

國立交通大學

科技法律研究所

碩士論文

Analysis of the Assessment of a Likelihood of
Confusion for the Community Trade Mark



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Abstract

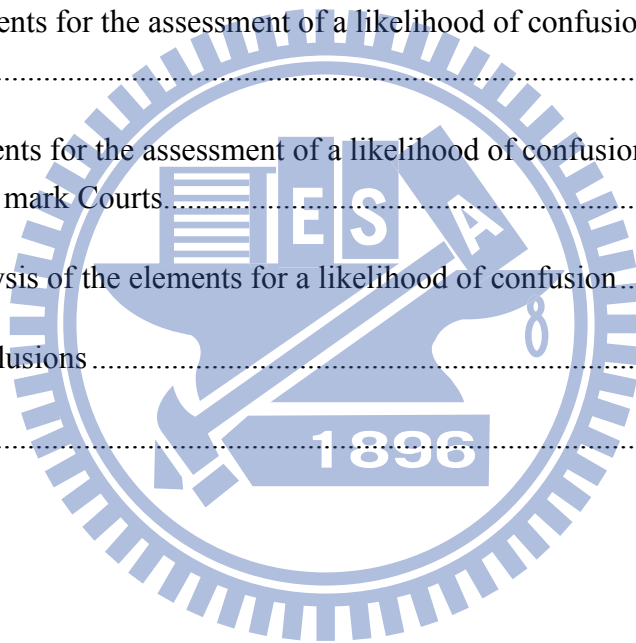
In Europe, the “Community trade mark system” was created in order to harmonize trade mark law throughout the European Community. This system grants trade mark protection through registration of a Community trade mark for the whole territory of the European Community.

This thesis takes a look at the state of trade mark law harmonization in the European Union and at the influence of the European Court of Justice’s preliminary rulings on the Member States’ national jurisprudence and practice in matters of assessing the existence of a likelihood of confusion. This thesis focuses on the case law of the German, Spanish and UK Community trade mark Courts regarding the standards for a determination of a likelihood of confusion in infringement proceedings.

Keywords: Community trade mark, CTM, likelihood of confusion, trade mark law, harmonization, ECJ, preliminary rulings.

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Chapter 1 - Introduction

Section 1 - Motive and purpose of research

Intellectual property refers to a number of different types of creations of the human intellect for which property rights are recognized, and their corresponding fields of law. Under intellectual property law, owners are granted certain exclusive rights to a variety of intangible assets, such as musical, literary, and artistic works; discoveries and inventions; and words, phrases, symbols, and designs.

Among the types of intellectual property are trade marks. A trade mark is a distinctive sign used by an individual, business organization, or other legal entity to identify that the products or services with which the trademark appears originate from a unique source, and to distinguish its products or services from those of other entities. Typically, a trade mark is a word, phrase, symbol or image, or a combination of all these elements. However, some trade marks fall into more non-conventional categories. For example, a smell or a shape can also obtain trade mark protection.

In some jurisdictions trade mark rights can be established either through actual use or through registration of the mark in the trade marks office or registry of that particular jurisdiction. Such trade mark registration confers upon the registered owner the right to exclusive use of the mark in relation to the products or services for which it is registered and also allows the owner of a registered trademark to prevent unauthorized use of the mark in relation to products or services which are identical or confusingly similar to the registered products or services. The test is always whether there is a likelihood of confusion between the two marks in question for the relevant products or services among the consumers of such products or services.

Once trademark rights are established in a particular jurisdiction, these rights are generally only enforceable in that jurisdiction. In Europe, a trade mark system called the

“Community trade mark system” grants trade mark protection through registration of a Community trade mark (hereinafter, CTM) for the whole territory of the European Community. This system was created in order to harmonize trade mark law throughout the European Community in order to achieve the goal of the common market, so such a unitary trade mark system was necessary. Otherwise, disparities in the trade mark laws among the European countries may hinder the free movement of goods and freedom to provide services and may distort competition within the common market.

The Member States of the European Union have all committed to trade mark law harmonization, and the law to be applied by the Community trade mark Courts is set out in the Community Trade Mark Regulation¹ (hereinafter, CTMR). The European Court of Justice has developed in its case law the factors for the assessment of a likelihood of confusion. All Community trade mark Courts (which are the national courts assigned by the Member States to have jurisdiction over infringement actions) should have a unanimous and consistent parameter in assessing the existence of a likelihood of confusion and are required to follow the criteria set in the preliminary rulings of the European Court of Justice.

However, in reality this is not the case. It is very difficult to come to a real consistent and harmonized approach in the question of assessing the existence of a likelihood of confusion. The Community trade mark Courts have to make an overall assessment taking into consideration various criteria for the assessment of a likelihood of confusion developed by the European Court of Justice. Since most of the criteria developed by the European Court of Justice are “uncertain legal concepts” and still leave a lot of room for interpretation there is always room to achieve different decisions, so it is very difficult to have every single court draw the same conclusions and assess the circumstances in the same way.

Furthermore, as the Community trade mark Courts in different Member States have

1 Council Regulation No. 40/94 of 20 December 1993 on the Community trade mark.

different national laws and interests, and are all independent national courts, they cannot be ordered to render a decision in a certain way. Also, matters not covered by the CTMR and the rules of procedure are regulated by the national law of each particular Member State. This implies that it would be possible for a trade mark to be declared valid in the courts of one Member State and invalid in the courts of another. Moreover, there is no single court system ending up in one court of last instance that is competent for all Community trade mark infringement cases. However, rulings as to the validity of the trade mark can have effect in all Member States of the European Union. Thus, different national court systems might be an obstacle to the achievement of consistent jurisprudence throughout the European Union.

Therefore, even though the Community trade mark Courts' decisions cite the rules laid down by the European Court of Justice, there is still a great possibility for different decisions and of arriving at different results when faced with the question of assessing the existence of a likelihood of confusion. Once a Community trade mark court has been chosen in a particular Member State, there is no appeal to a court outside that Member State.

This thesis deals exclusively with the issue of a likelihood of confusion between trade marks and does not discuss dilution issues. It takes a look at the state of harmonization and at the influence of the European Court of Justice's preliminary rulings on the national jurisprudence and practice in matters of assessing the existence of a likelihood of confusion. This thesis focuses on the case law of the German, Spanish and UK Community trade mark Courts regarding the standards for a determination of a likelihood of confusion in infringement proceedings.

