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LIKELIHOOD OF CONFUSION IN TRADEMARK LAW: A PRACTICAL GUIDE BASED ON THE CASE LAW IN COMMUNITY TRADE MARK OPPOSITIONS FROM 2002 TO 2012*

By Paul Maeyaert** and Jeroen Muyldermans***

I. INTRODUCTION

This article aims to offer a clearer insight into the assessment of the notion of “likelihood of confusion” within Community Trade Mark (“CTM”) law.

The owner of an earlier national trademark or CTM that is not well known will generally be entitled to oppose only the registration or use of a later CTM if there is a likelihood of confusion on the part of the public. The uniform CTM system has now been in force in the European Union (“EU”) for almost two decades and has led to extensive case law. During that period the jurisprudence of the EU has developed in an attempt to define the concept of “likelihood of confusion” and to establish the legal principles to be applied when examining that concept.

In short, the likelihood of confusion is the risk that the public may erroneously believe that the goods marketed under a trademark originate from the undertaking of the owner of a senior mark or, as the case may be, an undertaking economically linked to the latter. Such risk presupposes both that the junior mark and the senior mark are identical or similar and that the goods or services covered in the application for registration are identical or similar to those in respect of which the earlier mark was registered. Those conditions are cumulative. If one of those conditions is not satisfied, there cannot be a likelihood of confusion. Furthermore, a global appreciation of the likelihood of confusion necessitates that other circumstances that may be relevant to the case must be considered. This means that the likelihood of confusion will further depend on the degree of distinctive character or reputation of the senior mark and the

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interdependence between the similarity of the trademarks and the similarity of the goods and services involved.

To assist legal practitioners, this article provides an overview of the main principles and guidelines that the Court of Justice of the European Union (“CJEU”) and the General Court (“GC”) have developed in a substantial number of rulings. For the purpose of summarizing the different criteria and points of law, the case law of these judicial bodies delivered in CTM opposition proceedings up to December 31, 2012, is considered.

II. THE COMMUNITY TRADE MARK SYSTEM AND THE REGISTRATION PROCESS IN A NUTSHELL

For the purpose of promoting throughout the European Union the harmonious development of economic activities, whether in manufacturing and distributing goods or in providing services, and a continuous and balanced expansion of the same through an internal market that functions properly and offers conditions similar to those existing in a national market, the European legislator considered it necessary to create legal conditions that enable undertakings to adapt their activities to the scale of the European Community (“Community”). As part thereof, it was necessary to enact Community Regulations for trademarks, whereby undertakings are able to obtain, by means of one procedural system, CTMs that extend throughout the entire area of the European Union, regardless of frontiers, and to which uniform protection is given.

1994 marked the start of the uniform CTM with the adoption of Council Regulation (EC) No. 40/94 of December 20, 1993, on the Community Trade Mark1 (“Community Trade Mark Regulation” or “CTMR”).

For implementing the trademark law created by the CTMR, it was also essential to create administrative measures at the Community level, leading to the establishment of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”), which has, as an independent institution operating within the framework of the CTMR, legal, administrative, and financial autonomy.

Applications for a CTM may be filed either directly with OHIM or at any of the national trademark offices of the member states. The examiners at OHIM will first examine the application on technical requirements or formalities in addition to the test for acceptance or refusal based on the absolute grounds stipulated in the CTMR.

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Once the CTM has passed the test of the absolute grounds for refusal and if the result of the examination by OHIM is positive, the application will be published in the CTM Bulletin. This gives anyone the opportunity to oppose the application. Article 41 of the CTMR provides that, within a period of three months following the publication of a CTM application, the owner of a senior mark\(^2\) is entitled to give notice of opposition to registration of the trademark with the Opposition Division of OHIM. If no oppositions are filed during this period, the application proceeds to registration. (See the diagram of the process below.)

2. The “earlier trade marks” are defined in the second paragraph of Article 8 and cover

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks: (i) Community trade marks; (ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property; (iii) trade marks registered under international arrangements which have effect in a Member State; (iv) trade marks registered under international arrangements which have effect in the Community; (b) applications for the trade marks referred to in subparagraph (a), subject to their registration; (c) trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words “well known” are used in Article 6bis of the Paris Convention.” If the earlier trademark is a CTM, a licensee is also entitled to file the opposition if authorized by the owner of the CTM.

The opposition may be based on any of the “relative grounds for refusal” set forth in Article 8 of the CTMR, which states that:

1. 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.

2. (. . .)

3. Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

   (a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

   (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

5. Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of,
or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Discussing all the above relative grounds of refusal would obviously surpass the scope of this contribution. As indicated in the title and the foreword, this article will focus on the most appealing and enigmatic ground of them all: the likelihood of confusion, which has its legal basis in the above-quoted Article 8(1)(b) of the CTMR.

Relying on this ground, the owner of a senior mark is thus entitled to prevent the registration of a later sign as a CTM upon the condition that (1) the conflicting trademarks are identical or similar, (2) the conflicting trademarks cover identical or similar goods or services and that (3) this creates a likelihood of confusion on the part of the public in the territory where the senior mark is protected. Such likelihood of confusion includes the likelihood of association with the senior mark.

The main advantage of the opposition proceedings before OHIM is that the applicant knows at a relatively early stage—perhaps before he puts the junior mark to use and makes the associated investments—whether there is a risk of confusion with a senior mark and whether the owner of that mark may prevent the use or registration of the applied-for CTM.4

Anyone who is adversely affected by a decision delivered by OHIM opposition division may file an appeal. A party is “adversely affected” only when it has not obtained an order it requested. This means that, for example, in the case where a party that possesses several earlier rights, opposes a CTM application, it is “adversely affected” only if the Opposition Division rejects the opposition. A party is, by contrast, not “adversely affected” if the Opposition Division upholds the opposition, basing itself for reasons of procedural economy on only one of several earlier rights.5

In accordance with Articles 58 through 64 of the CTMR, the decision is subject to appeal before the Boards of Appeal of OHIM. Article 64 of the CTMR stipulates that the Board may either exercise any power within the competence of the department that was responsible for the decision appealed or remit the case to that department for further prosecution. In the latter case, that

4. Nevertheless, the fact remains that the owner of a CTM may, at a later stage after the registration, be faced with a cancellation claim filed with OHIM or a counterclaim filed in infringement proceedings before national courts of the Member States seeking to annul the CTM, among others, based on the same relative grounds for refusal as those upon which the opposition is likely to rely. Hence, the case law on Article 8(1)(b) of the CTMR is, of course, also relevant in the context of cancellation proceedings (see, to that effect, Perfette van Melle v. OHIM–Cloette Fazer (CENTER SHOCK), Case T-16/08, [2009] ECR II-97, para. 27 (GC, July 1, 2009); Weiler v. OHIM–The Int'l Certification Network (Q2WEB), Case T-242/07, [2008] ECR II-252, para. 19 (GC, Nov. 12, 2008)).

department shall be bound by the *ratio decidendi* of the Board of Appeal, in so far as the facts are the same.

Once the Board has rendered a decision, any party adversely affected may file an action before the General Court.\(^6\) Such an action must be lodged within two months of the notification of the decision of the Board of Appeal. The function of the General Court in this regard is merely to review the legality of decisions of the Boards of Appeal of OHIM as referred to in Article 65 of the CTMR. As a result, it is not the General Court’s function to review the facts in the light of documents produced for the first time before it.\(^7\) This also means that any applicant does not have the power to alter before the General Court the terms of the dispute, as delimited in the respective claims and allegations submitted before OHIM. Consequently, an argument expounded for the first time before the General Court and having such an effect must be rejected as inadmissible.\(^8\)

Decisions of the General Court are, in turn, amenable to actions before the CJEU. The appeal can relate only to points of law. If the appeal is admissible and well founded, the CJEU sets aside the judgment of the General Court. Where the state of the proceedings so permits, the CJEU may itself decide on the case. Otherwise, it refers the case back to the General Court, which is bound by the decision given by the CJEU on the appeal. As the appeal lies on only a point of law, the General Court has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts or evidence are distorted, constitute points of law subject, as such, to review by the CJEU on appeal.\(^9\) Also, OHIM remains a party to the opposition throughout the entire appeal proceedings.

This article will attempt to catalogue or classify the abundant case law delivered by the CJEU and General Court in the context of oppositions filed against CTM applications. Between 2002 and 2013, more than 500 decisions were handed down applying Article 8(1)(b) of the CTMR.\(^10\)

In examining the appeals against decisions of the OHIM Boards of Appeal, based on a violation of Articles 8(1)(b) of the

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\(^6\) Before the entry into force of the Lisbon Treaty amending the Treaty on European Union and the Treaty establishing the European Community on Dec. 1, 2009, the General Court was named the Court of First Instance.


\(^8\) The Smiley Co. v. OHIM, Case T-139/08, [2009] ECR II-03535, para. 24 (GC, Sept. 29, 2009).


CTMR, the General Court generally adopts the same order of reasons. After quoting the legal provisions involved and recapitulating the basic principles to be taken into consideration in assessing the likelihood of confusion, the General Court begins by defining the relevant class of persons having regard, on the one hand, to the territory where the senior mark is protected and, on the other hand, to the category of goods or services involved. It then proceeds to comparing the goods and services and the similarity of the conflicting trademarks from a visual, aural, and conceptual point of view. Based on the above findings and taking account of all circumstances relevant to the case, the General Court will ultimately decide on the likelihood of confusion.

For the sake of convenience, the same order will be respected in this contribution.

III. THE "LIKELIHOOD OF CONFUSION"

A. The Likelihood of Confusion as to the Origin of the Goods or Services

The concept of the likelihood of confusion is the most fundamental element of Article 8(1)(b) of the CTMR and is probably one of the most important concepts in trademark law. The prevention of a likelihood of confusion between marks is one of the fundamental precepts of the protection conferred by the trademark, in particular against use by third parties of nonidentical signs.11

In almost all of the decisions handed down over the years, the CJEU and General Court have defined “likelihood of confusion” as the risk that the public might believe that the goods or services marketed under the trademarks in question come from the same undertaking or from economically linked undertakings.12 This definition stresses the importance of the essential and

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11. Adidas v. adidas Benelux, Case C-102/07, [2008] ECR I-2439, para. 27 (CJEU, April 10, 2008); Levi Strauss, Case C-145/05, [2006] ECR I-3703, para. 14 (CJEU, Apr. 27, 2006): In conferring on the proprietor of a trademark the right to prevent all third parties from using an identical or similar sign, where there is a likelihood of confusion, and in setting out the uses of such a sign that may be prohibited, the European legislator sought to protect that proprietor from uses of signs likely to infringe that trademark.

fundamental function of the trademark, which is to guarantee the origin of the goods or services covered by the trademark.\textsuperscript{13}

The owner of a senior mark does not need to submit actual proof that the relevant public is confused as to the source or the origin of the goods or services offered under the trademark. It suffices that the relevant public perceiving the junior mark is likely to attribute the goods or services so marked with the undertaking of the proprietor of the senior mark or to a company economically linked to it. An indirect and hypothetical likelihood of confusion is therefore sufficient.

\textbf{B. The Global Assessment of the Likelihood of Confusion}

According to the Eighth Recital to the CTMR, the appreciation of the likelihood of confusion “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.”

According to well-established case law of the CJEU and the General Court, the existence of a likelihood of confusion on the part of the public must be appreciated globally with regard to the way in which the relevant public perceives the trademarks and goods or services and taking into account all factors relevant to the circumstances of the case, in particular the interdependence of the degree of similarity of the trademarks and the similarity of the goods and services.\textsuperscript{14}

In any event, the existence of a likelihood of confusion requires that both the goods and services covered by the junior mark are identical or similar to those for which the senior mark was registered and that the junior mark and the senior mark are

\textsuperscript{13} In addition, or accessorially, to the function of origin, Articles 8(1)(a) and 8(5) of the CTMR also aim to protect the function of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising (Interflora & Interflora British Unit, Case C-323/09, [2011] ECR I-08625, para. 38 (CJEU, Sept. 22, 2011); L’Oréal & Others, Case C-487/07, [2009] ECR I-05185 (CJEU, June 18, 2009).

identical or similar. Those conditions are cumulative. If one of those conditions is not satisfied, there cannot be a likelihood of confusion. In addition to the conditions expressly set forth in Article 8(1)(b) of the CTMR, case law also takes account of a number of other aspects relevant to the circumstances of the case when assessing the likelihood of confusion.

C. The Likelihood of Confusion Includes the Likelihood of Association

Article 8(1)(b) of the CTMR and Article 4(1)(b) of the First Council Directive 89/104/EEC of December 21, 1988, to approximate the laws of the Member States relating to trade marks stipulate that the likelihood of confusion includes the likelihood of association. The use of that wording in the Directive marked the end of the former (Benelux) theory adopted and approved by the Benelux Court of Justice, giving uniform interpretations on the uniform Benelux trademark law. The Benelux Court of Justice had previously repeatedly held that it was sufficient for the public perceiving the trademark to associate it with the senior mark for there to be a likelihood of confusion. Following the adoption of the Directive and the CTMR, it was made clear that the concept of likelihood of association is not an alternative to that of likelihood of confusion but serves to define its scope. As a consequence, where there is no likelihood of confusion on the part of the public, one cannot fall back on there being a mere likelihood of association.


By contrast, the condition of a likelihood of association does play a fundamental and independent role in the protection of well-known trademarks on the grounds of Article 4(3) of the Directive and Article 8(5) of the CTMR. However, the examination of that type of infringement falls outside the scope of this contribution.

Where the proprietor of a well-known trademark exclusively brings an action under Article 8(1)(b) of the CTMR, the likelihood of association—considering the reputation or high distinctive character of the trademark—will be just one of the elements to be taken into account. For these trademarks as well, the existence of a likelihood of association with the well-known trademark does not imply a presumption of the existence of a likelihood of confusion, which remains the matter to be proved.20 In other words, the existence of a likelihood of association is merely an indication, but does not establish the existence, of a likelihood of confusion. Conversely, it is safe to assume that where there is a likelihood of confusion, there is also a likelihood of association.21

D. The Relevant Public

1. Defining the “Relevant Public”

The likelihood of confusion must obviously be established in the mind of, or on the part of, the relevant public. Therefore, before proceeding to the examination of, on the one hand, the degree of similarity between the trademarks and, on the other hand, the degree of similarity between the goods or services covered by them, the examiner or judge must first define the “relevant public,” both from a territorial perspective and in connection to the category of goods and services.

