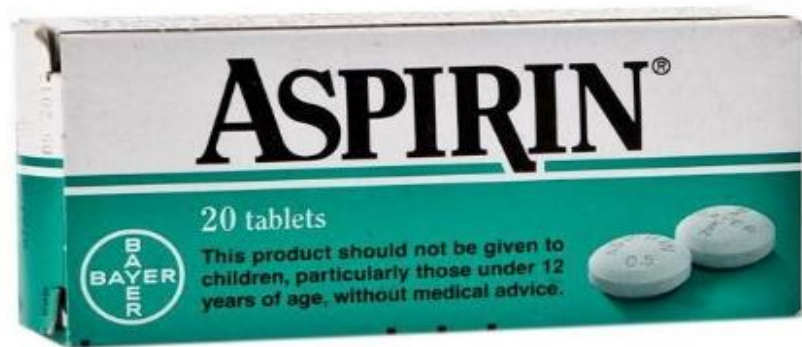
# Dilution – Comparative advertising

Bellure was advertising its perfume as a substitute for and in comparison to Lancome's perfume



# ASPIRIN / SALOSPIR

1<sup>st</sup> Instance Ct of Athens 270/2015



## **Case Study 1**

**Consider the registrability of the word mark “RACING RED” for “sports goods”.**

**Assume that a pictorial representation of a red racing car has already been registered as a trademark before for the same goods.**

## **Case Study 2**

**H. Ltd is a manufacturer of products for babies.**

**H. Ltd has designed a new style of babies' bottle, inspired by a registered design used by an Italian manufacturer for marathon runner water bottles.**

**H. Ltd bottle is flat with a hole in the middle which makes it very easy to grasp. H. Ltd wishes to register the following trademarks:**

- (a) The word mark DROP NOT for bottles for babies**
- (b) The shape of the bottle**
- (c) The pink and blue stripes which decorate the bottom of the otherwise clear bottle.**

## **Case Study 3**

**Consider the registrability of the word mark GREEN BEE for leather products.**

**A trademark consisting of a two dimensional representation of a bee in bright orange has already been registered before for footwear goods.**

## **Case Study 4**

**Consider the registrability of the word mark PERFETTO (it means “perfect” in Italian) for confectionary goods.**

**A trademark “IL GUSTO PERFETTO” (it means “perfect taste”) has already been registered for “preparations made from flour”**



## **Case Study 5**

**Consider the registrability of the word mark BUSINESS TODAY for financial information services.**

**There is an earlier registration for the mark THE BUSINESS DAILY accompanied by the picture of an eagle for newspapers.**