Section 2 – Summary of existing relevant literature

Taiwan's legal research has traditionally given American trade mark law

considerable emphasis, legal research on the European Community trade mark system is extremely lacking. In Taiwan, there are currently only a few theses on this topic in the country: first, a master's thesis from year 2008 named "Internationalization Development of Trademark Registration – Studies on Madrid International Registered Trademarks and Community Trademarks" written by Hsiao-Ching Sun. However, the main focus of this thesis is not the determination of infringement for the CTM, but served as a general introduction to the international development of Trademark Registration and also as a comparison between the registration of the Madrid International Registered Trademarks and of the CTMs. The second is also a master's thesis from year 2007 written by Juhsiang Wang with the topic "The Legislation and Application of Trademark Dilution Theory – Focusing on the Laws of the United States and the European Union". Last, a master's thesis from year 2002 written by I-Min Chou, whose topic was "The Comparative Study on the Trademark Examination System on the Application Stage of So-Called 'Absolute Review System' and 'Relative Review System'". Just like the first thesis mentioned, these last two theses concern in part the Community trade mark system, but with no focus on the infringement of the CTM.

Section 3 - Research method and structure of the present thesis

Research on the Community trade mark system is highly important but there is unfortunately a lack of related research in this country. This thesis focuses on the assessment of a likelihood of confusion for the CTM. The likelihood of confusion is the specific condition for the protection of a CTM during infringement proceedings. Certain national courts in each Member State are designated as "Community trade mark Courts" with exclusive jurisdiction for infringement to review such infringement proceedings.

A. Research method

This thesis focuses on the case law of the German, Spanish and United Kingdom Community trade mark Courts regarding the standards for a determination of a likelihood of confusion in infringement proceedings. A total of eleven Spanish cases have been analyzed. These cases consist of all Spanish Community trade mark Court cases between 2007 and 2009 that are related to the analysis of a likelihood of confusion for the CTM. A total of seven United Kingdom cases were analyzed, consisting of those United Kingdom Community trade mark Court cases after 2004 that concern the likelihood of confusion for the CTM. Lastly, ten German Community trade mark Court cases were analyzed, consisting of those German Community trade mark Court cases after 2007 that are related to the likelihood of confusion for the CTM. Following the analysis of these Community trade mark Court cases, the author analyzes the proportions in which each standard for the existence of a likelihood of confusion are assessed for each of these three Member States.

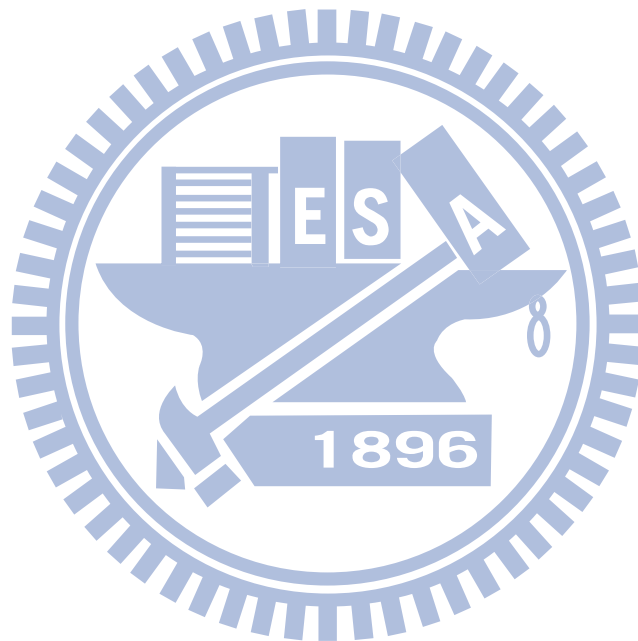
B. Structure of the present thesis

Chapter 2 starts with an introduction to the CTM system, after which its advantages and also the relevant major regulations to this system are described. This thesis then emphasizes the applicable provisions because the focus of this research is on the assessment of a likelihood of confusion for the CTM. Moreover, the Community trade mark Courts have exclusive jurisdiction for CTM infringement cases, and thus, the last section of this chapter deals with the territorial jurisdiction of the Community trade mark Courts and the legal effects of their decisions.

Chapter 3 deals with the factors for the assessment of a likelihood of confusion that were developed in the European Court of Justice's case law and also during the registration proceedings in the Office for the Harmonization of the Internal Market.

Moreover, a comparison is made between the factors for the determination of a likelihood of confusion by the European Court of Justice and by the Board of Appeals of

the Office for Harmonization in the Internal Market, hereinafter OHIM². Lastly, the author also points out the main differences between the United States and in the European Community regarding the factors for the determination of a likelihood of confusion.



² The Office for Harmonization in the Internal Market (Trade Marks and Designs), or OHIM.

Chapter 2 – An Introduction to the Community trade mark system

In order to create a common market in Europe it is necessary to harmonize trade mark law throughout the European Community. To achieve the goal of the common market, the CTMR created the Community trade mark system, which is a unitary trade mark system that governs the procedural and substantive provisions of trade mark law throughout the European Union.

Section 1 - What is a Community trade mark?

The CTM is a sign for identifying and distinguishing goods or services valid throughout the European Union and registered in the OHIM in accordance with the provisions of the CTMR.³ The OHIM is established by Article 2 of the CTMR.

The three basic principles of CTM law are "autonomy" — the CTM law is a body of European law not subject to national law unless specified; "coexistence" —CTM law does not replace or pre-empt national trade mark law, and CTMs coexist with national trade marks; and "unitary character" — CTMs are unitary and have the same effect throughout the European Community.⁴

The main benefit of the Community system is that it gives its owner a uniform right applicable in all Member States of the European Union through a single procedure which simplifies trade mark policies at European level. Traders are able to protect their marks throughout the Community on the basis of a single application, rather than having to file separate applications in each of the Member States. In other words, the CTM has a unitary character, meaning that it is valid in the entire European Community. The CTM is unitary in all respects: the application and the registration extend automatically to all

³ CTMR, *supra* note 1, at Art. 1(1): A trade mark for goods or services which is registered in accordance with the conditions contained in this Regulation and in the manner herein provided is hereinafter referred to as a 'Community trade mark'.

⁴ Alexander Von Mühlendahl, *Community Trade Mark Riddles: Territoriality and Unitary Character*, (30)(2) E.I.P.R. 66-70 (2008).