2. General Observations on the Relevant Public

The perception of the trademarks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. However, the average consumer normally perceives a trademark as a whole and does not analyze its various details.22 Also, the average consumer normally only

rarely has the chance to make a direct comparison between different trademarks and instead must place his trust in the imperfect picture of them that he has kept in his mind.23

Because the average consumer perceives a trademark as a whole and retains only an imperfect image of it, its predominant and distinctive components are of major importance and will more likely be retained in the mind.24

The relevant public for the assessment of the likelihood of confusion is composed of users likely to use both the goods or services covered by the earlier mark and those covered by the mark applied for. Thus, as a general rule, when goods or services covered by one of the marks at issue are included in the larger designation covered by the other mark, the relevant public is defined by reference to the more specific wording.25

For some categories of goods and services, the relevant public is not exclusively composed of end users. The CJEU also held that the likelihood of confusion must, in addition, be examined in the mind of intermediaries who deal with the product commercially. As with consumers or end users, it will tend to influence their conduct in the market.26 The involvement of intermediaries will typically be the case for pharmaceutical products. Because these products will often require a doctor’s prescription to be sold and are delivered to consumers in pharmacies, the relevant public includes not only the average consumer or end user, but also healthcare professionals—that is, the doctors who prescribe the medicinal products as well as the pharmacists delivering them.27
3. The Perception and Level of Attention Varies According to the Category of the Products or Services

The average consumer’s level of attention is likely to vary according to the category of goods or services in question.28 This rule has frequently been applied in the case law of the CJEU and the General Court. Generally speaking, the consumers’ level of attention in view of a category of goods is qualified as high, average, or low, depending on the category of goods.

The consumer’s level of attention will be average when the goods at issue are ordinary consumer goods intended for the general public. The “average” consumer is not absent-minded but is deemed to be reasonably well-informed and reasonably observant and circumspect.29

An average degree of attention typically applies to beverages and foodstuffs, which are abundantly displayed on shelves in food retailers, shopping centers, restaurants, and bars.30 The same applies in general to alcoholic beverages,31 such as wine.32


Regarding the relevant public for “energy drinks” specifically, one cannot assume that the degree of attention is higher than average because the consumer would, on account of belonging to an age group or of his party-going habits, display a high degree of attention when purchasing them, by contrast to goods of which consumers belonging to the younger generation may have specific expectations, for example, at the technological level.33

Case law is, by contrast, rather reluctant to accept that the consumer’s level of attention is plainly low for certain categories of products or services. A somewhat lower degree of attention will, for instance, apply to fast-moving mass consumer goods with a low (monetary) value and that are often purchased impulsively, such as chocolate and confectionary products,34 milk,35 or socks.36

The level of attention will, on the other hand, be higher, in those cases in which the goods or services are durable, have a high value, or are intended for more exceptional use. The same high level of attention is assumed where the public is made up of specialists in the sector.37 In view thereof, a high level of attention will typically be assumed with respect to cars38 as well as spare parts for cars,39 medical equipment (which is by virtue of its nature designed particularly for specialists working in the surgical and medical fields)40 chemicals (in Class 1) (which will be purchased by chemists and laboratory staff),41 and building materials (for which

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41. CureVac v. OHIM–Qiagen (RNAiFect), Case T-80/08, [2009] ECR II-4025, para. 29 (GC, Oct. 28, 2009); on the other hand, even though the relevant public for the gases used for welding is mainly composed of professionals, amateur welders may also form part of it. The level of attention of these amateurs will be higher than that of average consumers, but lower than that of the professionals. Air Prods. and Chems. v. OHIM–Messer Grp. (Ferromix), Cases T-305/06 to T-307/06, [2008] ECR II-220, para. 30 (GC, Oct. 15, 2008).
the relevant public is composed of professionals working in the construction industry).

Likewise, the level of attention will also be high if it involves the consumer’s health. For instance, consumers of tobacco will be highly circumspect and attentive given their addiction to these products and strong brand loyalty.

The same applies to pharmaceutical products, mainly sold as Class 5 goods, where the relevant public is made up of the medical professional as well as the end user. In this respect, a high or specialist level of attention will be assumed for the medical professionals when prescribing or delivering medicines, whereas the patients or end users of pharmaceutical products—irrespective of them being sold on prescription—are also assumed to be reasonably well informed and reasonably observant and circumspect. Because these goods can affect their state of health, consumers are less likely to confuse different versions of similar goods. For the same reasons, a higher level of attention is also assumed for dietetic products and food supplements. The “higher” degree of attention of the end user is not called into question by the finding that consumers are often assisted by healthcare professionals or doctors whose prior intervention is required in order to sell these goods.
The fact that the level of attention of the relevant public is above average and that intermediaries, such as healthcare professionals, may influence the decision of the consumers or may even be decisive in this respect, is not sufficient to exclude the possibility of a likelihood of confusion on the part of the public with respect to the origin of pharmaceutical products. Furthermore, the level of attention may also vary depending on the specific subcategory within the broader description of pharmaceutical products, which covers goods that are sufficiently different from each other in their intended purpose, in their intended consumers (according to their specific therapeutic indications), and in their channels of distribution, depending on whether they are available by medical prescription only or over the counter. Consequently, the criterion of the purpose or intended use of the product or service in question is of fundamental importance in the definition of a subcategory within the broader concept of pharmaceutical products, where the purpose and intended use of a product are expressed in its therapeutic indication. The degree of attention of the consumer will therefore be determined by the therapeutic indications of the product in question. The worse the pathology the products aim to cure, the higher the level of attention will be.

Nonetheless, the argument that the higher level of attention allows the patient to distinguish marks that are slightly different—often supported with the contention that confusion
would result in “particularly disagreeable consequences”—cannot be validly drawn. In a conflict between the earlier word mark SEROSTIM, registered for, *inter alia*, herbicides, and the applied-for word mark SEROSLIM, registered for, *inter alia*, dietetic substances, the General Court refused to accept that even minute differences between two verbal trademarks can have a decisive importance for pharmaceutical products based on a chemical nomenclature. After all, the higher level of attention does not imply that the average consumer has the same knowledge as a professional in the sector with regard to the prescription of pharmaceutical products. As a result, a likelihood of confusion was accepted.\(^52\)

The distinction between a high and an average level of attention is not always that unequivocal: the level of attention will sometimes lie in the middle, which makes the General Court speak not of a high degree but of a “(somewhat) higher degree of attention” than average or a “relatively high” degree of attention.

This elevated level of attention will apply to goods for which the actual act of purchase may be completed quickly but the process of comparison and reflection before the choice is made requires, by definition, more time, and therefore a higher level of attention, such as for consumer health goods,\(^53\) hygienic products,\(^54\) cosmetics, and make-up.\(^55\) A somewhat higher degree of attention will also apply to furniture, where the consumer makes his choice on the basis of a number of functional and aesthetic considerations, in order to ensure that it is in keeping with other furniture already in his possession.\(^56\)

The same applies to consumer goods that are not purchased regularly and that require the advice of a salesperson and/or that depend strongly on trends, personal taste, and brands, such as watches and jewelry\(^57\) or eyeglasses\(^58\) or for which the public has

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\(^56\) Inter-Ikea v. OHIM–Waibel (idea), Case T-112/06, [2008] ECR II-6, para. 37 (GC, Jan. 16, 2008).


very specific technological expectations, which is the case for video games and software.

As a general rule, where the relevant public is composed of different types of consumers showing both a high level of attention and an average (or somewhat higher) level of attention, such as consumers of pharmaceutical products, the public with the lowest level of attention will be taken into account for the purpose of the appreciation of the likelihood of confusion. Confusion on that part of the public will suffice to prevent the registration of the mark applied for.

Along the same lines, where the category of goods is sufficiently broad so as to include ranges of products for which the relevant consumers display both a normal and higher degree of attention, attention must be paid to the consumers with the lowest level of attention. An example of this is a case relating to food for babies: while it is undoubtedly true that the parents of babies or young children pay a higher degree of attention when purchasing products for babies because of the importance they attach to nutrition and health, the range of goods considered “food for babies” is so extensive that the group of average consumers for that category of goods does not only include (overly) careful parents but also includes the normal average consumer.

Similarly, the degree of attention of the relevant public can also largely vary depending on the various (sub) categories of the same class headings of the Nice Agreement, such as the subheading “Clothing” (Class 25). Because clothing and footwear


61. Ergo Versicherungsgruppe v. OHIM–Société de développement et de recherche industrielle (ERGO GROUP), Case T-221/09, [2011] ECR II-00238, para. 21 (GC, July 15, 2011); Kido v. OHMI–Amberes (SCORPIONEXO), Case T-152/08, [2010] ECR II-00165, para. 40 (GC, Sept. 8, 2010); Madaus v. OHIM–Optima Healthcare (ECHINAID), Case T-202/04, ECR 2006 II-1115, para. 23 (GC, Apr. 5, 2006); for these goods the relevant public is made up both of specialists such as pharmacists and doctors, who have a (very) high degree of attention, as well as the general public (patients), who are deemed to be reasonably well-informed, observant, and circumspect.

are, generally speaking, mass-consumption goods, the relevant public is made up of average consumers who are deemed to be reasonably well-informed, attentive, and circumspect.  

While it is true that clothing includes goods that vary widely in quality and price and that it is possible that consumers will be more attentive to brands and trademarks when buying a particularly expensive item, such an approach cannot be presumed, without evidence, for all goods in this category. For the well-defined subcategory of more expensive clothing articles, such as skiwear, ski boots, ski hats, hiking boots, and rucksacks, a significant part of the relevant public will be consumers who regularly ski or hike and therefore know those goods well. Those consumers will therefore tend to pay particular attention to ensure they obtain the best possible protection against the cold and snow, as well as paying attention to the technical features of the products offering enhanced performance and comfort. For this section of the public, the level of attention will be higher than for average consumers.

Conversely, it should also be noted that it is common in the clothing sector for the same trademark to be configured in different ways for different types of products and that it is therefore common for clothing manufacturers to use “sub-brands,” that is, trademarks that are derived from a principal trademark but share its common dominant element, to distinguish their clothing lines. In these circumstances, it is conceivable that the targeted public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges of products but as coming, none the less, from the same manufacturer. As a consequence, it will often be easier to come to

63. In more recent case law, the GC emphasized that clothing and belts “are mass consumption goods, frequently purchased by the average consumer. The degree of attention paid to those goods will be no higher than average given that the goods are for everyday use and that they do not have a serious impact on the health, budget or life of the European Union consumer.” See The Pukka Luggage v. OHMI–Azpiroz Arruti (PUKKA), Case T-483/10, [2011] ECR II-00424, para. 18 (GC, Nov. 23, 2011); Esprit Int’l v. OHIM–Marc O’Polo Int’l (figurative trademark representing the letter “e”), Case T-22/10, [2011] ECR II-00381, para. 47 (GC, Nov. 10, 2011); PJ Hungary v. OHIM–Pepekillo (PEPEQUILLO), Case T-580/08, ECR [2011] II-02423, para. 71 (GC, May 19, 2011); Canali Ireland v. OHIM–Canal Jean (CANAL JEAN CO. NEW YORK), Case T-301/03, [2005] ECR II-2479, para. 45 (GC, June 28, 2005); New Look v. OHIM–Naulover (NLSPORT), Cases T-117/03, T-119/03, and T-171/03, [2004] ECR II-3471, para. 25 (GC, Oct. 6, 2004); Laboratorios RTB v. OHIM–Giorgio Beverly Hills (GIORGIO BEVERLY HILLS), Case T-162/01, [2003] ECR II-2821, para. 34 (GC, July 9, 2003); Oberhauser v. OHIM–Petit Liberto (FIFTIES), Case T-104/01, ECR 2002 II-4359, para. 29 (GC, Oct. 23, 2002).


the conclusion of a likelihood of confusion in the clothing sector, even if the level of attention is at least average or, in some cases, above average. The same conclusions apply to goods that are very close to the clothing sector, such as bags and accessories.66

![Seven](image1)

Senior Mark        Junior Mark

If the objective characteristics of a given product means that the average consumer purchases it only after a particularly careful examination, it is important in law to take into account that such a fact may reduce the likelihood of confusion between marks relating to such goods at the crucial moment when the choice between those goods and marks is made.67 Specialists are obviously likely to take greater care in making their selection than the average consumer.68

Nonetheless, the fact remains that even where the relevant public is composed of professionals or operators who work in the industry involved and show an (extremely) high level of attention, that does not mean that minor differences between the trademarks at issue will be sufficient to exclude the likelihood of confusion and to prevent that public from thinking that the goods come from the same undertaking or, from economically linked undertakings, especially not in view of the identity of the products in question.

Legends v. OHIM–Acteon (OFFSHORE LEGENDS), Cases T-305/07 and T-306/07, [2009] ECR II-155, para. 89, 103 (GC, Sept. 16, 2009); Meric v. OHIM–Arbora & Ausonia (PAM-PIM’S BABY-PROP), Case T-133/05, [2006] ECR II-2737, para. 76 (GC, Sept. 7, 2006); New Look v. OHIM–Naulover (NLSPORT), Cases T-117/03, T-119/03, and T-171/03, [2004] ECR II-3471, para. 51 (GC, Oct. 6, 2004); Oberhauser v. OHIM–Petit Liberto (FIFTIES), Case T-104/01, [2002] ECR II-4359, para. 48 (GC, Oct. 23, 2002): “Since the average consumer will, amongst other things, retain in his mind the predominant word element of the earlier mark, namely the expression ‘miss fifties’, when he finds clothing of the same kind designated by the mark claimed he might think the goods have the same commercial origin. Consequently, even if the average consumer is capable of detecting certain differences between the two signs, the risk that he might associate the two marks with each other is very real.”


the high degree of similarity between the trademarks at issue, and/or the high degree of distinctiveness of the senior mark.69

An example of this is the conflict between the two trademarks shown below, both covering software: “Accordingly, the fact that the relevant public is composed of persons whose level of attention may be considered high is not sufficient, given the fact that the signs at issue are almost identical and the similarity between the goods in question, to exclude the possibility that that public might believe that the goods and services concerned come from the same undertaking or, as the case may be, from economically-linked undertakings.”70

Conversely, the global approach of the likelihood of confusion implicates that a low degree of attention on the part of the public does not imply that (very) slight similarities between the marks will suffice for there to be a likelihood of confusion.

4. The Relevant Public from a Territorial Point of View

Defining the relevant consumer in Europe from a territorial perspective may have an important influence on the outcome of the matter.

According to Article 8(2)(a) of the CTMR, “earlier trade marks” include CTMs, trademarks registered in a member state of the European Union (“Member State”) and trademarks registered under international arrangements that have effect in a Member State or the Community with a date of application for registration that is earlier than the date of application for registration of the opposed CTM.71

If the senior mark is a national mark registered in a given Member State, the consumer’s perception must be examined by


70. Apple Computer v. OHIM–TKS-Teknosoft (QUARTZ), Case T-328/05, [2008] ECR II-104, para. 59 (GC, July 1, 2008); T-79/07, SHS Polar Sistemas Informáticos v. OHIM–Polaris Software Lab (POLARIS), 2008 [ECR] II-99, para. 27 (GC, June 26, 2008): because the goods to which the trademark application relates must be regarded as directed solely at the management of financial institutions who are responsible for purchasing the specialized software used in those institutions, it was found that there is no likelihood of confusion between the earlier verbal trademark POLAR and the figurative trademark POLARIS.

reference to that territory. For instance, if the earlier national mark is registered in Italy or Spain, the relevant consumer will be the average Italian or Spaniard. If, by contrast, the senior mark is a CTM, the perception of the conflicting trademarks must be examined in the view of consumers in the entire European Union. If the opposition is based on a CTM, it is sufficient that the relative ground for refusal in the sense of Article 8(1)(b) of the CTMR exists only in part of the Community for the application to be rejected.

