

***GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)***

PART C

OPPOSITION

SECTION 2

***DOUBLE IDENTITY AND
LIKELIHOOD OF CONFUSION***

CHAPTER 7

GLOBAL ASSESSMENT

Table of Contents

1	Introduction.....	3
1.1	Nature of global assessment.....	3
2	Interdependence Principle.....	3
3	Imperfect Recollection	4
4	Impact of the Method of Purchase of Goods and Services	5
4.1	Visual similarity	5
4.2	Aural similarity	7
4.3	Conclusion.....	9
5	Impact of the Conceptual Similarity of the Signs on Likelihood of Confusion.....	9
6	Impact on Likelihood of Confusion of Components that are Non-distinctive or Distinctive Only to a Low Degree.....	10
6.1	Common components with a low degree of distinctiveness.....	11
6.2.	Common components with no distinctiveness.....	14
6.3	Distinctiveness of the earlier mark versus distinctiveness of the common component	15
7	Specific cases.....	16
7.1	Short signs.....	16
7.2	Name/Surnames	17
7.2.1	Names	17
7.2.2	Business names in combination with other components	17
7.2.3	First and family names	18
7.3	Colour marks per se.....	22

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, EU:C:1997:528, § 22).

The Office normally examines the most salient and habitually relevant factors relating to likelihood of confusion and establishes their degrees:

- (i) similarity of the goods and services;
- (ii) the relevant public and the level of attention;
- (iii) similarity of the signs taking into account their distinctive and dominant elements;
- (iv) the distinctiveness of the earlier mark.

In the last section of a decision containing the global assessment, those factors are weighed up. However, the global assessment can weigh up many other factors that are relevant to deciding on likelihood of confusion (see Chapter 6, 'Other Factors').

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, between the previously established findings on the degree of similarity between the marks and that 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, EU:C:1998:442, § 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 EUTMR, 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 that can be made with the used or registered sign, the degree of similarity between the mark and the sign and that between the goods or services identified (judgment of 10/09/2008, T-325/06, Capiro, EU:T:2008:338, § 72 and the case-law cited).

The requirement for a global assessment 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, and the distinctiveness of the earlier mark.

The outcome depends on the particularities of each case, but as a rule of thumb it can be said that when there is an average degree of similarity between the signs and between the goods or services, the degree of attention of the relevant public is average and the earlier trade mark has a normal distinctiveness, there will be a likelihood of confusion. On the other hand, the lower the degree of one factor, the higher the degree of other factors must be in order to find a likelihood of confusion (bearing in mind that the likelihood of confusion is inversely affected by an increased degree of attention of the relevant public). Therefore, on the basis of an average degree of distinctiveness of the earlier mark and an average degree of attentiveness of the public, 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 and/or services. However, such a finding is more difficult on the basis of a limited distinctiveness of the earlier mark and/or when the level of attention of the public is higher than average. Where the degrees of similarity of the marks are different in each aspect of comparison (visual, phonetic and conceptual), it has to be taken into account whether one aspect is more important for the public when purchasing the goods.

Moreover, the factors to be taken into account and their importance in the global assessment **will vary** according to the particular circumstances. For example, in clear-cut cases where the 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 (see below paragraph 4 ‘Impact of the Method of Purchase of Goods and Services’).

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, EU:C:1999:323, § 26). Even consumers with a high level of attention need to rely on

their imperfect recollection of trade marks (judgment of 21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 54).

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 or services in question and the way they are marketed (judgment of 22/09/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 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 comparison 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 either choose the clothes they wish to buy themselves 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 (judgments of 14/10/2003, T-292/01, Bass, EU:T:2003:264, § 55; 06/10/2004, T-117/03-T-119/03 and T-171/03, NL, EU:T:2004:293, § 50; 18/05/2011, T-502/07, McKenzie, EU:T:2011:223, § 50; 24/01/2012, T-593/10, B, EU:T:2012:25, § 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
		T-502/07
		T-593/10

The same considerations were central to a finding of likelihood of confusion in the following cases also for, inter alia, certain goods in Class 25.

Earlier sign	Contested sign	Case No
		R 1050/2008-4
PETER STORM	PEERSTORM	T-30/09
		T-376/09


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 for goods in Class 25.

