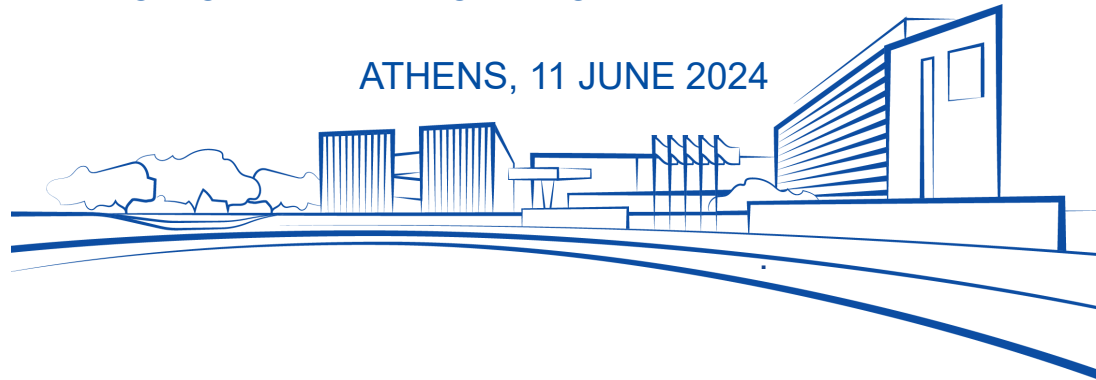


Global assessment of the likelihood of confusion where the similarity between the signs resides in a weak or non-distinctive element – EU case law

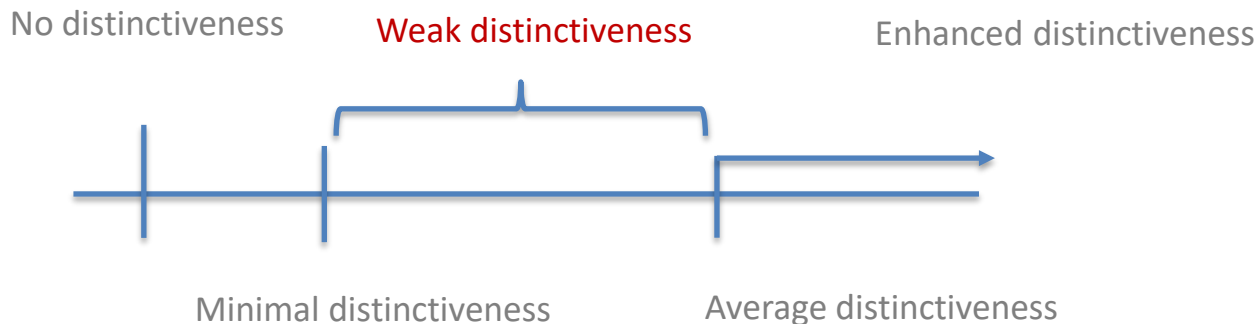
Session with IP Practitioners

NINA KORJUS
CHAIRPERSON OF THE 4TH BOARD OF APPEAL

ATHENS, 11 JUNE 2024



Weak elements of a sign – what does that mean?



BUT:

‘Where some elements of a sign are descriptive of the goods and services in respect of which the trade mark is registered or of the goods and services covered by the application for registration, those elements are recognised as having only a weak, or even very weak distinctive character.’

Case-law lines

Different case-law trends or just different factual assessments, but following the same legal principles?

- A global appreciation of the visual, aural or conceptual similarity of the signs in question, must be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).
- Descriptive, non-distinctive or weak elements will not generally be considered dominant in the overall impression conveyed by the signs, unless, particularly because of their position or size, they are likely to make an impression on consumers and be remembered by them.