Such distinction is important, as it may very well influence the assessment of the distinctiveness of (components of) the mark and the examination of phonetic and conceptual similarities between the marks at issue. Because of linguistic, cultural, social, and economic differences between the Member States, a trademark that is devoid of distinctive character or descriptive of the goods or services concerned in one Member State is not necessarily so in another Member State.

In assessing phonetic and conceptual similarities, account is taken of the language spoken in the territory concerned. Sometimes it is difficult to establish with certainty how the average consumer will pronounce a word of foreign origin in his native language. First, there is no certainty that the word will be recognized as being foreign. Second, even if the foreign origin of the word in question is recognized, it may not be pronounced in the same manner as in the original language. A correct pronunciation according to the original language presupposes not only knowledge of that pronunciation, but also the ability to pronounce the word in question with the correct accent. Therefore, as a general rule, knowledge of a foreign language cannot be assumed for the average consumer when assessing similarities conceptually and phonetically.

The fact that the earlier (national) trademark relied on, and therefore also the relevant consumer, might influence the outcome of the case, was, for instance, demonstrated in conflict where the

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General Court denied a likelihood of confusion on the part of the Spanish public. Given that the degree of familiarity of the Spanish public with the English language is generally held to be low, the General Court found that the Spanish consumer would not understand the meaning of the earlier mark DOGHNUTS with respect to pastry products and, hence, that this word was therefore not descriptive in assessing the similarities with the later mark BIMBO DOUGHNUTS.\textsuperscript{76} The perception of the English consumer might lead to a different result.

E. Miscellaneous

As a general principle in opposition proceedings, the existence of likelihood of confusion is determined by comparing the two trademarks as they appeared at the time of their registration or application for registration and not as they were or are used in a given market.

However, this rule does not apply to oppositions based on the existence of several trademarks with shared characteristics that make it possible for them to be regarded as part of a “family” or “series” of trademarks. According to the CJEU, where there is a “family” or “series” of trademarks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the junior mark or may consider that that trademark is part of that family or series of trademarks.\textsuperscript{77}

The relevant point in time to assess the likelihood of confusion in opposition proceedings concerning these series of marks is deemed to be the moment of purchase by the relevant public. The CJEU has held, for example, that even though the choice of pharmaceutical products can be influenced or determined by

\textsuperscript{76} Bimbo v. OHIM–Panrico (BIMBO DOUGHNUTS), Case T-569/10, not yet published, paras. 61-63 (GC, Oct. 10, 2012).

intermediaries, the actual purchases are made by consumers in pharmacies. The likelihood of confusion should therefore be assessed at the time consumers buy the products, even if they perform separate purchasing transactions for each product.\(^{78}\)

By contrast to the abstract and prospective opposition proceedings, trademark infringement proceedings may also consider confusion arising before the purchase (so-called “initial interest confusion”) as well as afterwards (the “post-sale confusion”).\(^{79}\) Also, in order to determine the scope of protection of a trademark in infringement proceedings (and therefore also the likelihood of confusion), the national courts dealing with the infringement must consider the perception of the relevant public at the time when the trademark-infringing sign began to be used.\(^{80}\)

**IV. SIMILARITY OF GOODS AND SERVICES**

**A. The Concept of “Similarity” and the Nice Agreement**

Once the relevant public is defined, the first question will be if, and to what extent, the average consumer is likely to consider the goods or services covered by the trademark to be identical, similar, or dissimilar. As is stated in Rule 2(4) of Regulation (EC) No. 2868/95 of the Commission of December 13, 1995, implementing the revised CTMR, the international classification of goods and services under the Nice Agreement is exclusively for administrative purposes and is not conclusive when assessing the similarity of goods and/or services. Therefore, goods and services may not be regarded as being dissimilar to each other on the ground that they appear in different classes under the Nice Classification. Conversely, goods and services may not automatically be regarded as similar to each other on the ground that they appear in the same class under the Nice Classification.\(^{81}\)

All that counts is the comparison of the description of the goods and services.

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\(^{79}\) These tests are actionable in light of paragraphs 56 through 57 of Arsenal Football Club v. Mr. Reed, Case C-206/01, [2002] ECR I-10273 (CJEU, Nov. 12, 2002), and have been applied to the merits in the landmark rulings of the High Court of Justice, Chancery Division, in Och Ziff Mgmt. v. Och Capital, [2010] EWHC 2599 (High Court of Justice (Ch)), and in Datacard v. Eagle Techs., [2011] EWHC (Pat) 244 (High Court of Justice (Ch) 2011).


B. The Assessment of Similarity

For the likelihood of confusion to be established, it is at least required that the goods and/or services involved are found to be similar. Save for the well-known trademarks that are dealt with in Article 8(5) of the CTMR, trademarks confer exclusive rights only for the goods and/or services listed in their registrations. This so-called principle of specialty defines the scope of protection of a trademark. As such, it is theoretically perfectly possible for identical trademarks to co-exist as long as they are registered and used for dissimilar goods or services. The word sign LOTUS, for instance, is registered and used for a wide array of goods (luxury cars, software, biscuits, toilet paper, etc.). As long as the owners use the trademark to market their goods or services within their specialist area, there is hypothetically not much chance of the public believing that the goods or services come from the same undertaking or undertakings economically linked to each other.

When examining the links between the goods and services involved, it is not enough to state that they are either similar or dissimilar. The examiner or judge should specify “to which degree” the goods and/or services are similar, considering that one should also examine the degree of similarity between trademarks at issue and the interdependence between those two conditions. The examiner or judge must therefore declare a degree of similarity that is strong or high, normal or certain, or weak or low. 82 Such finding is important in view of the global appreciation—and the balancing act—of the likelihood of confusion. As will be discussed further, “a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the trade marks, and vice versa.”83

In assessing the similarity of the goods and services, only the description of the goods and services of the junior mark can be considered. The actual use of a senior mark, for instance in a particular sector or on a particular market, cannot be taken into account where that registration cannot entail a restriction to that

82. The same rules also apply to the assessment of the similarity of the conflicting trademarks, where the judge or examiner has to specify the degree of similarity and the importance to be attached to each of the visual, phonetic, and/or conceptual similarities.

Neither may consideration be given to the contemplated use claimed by the applicant, such as use exclusively limited to luxury versions of a certain product.

This also means that no account may be taken of the allegation that the relevant public shows brand loyalty—which is by definition very subjective—for instance, when purchasing energy drinks. That argument cannot be taken into consideration in analyzing the similarity or identity of the goods covered by the marks at issue, as such an analysis must be carried out purely objectively, having regard, on the one hand, to the goods covered by the earlier mark and, on the other hand, to those covered by the mark applied for.

Where the goods or services covered by the earlier mark (such as “pharmaceutical products”) include the goods covered by the trademark application (such as “pharmaceutical products for the treatment of gastro-intestinal conditions”), those goods or services are considered to be identical. The same applies where goods or services designated by the earlier mark are included in a more general category, designated by the applied-for mark.

The influence on the comparison of goods that the recent IP Translator decision of the CJEU will have remains to be seen (see Chartered Inst. of Patent Attorneys/Registrar of Trade Marks (IP Translator), Case C-307/10, not yet published, para. 57 (CJEU, June 19, 2012). In paragraphs 61 and 62, the CJEU observed that accordingly, in order to respect the requirements of clarity and precision mentioned above, an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered. An application for registration which does not make it possible to establish whether, by using a particular class heading of the Nice Classification, the applicant intends to cover all or only some of the goods in that class cannot be considered sufficiently clear and precise.
In order to assess whether the goods and services covered by the two trademarks are similar or identical, all the relevant factors relating to the links between them must be taken into account. Those factors include, *inter alia*, their nature, their intended purpose, their method of use, and whether they are in competition with each other or are complementary.88 In the context of the global approach, the similarities between the goods and services outweigh the differences.89

Following OHIM’s definition (in point 2.6.1 of its Opposition Guidelines, available on its website) it has meanwhile become well-established case law that goods or services are complementary where there is a close connection between them, in the sense that one is indispensable or at least important for the use of the other, so that consumers may think that responsibility for the production of those goods or the provision of those services lies with the same undertaking.90 The use of the wording “indispensable” shows that the connection between the goods must be quite strict, in the sense “that a purchaser of one of those products would be led to purchase the other.” This may, for instance, be the case for chemical products for smoothing and levelling walls and floors (Class 1) and paints, lacquers, and undercoatings (Class 2).91 By contrast, although beer and tequila may be mixed, they are not complementary, as they have a different taste, different ingredients, and a different method of production and will generally be consumed separately.92 The same applies to rum and cola.93
Regarding the complementary nature of clothing (Class 25) versus other goods in Classes 18 and 25, the case law of the General Court is not always unambiguous. Some (rather dissenting) case law of the General Court finds the goods to be similar to some degree. This was, for instance, the case for:

- clothing (class 25) vs. footwear (class 25), as these are both destined to cover the human body and are often produced by the same companies, as well as clothing (class 25) vs. bags, handbags, wallets and purses (class 18).94
- headgear (class 25) vs. footwear (class 25), because they have the same basic nature, “albeit in respect of a different part of the human body.”95
- bags (class 18) vs. footwear (class 25): both products can be considered as accessories that are aesthetically complementary, since both may contribute jointly to the external image of the consumer concerned and are often sold in the same points of sales.96
- ornamental pins, tie pins, cuff links etc. (class 14) vs. watches (class 14), “taking account, first, of the fact that they are often manufactured from the same raw material and have a similar aesthetic function and, secondly, of the fact that they have the same distribution channels.”97

The general rule, which is adopted in more recent majority case law and which seems more correct, is, more or less that, while all kinds of clothing and fashion articles—such as sunglasses, jewelry, belts, bags, shirts, etc.—are complementary to some extent, the aesthetic or subjective complementary nature has not reached the stage of a true aesthetic “necessity” in the sense that consumers would think it unusual or shocking to carry a bag that does not perfectly match their shoes. After all, the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar.98 Hence, the below goods were found to be dissimilar:

96. Id., paras. 23 & 27.
• clothing and footwear (class 25) vs. trunks and umbrellas (class 8).99
• spectacles (class 9), jewellery (class 14), watches (class 14) vs. clothing (class 25), since “the relationship between those goods is too indirect to be regarded as conclusive.”100
• sunglasses (class 9), bracelets, necklaces and earrings (class 14) vs. clothing, footwear and headgear (class 25).101
• perfumes (class 3) vs. clothing (class 25) and leather goods (class 18): “Those goods, as of themselves, also differ as regards both their nature and their intended purpose or their method of use. There is nothing, either, that enables them to be regarded as in competition with each other or complementary.”102

Regarding the competing nature of alcoholic and nonalcoholic drinks, it is usually held that, although they can meet the same needs to a certain extent, they are too different to be considered similar. When comparing water (Class 30) with alcoholic beverages (Class 33), the General Court stated:

It is possible as a result of the alcohol content of the beverages to distinguish them from water and non alcoholic drinks. Such drinks have different characteristics. Whereas alcoholic drinks are usually consumed on special and convivial occasions, water and non-alcoholic drinks are consumed on a daily basis. Moreover, the consumption of water satisfies a vital need. The average consumer, deemed to be reasonably well informed and reasonably observant and circumspect, is aware of that distinction between alcoholic and non alcoholic drinks, which is, moreover, necessary, since some consumers do not wish to or cannot consume alcohol. Furthermore, the price of alcoholic drinks is generally much higher than that of non alcoholic drinks and the marketing of alcohol is, in a number of respects, more regulated, it being necessary, inter alia, to obtain a licence to sell alcohol and a minimum age restriction being imposed for the purchase of alcoholic drinks. The fact that the drinks at issue may be consumed in the same places and in a complementary fashion, in that they can be mixed or

served together, and that they are often consumed by the same people and sold at similar points of sale does not affect this finding.\textsuperscript{103}

The same conclusion applies to wine (Class 33) versus nonalcoholic beverages in general (Class 32)\textsuperscript{104} and to beer (Class 32) versus milk, tea, and coffee (Class 30).\textsuperscript{105}

Along the same lines, alcoholic beverages are not automatically considered to be similar either, especially in view of the extensive range of alcoholic beverages and their different method of production, ingredients, and intended use. The General Court, for instance, held that the following were dissimilar:

- wine (class 33) and beer (class 32): although both beverages contain alcohol obtained by a fermentation process and consumed during a meal or drunk as an aperitif, “the basic ingredients of those beverages do not have anything in common” and “the end products generated differ in colour, aroma and taste” which “leads the relevant consumer to perceive those two products as being different.”\textsuperscript{106}

- La Rioja wine (class 33) vs. Porto wine (class 33): wine is consumed during the meal, while Porto is consumed rather as an aperitif or digestive.\textsuperscript{107} In view thereof, and somewhat surprisingly, a degree of similarity was upheld between wine (class 33) vs. vinegar (class 30): even though vinegar, unlike wine, is not a drink, the fact remains that both products can be used in food preparation. Also, vinegar is commonly obtained by acetous fermentation of wine.\textsuperscript{108}

- rum (class 33) vs. wine (class 33): even if these are both alcoholic drinks marketed through the same distribution channels and points of sale, they differ in their nature,

\textsuperscript{103} Spa Monopole v. OHIM–De Francesco Import (SpagO), Case T-438/07, [2009] ECR II-4115, para. 30 (GC, Nov. 12, 2009).

\textsuperscript{104} Coca-Cola v. OHIM–San Polo (MEZZOPANE), Case T-175/06, [2008] ECR II-1055, para. 71-91 (GC, June 18, 2008). Conversely: Mystery Drinks v. OHIM–Karlsberg Brauerei (MYSTERY), Case T-99/01, [2003] ECR II-43, para. 40 (GC, Jan. 15, 2003): it was concluded that mixed beverages and beer or nonalcoholic beverages could be substituted to a certain degree.

\textsuperscript{105} Wessang v. OHIM–Greinwald (STAR FOODS), Case T-492/08, [2010] ECR II-82, para. 29 (GC, May 11, 2010).


method of production, origin and alcohol percentage so that
they are not competing nor complementary.\textsuperscript{109}

By contrast, nonalcoholic beverages will often be considered
similar to some degree, as they share the same basic needs and
purpose, that of quenching thirst, and are to a large extent in
competition: nonalcoholic beverages are normally drunk cold and
although the ingredients being admittedly different in most cases,
that does not affect the finding that they are interchangeable
because they are intended to meet an identical need. This was for
instance held in the comparison between herbal and vitamin
drinks (class 32) vs. concentrated fruit juices (class 32).\textsuperscript{110}

Other factors may also be taken into account to examine the
similarity, including the usual channels of distribution of the
category of goods in question.\textsuperscript{111} The nature of the goods will
determine the significance to be attributed to their common
channels of distribution.