Earlier sign	Contested sign	Case No
	FISHBONE	T-415/09 (appeal dismissed 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, EU:T:2011:437, § 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 (e.g. goods in Classes 29 and 30)** 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
	<p>EGLÉFRUIT</p>	<p>T-488/07</p>

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, confirming the finding of a likelihood of confusion, 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
<p>CMORE</p>		<p>T-501/08</p>

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. This consideration came into play in the finding of likelihood of confusion in the case below, which dealt with **vehicle rental and associated services**, which are recommended and chosen orally in a significant number of cases.

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

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, EU:T:2003:7, § 48).

Earlier sign	Contested sign	Case No
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 (judgments of 23/11/2010, T-35/08, Artesa Napa Valley, EU:T:2010:476, § 62; 13/07/2005, T-40/03, Julián Murúa Entrena, EU:T:2005:285, § 56; 12/03/2008, T-332/04, Coto d’Arcis, EU:T:2008:69, § 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
 ARTESO		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, EU:T:2010:347, § 106).



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

A conceptual **similarity** between signs with **analogous** semantic content may give rise to a likelihood of confusion where the earlier mark is particularly distinctive (judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24, where the signs shared the broader concept of a ‘bounding feline’, but did not evoke the same animal: a puma in the earlier mark and a cheetah in the contested mark).

However, exceptionally, where the signs have the **same** distinctive concept in common accompanied by visual similarities between the signs, this may lead to a likelihood of confusion even in the absence of a particularly high distinctiveness of the earlier mark, as illustrated by the following example.

Earlier sign	Contested sign	Case No
		Joined Cases T-81/03, T-82/03 and T-103/03
<p>G&S: Classes 32, 33 Territory: Spain (where ‘venado’ means ‘deer’) Assessment: The Court found that the signs had the same concept and that there was significant visual similarity. In the absence of a clear semantic link between a deer or a deer’s head and alcoholic or non-alcoholic beverages, the Court found it impossible to deny that the concept of a deer’s head portrayed facing forward inside a circle had at least average distinctive character for designating beverages (para. 110.). Enhanced distinctiveness was not considered – likelihood of confusion (for the Spanish public).</p>		

A conceptual similarity between the signs may not be sufficient to outweigh the visual and phonetic differences, where the concept in common is non-distinctive.

Earlier sign	Contested sign	Case No
K2 SPORTS		T-54/12
<p>G&S: Classes 18, 25, 28</p>		

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 likelihood of confusion.

According to case-law, the conceptual differences between signs may counteract their visual and phonetic similarity (judgment of 12/01/2006, C-361/04, PICARO, ECLI:EU:C:2006:25, § 20). According to Office practice, when a similarity is found in one aspect (visual/phonetic/conceptual), the examination of likelihood of confusion must continue¹. Therefore, the question whether the conceptual dissimilarity is sufficient to counteract the visual and/or phonetic similarity between the marks has to be examined in the global assessment of the likelihood of confusion. Furthermore, as explained above in Chapter 4, ‘Comparison of signs’, paragraph 3.4.4, the conceptual dissimilarity can be found only if each trade mark has a clear concept that may be immediately grasped by the public and these concepts are different.

The conceptual difference between the signs may not be sufficient to neutralise the visual and phonetic similarities.

Earlier sign	Contested sign	Case No
MUNDICOLOR	MUNDICOR	Joined Cases T-183/02 and T-184/02
<p>G&S: Class 2 <i>Territory:</i> Spain <i>Assessment:</i> Whilst ‘MUNDICOLOR’ is to a certain extent evocative of ‘colours of the world’ or ‘the world in colours’ for the Spanish public, it cannot be regarded as having any clear and specific meaning. In the mark applied for, the same prefix is accompanied by the suffix ‘cor’, a term which has no meaning in the Spanish language. Therefore, notwithstanding the evocative nature of the prefix ‘mundi’ (world), the latter is ultimately devoid of any concept for that public. As neither of the signs has a clear and specific meaning likely to be grasped immediately by the public, any conceptual difference between them is not such as to counteract their visual and aural similarities (paras 90-99) – likelihood of confusion.</p>		

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

When assessing the similarity of the signs, an analysis of whether the coinciding components are descriptive, allusive or otherwise weak is carried out in order to calculate the extent to which these coinciding components have a lesser or greater capacity to indicate commercial origin. It may be more difficult to establish that the

¹ See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 1.3.

public may be confused as to origin due to similarities that solely pertain to non-distinctive elements.²


The Office and a number of trade mark offices of the European Union have agreed on a **Common Practice** under the European Trade Mark and Designs Network with regard to the impact on likelihood of confusion of components that are non-distinctive or Distinctive only to a low degree.