Case-law lines

The no-LoC oriented approach

Comparison of the signs:

- A weak or non-distinctive element has a **limited impact** on the similarity of the signs:
 - ❖ even if in fact visually prominent or placed at the beginning of a sign, it is **not** considered to make a **memorable** impression on the public (also not usually found 'dominant')

Global assessment

- Similarity resulting from the weak elements is given little significance in the **global assessment**
- Weak earlier trade marks are given a corresponding **scope of protection**

The LoC oriented approach

Comparison of the signs:

- A weak or non-distinctive element is found dominant or having an **autonomous position** that would **attract the attention** of the public
 - ❖ due to its length – number of letters
 - ❖ position at the beginning of the sign

Global assessment

- Even in the case of a mark of weak distinctive character, **there may be a likelihood of confusion** on account, in particular, of the existence of a similarity between the signs and between the goods or services covered
- Weak distinctiveness of the earlier mark is only **one of the factors** in the global assessment - outweighed by the degree of similarity of the signs/goods

LoC oriented approach

*...assuming that an earlier national trade mark is in fact **descriptive in respect of some of the goods** for which it has been registered and that its protection **leads to improper monopolisation of the descriptive indication** in question, such a consequence must be remedied not by an application of Article 8(1)(b) EUTMR...., but by invalidity proceedings brought in the Member State...*

08/11/2016, C-43/15 P, COMPRESSOR TECHNOLOGY, § 68

*Giving **predominant relevance to the weak distinctiveness** of the earlier mark would have the effect of neutralising the factor of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which **would then be given undue importance**. The result would be that, where the earlier mark is of only 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**.*

15/03/2007, C-171/06 P, Q QUANTIM (fig.) / Quantieme (fig.), EU:C:2007:171, § 41

No-LoC oriented approach

*...the **ratio legis of trade mark law** is to strike a **balance** between the interest which the proprietor of a trade mark has in safeguarding its **essential function**, on the one hand, and the **interests of other economic operators** in having signs capable of denoting their products and services, on the other... It follows that excessive protection of marks consisting of elements which have very weak distinctive character, if any, in relation to the services at issue could **adversely affect the attainment of the objectives pursued by trade mark law**, if,... the mere presence of such elements in the signs at issue led to a finding of a likelihood of confusion without taking into account the remainder of the specific factors in the present case.*

No-LoC oriented approach

*Descriptive, non-distinctive or weak elements of complex signs **generally have less weight in the analysis of the similarity between the signs** than elements of a greater distinctiveness, which are also more able to dominate the overall impression created by the mark.*

*Where the signs overlap in a descriptive, non-distinctive or weak element, the **global assessment of the likelihood of confusion will rarely lead to a finding that that likelihood exists**. Nevertheless, a finding that it exists cannot be ruled out in advance and in any event without an assessment of the specific circumstances of the case.*

*A finding of a likelihood of confusion leads solely to **the protection of a certain combination of elements without**, however, a descriptive element which forms part of that combination being protected as such. Consequently, the proprietor of a complex trade mark cannot in any event claim an exclusive right solely in one element of the trade mark.*



Scenarios:

- Overlapping non-distinctive or weak element accompanied by other distinctive verbal elements
- Overlapping non-distinctive or weak element not accompanied by other distinctive verbal elements
- Single word signs with a weak suffix, prefix or root
- Overlapping figurative elements

Overlapping non-distinctive or weak element accompanied by other distinctive verbal elements

➤ No-LoC:



COMPAL
essential



Dr. Jacob's
essentials

09/09/2020, T-879/19, Dr. Jacob's essentials (fig.) / COMPAL essential (fig.) et al., EU:T:2020:401



WORKSPACE



UMA WORKSPACE

28/05/2020, T-506/19, Uma workspace / WORKSPACE (fig.) et al., EU:T:2020:220

➤ **No-LoC:**

e-POWER

VDL E-POWER

10/11/2021, T 755/20, Vdl e-power / e-POWER (fig.) et al., EU:T:2021:769

HYDRABIO



13/09/2023, T-328/22, EST. KORRES 1996 HYDRA-BIOME (fig.) / Hydrabio et al., EU:T:2023:533



➤ **No-LoC:**



01/02/2023, R 2929/2014-4, ζ ΕΖα (fig.) / Ζ ΖΗΤΑ (fig.)