The channels of distribution will typically play a role in
assessing the similarity between pharmaceutical products. For
instance, despite the fact that two pharmaceutical products have
different therapeutic indications (metabolism disorders vs.
cardiovascular diseases), the circumstances in which they are
recommended to consumers, namely by health professionals, and
the fact that they use the same channels of distribution, namely
health centers and pharmacies, may lead to the conclusion that the
goods are similar.\textsuperscript{112}

The same cannot be said for beverages. For instance, although
alcoholic and nonalcoholic beverages are often sold through the
same distribution channels, these drinks are not often offered for
sale on the same shelves in supermarkets and shops.\textsuperscript{113} The fact
that they may be sold in the same commercial establishments,
such as department stores or supermarkets, is not particularly
significant, as very different kinds of goods may be found in such

\textsuperscript{109} Bodegas Montebello v. OHIM–Montebello (MONTEBELLO RHUM AGRICOLE),
Case T-430/07, [2009] ECR II-49, para. 36 (GC, Apr. 29, 2009);


\textsuperscript{111} Rossi v. OHIM, Case C-214/05 P, [2006] ECR, I-7057, para. 65 (CJEU, July 18, 2006); Saint-Gobain Pam v. OHIM–Propamsa (PAM PLUVIAL), Case T-364/05, [2006] ECR II-757, para. 95 (GC, Mar. 22, 2007); Ampafrance v. OHIM–Johnson & Johnson (monBeBé),

\textsuperscript{112} Kureha v. OHIM–Sanofi-Aventis (KREMESIN), Case T-487/08, [2010] ECR II-111, paras. 75-76 (GC, June 16, 2010); GlaxoSmithkline v. OHIM–Serono Genetics Inst. (FAMOXIN),
(GC, Sept. 23, 2009).

\textsuperscript{113} Wessang v. OHIM–Greinwald (STAR FOODS), Case T-492/08, [2010] ECR II-82, para. 33 (GC, May 11, 2010).
shops, without consumers automatically believing them to have the same origin.¹¹⁴

If the applicant requests the opponent to furnish proof that the senior mark has been put to genuine use (as may be required under Article 42(2) CTMR) and the opponent only produces evidence for some of the goods or services covered by the senior mark, then the senior mark is deemed to have been registered solely for these goods or services.¹¹⁵ Lack of evidence of genuine use of the trademark for certain goods or services evidently does not entail an ex officio revocation of the trademark for lack of use.

If the earlier mark was registered for a category of goods, such as a Nice class heading, which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection only for that subcategory. The principle of so-called “partial use” will typically be important in assessing similarities between pharmaceutical products. It is assumed that the concept of “pharmaceutical preparations” in Class 5 covers goods that are sufficiently different in their intended purpose and end consumers, according to their specific therapeutic indications, and in their channels of distribution, depending on whether they are available by medical prescription or over the counter, for it to be possible to identify within it various subcategories.¹¹⁶

For instance, while the senior mark was registered for “pharmaceutical and sanitary preparations; plasters,” the fact that it had to be regarded as having been exclusively used for “multi-dose dry powder inhalers containing corticoids, available only on prescription” conferred protection only on that subcategory within which those goods fell.¹¹⁷ However, while the principle of partial use is likely to influence the assessment of similarities between the goods and will often exclude the goods being identical, the fact of the matter remains that, especially for pharmaceutical products, the different intended use or therapeutic indications do not call into question that all these goods have the same nature (pharmaceutical products), general purpose (treatment of human


health problems), consumers (medical professionals and patients) and distribution channels (typically pharmacies). This is apparent from the fact that they belong to the same general category of goods.\textsuperscript{118} Consequently, even if there were different therapeutic indications, the fact that all of them are meant for healing and curing human health problems, are directed at the same consumers and use the same distribution channels is sufficient to consider that they have a certain degree of similarity, although this cannot be qualified as “high.”\textsuperscript{119}

For the purposes of registration of a trademark covering retail services (Class 35), the CJEU held in \textit{Praktiker Bau- und Heimwerkermärkte} that it is not necessary to specify in detail the service(s). However, the types of goods to which those services relate must be specified. If the applicant fails to do so, he will not be able later to rely on a vague description of the goods to oppose later trademark registration applications for goods in the same class.\textsuperscript{120}

Obviously, goods and services can also be regarded as being similar to each other.\textsuperscript{121} This will, for instance, be the case where the earlier mark is registered for retail services of certain goods and the mark applied for is registered for those goods as such, and vice versa.

In a conflict between an senior mark (THE O-STORE) registered for, \textit{inter alia}, clothing and a later mark (O-STORE) registered, \textit{inter alia}, for the retail services of clothing, the General Court stated, with reference to the CJEU’s ruling in \textit{Praktiker Bau- und Heimwerkermärkte}, that the objective of retail trade is the sale of goods to consumers whereas that trade includes, in addition to sales transactions, all activity carried out by the trader for the purpose of encouraging such transactions. Such services, which are obviously provided with the aim of selling certain specific goods, would make no sense without the goods themselves. The relationship between retail services for clothing and the

\begin{itemize}
  \item \textsuperscript{118} Kureha v. OHIM–Sanofi-Aventis (KREMEZIN), Case T-487/08, [2010] ECR II-00111, paras. 75-78 (GC, June 16, 2010); Sanofi-Aventis v. OHIM–GD Searle (ATURION), Case T-146/06, [2008] ECR II-00017, paras. 32-35 (GC, Feb, 13, 2008);
  \item \textsuperscript{119} Longevity Health Prods. v. OHIM–Tecnifar (E-PLEX), Case T-161/10, [2011] ECR II-00156, para. 26 (GC, May 24, 2011).
  \item \textsuperscript{120} Praktiker Bau- und Heimwerkermärkte, Case C-418/02, [2005] ECR I-5873, para. 49 (CJEU, July 7, 2005); Frag Comercio Internacional v. OHIM–Tinkerbell Modas (GREEN by missako), Case T-162/08, [2009] ECR II-212, para. 31 (GC, Nov. 11, 2009); Oakley v. OHIM–Venticinque (O STORE), T-116/06, [2008] ECR II-2455, para. 43 (GC, Sept. 24, 2008).
\end{itemize}
clothing itself is characterized by a close link in the sense that the goods are indispensable to or, at the very least, important for the provision of those services when the goods are sold. Those services are therefore not merely auxiliary or ancillary to the goods in question but are complementary, all the more so because those services are generally offered in the same places as those where the goods are offered for sale. As a result, it was held that “the goods and services in question resemble each other to a certain degree.”

The General Court came to a similar conclusion when comparing restaurant services (Class 42) with foodstuffs such as meat and fish (Class 29).

V. THE SIMILARITY BETWEEN THE CONFLICTING TRADEMARKS

A. Introduction

It is indispensable that there is a certain degree of similarity between the goods and/or services covered by the two trademarks. If this is not the case, there is no further need to examine the similarity between the signs or the likelihood of confusion.

B. Comparison with the Trademark as Registered

For the purpose of assessing the similarity in opposition proceedings between the senior mark and the junior mark, the senior mark is viewed as it was registered and not as it is or might be used on the market.

Hence, when the opposition is based on a word mark, the opponent cannot rely upon the argument that the word can be presented with typography similar to that of the applied-for mark. It should be borne in mind that, when examining the similarity between conflicting trademarks, they must be examined as a whole, as they were registered or applied for. Word marks consist entirely of letters, words, or groups of words, written in printed characters in normal fonts, without any specific graphic element. The protection that results from registration of a word mark

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relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects that that mark might have. The graphic form that the word mark might adopt must not, therefore, be taken into account for the purposes of the examination of the visual similarity.\textsuperscript{125}

\begin{figure}[h]
\centering
\includegraphics[width=0.8\textwidth]{volvo_naber.png}
\caption{Volvo and Naber marks}
\end{figure}

The same reasoning applies to figurative marks. These are defined as a specific representation of word or graphic characteristics or a combination of word and graphic elements, whether or not in color. A complex figurative mark consists of two or more categories of signs, combining, for example, letters and graphics. Likewise, the examination of the similarity of such marks must take them into consideration as a whole, as they are registered or sought to be registered. Figurative marks are, by nature, exclusively protected in accordance with the fixed nature of their morphology covered by their registration. As a result, one may not consider any other graphic representation or any representation in enlarged format that the applied-for mark might take on in future.\textsuperscript{126}

\begin{figure}[h]
\centering
\includegraphics[width=0.8\textwidth]{senior_junior.png}
\caption{Senior and Junior marks}
\end{figure}

\textsuperscript{125} Volvo Trademark v. OHIM–Grebenshikova (SOLVO), Case T-434/07, [2009] ECR II-4415, para. 37 (GC, Dec. 2, 2009); Ontex v. OHIM–Curon Medical (CURON), Case T-353/04, [2007] ECR II-10, para. 74 (GC Feb. 13, 2007); Faber Chimica v. OHIM–Industrias Quimicas Naber (Faber), Case T-211/03, [2005] ECR II-1297, para. 26 (GC, Apr. 20, 2005). Surprisingly, other (dissenting) case law added that nothing prevents the owner of an earlier word mark from changing the font used to one comparable to the font used by the trademark applied for, thus making the trademarks visually more similar: see T-106/09, adp Gauselmann v. OHIM–Maclean (ARCHER MACLEAN’S MERCURY), [2010] ECR II-00182, para. 32 (GC, Sept. 9, 2010); Peek & Cloppenburg v. OHIM–Redfil (AGILE), Case T-386/07, [2009] ECR II-206, para. 27 (GC, Oct. 29, 2009).

\textsuperscript{126} Frag Comercio Internacional v. OHIM–Tinkerbell Modas (GREEN by missako), Case T-162/08, [2009] ECR II-212, para. 46 (GC, Nov. 11, 2009).
In comparing the above two marks with their specific presentation of the graphic and verbal elements, this meant that no similarity was found between the applied-for mark GREEN by missako, in which “by missako” was nearly illegible, and the earlier mark MI SA KO.

C. Global Appreciation of the Similarity

According to well-established case law, the global assessment of the likelihood of confusion must be made in relation to the visual, aural, or conceptual similarity of the trademarks in question and must be based on the overall impression given by those trademarks, bearing in mind, in particular, their distinctive and dominant components.127

As is the case for the assessment of the likelihood of confusion, the perception of the relevant public must be considered when examining the similarity of the conflicting trademarks. That perception of the marks by the average consumer of the goods or services in question plays a decisive role. The average consumer normally perceives a mark as a whole and does not proceed to analyze its various details. It follows from this that two trademarks, in general terms, are deemed to be similar when, from the point of view of the relevant public, they are at least partially identical in terms of one or more relevant aspects, namely the visual, aural, and conceptual aspects.128

While the likelihood of confusion must be assessed globally, each visual, aural, and conceptual component must be analyzed

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individually. In order to assess the degree of similarity between the trademarks concerned, it is necessary to assess the degree of visual, aural, or conceptual similarity between them and, where appropriate, to assess the importance that has to be attached to each of these factors, taking account of the category or categories of goods or services in question and the circumstances in which they are offered for sale.

D. The Distinctive Character and Reputation of the Earlier Trademark Do Not Yet Play a Role

Where the senior mark and the junior mark show no similarity whatsoever, there is no need to further examine the likelihood of confusion. This applies even if the senior mark is renowned or enjoys a reputation or the fact that the goods or services involved are similar or identical.

The same was held when assessing similarity with a reputed senior mark. Even though it is obvious that the degree of similarity required under Article 8(1)(b) of the CTMR is not identical to that required under Article 8(5) of the CTMR, it is clear that the relevant public is not likely to make a connection or establish a link with the senior mark in absence of any similarity with the applied-for mark. Only if there is similarity, even faint, between the trademarks must the court carry out a global assessment in order to ascertain whether or not, notwithstanding the low degree of similarity between them, there is, due to the presence of other relevant factors (such as the reputation or recognition enjoyed by the senior mark) a likelihood of confusion in the mind of the relevant public who makes a link made between the trademarks. In a conflict between the below two trademarks, the CJEU confirmed the lower court’s reasoning that, because

certain visual and phonetic features of the signs at issue precluded them from being perceived as similar, there was no further need to globally assess the likelihood of confusion, regardless of the reputation enjoyed by KINDER in relation to sweets.133

KINDER
Senior Mark                  Junior Mark

Hence, the reputation of a senior mark or its particular distinctive character can be taken into consideration only for the purposes of globally assessing the likelihood of confusion but not for the purposes of assessing the similarity of the trademarks, which assessment is made prior to assessing the likelihood of confusion134 or, for the purpose of Article 8(5) of the CTMR, in assessing whether or not the relevant section of the public establishes a link between the trademarks.135

SAINT-HUBERT 41
Senior Mark                  Junior Mark

However, it is important to stress that this rule may not be confused with the need to examine the distinctiveness of an element of a composite mark at the stage of assessing the similarity of the signs, to determine if there is any dominant (and distinctive) element(s) of that trademark.136

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133. Ferrero v. OHIM, Case C-552/09P, [2011] ECR I-02063, para. 52-53 and 66 (CJEU, Mar. 24, 2011): “That condition of similarity between the mark and the sign requires, in the context both of Article 8(1)(b) and of Article 8(5) of Regulation No 40/94, the existence, in particular, of elements of visual, aural or conceptual similarity.”

134. Ravensburger v. OHIM–Educa Borras (EDUCA Memory game), Case T-243/08, [2010] ECR II-95, para. 27 (GC, May 19, 2010); Parfums Christian Dior v. OHIM–Consolidated Artists (MANGO adorably), Case T-308/08, [2009] ECR II-147, paras. 53-54 (GC, Sept. 15, 2009); Gateway v. OHIM–Fujitsu Siemens Computers (ACTIVY Media Gateway), Case T-434/05, [2007] ECR II-163, paras. 50-51 (GC, Nov. 27, 2007); Vedial v. OHIM–France Distribution (HUBERT), Case T-110/01, [2002] ECR II-5275, para. 65 (GC Dec. 12, 2002): the General Court agreed with the Board of Appeal that there was no likelihood of confusion, in spite of the identity between the goods and the fact that the earlier national mark enjoyed a reputation in France, given the lack of similarity between the marks at issue.


E. The Search for the Dominant and Distinctive Component(s)

Determining the dominant and distinctive components, on the basis of which the phonetic, visual, and conceptual comparison must be made, will often be challenging, especially if not only word but figurative or complex marks are also involved.