Member States of the European Community indivisibly; the effect of an invalidation, a refused application, or the expiry of the CTM necessarily is for the entire Community. That is, if a ground for refusal exists only in part of the Community, the OHIM will refuse the entire CTM application. Moreover, the CTM is one single asset and can only be transferred for the whole of the Community, not with respect to individual States.⁵ While the CTM presents certain obvious advantages to trade mark applicants, the unitary character of the CTM also presents certain risks, for example, a single invalidation action may cause the mark to be invalid for the whole territory of the European Union.⁶

The CTM may be obtained for a sign which is either applied for directly at the OHIM or which has been previously applied for through a national office. The national office is obliged to forward the application to the OHIM within two weeks.⁷ Those applying for a CTM must be a national of or domiciled or a business in an Member State or a country which is a party to the Paris Convention⁸ or to the World Trade Organization (WTO), or be a national of a state which accords reciprocal protection⁹. This application may be filed in any of the official languages of the European Union, but should also specify a second language (chosen from the five official languages of the OHIM: English, French, German, Italian, or Spanish) in which opposition proceedings may be conducted.

Examination at the OHIM is restricted to an inquiry of whether the application complies with the absolute grounds of refusal (for example, a lack of any distinctive character, or the fact that the shape results from the nature of the goods themselves, among others)¹⁰, which will apply to the mark across the whole Community, even if the

5 CTMR, *supra* note 1, at Art.1(2): A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle shall apply unless otherwise provided in this Regulation.

6 Frederick M. Abbott et al., *International Intellectual Property in an Integrated World Economy* 379 (2007).

7 CTMR, *supra* note 1, at Art. 25(2).

8 See Paris Convention for the Protection of Industrial Property of March 20, 1883.

9 CTMR, *supra* note 1, at Art. 29.

10 CTMR, *supra* note 1, at Art. 38. Absolute grounds of refusal are set out in Art. 7(1).

absolute grounds of refusal only arise in one Member State.¹¹ Where the application fails to comply with the absolute grounds for refusal, the application may be amended or withdrawn.¹² Successful registration of the CTM at the OHIM lasts for ten years¹³ and may be renewed for further periods of ten years.¹⁴

Once an application has been successfully examined, it will then be published in the Community Trade Marks Bulletin.¹⁵ Within three months of publication, the application may be opposed on relative grounds. Only the owners of senior trade marks and their licensees, the owners of trade marks, and the owners of senior marks or signs are entitled to bring opposition proceedings.¹⁶ If the application to the OHIM is rejected or withdrawn, it may be converted back into a series of national applications which retain the filing date used at the OHIM.¹⁷

Furthermore, the CTM system leaves the national trade mark systems of Member States unaffected. Enterprises are free to file national trade mark applications, a CTM application, or both. National trade mark registrations and the rights conferred by it are not affected by the CTM. The CTMR does “not abolish national trade mark protection; rather, it creates a mark that co-exists with national trade marks”.¹⁸ However, senior national trade marks possess senior rights against a CTM, and vice versa.

The CTM fulfills three essential functions of a trade mark at European level. First, it identifies the origin of goods and services, which is the most important function. “Without trade marks, manufacturers would have no incentive to produce goods of high quality because consumers would have no way of identifying goods emanating from a particular source and would not be able to reward a supplier of quality products with their

11 CTMR, *supra* note 1, at Art. 7(2).

12 CTMR, *supra* note 1, Art. 38(3), Art. 44.

13 CTMR, *supra* note 1, at Art. 46.

14 CTMR, *supra* note 1, at Art. 47.

15 CTMR, *supra* note 1, at Arts. 40 and 85.

16 CTMR, *supra* note 1, Art. 42.

17 CTMR, *supra* note 1, Art. 108.

18 Marshall A. Leaffer, *The New World of Intellectual Trademark Law*, 2 Marq. Intell. Prop. L. Rev 1, 25 (1998).

continued patronage.”¹⁹ Not only manufacturers and traders have an interest in preserving the origin function of trade marks, but customers as well share the same interest in avoiding confusion as to the commercial origin of goods and services.

But we see that the two most important pieces of Community legislation on trade marks, the First Trade Mark Directive (hereinafter, “First Directive”)²⁰ and the CTMR, state in their preambles that the function of a trade mark is “in particular to guarantee the trade mark as an indication of origin”.²¹ The words “in particular” suggest that the origin function is not the only function. Indeed, another function of the CTM is to guarantee consistent quality through evidence of the company’s commitment vis-à-vis the consumer. Lastly, it is a form of communication, a basis for publicity and advertising. Sometimes, the trade mark owner may be entitled to rely on the trade mark to prevent advertising by unauthorized dealers which might damage the reputation of the mark, without, however, creating any confusion as to the origin of the branded goods.²²

Section 2 - Major Regulations relevant to the Community trade mark system

In this section the First Directive²³ and the CTMR²⁴ are introduced.

A. The First Trade Marks Directive

On March 25, 1957, the Treaty of Rome was signed, creating the European Economic Community. The recitals of the treaty state that its purpose is “to ensure the economic and social progress of the European countries by common action to eliminate the barriers which divide Europe”. The treaty calls for “concerted action to remove the

19 David T. Keeling, *Intellectual Property Rights in EU Law, Volume I: Free Movement and Competition Law* 147 (Oxford University Press ed.) (2003).

20 Council Directive No. 89/104 of 21 December 1988 to Approximate the Laws of the Member States Relating to Trade Marks.

21 First Directive, *supra* note 20, at tenth recital in the preamble; CTMR, *supra* note 1, at seventh recital in the preamble.

22 Keeling., *supra* note 19, at 151. For example, see Case C-337/95, *Christian Dior v. Evora*, 1997 ECR I-6034; and Case C-63-97, *BMW v. Deenik*, 1998 ECR I-925.

23 First Directive, *supra* note 20.

24 *Supra* note 1.

existing obstacles to trade in order to guarantee “steady expansion, balanced trade and fair competition.”²⁵ Soon after the creation of the treaty, it was recognized that in order to create a common market in Europe it would be necessary to harmonize trade mark law throughout the continent. This harmonization would necessarily be substantive in nature, as the ultimate goal was the creation of a unitary trade mark system to govern the entire European Community.

It may be helpful to think of the benefit and necessity of a unitary trade mark system in economic terms. National, as opposed to unitary, trade mark law presents at least two barriers to a common market: first, it increases transaction costs by forcing the mastery of a number of distinct legal regimes, and second, even goods that have been introduced to an industrial market, despite the increased transaction costs, could suffer from the application of national trade mark law to stop the free flow of goods within the market.