Overlapping non-distinctive or weak element not accompanied by other distinctive verbal elements

➤ LoC:



Vital
like nature



20/10/2021, T-351/20, Vital like nature (fig.) / VITAL (fig.), EU:T:2021:719

06/09/2023, T-557/22, granulat (fig.) / GRANULAT 2000 (fig.) et al., EU:T:2023:505

The Feed.

Feed.

31/01/2024, T-26/23, Feed. (fig.) / The Feed. (fig.) et al., EU:T:2024:48

➤ **No-LoC**



08/03/2019, T-326/18, CARAJILLO LICOR 43 CUARENTA Y TRES (fig.) / Carajillo (fig.), EU:T:2019:149

VERONESE

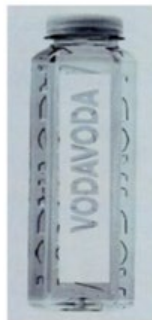


23/09/2020, T-608/19, VERONESE (fig.) / Veronese, EU:T:2020:423

➤ **No-LoC**



12/05/2021, T-70/20, MUSEUM OF ILLUSIONS (fig.) / MUSEUM OF ILLUSIONS (fig.), EU:T:2021:253



12/05/2021, T-637/19, AQUA CARPATICA AC AC AQUA AC BOTTLE (3D) / VODAVODA BOTTLE (3D) et al.,
EU:T:2021:255

Single word signs with a weak suffix, prefix or root

➤ LoC

LUXOCOLAT

Xocolat

CERETHERM

CREATHERM

24/10/2019, T-58/18, Xocolat / LUXOCOLAT, EU:T:2019:759

24/03/2021, T-168/20, Creatherm / Ceretherm, EU:T:2021:160

Hyo-Vision

Hydrovision

financify

Financery

27/01/2021, T-817/19, Hydrovision (fig.) / Hylo vision, EU:T:2021:41

03/05/2023, T-7/22, Financery / financify, EU:T:2023:234

➤ **No-LoC**

AQUACEM

AQUAPRINT

Dermowas

DermoFaes

23/05/2019, T-312/18, AQUAPRINT / AQUACEM et al., EU:T:2019:358

28/11/2019, T-643/18, DermoFaes / Dermowas, EU:T:2019:818

NATURALIUM

NATURANOVE

05/10/2020, T-602/19, NATURANOVE / NATURALIUM et al., EU:T:2020:470

Shopify



Shoppi

AllergoSkin



algoskin

12/10/2022, T-222/21, Shoppi (fig.) / Shopify, EU:T:2022:633

17/05/2023, R 200/2023-1, algoskin (fig.) / AllergoSkin

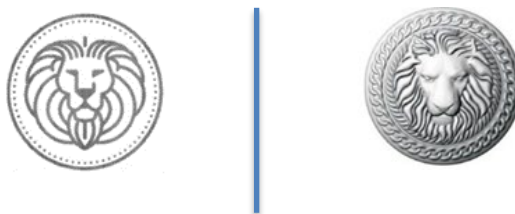
Overlapping figurative elements

➤ No-LoC:



14/11/2019, T-149/19, DEVICE OF A HUMAN FIGURE CENTERED OVER A BLUE ESCUTCHEON (fig.) / DEVICE OF A HUMAN FIGURE WITH A SEMICIRCLE (fig.), EU:T:2019:789

11/11/2020, T-25/20, DEVICE OF A HORN (fig.) / DEVICE OF A HORN (fig.), EU:T:2020:537

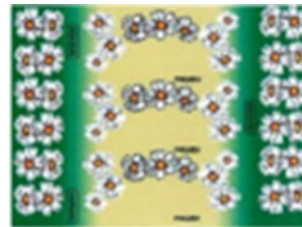


20/12/2023, T-564/22, DEVICE OF A LION HEAD (fig.) / DEVICE OF A LION HEAD (fig.), EU:T:2023:851

➤ **LoC**



29/11/2023, T-29/23, CHERRY Passion (fig.) / MIESZKO PRALINES CHERRISSIMO (fig.) et al., EU:T:2023:765



13/05/2020, T-63/19, РОШЕН (fig.) / ПОМАШКИ (fig.), EU:T:2020:195



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Thank you