In that context, for the purposes of assessing the degree of distinctiveness of a mark, it is necessary to carry out an overall assessment of 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. When assessing the distinctiveness of an element of a composite mark, the same criterion applies, so that it is necessary to assess the greater or lesser capacity of that element of the mark to identify the goods or services for which that mark has been registered as coming from a particular undertaking.\textsuperscript{137}

In making that assessment, account should be taken, in particular, of the inherent characteristics of the element in question in the light of whether it is at all descriptive of the goods or services for which the mark has been registered. For instance, in a case relating to milk and dairy products, the General Court held that the cowhide design forming part the earlier mark consisting of the image of a milk carton could not be regarded as highly distinctive, because that element is strongly allusive to the goods in question and constitutes an element that is unimaginative to designate milk and dairy products.\textsuperscript{138} As a result, the opponent was unsuccessful in alleging any similarity with the abstract cowhide design as such.

\textsuperscript{137} Id., para. 38.

In this context, it is also necessary to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character that an element of a composite mark possesses and that determines its ability to dominate the overall impression created by the mark.\textsuperscript{139} While it is true that it is necessary to examine the distinctiveness of an element of a composite mark at the stage of assessing the similarity of the signs in order to determine any dominant element of the sign, the degree of distinctiveness of the earlier mark is also an element to be taken into account in the context of the global assessment of the likelihood of confusion. It is therefore not appropriate to take account of what may be a low degree of distinctiveness of the earlier mark at the stage of assessing the similarity of the signs.\textsuperscript{140}

The global approach to examining a likelihood of confusion does not include taking into consideration only one component of a complex trademark and comparing it with another trademark. On the contrary, such comparison must be made by examining the trademarks in question, each considered as a whole. However, that does not preclude that the overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components.\textsuperscript{141}

In assessing the \textit{dominant} character of one or more given components of a complex trademark, the intrinsic qualities of each of those components must be taken into account by comparing them with the qualities of the other components. In addition and accessorially, the relative position of the various components within the arrangement of the complex trademark may be taken into account.\textsuperscript{142}

In the case below, the different configuration of the verbal and figurative elements of the complex marks involved led the General Court to conclude that there were “notable visual differences”:

\textsuperscript{139} L’Oréal v. OHIM–Revlon (FLEXI AIR), Case C-235/05P, [2006] ECR I-00057, para. 43 (CJEU, Apr. 27, 2006).

\textsuperscript{140} Nestlé v. OHIM–Master Beverage Indus. (GOLDEN EAGLE), Cases T-5/08 and T-7/08, [2010] ECR II-1177, para. 65 (GC, Mar. 25, 2010).


The General Court applied this theory for the first time to a case where it had to examine the opposition by the proprietor of the earlier Spanish word mark MATRATZEN registered for mattresses and pillows, against an application to register a complex trademark containing some figurative elements and the words “Matratzen Concord” and “Markt” for nearly identical goods.

The General Court held as follows:

33. Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex trade mark, unless that component forms the dominant element within the overall impression created by the complex trade mark. That is the case where that component is likely to dominate, by itself, the image of that trade mark which the relevant public keeps in mind, with the result that all the other components of the trade mark are negligible within the overall impression created by it.

34. It should be made clear that that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another trade mark. On the contrary, such a comparison must be made by examining the trade marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.

35. With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of
other components. In addition and accessorily, account may be taken of the relative position of the various components within the arrangement of the complex trade mark.\(^{143}\)

This led the General Court to conclude that, in the perception of the Spanish public, the word “matratzen,” which is not understood by the consumer as meaning “mattresses,” was the dominant element in the applied-for mark. Hence, this resulted in a significant degree of aural and visual similarity with the earlier word mark, especially because this element was characterized by a preponderance of consonants with hard sounds, while the word “Markt” is negligible, and the figurative element of a man walking with a mattress was perceived by the relevant public as descriptive of the goods designated by the junior mark.\(^{144}\)

However, the fact that one of the terms making up a composite trademark is frequently \textit{used} for goods in the same class—for instance, the word “victory” for sporting articles—does not constitute an intrinsic quality of the component and, consequently, is of no relevance for purposes of the assessment of that element’s dominant character. This would, after all, amount to taking the view that genuine use of a senior mark by its proprietor has the consequence of altering, and more specifically, reducing, the protection conferred by the registration of that trademark.\(^{145}\)

Only when all other components of the compound trademark are negligible is it correct to carry out the comparison of the similarity between the conflicting trademarks solely on the basis of the element dominating the overall impression created by the compound trademark. In other words, the dominant component must, by itself, dominate the image of the trademark kept in mind by the public while it must be found that all other components are negligible in the overall impression that is produced by that trademark.\(^{146}\) In an opposition based on the earlier word mark


QUICKIES, the CJEU annulled a decision of the General Court to the extent that the latter considered the figurative aspect within the applied-for mark QUICKY to be negligible and had accepted the likelihood of confusion based on the visual similarity between the verbal elements “quicky” and “quickies” without assessing the visual similarity of both signs on the ground of the overall impression that is created by both marks. In addition, the fact that an element is not negligible does not mean that it is dominant and, by the same token, the fact that an element is not dominant in no way means that it is negligible.147

Also, as a general rule, the public will not consider a descriptive element forming part of a complex trademark—in the present example, the element “CONFOR” may be regarded as descriptive of an essential quality of furniture (comfort)—as the distinctive and dominant element of the overall impression conveyed by that trademark.148 Along the same lines, the addition of the geographical origin of the product in question will, in most cases, not be considered as a distinctive component of the composite trademark.149


It should also be borne in mind that, when a trademark is composed of verbal and figurative elements, the former are in principle more distinctive than the latter, because the average consumer will more readily refer to the goods by quoting their name than by describing the figurative element of the trademark.150

However, the weak distinctive character of an element of a complex trademark does not necessarily imply that that element cannot constitute a dominant element, because, as a result of its position or its size, it may make an impression on consumers and be remembered by them.151

This principle was strikingly demonstrated in a case where Nestlé successfully opposed the registration of a complex mark consisting of the image of a red mug of steaming coffee, an eagle, and the words “Golden Eagle” relying solely on an earlier mark of Nestlé’s containing the image of a similar red mug of steaming coffee.

According to the Court, “the element consisting of a red mug on a bed of coffee beans cannot be regarded as entirely negligible

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in the overall impression created by the mark. While that element is far less likely to indicate the commercial origin of the goods in question than the word element and the figurative element representing an eagle, it nevertheless occupies about one half of the mark and is not entirely negligible in the overall impression created by that sign.” Hence, “the comparison between the signs at issue must be based on the overall impression created by those signs, and cannot be limited to some of their elements.” 152

Along the same lines was the CJEU’s ruling in a case in which the owner of the earlier Spanish word mark LIMONCHELO (for alcoholic beverages) opposed the registration of a composite mark composed of a plate decorated with lemons and the words “Limoncello del la Costiera Amalfitana” and “Shaker” (for alcoholic beverages limited to lemon liqueurs from the Italian Amalfi Coast). The CJEU set aside a decision of the General Court, which was of the opinion that the figurative element in the opposed mark was the only one dominating the overall impression, as a result of which the partial similarity between “Limonchelo” and “Limoncello” was negligible. 153

When the case was remitted, the General Court then remarkably held that the verbal element in the junior mark was likely to dominate the overall impression. Because the senior mark was exclusively composed of the word “Limonchelo” and the applied-for mark was held to contain the dominant verbal element “Limoncello,” the General Court concluded that the signs were similar and, given the identical nature of the goods, that there was a likelihood of confusion. 154 It further pointed out that this


154. Shaker v. OHIM–Limiñana y Botella (Limoncello della Costiera Amalfitana shaker), Case T-7/04, [2008] ECR II-3085 (GC, Nov. 12, 2008): it is important to point out
reasoning could not be challenged by the argument that the word “limoncello” does not have an inherent distinctive character because of its reference to lemons. Without examining the argument in view of the perception of the relevant public, the General Court circumvented the delicate issue by stating that, in any event, the possibly weak distinctive character of an element of a complex trademark does not necessarily imply that that element cannot constitute a dominant element, because, as a result of its position or its size, it may make an impression on consumers and be remembered by them.155

In a conflict between the earlier complex mark TriBion Harmonis and the applied-for word mark TRUBION, it was held that, even though consumers will more readily refer to the goods in question by quoting the name of the goods rather than by describing the figurative element of the trademark and that the figurative element in the trademark below was likely to be perceived by consumers essentially as a decorative element and not as an element indicating the commercial origin of the goods, it was not entirely negligible in the overall impression produced by the sign. Therefore, the comparison could not be made on the sole basis of the word element “TriBion” but had to made by considering each mark as a whole. However, this did not preclude a likelihood of confusion in light of the degree of overall similarity between the marks and the goods.156

That the applicant was unable to challenge the validity of the earlier Spanish trademark in the context of the opposition. Therefore, the argument that limoncello or limonchelo is descriptive in relation to lemon liqueur was not taken into account. Naloccebar v. OHIM–Limiñana y Botella (Limoncello di Capri), Case T-210/05, [2008] ECR II-245 (GC, Nov. 12, 2008).


F. The Phonetic, Visual, and Conceptual Comparison

Once the search for the dominant and distinctive elements has been completed, the merits of the actual comparison may be carried out. In order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural, or conceptual similarity between them and, where appropriate, to assess the importance to be attached to those various factors, taking account of the category of goods or services in question and the circumstances in which they are marketed.157

1. The Phonetic and Visual Comparison of the (Word) Elements

When assessing the phonetic similarities between word marks or the word elements of compound marks and when determining the global impression, the pronunciation, the number and order of the different syllables, and the intonation in the relevant language of the target public must all be taken into account.158 A difference in the number of syllables is not sufficient to rule out any phonetic similarity.159

If the conflicting trademarks consist of individual letters or abbreviations, then the phonetic similarity can be assessed by taking into account the way in which the targeted public will pronounce the marks.160

Regarding the phonetic comparison, the average consumer will, when speaking, tend to abbreviate a mark comprising a number of terms in order to make it easier to pronounce.161 Hence, consumers will generally tend not to pronounce all verbal elements that might be viewed as negligible in an overall impression; these possibly negligible verbal elements take time to pronounce and are easily separable from the dominant element of the mark, as in the

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example shown below, where the word “BÜRGER” is the dominant element of the mark.\textsuperscript{162}

It should also be borne in mind that the phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another (word) mark. A figurative mark without word elements cannot, by definition, be pronounced. In a case between two figurative marks containing the image of one or more elephants, that rule was illustrated with the argument that, at the very most, the visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.\textsuperscript{163}

Even though the CJEU held that it is conceivable that a mere phonetic similarity may create a likelihood of confusion,\textsuperscript{164} it

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Senior Mark & Junior Mark
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\textsuperscript{162} Scandic Distilleries v. OHIM–Bürgerbräu, Röhm & Söhne (BÜRGER), Case T-460/11, not yet published, para. 48 (GC, Sept. 18, 2012).


\textsuperscript{164} Lloyd Schuhfabrik Meyer, Case C-342/97, [1999] ECR I-3819, para. 28 (CJEU, June 22, 1999); Fratex Industria e Comércio v. OHIM–USA Track & Field (TRACK & FIELD USA), Case T-103/07, [2009] ECR II-169, para. 64 (GC, Sept. 23, 2009); Faber Chimica/OHIM–Industrias Quimicas Naber (Faber), Case T-211/03, [2005] ECR II-1297, para. 27 (GC, Apr. 20, 2005).
immediately added that the existence of such a likelihood must be established as part of a global assessment of the conceptual, visual, and aural similarities between the trademarks at issue.\textsuperscript{165}

In other words, a likelihood of confusion cannot necessarily be inferred from a comparison that has established a mere phonetic similarity between two trademarks.\textsuperscript{166}

The length of a verbal trademark, the letters that make it up, and the order of the letters must all be taken into account in assessing the visual similarities between the verbal trademarks.\textsuperscript{167}

There is also nothing to prevent a court deeming a word mark and a figurative mark to be visually similar, because both types of trademarks have graphic forms capable of creating a visual impression.\textsuperscript{168}

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In this respect, as a general rule that applies both to the phonetic as well as the visual comparison, consumers will usually pay more attention to the first part of the verbal element than the following parts.\textsuperscript{169} However, even where the beginning of a


trademark has a significant importance in the overall impression given, this cannot cast doubt on the principle that the assessment of the similarity of trademarks must take account of their overall impressions, because the average consumer normally perceives a trademark as a whole and does not examine its individual details.170

The General Court therefore held in a conflict between the verbal trademarks XENTEO and PENTEO that, while it is true that the initial part of the word marks may be liable to attract the consumer’s attention more than the following parts, the difference in the first letters of each sign was not enough to counteract the visual similarity between the signs in respect of all the other letters making up the majority of the signs in issue.171

A word mark consisting of a single word may include a syllable or prefix likely to be considered as the dominant element172 but even if the first part of the verbal element is identical, then it is still conceivable that the overall impression leads only to a low degree of phonetic similarity.173 In other words, even if it is true that the first component of a word mark may be more likely than the second and subsequent components to catch the consumer’s attention, the visual attention can also be drawn by the final letters, especially considering the limited length of the trademarks.174

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For relatively short word marks, the elements at the beginning and end are as important as the central elements. In such cases, the relevant public will concentrate on the word taken as a whole. In the dispute between the earlier well-known trademark SPA and the new trademark SpagO, it was held that it is unlikely that the average consumer would break the junior mark down into the two words, “spa” and “go,” considering that it was small and simple in structure.

If the two word marks differ by a single letter placed in the middle of both words, they can in general be considered to be similar, both from the visual and phonetic points of view. However, no phonetic similarity was upheld between CELIA and CELTA. Furthermore, in the conflict between the word marks PICASSO and PICARO, it was held that conceptual differences may, in certain circumstances, counterbalance the visual and phonetic similarities, provided that both trademarks have clear and specific meanings. Likewise, the presence of figurative elements set out in a specific and original way had the effect that the overall impression conveyed by the below trademarks was different, notwithstanding that they differed in only one letter:


Also, when the junior mark is made up exclusively of an earlier (word) mark, to which another sign or word has been added, this will generally indicate that the two marks, taken as a whole, are to some degree similar.\textsuperscript{180}

For instance, where one of the two words that constitute a word mark is identical, both visually and phonetically, to the single word that constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the trademarks, each considered as a whole, are similar (for example, MOU and KIAP MOU).\textsuperscript{181}

Such finding, however, will never automatically lead to the conclusion of a certain degree of similarity between the marks, as that examination must be carried globally. For instance, there was no sufficient similarity between the senior mark ROCK and the junior mark REDROCK, both in relation to construction materials: even if the common word element “Rock” might have different meanings in German—referring to a type of music or skirt—the distinctive or descriptive character of the trademark in relation to the goods covered by it must also be taken into account, so that the


term “Rock” in its meaning of “stone” obviously has a rather weak distinctive character in relation to construction materials.182

Likewise, because the senior mark GTI enjoyed very little distinctiveness in relation to cars, the General Court held that there was no sufficient phonetic and visual similarity with the mark applied for SWIFT GTi.183

Along the same lines, significant differences were established between the senior mark GIORGIO and the junior mark GIORGIO BEVERLY HILLS, both for clothing. The case law mentioned above in relation to the importance of the first component of word marks and the incorporation of the senior mark into the junior mark cannot change the fact that it is necessary to take account of the overall impression given by the trademarks when examining their similarity—all the more so because the average consumer normally perceives a trademark as a whole and does not proceed to analyze its various details. It should also be recalled that in a business sector such as clothing, in which it is common to use signs consisting of forenames and surnames (and, in particular, Italian ones) it may be assumed, in the absence of any enhanced distinctiveness through use of the senior mark, that consumers will not infer from the use of that forename the existence of an economic link between all the proprietors of trademarks containing that forename.184

While it is accepted that there is a degree of similarity between two word marks if one of the two words is identical to the earlier word mark, this does not also apply if figurative elements are added to the words. For instance, there was only a low degree of similarity between the earlier word trademark MEZZO and the figurative junior mark MEZZOPANE, shown below.185

The inversion of the two word elements, to conclude with, will generally not be sufficient to invalidate the phonetic and visual

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similarity between the trademarks. Hence, a significant degree of similarity was found to exist between the senior mark VITS4KIDS and the junior mark KIDS VITS, both for diet products.\textsuperscript{186} On the other hand, no similarity was found between the senior mark FRUTISOL and the junior mark SOLFRUTTA, both for nonalcoholic drinks.\textsuperscript{187}

In conclusion, the assessment of visual and phonetic similarities depends strongly on a case-by-case analysis.