6.1 Common components with a low degree of distinctiveness

According to the Common Practice³, when the marks share an element with a **low degree of distinctiveness**, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks, as previously assessed in the comparison of signs. That assessment takes into account the similarities/differences and distinctiveness of the non-coinciding components.


A coincidence in an element with a low degree of distinctiveness **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. There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.


In the following examples **no likelihood of confusion** was found:

Earlier sign	Contested sign	Case No
	TORO XL	T-169/10
<p><i>G&S: Class 33 Alcoholic beverages</i> <i>Territory: EU.</i> <i>Assessment:</i> 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. For the goods in question, namely <i>alcoholic beverages</i>, the public is likely to associate it with an extra quantity of a drink (paras 34, 35). The word element TORO is distinctive (para. 42). The marks are visually, and phonetically dissimilar (paras 46 and 48) and there is only a weak conceptual similarity (para. 52). The likelihood of confusion is excluded (para. 57)</p>		



² See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the earlier mark.

³ For the purposes of the Common Practice, all the other factors that may be relevant for the global appreciation of likelihood of confusion are deemed not to affect the outcome. It is also considered that the goods and services are identical.

Earlier sign	Contested sign	Case No
ZITRO SPIN BINGO,		T-665/13
<p>G&S: Classes 9, 41, 42 in relation to <i>games</i> <i>Territory:</i> EU <i>Assessment:</i> The word 'bingo' is descriptive of the corresponding game of chance, the English word 'spin' alludes to a rotating object or to the action of spinning something (para. 36). The Court confirmed the Board's finding that there was a low degree of visual, aural and conceptual similarity between the signs at issue, despite the fact that they contain the expression 'spin bingo'. On a visual level, the degree of similarity is low because, regarding the earlier sign, the public would pay attention to the more distinctive element 'zitro', which is devoid of any meaning in the relevant languages and is at the beginning of the sign. Concerning the contested sign, consumers will pay as much attention to the different colour elements of the device which are the circles and the reel on which there is a representation of a smiling face. On the aural level, the similarity was weak as well in the light of the descriptive meaning of the expression 'spin bingo', and the fact that the public will pay attention to the more distinctive element 'zitro'. On the conceptual level, the word 'zitro' was dominant and was not conceptually similar to the contested sign (paras 11 and 44). There is no likelihood of confusion.</p>		

Earlier sign	Contested sign	Case No
CLUB DEL GOURMET, 	CLUB GOURMET	R-1946/2010-1 Confirmed by T-571/11 Appealed C-301/13 P
<p>G&S: Classes 16, 21, 29, 30, 32, 33 <i>Territory:</i> Spain. <i>Assessment:</i> The conflicting signs only share the two words 'CLUB' and 'GOURMET'. However, they differ in all their other characteristics. First, the dominant and distinctive element of the earlier sign is not reproduced in the contested sign. Second, the verbal element 'CLUB GOURMET' differs from the verbal element 'CLUB DEL GOURMET': the earlier sign has fourteen letters (whilst the contested sign has eleven) and it is separated by the word 'DEL' and followed by a comma. Finally, they differ with respect to the following aspects: the number of words (seven for the earlier sign, two for the contested sign), the use of punctuation marks (',' and '...' in the earlier sign), the triangle (which is absent in the contested sign and contains no figurative element at all) and the font (which is partly stylised in the earlier sign). The common elements 'CLUB' and 'GOURMET' only have a weak distinctive character in relation to the goods and services at issue. Indeed, there exists, for the relevant consumer, a strong conceptual link between the verbal element 'CLUB DEL GOURMET' and the goods provided for by the opponent's services, which mainly consist of food and beverages. In the consumer's mind, 'GOURMET' refers to the idea of a connoisseur or lover of good food or a person with a discerning palate, that is to say, someone who appreciates good food and drink. Although it sounds and is of French origin, the meaning will be immediately grasped by the Spanish consumer (paras 39 and 40).</p>		

In the following example there was a likelihood of confusion because 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.

