

The Likelihood of Confusion in the European Union Trade Mark Opposition Procedure – Part II



In light of an opposition procedure under Article 8 of the European Union Trade Mark Regulation (EUTMR)¹, one must assess the **similarity between marks** to establish the possibility of finding ‘likelihood of confusion’, in conjunction with the similarity between goods and services, which was discussed in Part I of this piece.

In the assessment of marks, there is a very fine line between finding a mark to be similar or dissimilar, which line is not always easy to define. For most cases, it is sufficient to globally assess the marks through three important elements, which elements were firstly introduced in the *Sabel vs Puma* case² but still remain of great importance today. These elements are the following:

1. Visual similarity

The visual element is naturally the main criterion of assessment since marks are mostly perceived visually. Yet, it is also the most complex one since it includes any textual content, colour, shape, size and position, thus not all visual comparisons might be the same. As an example, a visual comparison involving word marks is not the same as a visual comparison involving figurative marks.

As an example, the Courts have found the following marks visually similar since there was no high variation in the style of the word elements in the figurative marks in comparison to the word element which was easily recognisable and legible:

Earlier Sign	Contested Sign
vendus sales & communication group	 3
EMERGEA	 4



¹ Council Regulation (EC) No 207/2009 on the European Union Trade Mark

² Case C-251/95 *Sabel vs Puma* [11.11.1997] European Court of Justice

³ Case R 0994/2009-4 *Ventus-Česko s.r.o. vs Vendus Sales & Communications Group GmbH* [15.07.2010] EUIPO Board of Appeal

⁴ Case T- 172/04 *Telefónica, S.A vs OHIM* [27.09.2006] General Court

In the case of *Stephanie Scatizza vs Office for Harmonization in the Internal Market (OHIM)*⁵, involving the below figurative marks, the Court assessed the marks visually and came to the conclusion that the difference between them was not satisfactory in avoiding a frail degree of similarity between them and the Court still found ‘likelihood of confusion’ due to the identity of the goods and the marks being conceptually identical and phonetically similar.

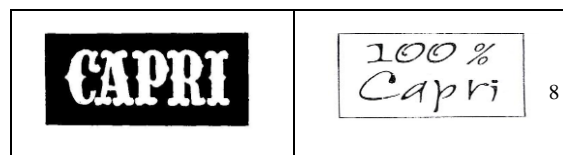
Earlier Sign	Contested Sign
	

However, these are not the only types of visual similarities one might come across. The EUIPO (European Union Intellectual Property Office), in its guidelines⁶, makes reference to other types of visual comparisons including the comparison between the below signs which were all found to be similar:

- Purely figurative signs vs purely figurative signs;



- Stylised marks vs stylised marks;



- Word/figurative signs vs purely figurative signs;



⁵ Case T-238/10 *Stephanie Scatizza vs OHIM* [20.10.11] General Court

⁶ ‘Guidelines for Examination of European Trade Marks’ Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 4, Sub section 3.4.1, Page 27 [Version 1.0, 01.02.2017]

⁷ Opposition B 1 175 769 *Paul Fitoussi vs Jens Håkansson AB* [11.03.2009] Opposition Division

⁸ Case T- 1148/08 *Antonino Aiello vs OHIM* [12.07.2012] General Court

⁹ Case T-81/03, T-82/03 and T-103/03 *Mast-Jägermeister AG VS OHIM* [14.12.06] General Court

2. Aural (phonetic) similarity

The syllables, along with their sequence and stress, form the major elements which determine the overall phonetic impression of a mark. A single letter can also be compared phonetically when there is a reproduction of that sole letter.

A landmark judgment which assessed the examination of the aural element was the case of *Lloyd vs Schufabrik*¹⁰ in which the Court held that:

“It is possible that mere aural similarity between trade marks may create a likelihood of confusion”

The Court stated that, while aural similarity can cause sufficient confusion on its own, the assessment whether the threshold of the likelihood of confusion has been reached would depend upon the overall picture of the mark and several other factors, such as whether the sound has any additional connotation to its meaning or whether the mark contains any element descriptive of the goods or services it represents.