The First Directive to approximate the laws of the Member States relating to trade marks was adopted under Article 100(a) of the EC Treaty and approved by the Council in 21 December 1988.²⁶ In its introductory considerations it is pointed out that... the trade mark laws at present applicable in the Member States contain disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the Common Market. It did not intend to undertake a full-scale approximation of the trade mark laws of the Member States, but was only a measure to approximate “those national provisions of law which most directly affect the functioning of the internal market”.²⁷ In other words, the Directive was designed to harmonize the disparities in trade mark law that had the potential of impeding the free movement of

25 Treaty of Rome, at recitals.

26 Now Art.114(a) of the Treaty on the Functioning of the European Union (TFEU) and formerly Article 95(a) of the EC Treaty, which state that the Council, acting by means of a unanimous vote on a proposal of the Commission, shall issue directives for the approximation of such legislative and administrative provisions of the Member States as have a direct incidence on the establishment or functioning of the Common Market.

27 First Directive, *supra* note 20, at third recital: “Whereas it does not appear to be necessary at present to undertake full-scale approximation of the trade mark laws of the Member States and it will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market’...”

goods and the provision of services within the European Union. In essence, the Directive harmonizes the “conditions for obtaining and continuing to hold a registered trade mark”²⁸ and the rights conferred by a trade mark.²⁹

However, the Member States had discretion regarding the precise way in which the Directive would be implemented in national law. Each state would remain responsible for granting trade mark registrations, and the courts of each Member State would interpret national law in light of the Directive (subject to referral to the European Court of Justice). It would be possible for a trade mark to be declared valid in the courts of one Member State and invalid in the courts of another³⁰, thus hindering harmonization of trade mark law throughout the European Community.

B. The Community Trade Mark Regulation (CTMR)

As a way to further achieve the goal of trade mark harmonization, the Council Regulation (EC) No. 40/94 of 20 December 1994 on the Community trade mark (the Community Trade Mark Regulation) was adopted. It is the fundamental text for the CTM system. The Trade Mark Directive was never intended to be an end in and of itself. Rather, it was viewed as a necessary precursor to the CTMR, which created a unitary trade mark system that governs the procedural and substantive provisions of trade mark law throughout the European Union.

The CTMR put in place a system under which an applicant may, by filing a single application, obtain one CTM registration according rights throughout the entire territory of the European Union³¹ by means of one application submitted to one office under one procedure governed by one law.³² The CTMR took a substantially different approach from the First Directive. The Trade Marks Directive focused on harmonizing the

28 First Directive, *supra* note 20, at seventh recital: Whereas attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States [...].

29 First Directive, *supra* note 20, at Art. 5, 6 and 7.

30 Frederick M. Abbott, *supra* note 6, at 379.

31 CTMR, *supra* note 1, Art. 1(2).

32 CTMR, *supra* note 1, Art. 25.

substantive national trade mark laws of the Member States, but the CTMR additionally makes detailed provision regarding the processes of application, examination, opposition, cancellation and enforcement.

Being a Regulation, it is directly applicable as the law of the Member States, and national legislatures do not have discretion as to how the rules will be implemented.³³ And as a text of Community law, it is governed by Article 249 of the EC Treaty³⁴ as well as by the principles which result from that Article, which means: direct applicability and supremacy of Community law.

Article 4 of the CTMR provides that a “Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of another undertakings.” This is a non-exhaustive list of the sorts of signs which can be registered as CTMs (all signs can potentially constitute a trade mark, including words, drawings, numbers and letters, the shape of goods, sounds, color combinations, and even smells and tastes). The only two conditions are that the sign must be capable of being represented graphically, and that the sign must distinguish the goods or services of one undertaking from those of other undertakings. If a sign cannot meet this requirement (or is devoid of any distinctive character, is a descriptive sign, is a customary sign, is a descriptive shape, is contrary to public policy or to accepted principles of morality, is deceptive, is an official or public emblematic trade mark, or is a geographical indication), these are absolute grounds to refuse its registration pursuant to Article 7(1) of the CTMR.³⁵

Moreover, Article 8 of the CTMR relates to grounds on which registration of a CTM

33 Frederick M. Abbott, *supra* note 6, at 379.

34 Now Art.288 of the Treaty on the Functioning of the European Union (TFEU) and formerly Article 189 of the EC Treaty: “A regulation shall have general application. It shall be binding in its entirety and directly applicable in all Member States.”

35 CTMR, *supra* note 1, at Art. 7(1).

may be refused, arising from some conflict with the rights of another party.³⁶

Section 3 - Applicable provisions in the assessment of a likelihood of confusion

The value of a trade mark depends on the scope of protection a trade mark system guarantees in cases of collision. In *HAG II* Advocate General Jacobs stated that “A trade mark can only fulfill that role if it is exclusive. Once the owner is forced to share the mark with a competitor, he loses control over the goodwill associated with the mark. The reputation of his own goods will be harmed if the competitor sells inferior goods. From the consumer’s point of view, equally undesirable consequences will ensue, because the clarity of the signal transmitted by the trade mark will be impaired. The consumer will be confused and misled”³⁷.

Consequently, besides the barrier that absolute grounds represent for the registration of trade mark rights, the determination of risk of confusion is the decisive element in a working trade mark protection system. Owing to that central function of the determination of risk of confusion, the tenth recital of the Preamble to the Trade Marks Directive states that “the likelihood of confusion ... constitutes the specific condition for such protection”.³⁸

The term “likelihood of confusion” is found in Articles 4(1)(b) and 5(1)(b) of the Directive, and in Articles 8(1)(b) and 9(1)(b) of the CTMR. Article 4(1)(b) of the Directive and Article 8(1)(b) of the CTMR deal with refusal of registration of a trade

36 CTMR, *supra* note 1, at Art. 8.

37 Case C-10/89, CNL Sucal v HAG GF, 1990 E.C.R. I-3711.

38 First Directive, *supra* note 20, at the tenth recital of the preamble: Whereas the protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between the mark and the sign and goods or services; whereas the protection applies also in case of similarity between the mark and the sign and the goods or services; whereas it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection; whereas the ways in which likelihood of confusion may be established, and in particular the onus of proof, are a matter for national Procedural rules which are not prejudiced by the Directive

mark by reason of a prior registration. On the other side, Article 5(1)(b) of the Directive and Article 9(1)(b) of the CTMR deal with the exclusive rights of a registered trade mark owner.

A. Assessment of a likelihood of confusion during the registration process

A sign will not be registered as a CTM if, because of its identity with or similarity to an senior trade mark, and the identity or similarity of the goods or services covered by the trade mark, there is a likelihood of confusion on the part of the public in the territory in which the senior trade mark is protected.

