

RELATIVE GROUNDS FOR REFUSAL

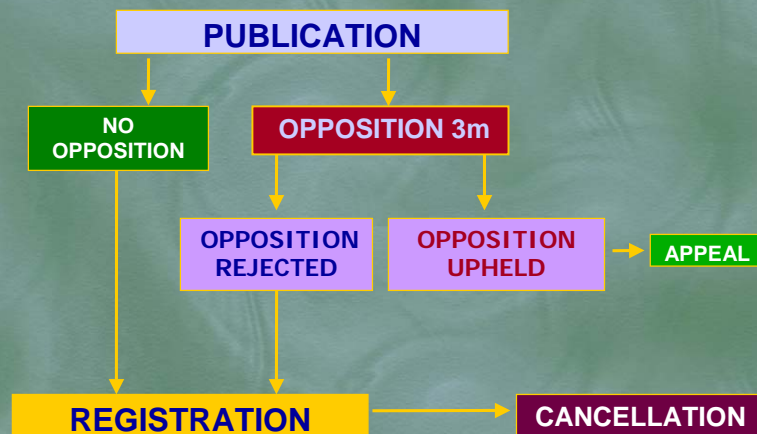
Identity and likelihood of confusion



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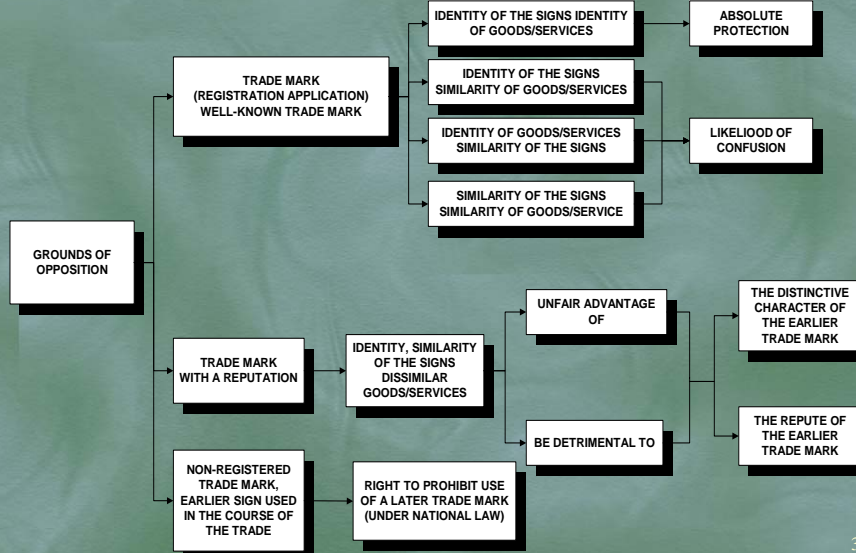
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OPPOSITION & CANCELLATION



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GROUNDS OF OPPOSITION: Art. 8 CTMR



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Identity

Art.8(1)(a)

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

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.

SIGNS

G & S

identity



identity

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Identity

- Signs: Accepted cases of identity

LIKELIHOOD OF CONFUSION		
Identity	DECISION 314/2000	
Signs	Earlier trade mark	CTM application
Accepted	SEMCO	semco


LIKELIHOOD OF CONFUSION		
Identity	DECISION 2454/2000	
Signs	Earlier trade mark	CTM application
Accepted	SAVANNAH	savannah

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Identity

- Signs: Identity rejected

LIKELIHOOD OF CONFUSION		
Identity	DECISION 1525/1999	
Signs	Earlier trade mark	CTM application
Rejected	NOVALLOY	NOVALOY

LIKELIHOOD OF CONFUSION		
Identity	DECISION 92/2001	
Signs	Earlier trade mark	CTM application
Rejected	EPOCA	

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Likelihood of confusion

Art.8(1)(b)

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

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 mark 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.

SIGNS

GOODS



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Likelihood of confusion

Practice principles

- Definition of the nature of G&S.
 - Intrinsic characteristics and qualities.
 - Description of G&S and classification.
 - Definitions (dictionaries, technical encyclopaedias).
 - Situation of the relevant market.

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Likelihood of confusion

Practice principles

- Determining who is the relevant consumer /customer
 - Nature and intended purpose of G&S.
 - Specialised consumers / general consumer
 - Vertical consumers (raw material or semi elaborated suppliers / terminated goods)
 - Trade mark fidelity / expert advised buy. Customers different from actual consumers.

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Likelihood of confusion

Practice principles

- Criteria of similarity of G&S
 - Complementarities
 - Goods that are necessary for the production of others.
 - Sold together or in a combined form. Commercially interchangeable.
 - Common distribution channels and outlets. Exception: complimentary presents.

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Likelihood of confusion

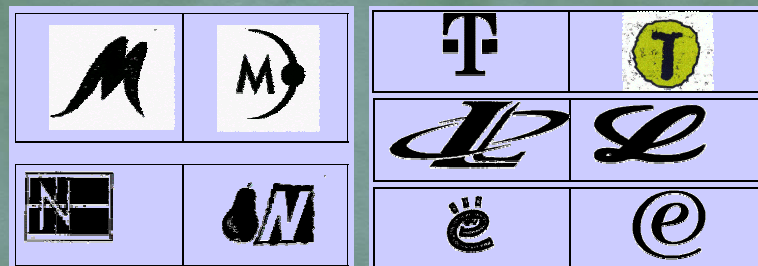
Practice principles

- Similarity of signs
 - **Global assessment** of sign vs. splitting elements
 - Length of the sign
 - Initial part of the sign
 - Drives the attention of consumers.
 - Vowel structure.
 - Defines the rhythm of pronunciation.
 - Short signs.
 - Small variations in very short signs may imply already sufficient difference.