Earlier sign	Contested sign	Case No
		T-395/12
<p><i>Territory:</i> UK <i>G&S:</i> Class 19. <i>Assessment:</i> The word element 'solid floor' of the earlier mark is only of weak distinctive character (para. 32), but the differentiating element in the contested sign, 'The professional's choice', will be perceived by the relevant public as a clearly laudatory and banal slogan with no trade mark connotations that would allow them to perceive it as a badge of origin (para. 34) and the figurative elements of the signs at issue are limited (para. 35). There is a [average] visual similarity and a high degree of phonetic and conceptual similarity (paras 36, 38 and 40). There is a likelihood of confusion for identical and similar goods, namely <i>building materials, not of metal, parquet flooring of plastic and wood, flooring of wood, cork and laminate; subfloors; transportable floors, not of metal.</i></p>		

There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.

Earlier sign	Contested sign	Case No
waterPerfect	AquaPerfect	T-123/14
<p><i>G&S:</i> Class 7 <i>Territory:</i> EU <i>Assessment:</i> 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 owing to the fact that they will be perceived by the relevant public as meaning 'water' and the goods covered all involve, in one way or another, <i>water</i> (para. 42). Visually and phonetically, the similarity of the signs at issue is not limited to the presence of the term 'perfect' within each of those two signs, since those signs also have the same length and the same number of syllables, that are identically stressed, and an almost identical sequence of vowels; based on an overall impression, the similar elements between the signs referred to prevail globally over the dissimilar elements (paras 28 and 32). The signs were found visually, phonetically and conceptually similar to an average degree (paras 32, 33 and 40).</p>		

Further (invented) examples, agreed upon in the context of the Common Practice, where the common component(s) is/are considered to possess a low degree of distinctiveness can be found in the documents related to **CP 5. Relative Grounds – Likelihood of Confusion**⁴.



⁴ Principles of the common practice CP 5. Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)
<https://www.tmdn.org/network/documents/10181/897c811d-65ca-4779-b91d-636c71de2ec9>
 page 9.

6.2. Common components with no distinctiveness



According to the Common Practice, when marks share an element with **no distinctiveness**, the assessment will focus on the impact of the non-coinciding components on the overall impression of the marks. The assessment will take into account the similarities/differences and distinctiveness of the non-coinciding components.

A coincidence only in non-distinctive components **does not lead to likelihood of confusion**. However, when marks also contain other figurative and/or word elements that are similar, there will be likelihood of confusion if the overall impression of the marks is highly similar or identical.

In the following examples, **no likelihood of confusion** was found, as the signs coincide solely in a non-distinctive element.

Earlier sign	Contested sign	Case No
		T-402/14
<p>G&S: Classes 35, 37, 39, 40, 42 Territory: EU Assessment: The Court confirmed that the lack of distinctive character of the term 'AQUA' has to be taken into account and that the specialised relevant public will not pay much attention to the descriptive element 'AQUA', the only common element of the conflicting signs (paras 84 and 85). The figurative elements of the signs are totally different. They are basic but not insignificant, so they must be taken into account in the overall impression of the signs (paras 54 and 55). There is a low degree of visual similarity. There is a low degree of phonetic and conceptual similarity, even though the different suffixes allow the specialised public to gather a different conceptual content (paras 71 to 73). The differences between the signs are sufficient to exclude the likelihood of confusion, even for identical services and taking into account that the earlier trade mark, as a whole, has an enhanced distinctiveness (para. 86).</p>		

In the following examples likelihood of confusion was found, because the marks also contain other figurative and/or word elements that are similar, and the overall impression of the marks is highly similar or identical:

Earlier sign	Contested sign	Case No
		T-745/14
<p>G&S: Classes 36 and 38 Territory: Bulgaria Assessment: The Court confirmed that the signs at issue are visually and phonetically highly similar, and conceptually identical, given that they coincide in their word elements, and despite the figurative nature of the signs at issue, the fonts used for the word elements do not make it possible to detect any particular difference between them (para. 28 <i>in fine</i>).</p>		