2. The Conceptual Comparison

While the average consumer normally perceives a trademark as a whole and does not proceed to analyze its various details,\textsuperscript{188} the fact remains that when he perceives a word sign, he will break it down into elements that suggest a concrete meaning to him or that resemble words known to him.\textsuperscript{189} The common element “Focus” can therefore lead to a degree of conceptual similarity, referring to the idea of intellectual concentration or focusing, which led the General Court to establish a likelihood of confusion between the two marks shown below.\textsuperscript{190}

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\textbf{FOCUS} & \\
Senior Mark & Junior Mark \\
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In this regard, it should be pointed out that the conceptual similarity resulting from the fact that two trademarks use images with analogous semantic content is likely to give rise to a likelihood of confusion where the senior mark has a particularly

\begin{thebibliography}{9}
\bibitem{186} Longevity Health Prods. v. OHIM–Merck (KIDS VITS), Case T-484/08, [2009] ECR II-234, paras. 32-33 (GC, Dec. 9, 2009).
\bibitem{187} REWE-Zentral v. OHIM–Grupo Corporativo Teype (SOLFRUTTA), Case T-331/08, [2010] ECR II-11, para. 16 (GC, Jan. 27, 2010).
\bibitem{188} Lloyd Schuhfabrik Meyer, Case C-342/97, [1999] ECR I-3819, para. 25 (CJEU, June 22, 1999).
\end{thebibliography}
distinctive character either *per se* or because of the reputation it enjoys with the public.191

However, as shown below, where the trademark is not especially well known to the public and consists of an image with little imaginative content—such as a peacock, suggesting or transmitting to the relevant public “an idea of the beauty or elegance of the goods concerned”—the mere fact that the two trademarks are conceptually similar is not sufficient to cause a likelihood of confusion, especially in view of the fact that preponderant significance had to be attached to the phonetic and visual dissimilarities to the junior mark, including the words “Thai Silk,” when purchasing clothes.192

On the other hand, the General Court held that there was a likelihood of confusion in a case where the visual differences between the senior mark and the junior mark, which both used an image of a pelican, and both covered similar goods, were outweighed by the conceptual similarity.193

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Also, a prefix or suffix common to the two trademarks in dispute might have the effect of making them conceptually closer, notwithstanding the limited distinctiveness the suffix or prefix may have in relation to the goods in question.\textsuperscript{194}

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\includegraphics[width=0.8\textwidth]{figures/tmr103.jpg}
\caption{Senior Mark vs. Junior Mark}
\end{figure}

It may, therefore, be rather surprising to see that the limited distinctiveness or even descriptive nature of the concepts in relation to the goods in question can make them more similar conceptually. The General Court, for instance, held that the weak distinctive character of the common word element “olive” in relation to, \textit{inter alia}, soap could not call into question the conclusion that they are similar concepts creating a certain link between the marks at issue, particularly given that the element “olive” was the one remembered by the public faced with the junior mark and constituted one of the two elements of equivalent distinctive force in the earlier word mark “Olive lines.”\textsuperscript{195}

\begin{figure}[h]
\centering
\includegraphics[width=0.8\textwidth]{figures/tmr103.jpg}
\caption{Senior Mark vs. Junior Mark}
\end{figure}

By contrast, although it can be assumed that consumers, when perceiving a word mark, will break it down into elements that suggest a concrete meaning or that resemble words known to them, this does not prevent the descriptiveness of a word element being deemed to have no relevance to the assessment of visual and phonetic similarities.\textsuperscript{196} For example, even if there was a certain degree of conceptual similarity between the verbal trademarks

\begin{figure}[h]
\centering
\includegraphics[width=0.8\textwidth]{figures/tmr103.jpg}
\caption{Senior Mark vs. Junior Mark}
\end{figure}

\begin{footnotesize}
\begin{enumerate}
\item \textsuperscript{195} Olive Line Int'l v. OHIM–Umbria Olii (O-LIVE), Case T-273/10, not yet published, para. 67 (GC, 22 May 22, 2012).
\item \textsuperscript{196} Abbott Labs. v. OHIM–aRigen (SORVIR), Case T-149/08, [2010] ECR II-00198, para. 37 (GC, Sept. 13, 2010).
\end{enumerate}
\end{footnotesize}
NORVIR and SORVIR, in relation to pharmaceutical products (as a result of the common element “VIR” referring to a virus), this cannot have an influence on the assessment of the visual or phonetic similarity.

3. The Juxtaposition of a Word, Personal Name, or Figurative Element and the “Independent Distinctive Role”

In the landmark case generally referred to as the Thomson Life case, the CJEU postulated that:

beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.197

In Thomson Life, Medion, the owner of the senior mark LIFE (registered for leisure electronic devices) opposed Thomson Multimedia Sales, who used the trademark THOMSON LIFE to market a number of its products. Both trademarks covered, at least in part, the same products, which led Medion to seek injunctive relief before a national court of a Member State against the use by Thomson Multimedia Sales of the words “Thomson Life” for goods identical to those for which the senior mark LIFE was registered.

Upon preliminary referral, the CJEU answered the questions posed, building on Matratzen, that, by way of exception to the rule of the “global approach” and the “overall impression,” a third party juxtaposing a senior mark and a trade name or company name—thereby absorbing the senior mark—may still cause a likelihood of confusion inasmuch as it can be found that the senior mark retains an independent distinctive place within the compound trademark. Adding the trade name “Thomson” to “Life” was therefore considered insufficient to rule out the likelihood of confusion.

The Thomson Life doctrine may be seen as an equivalent to the general principle highlighted above stating that a mark that consists exclusively of the earlier mark to which another word has been added is an indication that the two trademarks are similar.198 As with every general rule, it is not absolute and cannot call into

question that the global assessment of the likelihood of confusion must be based on the overall impression created by the dominant and distinctive components of the trademarks involved.

For instance, after having compared the senior mark PRESTIGE, written in a specific font, with the applied-for word mark, P&G BEAUTE PRESTIGE, both for cosmetics, the General Court held that, even if it was unlikely that the relevant public would associate the element “P&G” with the company name “Procter & Gamble,” that element nevertheless constituted the dominant and distinctive element of the compound junior mark. Despite certain faint phonetic and conceptual similarities and the fact that the earlier mark was included in the later mark, the General Court ruled out a likelihood of confusion. The General Court further found that Thomson Life could not be applied to this case because the word “prestige” is not the name of an undertaking and does not retain an independent distinctive role in the trademark.199

Irrespective of the fact that the verbal trademark PRESTIGE is not a company name, the finding that there is no visual similarity between the trademarks and that the word “prestige,” albeit not dominant, does not retain an independent distinctive place in the compound trademark, is debatable.

It was also surprising to see that in spite of the identical nature of the goods the General Court denied a likelihood of confusion in a dispute between the earlier word trademark VIVA and the junior mark NATURAVIVA. The General Court took the view that the element “viva” did not retain an independent distinctive place within the junior mark because it would be perceived by a large part of the relevant public as a qualifying adjective accompanying the noun “natura” and thus forming, with that noun, the logical unit “naturaviva.”200

The Thomson Life doctrine will also not automatically apply to trademarks consisting of personal names. For instance, the CJEU considered that the General Court was incorrect to find that there was a likelihood of confusion between the senior mark BECKER and the junior mark BARBARA BECKER (Boris Becker’s ex-wife), both for goods in Class 9. The CJEU repeated that the global

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approach must take account of all relevant circumstances, including in this case, the fact that, even though consumers generally attribute greater distinctiveness to the surname than to the forename in word signs, the surname might be quite common in a given territory.\textsuperscript{201} It is obvious that the CJEU, by implication, held that the surname “Becker” did not retain an independent distinctive place, as it was a common surname in Germany. In addition, it must also be taken into account whether or not the person who requests that his first name and surname, taken together, be registered as a trademark is well known, because that will obviously influence the perception of the mark by the relevant public.\textsuperscript{202}

Despite “Velasco” being a popular surname in Spain, the General Court held that there was a likelihood of confusion between the junior mark MANSO DE VELASCO and the earlier Spanish trademark VELASCO, both for wines.\textsuperscript{203}

Also, even if the target public for clothing is used to the fact that the same manufacturer has different clothing brands named after designers or the fashion house, followed or preceded by the name of the brand, the General Court held that there was no likelihood of confusion between the earlier French word mark LOFT and the applied-for word mark ANN TAYLOR LOFT.\textsuperscript{204}

The application of the Thomson Life doctrine has meanwhile been expanded to cover not only signs that are identical, but also signs that are similar. Accordingly, and sometimes surprisingly, it is equally possible that the trademarks in dispute are found to be similar overall as a result of the similarity between the earlier mark and a component of the later mark that retains, within that mark, an autonomous distinctive place. This was radically demonstrated in a conflict where a likelihood of confusion was established between the below two complex marks, for which the

\textsuperscript{201}. \textit{To that effect see} Fusco v. OHIM–Fusco Int’l (ENZO FUSCO), Case T-185/03, [2005] ECR II-715, para. 54 (GC, Mar. 1, 2005): the GC held that there was a likelihood of confusion between the trademarks ENZO FUSCO and ANTONIO FUSCO on the ground that the Italian consumer will, as a general rule, attribute greater distinctiveness to the surname than to the forename in the marks in question. Conversely, the GC has also held that the presence of the same surname in both marks does not (automatically) lead to a sufficiently high degree of similarity to establish a likelihood of confusion, Rossi v. OHIM–Marcorossi (MARCO ROSSI), Case T-97/05, [2006] ECR II-54, paras. 46-47 (GC, July 12, 2006).


only similarity consisted of the words “veste lo sport” and “veste e premia lo sport.”

The above examples again show that the assessment of similarities strongly depends on a case-by-case analysis.

4. The Assessment of the Similarity with a Complex Trademark

As was highlighted above, assessing the similarity with a complex trademark will have to be preceded by searching its dominant and distinctive elements. According to well-established case law:

A complex mark and another mark which is identical or similar to one of the components of the complex mark may be regarded as being similar where that component forms the dominant element within the overall impression given by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression given by it. That approach does not amount, however, to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole.

However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components. Furthermore, with regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorily, account may be taken

of the relative position of the various components within the arrangement of the complex mark.\textsuperscript{206}

The phonetic, visual, and conceptual comparison of the (complex) trademarks involved must be carried out in light of those principles. Case law shows that the identifying the dominant and distinctive components (and assessing the similarities) is often very casuistic.

A likelihood of confusion was, for instance, found between the composite marks Euro Wings and Smart Wings, both for services in the field of aviation transport. Even though the component “Wings” had a weak distinctive character in relation to such services and even though the first word elements were different, the element “Wings” nevertheless constituted the dominant component that—in particular, as a result of its position and its size—made an impression on consumers and was likely to be remembered by them.\textsuperscript{207}

\textbf{EuroWings} \hspace{1cm} \textbf{smartWings}

Senior Mark \hspace{1cm} Junior Mark

The earlier Spanish word mark COTO DE IMAZ was deemed similar to the applied-for compound mark COTO DE GOMARIZ, both in relation to wines. The General Court took the view that, even if “Coto” might be understood by the Spanish consumer as meaning “a wasteland used for fishing or hunting” and “de” meaning “belonging to,” it was at least as dominant an element as the verbal elements “Gomariz” and “Imaz,” all the more so because it is the first element within both signs.\textsuperscript{208}

\textsuperscript{206} Quelle v. OHIM–Nars Cosmetics (NARS), Case T-88/05, [2007] ECR II-8, paras. 57-58 (GC, Feb. 8, 2007).

\textsuperscript{207} Travel Serv. V. OHIM–Eurowings Luftverkehrs (Smartwings), Case T-72/08, [2010] ECR II-00196, paras. 45-48 (GC, Sept. 22, 2010).

Conversely, similarity was denied between the junior mark EDUCA Memory games and the senior mark MEMORY, both registered for games and toys (see illustration below). The element “EDUCA” was the dominant component in the composite trademark and the element “Memory” did not retain an independent distinctive role in the trademark.209

As was discussed above, where a trademark is composed of verbal and figurative elements, the former are in principle more distinctive than the latter, because the average consumer will more readily refer to the goods by quoting their name than by describing the figurative element of the trademark.210

Therefore, even if the word “offshore” has a low degree of distinctiveness in respect of certain goods, such as clothing for nautical sports, and did not dominate the earlier compound trademark—which was composed of the number “1,” occupying half of the mark, a laurel wreath and the words “off shore”—the word “offshore” retained an independent distinctive place within the combination of those signs and could not be regarded as negligible. It was therefore concluded that the senior mark was sufficiently similar to the junior mark, composed of a racing boat and the words “offshore legends,” for there to be a likelihood of confusion.211

![Illustration of trademarks](image.png)

Senior Mark

Junior Mark


However, where a trademark consists of both figurative and word elements, it does not automatically follow that the word element must always be considered to be dominant.\textsuperscript{212} For instance, it is possible that the figurative element may rank equally with the word element.\textsuperscript{213} It is also possible that the figurative element is visually dominant because of its substantially larger size or because it is placed above the word element.