Article 4(1)(b) of the Directive regulates the registration of a trade mark and the validity of existing registrations, and provides that a mark shall not be registered, or if registered, shall be liable to be declared invalid if because of its identity with, or similarity to, the senior 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; the likelihood of confusion includes the likelihood of association with the senior trade mark.

Similarly, the wording of Article 8(1)(b) of the CTMR is essentially the same as Article 4(1)(b) of the Directive. Article 8(1)(b) of the CTMR provides that upon opposition by the owner of a senior trade mark the trade mark applied for shall not be registered if because of its identity with or similarity to the senior 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 senior trade mark is protected; the likelihood of confusion includes the likelihood of association with the senior trade mark.

B. Assessment of a likelihood of confusion during infringement proceedings

Furthermore, a CTM confers on its owner an exclusive right to use the trade mark and

to prevent third parties to use, without consent, the same or a similar mark for identical or similar goods and/or services as those protected by the CTM.

The grounds on which the non-consensual use by a third party of a trade mark causes an infringement are defined in Article 5(1) of the Directive. Being Article 5(1) substantially identical to Article 4(1), there is infringement under the same conditions as defined in Article 4(1).

Art. 5(1)(b) of the First Directive states that the registered trade mark shall confer on the owner exclusive rights therein. The owner shall be entitled to prevent all third parties not having his consent from using in the course of trade: any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark.

That is, the owner of the senior mark is entitled to prevent third parties not having his consent from using in the course of trade any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public.

Article 9(1)(b) of the CTMR, which is substantially identical to Article 8(1)(b) provides that the owner of a CTM is entitled to have all third parties not having his consent from using in the course of trade any sign where, because of its identity with or similarity to the CTM and the identity or similarity of the goods or services covered by the CTM and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark.

Section 4 – The Community trade mark Courts

Title X of the CTMR deals with the litigation system relating to CTMs³⁹. In general terms, it sets out the rules on jurisdiction and procedure governing any legal action involving a CTM. These Courts are obliged to enforce such Regulations and not to apply national provisions which would be in conflict with the Community rule, thus ensuring the supremacy of the Community law.⁴⁰ The European Court of Justice has the constitutional task of ensuring that in the interpretation and application of the EC Treaty the law is observed. Keystone of the coordination between the national courts and the Court of Justices tasks is the mechanism of preliminary rulings instituted by Article 234 of the EC Treaty.⁴¹

The CTM is subject to the principle of Community territoriality and its unitary nature prevents any different treatment of the trade mark in different parts of the European Union.⁴² The implementation of the law instituted by the CTMR, and in particular the implementation of the rights conferred by a CTM, are entrusted to Courts of the European Community Member States. Since the CTM is a unitary Community-wide right, the CTM system has to provide rules to identify which court in which Member State has jurisdiction to hear each case, as well as the substantive law that will be applied. It is also necessary to have rules ensuring that any decision adopted by a court of a Member State in implementation of the CTMR is recognized and, if necessary, enforced in the other Member States.⁴³ This is achieved by Title X of the CTMR.

Section 2 “Disputes Concerning the Infringement and Validity of Community Trade Marks” of Title X contains an original set of rules specifically governing disputes concerning infringement and validity of CTMs. This is the central and most innovative part of the system, pushing as far as possible the unification of the law regarding

39 CTMR, *supra* note 1, Title X: Jurisdiction and Procedure in Legal Actions relating to Community Trade Marks.

40 Case C-6/64, *Costa v. ENEL*, 1964 E.C.R. 585.

41 Now Art.267 of the Treaty on the Functioning of the European Union (TFEU) and formerly Article 177 of the EC Treaty.

42 CTMR, *supra* note 1, Article 1

43 Mario Franzosi, *European Community Trade Mark: Commentary to the European Community Regulations*, 371 (Kluwer Law International ed., 1997).

infringement within the European Union.⁴⁴

A. The Community trade mark Courts: territorial jurisdiction

First, under Article 91(1) of the CTMR, the European Community Member States are required to designate some national courts of first (trial) and second (appeal) instance to act as “Community trade mark Courts” with exclusive jurisdiction for infringement.⁴⁵ The number of such courts should be as limited as possible.

However, these courts are not “Community Courts”. They are national courts that remain part of the legal system of the Member State in which they are situated, and act as any other national court called upon to implement the Community law when implement the CTMR.

The reason behind Article 91 is the establishment of specialized courts justified by the need to ensure that a right representing such a valuable asset as a CTM is dealt with in specialized courts by judges with special knowledge and experience in trade mark cases. These courts even have jurisdiction, if so requested by the defendant in infringement proceedings by way of a counterclaim, to revoke or to declare invalid the CTM with effect for the whole territory of the European Union. If there were no such designated Community trade mark Courts, there would be a risk that in some cases the actions would be heard by courts lacking the indispensable experience related to CTMs.⁴⁶

It is important to emphasize that when such national courts are sitting as Community trade mark Courts, they will apply the substantive law of the regulation rather than the national, directive-consistent trade mark law of the state in which they sit. Certain matters are, however, left to national law, such as procedural laws, remedies for infringement other than injunctions, interim measures, and appeals. For example, an appeal goes to the Community trade mark Courts of second instance from judgments of the Community

44 Mario Franzosi, *supra* note 43, at 372.

45 For a list of CTM Courts, see http://oami.europa.eu/de/office/aspects/tmc/liste_tmc.htm.

46 Mario Franzosi, *supra* note 43, at 383.

trade mark Courts of first instance in respect of proceeding arising from relevant actions.⁴⁷ The conditions under which an appeal may be lodged with a Community trade mark court of second instance are determined by the national law of the Member State in which that court is located. National rules concerning further appeal are also applicable in respect of decisions of Community trade mark Courts of second instance.

While most of the Member States only nominated a few courts, Germany and Italy designated a large number of Community trade mark Courts. In Germany this is because of its federal system and the fact that the German States (Länder) have the competence to organize the courts, so of course every State in Germany wanted to have Community trade mark courts of its own. The Courts are supposed to be specialized in CTM law. However, some Member States have several courts and their specialization and knowledge might not always be sufficient. In Germany there are a few courts, for example München, Köln and Düsseldorf, which have the reputation for being more knowledgeable in CTM matters than others.