In assessing aural similarities, one must also take into consideration symbols and abbreviations such as ‘&’ and ‘@’ and ask whether these would be considered in the phonetic assessment. Indeed they are, since they are generally read and pronounced, and thus should be included. When it comes to marks that consist of foreign and/or invented words, it is assumed that the relevant public is not familiar with how foreign native speakers will pronounce their language, thus the public will possibly pronounce a foreign word as per their own language’s phonological rules, rendering it unintentionally similar to the foreign word. The LIDL case was a clear example of this, in fact, the OHIM concluded that since the first two letters and the last one were the same in both marks;

“LIDL will often be pronounced as if it spelt LIDEL. For phonological reasons, D and L are nearly impossible in most languages to pronounce without uttering a vowel between them. So, the marks would sound LIFEL and LIDEL in languages like Spanish, Italian, German, and French. The degree of similarity is very high, because the two sounds only differ in the middle of the words (F instead of D).”¹¹

Nonetheless, the above interpretation would not be followed in cases where the relevant public is familiar with a foreign word, for example, in the case of the English language, which is a language presumed to be known worldwide and where the relevant public would be familiar with the word. This also applies where particular terminology is known by the relevant public for certain classes of goods or services.

3. Conceptual similarity

The final element to assess is related to signs which are identical or similar conceptually. This is generally examined through the analogue semantic content of the mark, which is essentially related to what the mark means, what it suggests or when a shape or image is used and what it represents. In this case, the comparison is generally not influenced by the relevant goods or services but rather how the term is perceived by the relevant public.

¹⁰ Case C-342/97 *Lloyd Schufabrik & Co GmbH vs Klijsen Handel BV* [22.06.1999] European Court of Justice

¹¹ Opposition R 0410/2010-1 *Lidl Stiftung & Co. KG vs Nikhil Joshi* [19.10.2010] Opposition Division

The Opposition Division of the EUIPO generally follows the reasoning that if none of the signs have any concept, then no conceptual comparison is possible, while if only one of the signs evokes a concept, the signs would not be conceptually similar either. It is only when both signs have a concept that the examiners go ahead with conducting a conceptual comparison to establish if the signs are conceptually identical or similar. The five main scenarios when such comparison takes place are when:

- Both marks share a word and/or expression;
- Words or terms have the same meaning, in different languages;
- Words refer to the same or a variation of a semantic term;
- Two figurative signs, shapes and/or symbols represent the same object or idea; and
- Word vs figurative sign, symbol, shape and/or colour representing the concept behind the word.

These elements are to be taken into account along with the overall impression created by the marks, whilst keeping in mind the distinctive and dominant characters of the marks as well as the relevant public.

During the 'likelihood of confusion' assessment, various factors are considered in order to evaluate the similarity of marks and the likely risk of confusion. Every factor must firstly be examined in isolation, and subsequently a comprehensive analysis would be required to assess the interrelationships between these elements.

Of course, there are certain elements and comparisons which prevail over others. The visual similarity, for example, in the comparison of marks, is generally considered as a dominant element. On the other hand, mere conceptual similarity is unlikely to lead to 'likelihood of confusion', unless the earlier mark has a strong distinctive character. However, these factors are not only assessed separately, but are also examined through a global lens together with the others, creating a balancing exercise which would lead to the findings of confusion, or otherwise.

Apart from the assessment of several factors and elements, 'likelihood of confusion' is also determined by taking into consideration reasonable consumers, whose perception of confusion or otherwise will be detrimental to the opposition decision.

In conclusion, it is clear that while no specific rules as to the interpretation of 'likelihood of confusion' are found, common sense and consistency have prevailed in EU case law in recent years. This has helped opponents and applicants have a better understanding of how the law should be interpreted. The principles established by the European Court of Justice, have served as a good foundation for the assessment and analysis of 'likelihood of confusion', which in turn has increased coherence levels in EUIPO decisions.