Therefore, even where two trademarks contain highly similar verbal elements, such as “DUSCHO” and “duschy,” that fact did not, by itself, support the inference that there is a visual similarity between the below marks. The presence, in one of the two signs, of figurative elements set out in a specific and original way, such as the blowing whale, can have the effect that the overall impression conveyed by each mark is different and that those figurative elements will hold the consumer’s attention and will not be perceived as a decorative or secondary element in relation to the word element. As a result, the degree of similarity between the below two trademarks was insufficient for there to be a likelihood of confusion.\textsuperscript{214}

The same was held in a conflict between the earlier word mark KINNIE and the complex mark including the image of a racoon and the words “KINJI by SPA”: the presence in the later trademark of figurative elements set out in a specific and original way had the effect that the overall impression conveyed by each of the trademarks was different.\textsuperscript{215}

\begin{figure}[h]
\centering
\includegraphics[width=0.5\textwidth]{DUSCHO_Harmony.png}
\caption{Senior Mark}
\end{figure}

\begin{figure}[h]
\centering
\includegraphics[width=0.5\textwidth]{duschy.png}
\caption{Junior Mark}
\end{figure}

\begin{itemize}
\item \textsuperscript{214} Duscholux Ibérica/OHIM–Duschprodukt i Skandinavien (duschy), not yet published, Case T-295/11, paras. 66-67 (Sept. 12, 2012).
\end{itemize}
Along the same lines and irrespective of the verbal elements “SANTA MARIA” and “POLO” present in the applied-for mark, the image of the polo player was found to retain an independent distinctive place within the complex junior mark, as a result of which there was a visual similarity with the earlier figurative trademark, exclusively composed of the image of a polo player of the Polo/Ralph Lauren Company.\

5. Neutralization of the Visual and Phonetic Similarities Because of the Clear and Specific Meaning of a Word

Well-established case law of the CJEU and General Court shows that the global assessment of the likelihood of confusion implies that conceptual differences between two trademarks may counteract phonetic and visual similarities between them, provided that at least one of them has, from the point of view of the relevant public, a clear and specific meaning that the public can grasp immediately.

It is sufficient that one of the trademarks at issue has such a meaning, irrespective of the fact that the other trademark has no meaning or a completely different one, to neutralize the visual and aural similarities between the trademarks.

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In a conflict between the word marks PASH and BASS, both covering clothing, the General Court held that the visual and phonetic similarities were counteracted by the fact that the word “bass” had a clear meaning to the German public, “calling to mind the voice of a singer or a musical instrument,” even if that mark did not refer to any characteristic of the goods in respect of which it had been applied for, since that would not prevent the relevant public from immediately grasping its meaning.219

The CJEU ruled that the General Court had correctly applied this theory by finding that the trademark OBELIX has a clear and specific meaning for the relevant public as a popular strip-cartoon character (see illustration below), which neutralized the phonetic and visual similarities between MOBILIX and OBELIX.220

Likewise, in the dispute between the owners of the two word marks PICASSO and PICARO, the General Court took the view that PICASSO had a clear and specific semantic meaning (the name of the famous painter Pablo Picasso). The conceptual differences between the trademarks therefore counteracted the aural and visual similarities. Moreover, the court took account of the particularly high level of attention on the part of the relevant consumers, considering the nature of the goods for which the trademarks had been registered or applied for (cars) and especially because of their price and technological nature.221


that the senior mark did not enjoy a broader scope of protection based on its enhanced distinctiveness.222

By contrast, even if the word mark ENERGOL might be seen as a reference to “energy” and “oil,” it did not immediately have a clear and specific meaning for the relevant public, as a result of which the visual and phonetic similarities with the junior mark ENERCON were not counteracted.223 While the word mark ICEBERG was to found to have a clear meaning for the relevant Italian public, the conceptual comparison was not decisive and therefore did not neutralize the visual and phonetic similarities with the junior mark ICEBREAKER.224

6. Neutralization of the Conceptual Similarity Because of the Visual and Phonetic Differences

Conversely, a conceptual similarity can also be counteracted by the clear visual and phonetic differences.

It was, for instance, found to be implausible that the relevant public, when faced with the two trademarks at issue (on the one hand, an image of a peacock and on the other hand, an image of a peacock and a smaller verbal element “Thai Silk”) could establish a link between them giving rise to a likelihood of confusion and to the belief that the goods concerned came from the same undertaking or from economically linked undertakings. The same was essentially held in a case where the trademarks involved, covering clothing, referred to the concept of tennis by using expressions placed just below the letters making up the acronym to which they referred:

Senior Mark

Junior Mark

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222. When it was pleaded before the CJEU that the General Court had violated article 8(4)(b) of the CTMR by incorrectly applying the rule that a mark enjoys a broader scope of protection when its distinctive character is stronger, either per se or because of the reputation it enjoys on the market, the CJEU rejected the plea on the rather bizarre ground that the GC would have found by implication that the sign PICASSO did not per se enjoy a strong distinctive character in relation to automobiles (Ruiz-Picasso & Others v. OHIM, Case C-361/04 P, [2006] ECR I-643, paras. 29-33 (CJEU, Jan. 12, 2006)).


Even if the objective of such a presentation is, generally, to facilitate memorization of the acronym, the semantic meaning of both marks was held to be similar. However, the conceptual similarity in that case was cancelled out by the clear visual and phonetic differences, making it wholly improbable for the relevant public, faced with the two trademarks at issue, to believe that they were variants of the same mark or sub-brands of the same manufacturer.225

G. The Importance to Be Attached to the Phonetic, Visual, or Conceptual Aspects Differs Depending on the Terms of Sale of the Goods or Services

As stated above, the visual, aural, and conceptual aspects of the trademarks in dispute do not all have the same weight in the global assessment of the likelihood of confusion. It is, in that respect, appropriate to examine the objective conditions under which the trademarks are presented on the market.

The extent of the similarity or difference between the trademarks may depend, in particular, on their inherent qualities or the conditions under which the goods or services covered by them are offered for sale.

If the goods in question are usually sold in self-service stores where consumers choose the product themselves from the shelves and must therefore rely primarily on the image of the trademark affixed to the product, the visual similarities between the signs will, as a general rule, be more important.

This is typically the case for foodstuffs: these goods are most commonly purchased in supermarkets or establishments where the products are arranged on different shelves and picked out by consumers, rather than asked for verbally. Consumers spend little time between making consecutive purchases in these points of sale and generally do not read the information on the packaging. Consumers are guided more by the global visual impact created by the labels and the packaging. For the assessment of the existence of a potential likelihood of confusion, the result of the analysis of the visual similarities between the trademarks will be more important than the results of the analysis of their phonetic and conceptual similarities.226 As olive oil is a common consumer product, mainly sold in supermarkets or shops where the goods are arranged on shelves next to each other, the consumer is first of all


guided by the visual impact of the trademark. As a consequence, the CJEU held that the General Court was right to conclude that the figurative elements of the trademarks were dominant as opposed to the verbal elements “La Española” and “Carbonell,” also given the weak distinctive character of the verbal element of the applied-for mark “La Española,” referring to the geographic origin of the goods.227

Senior Mark

Junior Mark

Preponderant importance will also be attached to the visual aspect when buying clothing, footwear, and headgear: it is assumed that clothing is observed carefully228 and that the visual perception occurs before the actual purchase of the goods.229 The same applies to sales via catalogue, mail order, or the Internet. To the extent that the sale is discussed verbally or over the telephone, this will usually take place only after consumers have consulted the catalogue and looked at the goods.230 As was stated above, this does not, however, prevent the graphic or visual element, even if it


appears overall to dominate the trademark, being deemed, in certain cases, subordinate to the verbal element.231

If, on the other hand, the products are primarily sold remotely by telephone or other verbal means, greater weight will be attributed to the aural similarities between the trademarks.232

In general, it is assumed that greater weight will be attributed to the phonetic aspects when purchasing alcoholic drinks, as consumers are used to describing and recognizing these products by reference to the verbal element that identifies them.233 This applies in particular to restaurants and bars, where alcoholic drinks such as wine or beer are ordered verbally with the waiter after the consumer has seen their names on the wine list or menu. Hence, in a case that opposed the below two complex marks including the words “ARTESO” and “ARTESA NAPA VALLEY,” the General Court attached significant importance to the phonetic similarities between the words and upheld the likelihood of confusion, notwithstanding the entirely different structure of the marks and the significant visual differences:234


However, when assessing the similarity between several composite trademarks for *cachaça* (a sugar-cane spirit) including the numeral “51” and the applied-for composite mark including the numeral “61,” the General Court accepted a likelihood of confusion because more importance had to be given to the visual and conceptual perception: these goods “are usually widely distributed and are also sold not only in specialist shops, but in large shopping centres as well. Moreover, (...) where the alcoholic beverages or liqueurs made of sugar cane covered by the marks at issue are consumed in bars or restaurants, they are generally consumed as an ingredient of certain cocktails, such as caipirinha. It follows that those beverages are normally ordered orally under the name of those cocktails and not under their own name.” As a result, “the phonetic dissimilarities between the marks at issue, however evident, are, in the present case, relatively secondary.”

In any event, the fact remains that the degree of phonetic similarity will, all in all, remain of rather limited importance because of the way in which the goods are offered for sale, which normally involves the relevant public making a visual perception of the trademarks. And even where the goods are normally

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236. Procter & Gamble v. OHIM–Prestige Cosmetics (P&G PRESTIGE BEAUTE), Case T-366/07, [2010] ECR II-00194, para. 84 (GC, Sept. 13, 2010); Canali Ireland v. OHIM–
ordered orally, such as for prescription drugs, food supplements, or diet products, instead of being lifted freely from the shelves, such assumption does not preclude the possibility of the consumer looking at the trademark on the pharmaceutical preparation at the time of purchase or reading the prescription between the time at which it is written by the doctor and when it is handed to the pharmacist.237

Importantly, in Quantième,238 the General Court held that, when assessing the likelihood of confusion in opposition proceedings, no consideration may be given to the way in which the goods or services are marketed in concreto at the time of the dispute. Only “consideration of the objective circumstances in which the goods covered by the trade marks are marketed” is justified in particular in order to determine the respective weight to be given to their visual, phonetic and conceptual aspects.239

The General Court annulled the decision of the Board of Appeal in which the latter had decided that there was no likelihood of confusion between the marks depicted on the right because the watches covered by the junior mark QuantiÈme were to be sold only through the French discount store chain E. Leclerc, where the visual perception would be decisive, while the watches covered by the senior mark QUANTUM were sold only through specialist jewelry shops involving the assistance of a salesman and were therefore were mainly ordered orally:

103. According to case-law, in the global assessment of the likelihood of confusion the respective weight to be given to the visual, phonetic or conceptual aspects may vary on the basis of the objective circumstances in which the trade marks may be present on the market. It should be noted in that respect that


the “usual” circumstances in which the goods covered by the trade marks are marketed must be taken as a benchmark, that is, those which it is usual to expect for the category of goods covered by the trade marks. In this case, for watches and watch bands or straps, those conditions generally include purchase through a salesperson, without the consumer having direct self-service access to those goods.

104. Consideration of the objective circumstances in which the goods covered by the trade marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the trade marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two trade marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.

105. On the other hand, the OHIM authorities are permitted to take into account the objective conditions under which the goods are marketed, in particular in order to determine the respective weight to be given to the visual, phonetic and conceptual aspects of the trade marks. Thus, if the goods covered by a given trade mark are only sold on oral request, the phonetic aspects of the sign in question are bound to have greater significance for the relevant public than the visual aspects.240

This means that the global appreciation of the likelihood of confusion must be carried out objectively and cannot be influenced by subjective considerations alien to the commercial origin of the product. Hence, the prospective assessment of the likelihood of confusion between two trademarks cannot depend on marketing intentions, whether implemented or not, which are by their very nature subjective for the proprietors of the trademarks.241 The commercial choices made (or which may be made) by the proprietors of the trademarks are factors that must be distinguished from the rights derived from those trademarks and may be changed, because they depend solely on the will of the


proprietors, so that these factors cannot be taken into account when examining the likelihood of confusion.242

VI. OTHER CIRCUMSTANCES RELEVANT TO THE CASE

A. Introduction

As was stated at the beginning of this contribution, the finding of, on the one hand, a degree of identity or similarity between the goods or services and, on the other hand, a degree of identity or similarity between the trademarks, is an indispensable condition to be able to conclude to there being a likelihood of confusion.

However, the likelihood of confusion also depends on other factors or circumstances that the administrative bodies or (national) courts deem relevant and take into account. The Tenth Recital of the Directive and the Eighth Recital of the CTMR, as well as settled case law of the CJEU and the General Court, have clarified that the interdependence between the similarity of the trademarks and the goods or services covered by them and the degree of distinctive character and/or reputation of the senior mark must also be taken into account. Other relevant elements, such as the peaceful coexistence on the market of both trademarks in dispute or the existence of family or series of trademarks, may also play a role in assessing the likelihood of confusion.

B. The Interdependence Between the Similarity of the Trademarks and the Similarity of the Products or Services Covered by Them

In almost all of their decisions, the CJEU and General Court have explicitly postulated that the global assessment of the likelihood of confusion implies some interdependence between the relevant factors and, in particular, between the similarity of the conflicting trademarks and the goods or services covered by them. Both elements have to be weighed in the scale:

Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the trade marks, and vice versa.243


However, the fact remains that where the designated goods or services are identical, this cannot, in the global assessment of the likelihood of confusion, compensate for the complete lack of similarity between the trademarks. This was, for instance, held in the case below, where the identical services covered by the marks could not make up for the lack of similarity between them, especially given that the common element “CAPITAL MARKETS” was descriptive to those services:

![Capital Markets](image1)

Senior Mark

![Carbon Capital Markets](image2)

Junior Mark

In view of the above case law, it was rather surprising to see that a likelihood of confusion was denied on the part of Spanish consumers between the two complex trademarks illustrated below, notwithstanding the finding that both marks contained the image of an Indian’s head and a similar dominant verbal element, namely “COHIBA” and “KIOWA,” and they both covered tobacco goods:

![Cohiba](image3)

Senior Mark

![Kiowa](image4)

Junior Mark

The outcome might also be debatable to the extent that the General Court failed to make a global examination by not having sufficient regard to the identity of the goods and the repute of the senior mark.