Second, Article 92 of the CTMR provides that Community trade mark Courts have exclusive jurisdiction for: (a) all infringement actions and all actions in respect of threatened infringement (provided they are permitted under the national law of the court having power) relating to CTMs; (b) actions for a declaration of non-infringement, if such are permitted under national law; (c) actions for reasonable compensation in respect of matters arising between the date of publication of the CTM application and the date of publication of the registration of the said mark; and (d) counterclaims for revocation or for declaration of invalidity of a CTM raised in infringement actions or actions for threatened infringement.⁴⁸

47 CTMR, *supra* note 1, Art. 101.

48 CTMR, *supra* note 1, at Art. 92: The Community trade mark courts shall have exclusive jurisdiction:

- (a) for all infringement actions and — if they are permitted under national law — actions in respect of threatened infringement relating to Community trade marks;
- (b) for actions for declaration of non-infringement, if they are permitted under national law;
- (c) for all actions brought as a result of acts referred to in Article 9 (3), second sentence;
- (d) for counterclaims for revocation or for a declaration of invalidity of the Community trade mark

Article 91 must be seen in the light of the unitary set of rules on international jurisdiction contained in Article 93, according to which it can be established in each case in which Member State a court has jurisdiction for dealing with infringement and invalidity proceedings. Article 93 of the CTMR determines the jurisdictions in which the CTM registrant may bring enforcement proceedings:

1. the Member State in which the defendant has his domicile (its registered office in case of a legal person),
2. the Member State where the defendant has an establishment,
3. the Member State where the plaintiff has his domicile (its registered office in case of a legal person),
4. the Member State where the plaintiff has an establishment,
5. the Member State where the OHIM has its seat, i.e. Spain.

It is through these two main instruments that the CTMR governs jurisdiction for the legal actions mentioned above: first, the designation by each EC Member State of a number as limited as possible of so-called “Community trade mark Courts”; second, a set of rules of choice of jurisdiction to the effect that in each case, regardless of whether the parties have their domicile within or beyond the European Union, a competent court can always be clearly identified.⁴⁹

This thesis will focus exclusively on actions for infringement of a CTM. For infringement actions the plaintiff has in each case the choice between two alternative jurisdictions:

1. a court situated in the Member State where the defendant (the alleged infringer) has his domicile or, if this criterion fails, in a Member State determined by applying some subsidiary criteria, (Article 93(1) to (3)), or
2. a court situated in the Member State where the act of infringement was committed (Article 93(5)).

pursuant to Article 96.

⁴⁹ CTMR, *supra* note 1, Art. 93.

B. The legal effect of the Community trade mark Courts' judgments

By virtue of Article 94 of the CTMR, the choice between the two alternatives stated in Article 93 has consequences regarding the extent of the jurisdiction of the court having power. That is, the extent of the jurisdiction which will vary according to these two alternatives. A court whose jurisdiction is based on the domicile of the parties has jurisdiction in respect of any act of infringement committed within the European Union, and therefore the jurisdiction of that court extends for relevant matters to the whole of the European Union. In contrast, if a court has jurisdiction based on the place where infringement took place (or threatens to take place), it has jurisdiction only in respect of acts of infringement committed within the territory of the Member State where it is situated.

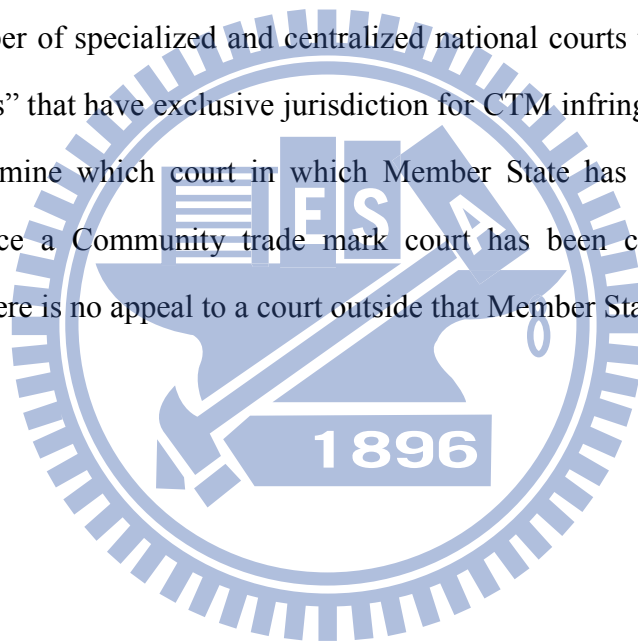
As for procedural matters in disputes concerning infringement or validity, Article 97(3) provides that each Community trade mark court has to apply the rules of procedure that govern the same type of actions relating to a national trade mark under its national law. In other words, an action for infringement of a CTM will be dealt with by the competent Community trade mark court, from the procedural point of view, as if it were an infringement action of a national trade mark of the Member State where the court is situated. This rule applies to each of the three possible court levels which are usually opened to the parties under national procedural law.

According to Article 101(1) there is a right to appeal against a decision reached by a Community trade mark court of first instance before the competent Community trade mark court of second instance. According to Article 101(3) a further appeal against a decision by a Community trade mark court of second instance can be lodged before the higher national judicial level.

In sum, to create a common market in Europe by harmonizing trade mark law

throughout the European Community, the First Directive and the CTMR were adopted. The Directive to approximate the laws of the Member States relating to trade marks was intended to harmonize the disparities in trade mark law that impeded the free movement of goods and the provision of services within the European Union.

The adoption of the CTMR was a further step to achieve this trade mark harmonization. It created a unitary trade mark system, allowing the registration of one CTM that is valid throughout the entire territory of the European Union. The protection of these trade marks requires a finding of a “likelihood of confusion”, which is regulated in Articles 8(1)(b) and 9(1)(b) of the CTMR. The CTMR requires that Member States designate a number of specialized and centralized national courts to act as “Community trade mark Courts” that have exclusive jurisdiction for CTM infringement cases, and also has rule to determine which court in which Member State has jurisdiction to hear a certain case. Once a Community trade mark court has been chosen in a particular Member State, there is no appeal to a court outside that Member State.



Chapter 3 – Elements for the assessment of a likelihood of confusion in the OHIM and the ECJ

In this chapter, we will analyze the factors developed by the OHIM⁵⁰ as well as by the ECJ case law in the assessment of a likelihood of confusion between two marks. First, the OHIM principles in determining the existence of a likelihood of confusion are explained. Second, the four cases in which the ECJ developed the criteria for the assessment of a likelihood of confusion will be introduced and summarized.