Earlier sign	Contested sign	Case No
BIOCERT	BIOCEF	T-605/11
<p>G&S: Class 5 Territory: Austria Assessment: The Court found that 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' (para. 38). The difference in the last letters, 'rt' versus 'f', does not counteract the important similarity arising from the fact that the first five letters at the centre of the two signs, which are of very similar length, are identical (para. 39). There is an average degree of visual and phonetic similarity (paras 40 and 46), whereas the conceptual comparison is neutral (para. 48)</p>		

Further (invented) examples agreed in the context of the Common Practice, where the common component(s) is/are considered to possess a low degree of distinctiveness can be found in the documents related to CP 5. Relative Grounds – Likelihood of Confusion⁵.

6.3 Distinctiveness of the earlier mark versus distinctiveness of the common component

The abovementioned examples concern the coincidence in a weakly distinctive or non-distinctive element of the marks. The distinctiveness of an element of the mark is a separate question from the assessment of the distinctiveness of the earlier mark as a whole (see the Guidelines, Part C, Opposition, Section 2, Chapter 5, Distinctiveness of the Earlier Mark, paragraph 2, Assessment of the Distinctiveness of the Earlier Mark). The enhanced distinctiveness of the earlier mark does not automatically lead to an enhanced distinctiveness of the common element (see example T-402/14 'AQUALIA / AQUALOGY' in point 6.2 above).

However, when the earlier trade mark is entirely contained in the contested EUTM application and recognisable as such, its degree of distinctiveness naturally equals to that of the coinciding element, with the following consequences.

The analysis of the cases where the earlier mark is entirely contained in the contested EUTM application cannot follow the principles established above in paragraph 6.2 (Common components with no distinctiveness) but rather those established in paragraph 6.1 (Common components with a low degree of distinctiveness). This is because the Office applies the practice clarified in the judgment of 24/05/2012, C-196/11, F1-LIVE, EU:C:2012:314, namely that in proceedings opposing the registration of an EUTM application, the validity of earlier trade marks may not be called into question. Consequently, the elements corresponding to the earlier mark cannot be considered as devoid of distinctive character in the trade mark comparison, but must be deemed to be endowed with some (low/minimal) degree of distinctiveness (the Guidelines, Part C, Opposition, Section 2, Chapter 4, Comparison of signs, 3.2.3.4 'Earlier marks, the distinctiveness of which is called into question').

⁵ Principles of the common practice CP 5. Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components). <https://www.tmdn.org/network/documents/10181/897c811d-65ca-4779-b91d-636c71de2ec9>; page 10.

If the earlier mark contained in the contested EUTM application enjoys an enhanced distinctiveness through use despite low inherent distinctiveness, the common element corresponding to that mark cannot be considered distinctive to a low degree and the principles of Common Practice mentioned above in paragraphs 6.1 and 6.2 do not apply.

Earlier sign	Contested sign	Case No
MINI		R-596/014-4 Confirmed by T-160/15
<p>G&S: Class 12 Territory: UK Assessment: The earlier trade mark is reputed for <i>cars</i>, and accordingly, it has enhanced distinctive character in the UK. Thus, for the relevant public in the UK, the contested composite sign will be perceived as the widely-known trade mark 'MINI' in combination with the descriptive word 'CARGO'. This is as a direct consequence of the earlier trade mark's repute in the field of motor vehicles (paras 19, 25 and 26).</p>		

7 Specific cases

7.1 Short signs

As indicated before, the Courts have not exactly defined what a short sign is. However, signs with three or fewer letters/numbers are considered by the Office as short 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 (judgments of 06/10/2004, T-117/03-T-119/03 and T-71/03, NL, EU:T:2004:293, § 47-48, and 10/05/2011, T-187/10, G, EU:T:2011:202, § 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 Chapter 5 of this Section, Distinctiveness of the earlier mark, and the specific section on short signs.

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 (judgment of T-187/10, G, EU:T:2011:202, § 60).

Consequently, a likelihood of confusion can be safely excluded when two conflicting signs, albeit containing or consisting of the same single letter or a combination of letters not recognisable as a word, are stylised in a sufficiently different way or contain a sufficiently different figurative element, so that their different overall graphical representation eclipses the common verbal element.