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245. Habanos v. OHIM–Tabacos de Centroamérica (KIOWA), Case T-207/08, [2011] ECR II-00140, para. 59 (GC, May 18, 2011): surprisingly, the GC, *inter alia*, found that the word “Kiowa” had a fixed and clear meaning to the Spanish and Community consumer, referring to an American Indian tribe, thereby counteracting the phonetic similarities.
C. Distinctive Character or Reputation of the Earlier Trademark

Provided that a certain degree of similarity between the trademarks and the goods or services covered by them has been established, the distinctive character of the senior mark and, in particular, its reputation must be taken into account when assessing whether there is a likelihood of confusion.246 The CJEU has made it clear that the more distinctive the senior mark, the greater will be the likelihood of confusion.247

Thus, trade marks with a highly distinctive character, either per se, inherently, or because of the reputation they possess on the market, enjoy a broader scope of protection than trade marks having a less distinctive character.248

The highly distinctive character of a sign is relevant only in respect of the earlier mark and not the later mark. The reputation of the later mark is therefore not one of the points of law that must be examined in the prospective opposition proceedings and cannot be pleaded as a circumstance reducing a likelihood of confusion.249

As is the case for the examination of the distinctiveness of an element of a compound mark, the assessment of the distinctiveness of the trademark considered as a whole must be carried out having regard to the products or services covered by the trademark relied upon to support the opposition.250 For the purpose of assessing whether or not a trademark has distinctive character per se, it is


necessary to take into account, in particular, the inherent characteristics of the elements of the trademark and to verify whether or not they are at all descriptive to the goods or services for which it was registered.\textsuperscript{251}

In order to assess whether or not a trademark has a highly distinctive character as a result of the public’s recognition of it, all the relevant facts of the case must be taken into consideration, in particular, the market share held by the products covered by the trademark; how intensive, geographically widespread and long-standing the use of the trademark has been; the amount invested by the undertaking in promoting the trademark; the proportion of the relevant section of the public that, because of the trademark, identifies the goods or services as originating from a particular undertaking as well as statements from chambers of commerce and industry or other trade and professional associations.\textsuperscript{252}

The existence of an unusually high level of distinctiveness as a result of the public’s recognition of a trademark on the market necessarily presupposes that at least a significant part of the relevant public is familiar with it, without it necessarily having to have “a reputation” within the meaning of Article 8(5) of the CTMR.\textsuperscript{253} Hence, it must be acknowledged that there is a certain degree of interdependence between the public’s recognition of a trademark and its distinctive character, in that the more the trademark is recognized by the target public, the more its distinctive character is strengthened.\textsuperscript{254}

If the party bringing the opposition proceedings intends to rely on the fact that its trademark is well known, it bears the onus of proof and is required to put forward facts and, if necessary,

\begin{itemize}
\end{itemize}
evidence showing such reputation. Furthermore, it must be shown that the enhanced distinctive character of the senior mark was acquired through use prior to the date of the filing of the application for registration.

For the purpose of assessing the likelihood of confusion, the enhanced distinctive character or reputation of a trademark can only counteract a lower degree of similarity between the goods or services or the conflicting trademarks but cannot in any event make up for the complete lack of such similarity. To that effect, the CJEU held that the General Court did not err in finding that the complete lack in similarity between the goods concerned—wine, on the one hand, and glassware and porcelain, on the other hand, could not be compensated by the strong reputation of the trademark Waterford relied upon in respect of glassware and chinaware. Likewise, although account must be taken of the fact that a trademark is well known or has a reputation for the purposes of assessing the likelihood of confusion, that fact has no bearing on the assessment of the likelihood of confusion where the trademarks at issue are themselves globally different.

As was highlighted above, this also led to the conclusion that the lack of similarity between the conflicting complex trademarks IDEA (in lowercase letters) and IKEA, both in relation to furniture, could not be offset by the strong reputation enjoyed by IKEA.

Conversely, where the General Court must verify the way in which the relevant public perceives a sign that is identical to the national trademark in the applied-for mark and evaluate, if necessary, the degree of distinctiveness of that sign, that verification has limits. This was recently demonstrated in a case where the CJEU annulled a decision of the General Court because the latter had denied a likelihood of confusion based on the earlier marks F1 and F1 FORMULA 1 against the registration of a complex mark F1-LIVE in respect of, inter alia, “electronic publication of books; entertainment information; arranging competitions on the Internet; reservation of tickets for shows.


258. Inter-Ikea v. OHIM–Waibel (idea), Case T-112/06, [2008] ECR II-6, para. 84 (GC, Jan. 16, 2008).
on-line gaming; all the aforesaid services relating to the field of formula 1.”

According to the General Court, “Formula 1” was used to designate, in generic terms, the sport of motor racing, whereas “F1” is the familiar abbreviation of that term. As a result, “the abbreviation ‘F1’ can be used in a descriptive context. (. . .) it must be held that the relevant public will not perceive the ‘F1’ element in the mark applied for as a distinctive element, but as an element with a descriptive function.” The CJEU set aside the decision because the way in which public perceives a sign that is identical to the national trademark may not culminate in a finding of the complete lack of distinctive character. As the invalidity of a senior mark cannot be examined in an opposition, it is in any event necessary to acknowledge at least a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a CTM is based.

Moreover, granting excessive importance to the fact that the earlier mark has only a weak distinctive character would have the effect that the factor of the similarity of the marks at issue would be disregarded in favor of the factor based on the distinctive character of the earlier mark. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the signs at issue. Such a result would not, however, be consistent with the very nature of the global assessment that the competent authorities are required to undertake. The finding of a potentially weak distinctive character of the senior mark does not allow neglecting the comparison between the trademarks in dispute and does not prohibit the finding of a likelihood of confusion. Again, such assessment would otherwise fail to respect the global approach of

the likelihood of confusion.\(^{262}\) Although the distinctive character of the senior mark must be taken into account when assessing the likelihood of confusion, it is just only one factor among many others.

Therefore, even in a case involving a senior mark with a weak distinctive character, there may be a likelihood of confusion, in particular where the goods or services in question are identical and the trademarks at issue are highly similar.\(^{263}\) That, for instance, was the conclusion of the General Court in a dispute between the earlier word trademark FLEX and the junior mark FLEXI AIR, both in relation to shampoos and hair care products.\(^{264}\)

On the other hand, it was held that there can be a likelihood of confusion, notwithstanding a low degree of similarity between the trademarks, where the goods or services covered by them are very similar and the senior mark is highly distinctive.\(^{265}\) This will certainly be the case where the junior mark includes elements that are even less distinctive than the element that is common to the trademarks at issue.\(^{266}\)

For instance, the General Court held that the rather descriptive nature of the element “SKIN” did not prevent there being a likelihood of confusion between the junior mark FIRST-ON-SKIN and the senior mark SKIN, both for clothes and socks, the more because the word “SKIN” was found to retain an independent distinctive place within the junior mark.\(^{267}\) The

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General Court ruled accordingly where it withheld a degree of similarity between the junior mark TOMORROW FOCUS and the earlier compound trademark composed of a logo followed by the word “FOCUS,” both for products and services regarding data processing. The word “TOMORROW” was considered laudatory, and therefore only weakly distinctive.\(^{268}\)

In CURON,\(^{269}\) the General Court concluded that there was no likelihood of confusion on the part of the mainly specialist public of doctors between the trademarks EURON and CURON, both for surgical and medical apparatus. It held that the element “EURO” had such a \textit{force évocatrice} (evocative effect) that, firstly, the senior mark had a weak distinctive character, because it might refer to the European origin of the goods involved and, secondly, that it emphasized the conceptual difference with CURON. Considering, \textit{inter alia}, that weak distinctive character, the identity of the goods was not sufficient to compensate for the low degree of visual and phonetic similarities between the trademarks.

Conversely, the addition of the component “Euro” to the sign “Basket” was sufficient to rule out a likelihood of confusion with the earlier semi-figurative mark BASKET. As the component “Basket” with respect to clothing could be viewed by the relevant public as denoting the intended use of the mark, it was found to be descriptive and furthermore not a dominant element in the applied-for mark.\(^{270}\)

![Basket](image)

Senior Mark

![EuroBasket](image)

Junior Mark

However, in Ferrero,\(^ {271}\) the CJEU concluded that, in the global assessment of the likelihood of confusion between the junior mark FERRO and the earlier German trademark FERRERO, the low degree of similarity between the goods covered, namely salted products as opposed to sweetened products, was counteracted by the high degree of similarity between the conflicting trademarks and the strong distinctive character of the trademark FERRERO, because of the reputation it enjoys on the German market.

\(^{268}\) Tomorrow Focus v. OHIM–Information Builders (TOMORROW FOCUS), Case T-90/06, [2008] ECR II-318, para. 27 (GC, Dec. 11, 2008); Inter-Ikea v. OHIM–Waibel (idea), Case T-112/06, [2008] ECR II-6, para. 51 (GC, Jan. 16, 2008).


D. The Peaceful Co-Existence of the Conflicting Trademarks

It cannot be ruled out that the co-existence of two trademarks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those trademarks on the part of the relevant public. In any event, the peaceful co-existence of national trademarks for more than five years must be proven in the opposition, in absence of which OHIM is unable to consider its peaceful nature.

The General Court held that it could not be entirely ruled out that, in some cases, the coexistence of senior marks on the market is likely to reduce the likelihood of confusion that the adjudicating bodies of OHIM found to exist between the two trademarks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings before OHIM concerning relative grounds for refusal, the applicant has duly demonstrated that such co-existence was based upon the absence of any likelihood of confusion on the part of the relevant public between the senior marks upon which it relies and the intervener’s senior mark on which the opposition is based, and provided that the trademarks at issue are identical.

Peaceful coexistence is furthermore not considered to be relevant in all cases. For instance, in a conflict between the earlier collective CTM RIOJA, the applicant, who already owned the registered national Spanish trademark RIOJAVINA and who had marketed vinegar under this trademark for over fifty years in Spain, did not at all preclude there being a likelihood of confusion on the part of the Spanish consumer. It was also relevant to note that the targeted public to be taken into account for the purpose of examining the likelihood of confusion with the earlier collective CTM was, of course, not limited to the Spanish public but, by contrast, was broader and extended to the public at large in the European Union.

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With reference to the Latin maxim *negativa non sunt probanda* (negatives cannot be proven), the question remains how to adduce evidence for the absence of any likelihood of confusion on a given market in a Member State. The fact that there is no likelihood of confusion cannot be inferred from the mere reproduction of extracts from databases relating to the registration of marks.\(^{276}\) Likewise, it is not possible to infer from mere photocopies of different beer labels allegedly belonging to third parties any use at all of those signs on the European Union market, so that not even the identity of registrations coexisting on the market had been proved.\(^{277}\)

Because the requirements to establish a coexistence on the national or local markets are so stringent, the owner of a national trademark identical to an applied-for CTM is, in fact, compelled to institute beforehand a declaratory action before a national court seeking to establish that there is no infringement on a given market. Cases where the bodies of OHIM or the General Court have accepted the absence of a likelihood of confusion based on a peaceful co-existence between the trademarks involved are rare, if not unknown, to date.

**E. The Existence of a Family or Series of Trademarks**

As was discussed above, the fact that the opposition is based on various series of trademarks (for instance, because each trademark contains the same word element—a noun, prefix, or suffix, or the same figurative element) is an element that may be taken into account for the purposes of assessing the likelihood of confusion.\(^{278}\)

The situation discussed here does not relate to cases where consumers might confuse the junior mark with one or another trademark belonging to the series, but to cases where there is a risk that consumers might be of the opinion that the junior mark is part of a family or series of marks. A likelihood of confusion attaching to the existence of a family of earlier marks can be pleaded only if both of two conditions are satisfied.

First, the proprietor of a series of earlier registrations must furnish proof of use of all the marks belonging to a series or, at the very least, of a number of marks capable of constituting a series.

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For there to be a likelihood of the public’s being mistaken as to whether the junior mark belongs to a series, the earlier marks forming part of that series must necessarily be present on the market. Because taking into account the serial nature of the earlier marks would entail widening the scope of protection of the trademarks forming part of the series, considered individually, any assessment in the abstract of the likelihood of confusion, based solely on the existence of several registrations covering marks reproducing the same distinctive element, and in the absence of any actual use of the marks, must be regarded as excluded. Consequently, failing proof of such use, any likelihood of confusion entailed by the appearance on the market of the junior mark will have to be assessed by comparing each of the earlier marks, taken individually, with the junior mark.279

Secondly, the applied-for mark must not only be similar to the marks belonging to the series but also display characteristics capable of associating it with the series. That would not be the case where, for example, the element common to the earlier serial marks (for instance, “TORRES” placed above or under the image of three towers) is used in the junior mark either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content.280

By requiring the opponent to establish the actual use on the market of all the trademarks forming part of the series, the General Court seems to be adding a condition that has a basis in neither the Directive nor the CTMR.

When applying those two cumulative conditions, the presence of the same prefix “uni” in the applied-for word marks UNIWEB and UniCredit Wealth Management and the earlier word


trademarks UNIFONDS, UNIRAK, and UNIZINS, even if they were both registered for financial services, was insufficient to find that the applied-for trademarks would be associated with the existing series.\textsuperscript{281} The CJEU has since set aside that judgment and referred the case back to the General Court because the latter did not analyze the structure of the trademarks to be compared or of the influence of the position of their common element, that is, the prefix "uni," on the perception that the relevant public may have of those trademarks.\textsuperscript{282}

\textbf{VII. CONCLUSION:}\\
THE LIKELIHOOD OF CONFUSION UNRAVELLED?

Finding systematic rules for the assessment of the likelihood of confusion by analyzing the case law delivered in CTM opposition proceedings over the past ten years is challenging, without a doubt. After examining the abundance of decisions handed down by the CJEU and the General Court, it is apparent that trademark law and the notion of a likelihood of confusion, in particular, is not an exact science.

Especially when comparing the similarity involving one or more compound trademarks, identifying the dominant or distinctive component, let alone identifying whether or not it retains an independent distinctive place, depends on a case-by-case analysis for which the outcome cannot be predicted by the application of uniform rules.

For instance, the fact that the rather low or high degree of distinctive character of a senior mark is taken into consideration only in the global approach of the likelihood of confusion, by contrast to the prior examination of the similarity between the conflicting trademarks, may look odd. A consumer faced with a more recent infringing trademark may, after all, be confused or deceived exactly because it had already called to mind the imperfect picture of the earlier distinctive or well-known trademark, at the time he or she was seeing the more recent similar trademark. Failing to take account of what may be a low degree of distinctiveness of the senior mark at the stage of assessing the similarity of the trademarks—for instance, a red mug of coffee on a bed of coffee beans—is too theoretical an approach and does not entirely correspond to the consumers’ perception in real life. For instance, the fact that the conceptual similarity and therefore, at a later stage also, the likelihood of confusion itself, between two compound trademarks is often the


result of a weak and descriptive, or at least suggestive, common element—such as “WINGS” or the red mug on a bed of coffee beans—is questionable.

If a component is weak or suggestive, consumers will, in reality, usually focus on or look for other, more distinctive elements. In paper opposition battles, however, “weak” clearly does not always actually mean that a component is considered weak.

Unlike for infringement proceedings brought before a national court of a Member State, the actual use of the trademarks in dispute may not be taken into account for the purpose of assessing the likelihood of confusion between them. Account may be taken only of the image of the conflicting trademarks as listed in the trademark registries and the goods or services covered by them. By starting from that point, it is necessary to continue further down the same theoretical path. Opposition proceedings, therefore, are, by their very nature (and in contrast to infringement proceedings) prospective and utterly abstract and are likely to fail to respect concrete real-life situations where the transactional decisions for everyday consumer goods are often taken in a matter of seconds.

By studying the concept of a likelihood of confusion at such great length in search of certain systematic rules, only to discover that each rule has several exceptions, it has become clear that the likelihood of confusion between trademarks will always depend on a subjective approach, both by the average reasonably informed, circumspect, and attentive consumer as well as by the judge or adjudicating bodies attempting to put themselves in the minds of that mythical consumer. This leaves more than enough for lawyers to discuss in their observations.