Section 1 – Likelihood of Confusion in the Board of Appeals of the OHIM

The Boards of Appeal are responsible for deciding on appeals from decisions of the examiners, Opposition Divisions, Administration of Trade Marks and Legal Division and Cancellation Divisions.⁵¹ For the reasons outlined by Advocate General Francis Jacobs in his opinion in the *Sabèl* case, the standards developed by the Court to be observed in determining risk of confusion will have to be applied by the OHIM as well.

Basically these criteria have to be applied in the same way when the national courts decide on infringement cases - irrelevant whether they apply CTM law or national law, as by the directive the trade mark law of the Member States must be harmonized. These factors were developed from the standards set up by the ECJ in its four leading cases related to the assessment of a likelihood of confusion. Thus, both set of factors are consistent, although the OHIM has developed a few additional factors that will be introduced in this section.

The Opposition Guidelines⁵² of the OHIM list a number of principles that have been derived from practice, in particular from the cases decided by the Opposition Division and the Boards of Appeal. While these principles must be applied in general, it may

50 Office for Harmonization in the Internal Market.

51 CTMR, *supra* note 24, at Art. 130.

52 <http://oami.europa.eu/ows/rw/pages/CTM/legalReferences/guidelines/guidelines.en.do>

happen that exceptions to these principles may apply depending on the specific case. A likelihood of confusion depends in particular on the relevant factors set out below:

1. Degree of similarity of the goods and services in question; where the applicant has requested the opponent to furnish proof of use, those goods and services have to be compared for which the opponent has established use;
2. Degree of similarity of the signs;
3. Degree of distinctiveness (inherent or acquired), strength or reputation of the senior mark;
4. The degree of sophistication and attention of the relevant public, i.e. of the actual or potential customers of the category of goods or services in question;
5. Coexistence of the conflicting marks on the market in the same territory;
6. Incidences of actual confusion;
7. Prior decisions by Community or national authorities involving conflicts between the same (or similar) marks.⁵³

The question as to whether or not there is a likelihood of confusion has to be determined in the light of the preceding factors and of any other factors that may be relevant in the specific case.

The Opposition Division takes into consideration the overall appearance of the two trade marks in a visual or phonetic respect, and also considers their potential meaning. It also emphasizes that, in particular, the different and dominant elements have to be considered.

Moreover, in determining the similarity of goods and services, which is one of the relevant factors for determining a likelihood of confusion, the following relevant factors were identified: nature, purpose, method of use, complementary character, and

⁵³ Opposition Guidelines, Part C, Part 2, Chapter 2 Identity and likelihood of confusion: A. General Remarks, III-4 Assessment of likelihood of confusion: Overview of the criteria, http://oami.europa.eu/ows/rw/resource/documents/CTM/guidelines/opposition_general_en.pdf.

competitive character, channels of distribution, relevant public, and usual origin of the goods/services. In particular, the criteria defining the likelihood of confusion between the goods or services are their composition, functioning principle, physical condition, appearance, and value.

In addition, the OHIM Opposition Guidelines have analyzed and defined the term “relevant public” in the factors for determination of a likelihood of confusion.⁵⁴ A likelihood of confusion on the part of the public includes all the instances where the public may come into contact with the senior and the junior mark or with both. Thus, consideration must be given to pre-sale confusion, e.g. confusion arising in the course of advertising of goods or services; to confusion at the time or in the context of purchasing the goods or services, such as when making purchases in a supermarket, by telephone, by mail-order, or through the Internet; and to post-sale confusion, i.e. to confusion arising after the goods or services have been purchased; this is relevant for example when packaged goods are purchased and the confusion arises only when the goods are unpacked; or where the goods or services are purchased by “discriminating” purchasers but are actually used by a broader category of users (members of the family, etc.).

The European Court of Justice has so far mainly equated the relevant public with the average “consumer”. The Opposition Guidelines state that the term “consumer” should be taken to include the “ultimate” consumer, who may be “consuming” the goods or services in his private activity, or who may be a professional “ultimate” consumer. However, there are also goods/services that are bought by persons in the production or distribution (i.e. wholesalers or retailers) chain, which are usually not referred to as “consumers”. The broader term average “customers” appears to be better suited to include those in the production and distribution chain. The term *customers* always refers to the *actual* and the *potential* customers, that is, the customers that currently are or in the future may be purchasing the goods/services. The potential customers include those customers who, in

⁵⁴ Ibid., at III-6 Relevant public.

the usual course of events, are likely to buy the goods/services (e.g. a family member buys a good or service he/she does not need for another family member).

Furthermore, if a *significant* part of the relevant public may be confused as to the origin of the goods, this is sufficient to establish a likelihood of confusion. There may be several distinct groups of customers for one and the same good or service, and all may have a substantial size, i.e. there may be several relevant publics. In such a case, each of these distinct publics may have characteristics of their own. A likelihood of confusion may then differ, depending on the respective group. If the examiner finds a likelihood of confusion with respect to one group of a substantial size only, this will be a sufficient basis for finding a likelihood of confusion.

The OHIM will also take into consideration the existence of more or less similar registered trade marks when considering risk of confusion between two marks in opposition proceedings.

Finally, the similarity of the goods and services in question is assessed from a commercial perspective. The examiner must consider the marketplace realities that characterize the relationship of the goods and services under comparison. These marketplace realities will again often also play an important role in the global assessment of a likelihood of confusion. For instance, the features of the goods may have an impact on the degree of attention of the customer: in the cases of expensive purchases (such as cars), the degree of attention is usually higher than where the buying behavior is casual (e.g. sweets).⁵⁵ Finally, the relevant moment for assessing a likelihood of confusion is the time when the decision is taken.⁵⁶

The factors for the assessment of a likelihood of confusion in the Opposition Guidelines of the OHIM are mostly the same as those stated in the case law of the ECJ. The small difference is that the OHIM includes the coexistence of the conflicting marks

55 Opposition Guidelines, Part C, Part 2, Chapter 2 Identity and likelihood of confusion: A. General Remarks, III-8 Similarity of goods/services.

56 Ibid., at III-9 The relevant point in time.

on the market in the same territory, incidences of actual confusion, and also prior decisions by Community or national authorities involving conflicts between the same or similar marks. These three factors are not within those developed in the case law of the ECJ for the assessment of a likelihood of confusion.