Where the opponent has successfully proven that its earlier mark has acquired enhanced distinctiveness through intensive use or reputation, the impact thereof on the final outcome has to be carefully assessed. Firstly, enhanced distinctiveness on the

part of an earlier mark containing or consisting of a single letter or a combination of letters cannot justify a finding of a likelihood of confusion if the overall visual impression of the signs is so different as to safely set them apart. Secondly, if the evidence shows use of a single letter or combination of letters stylised or accompanied by additional figurative elements, the benefit of the resulting broader scope of protection accrues to the form in which it was used and not to the single letter as such or any other stylised variation.

7.2 Name/Surnames

7.2.1 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.

7.2.2 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&S: Class 25 Territory: Denmark, Finland, Sweden Assessment: 'The element 'by CAMPER' will be perceived as subsidiary, also due to the fact that the relevant public will perceive it as a mere indication of the undertaking producing the goods in question.' Therefore, the relevant consumer will focus their attention on the word 'BROTHERS' and might attribute a common origin to the goods concerned (paras 65 and 86) – likelihood of confusion.</p>		

7.2.3 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 who 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 Office or the EU courts, may provide useful guidelines (judgment of 01/03/2005, T-185/03, Enzo Fusco, EU:T:2005:73, § 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 names of natural persons, due to the special protection provided by Article 14(a) EUTMR and 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
G&S: Classes 18, 25 Territory: Portugal Assessment: 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) – likelihood of confusion.		
Earlier sign	Contested sign	Case No
ELISE		T-130/09
G&S: Classes 9, 42 Territory: Portugal Assessment: 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) – likelihood of confusion.		
Earlier sign	Contested sign	Case No
GISELA	GISELE	R 1515/2010-4
G&S: Class 25		

Territory: EU

Assessment: The marks compared are both variations of the female first name Giselle of old German and French origin and are overall very similar, so that a likelihood of confusion exists (paras 14, 15 and 20) – likelihood of confusion.

- 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 95/2000-2
<p>G&S: Class 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 likelihood of confusion.</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&S: Classes 29, 30 <i>Territory:</i> Spain <i>Assessment:</i> The 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) (para. 31) – likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
ROSALIA	ROSALIA DE CASTRO	T-421/10 (appeal dismissed C-649/11P)
<p>G&S: Classes 32, 33, 35 <i>Territory:</i> Spain <i>Assessment:</i> 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 to 51) – likelihood of confusion.</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, that is to say, the differences between the signs are lost in the overall impression created 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: Classes 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 – likelihood of confusion.		

- 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 it is that it will attract 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: Classes 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) – likelihood of confusion.		

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 (judgments of 01/03/2005, T-169/03, Sissi Rossi, EU:T:2005:72, § 82-83; and 24/06/2010, C-51/09 P, Barbara Becker, EU:C:2010:368, § 36). Consumers are used to trade marks that 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 547/2010-2
G&S: Classes 18, 25 Territory: EU Assessment: Not only are consumers throughout the EU 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 to 35) – no likelihood of confusion.


- 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&S: Class 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) – likelihood of confusion.</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.

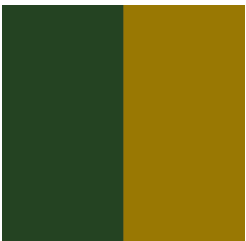

Earlier sign	Contested sign	Case No
MURÚA		T-40/03
<p>G&S: Class 33 Territory: Spain Assessment: It is common ground that the Spanish public will perceive the verbal element making up the trade mark applied for as a proper name (first name plus surnames) and the earlier trade mark as a surname. It is 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) – likelihood of confusion.</p>		

Earlier signs	Contested sign	Case No
BRADLEY	VERA BRADLEY	R 1918/2010-1
<p>G&S: Class 11 Territory: EU Assessment: The sign for which the EUTM 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. 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 to 37 and 52) – likelihood of confusion.</p>		

7.3 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' (judgments of 24/06/2004, C-49/02 Blau/Gelb, EU:C:2004:384, § 41, and 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 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 755/2009-4
<p>G&S: Class 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 is limited (para. 18). The BoA referred to CJEU 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 likelihood of confusion.</p>		