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Likelihood of confusion: Comparison of signs

Length matters: One-letter signs (dissimilar)



But similar if stylisation imitated



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Practical cases



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Practical cases

Decision 830/2000

Earlier right	
DE 2 038 772	
Registered	17/02/1994
Goods	(Class 9) <i>Electronic circuitry and components, digital and analogue modules (so far as included in class 9).</i>

C TM Applicat	
714 204	DIABLOCK
Applied on	31/12/1997
Publication on	04/01/1999
Goods	"(class 9) <i>Electromagnetic/electromechanical locks</i> ".

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Practical cases

Decision 830/2000

- Arguments of the parties
 - On the Signs
 - Applicant:
 - Letters « B » and « K » contribute to separate the coinciding parts « DIA » and « LOC ».
 - Letter « B » introduces an important change in pronunciation and intonation rhythm between « DIALOC » and « DIABLOCK »
 - CTMA conveys the idea of « DIABLO » + « LOCK », thus differing from the earlier sign.
 - Opponent
 - Conceptual association will not be possible in the German market because it implies two different foreign languages (ES + EN) and because of the unitary perception of the sign.



DIABLOCK

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Practical cases

Decision 830/2000

- Arguments of the parties
 - On the Goods
 - Applicant:
 - Goods of the CTMA are finished products whereas those of the earlier mark are always used as semifinished.
 - Addressed to different customers
 - Opponent
 - Goods of the CTMA are not finished ones because they are used in modules together with electronic circuits (earlier goods) in the door control system of a building.
 - A company producing electronic circuitry and components will be considered also skilled in the production of the CTMA goods.

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Practical cases

Decision 830/2000

- Decision of OD
 - On the Signs
 - Germany is the relevant market
 - There are visual differences: « DIA » part. Nevertheless, visual impression remains weakly similar.
 - Phonetically the difference lies only in the last syllable: begins with « B » in the CTMA. Nevertheless, even this last syllable has a similar ending in both cases [-oc].
 - Conceptually: no consideration. Only to consumers very familiar with the foreign languages used would a ' split ' of the sign in two words be suggested and, therefore, convey a particular meaning.
 - Conclusion: signs are similar

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Practical cases

Decision 830/2000

- Decision of OD
 - On the Goods
 - Although CTMA goods are finished ones, they usually form part of more complex systems for remote control of door opening, thus cooperating with electronic control circuits.
 - This does not make them similar: they can be used also in other purposes; they have clearly differentiated functions even when forming part of the same ' system '.
 - Electromagnetic/electromechanical locks are bought by their mechanical reliability. Even if they also include an electronic part, this is not relevant for consumers.
 - Conclusion: goods are dissimilar
 - Nevertheless a link exists between them, which could be made evident in particular circumstances

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Practical cases

Decision 830/2000

- Decision of Opposition Division
 - Signs are not sufficiently similar to make the link between the goods evident to consumer



NO LIKELIHOOD OF
CONFUSION
OPPOSITION
REJECTED

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YMA

(earlier CTM)

vs.

IMA

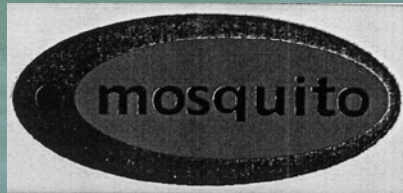
(CTM applic.)

*Class 32
non-alcoholic
beverages*

Cl 33

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Complementary goods



Earlier CTM

Class: 25



Contested CTMA

Class: 28

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Likelihood of confusion

Practice principles

- Criteria for assessing similarity of signs.
 - Dominant elements of the sign.
 - Verbal / Device.
 - Usually verbal expression predominates.
 - Particularly important if it's the common part of opposing signs.
 - Full reproduction of earlier trade mark.

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Perception of a mark as a whole

INTACRYL

Lacryl

Earlier CTM

Contested CTMA

Class: 2

Class: 2

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Dominant/distinctive element

RICO

vs.



Earlier **PT**
mark

CTM application

Classes: 29, 30

Class: 29

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Dominant/distinctive element



vs.

CITROQUICK

Earlier PT mark

CTM application

Class: 32

Classes: 30, 32

25

Figurative component more outstanding



Earlier Spanish TM



Contested CTMA

Class: 41

Classes: 3,9,14,16,
18,21,24-26,28,32,
34, 39 and 41

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Weak elements of marks



ROYAL FRESH

Earlier Spanish TM

Contested CTMA

Classes: 30, 31

Class: 31

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Weak components



Earlier CTM

Contested CTMA

Classes: 10,18,24,25

Classes: 18,24,25

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Weak elements



Earlier Spanish TM

Class: 32



Contested CTMA

Class: 32

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Distinctive and dominant elements

BANCO POPULAR



Earlier CTM, Spanish TM

Contested CTMA

Classes: 9,35,36,38,41,42

Classes: 35,36,41,42

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