

Convergence Programme (CP5):

Non-distinctive & weak elements in the assessment of the Likelihood of Confusion

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The Convergence Programme Effort

109

Individuals
from 27
EU Offices

4

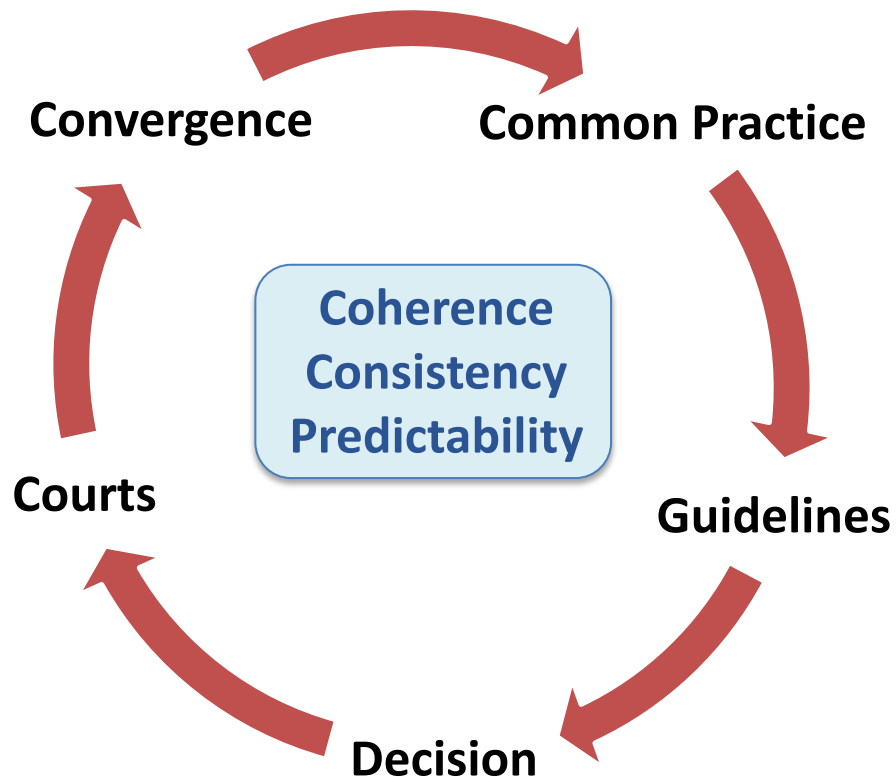
Non EU
Offices
as observers

12

User
associations
as observers



Working towards Convergence: A Continuous Process



CP5 Relative grounds: Likelihood of Confusion

28

Implementing
Offices

2

Non- participating
Offices

 **European trademark**
European Trade Mark and
Design Network

 OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
TRADE MARKS AND DESIGNS



1

Not implementing
Office

3

Users Associations

Objective 1: What do we compare?

Finding No 1

When assessing likelihood of confusion:

- **The distinctiveness of the earlier mark as a whole is addressed, considering that a certain degree of distinctiveness needs to be acknowledged (F1).**
- **The distinctiveness of all components of the earlier mark and of the later mark is also assessed, prioritising the coinciding components**

Example



ZITRO SPIN BINGO

(earlier mark)

Cl. 9, including betting terminals, Cl. 28 including games,
Cl. 41, including entertainment

Objective 2: how to assess the distinctiveness of the marks and their elements?

Finding No 2

- **When assessing the distinctiveness of the marks in relative grounds, the same criteria that are used to determine distinctiveness as in absolute grounds apply.**
- **However, in relative grounds, these criteria are used not only to determine whether a minimum threshold of distinctiveness is met but also to consider the varying degrees of distinctiveness**

Objectives 3 & 4: which weight to give to weak or non-distinctive elements?

Finding No 3

- When marks share an element with a low degree of distinctiveness, the assessment will focus on the impact of the non-coinciding components on the overall impression. It will take into account the similarities & differences, as well as the distinctiveness of the non-coinciding components.
- Coincidence in an element with a low degree of distinctiveness will not normally on its own lead to likelihood of confusion.
- Coincidence only in non-distinctive components does not lead to a likelihood of confusion.

Examples

Booking.com

anytime **booking** Negys

MFMBOOKING



 **trybooking.com**
EVENT TICKETING MADE EASY

T-608/13 EasyGroup IP Licensing Ltd v. OHMI

easyAir-tours

airtours
Ticket Factory

Objectives 3 & 4: Which weight to give to weak or non distinctive elements?

Finding No 4

However, there may be likelihood of confusion if:

- The other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar
- Or the overall impression of the marks is highly similar or identical

T-395/12, Fetim BV v. OHIM



Solidfloor The professional's choice

Cl 19: Building materials, not of metal,
parquet flooring of plastic and wood

SOLID
floor

SOLID
floor

T-123/14, 28 Jan. 2015, BSH Bosch und Siemens Hausgeräte GmbH / OHIM

AquaPerfect / WaterPerfect

(Cl 7: electric apparatus, washing machines etc.)

T-33/13, Türkiye Garanti Bankasi AS / OHIM

bonus & more

bonus net

C-579/08, Ferromix, Inomix, Alumix / FERROMAXX, INOMAXX, ALUMAXX

73. Given the need to carry out a global assessment of marks composed of two or more elements, the finding that there is a likelihood of confusion leads solely to the protection of a certain combination of descriptive elements assessed in the specific case, without a descriptive element as such being protected.



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Thank you