Section 2 - Likelihood of confusion in the case law of the European Court of Justice

Article 234 of the EC Treaty provides that the Court of Justice has jurisdiction to give preliminary rulings notably in connection with the interpretation of the EC Treaty and the validity and interpretation of acts of the institutions of the European Union in order to ensure that there is a single, uniform interpretation of Community law, and in particular of the rules of Community law with direct effect, by national courts or tribunals. Consequently, any preliminary ruling by the Court of Justice on a question of Community law is binding upon any national court or tribunal in a dispute in connection with the relevant Community law provisions or acts. That is, the ECJ gives guidance as to the interpretation of the Treaty (or Community measures made thereunder) and the national tribunal is to apply such an interpretation to the cases before it.

The European Court of Justice has interpreted the concept of a likelihood of confusion in several occasions in the context of the identical provision of Article 4(1)(b) of the Directive to approximate the laws of the Member States relating to trade marks. The European Court of Justice has stated that its interpretation of Article 4(1)(b) also applies to Article 5(1)(b).⁵⁷

Furthermore, that both provisions in the Directive as well as in the CTMR have to be interpreted in the same manner has been stressed by the Advocate General⁵⁸ Francis

⁵⁷ Case C-425/98, *Marca Mode v. Adidas*, 2000 E.C.R. I-4861.

⁵⁸ The Advocate General is a figure whose duty is to “present to the ECJ reasoned submissions on cases to assist the ECJ in the performance” of its duties under the Treaty of Rome. Tessensohn, *May You Live in Interesting Times – European Trademark Law in the Wake of Sabèl BV v. Puma AG*, 6 *Journal of Intellectual Property Law* 217, at 248 n.137 (1999). The Advocate General must “analyze the case in an impartial and independent manner and their submissions ‘are objective and do not represent the views of either party’”. *Id.* (quoting Penelope Kent, *European Community Law* 18 (1992).

Jacobs in his opinion delivered in the Sabèl case⁵⁹: “It is also relevant to note at this point the establishment of the CTM under the CTMR, which, as mentioned above, contains provisions relating to confusion between which are virtually identical to those in the Directive. It is clearly appropriate that the provisions of the Directive should be interpreted in the same way as the corresponding provision of the Regulation”.⁶⁰

The basic legal requirements for determining a likelihood of confusion under the CTMR are laid down in Article 8(1)(b) and the seventh recital to the CTMR. The seventh recital states that a likelihood of confusion constitutes the specific condition for the protection afforded by the CTM and that the concept of similarity must be interpreted in relation to the likelihood of confusion: “Whereas the protection afforded by a CTM, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between the mark and the sign and the goods or services; whereas the protection applies also in cases of similarity between the mark and the sign and the goods or services; whereas an interpretation should be given of the concept of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which 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, constitutes the *specific condition* for such protection.” Furthermore, in cases in which only similar trade marks and/or goods/services are at issue, Article 8(1)(b) of the CTMR requires a risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings.

The interpretation of Article 4(1)(b) of the Directive came before the European Court of Justice for the first time in Sabèl v. Puma⁶¹. The Court has construed the concept

59 Case C-251/95, Sabèl v. Puma, 1997 E.C.R. I-6191.

60 Sabèl, *supra* note 59, at paragraph 52.

61 Sabèl, *supra* note 59.

of the likelihood of confusion in three other rulings where it has set out the principles for the assessment of a likelihood of confusion. These four cases which will be discussed in chronological order. Lastly, the Court's statements have been grouped beneath headings that correspond to the issues arising from these provisions.

A. Sabèl BV v. Puma AG, Rudolf Dassler Sport

The interpretation of Article 4(1)(b) of the Directive came before the European Court of Justice for the first time in Sabèl v. Puma. Puma, a registered owner of a trade mark depicting a bounding/running puma, opposed registration of a mark by Sabèl that consisted of a bounding/running cheetah. The Bundesgerichtshof (Supreme Court of Germany) inquired two issues:

- How should one approach the issue of making a comparison of marks in general terms?
- Was the mere fact that the public might associate goods bearing the respective marks with one another itself a ground of confusion?

In summary, the ruling said: "The appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, on the association that the public might make between the two marks and the degree of similarity between the signs and the goods. The likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case."⁶²

As the average consumer normally perceives a mark as a whole and does not analyze its various details, the global appreciation of the oral, visual and conceptual similarity of the marks in question must be based on the overall impression the marks convey, bearing in mind, in particular, their distinctive and dominant components.⁶³ Simultaneously, account needs to be taken of the fact that the average consumer only

62 Sabèl, *supra* note 59, at paragraph 22.

63 Sabèl, *supra* note 59, at paragraph 23.

rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.⁶⁴

Moreover, the more distinctive the senior mark, the greater will be the likelihood of confusion.⁶⁵ It is not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the senior mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public. However, where the senior mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.⁶⁶ Mere association that the public might make between the two marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion.⁶⁷

B. Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.

The case *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (hereinafter, “*Canon v. MGM*”⁶⁸) was built on the *Sabèl* ruling. This case, also referred to the ECJ from Germany, turned on whether there was a likelihood of confusion between the senior registered work mark CANON for pre-recorded video tapes and the applicant’s sign CANNON for blank video tapes.⁶⁹ This was a case in which the competing marks were both visually and aurally (but not conceptually) similar, unlike *Sabèl*, which was a case in which the principal similarity between the marks was conceptual.

The ECJ did have the chance in *Canon v. MGM* to "give guidance on the assessment of similarity of goods as an element necessary to confirm or deny risk of confusion." The

64 *Sabèl*, *supra* note 59, at paragraph 23

65 *Sabèl*, *supra* note 59, at paragraph 24.

66 *Sabèl*, *supra* note 59, at paragraphs 24 and 25.

67 *Sabèl*, *supra* note 59, at paragraph 26.

68 Case C-39/97, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, 1998 E.C.R. I-5507.

69 *Canon*, *supra* note 68, at paragraphs 4 and 5.

Supreme Court of Germany asked the ECJ whether, on a proper construction of Article 4(1)(b) of the Directive, the distinctive character of the senior trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

The ECJ analysis began by quoting the tenth recital of the First Directive which stresses the importance of interpreting the concept "similarity" in relation to "likelihood of confusion," where a likelihood of confusion is dependent upon many factors, inter alia, the recognition of the trade mark by the public as well as the extent of similarity between both the senior mark, the third party mark, and the goods covered.

When examining whether the public is likely to be confused, such "likelihood" has to be "appreciated globally taking into account all factors relevant."⁷⁰ Following the proposition espoused in *Sabèl*, namely that the "more distinctive the senior mark, the greater the risk of confusion," the ECJ concluded that if there is a lesser degree of similarity between the goods or services covered, and if the marks have a high degree of similarity and the senior mark has a distinctive character, registration may be refused.⁷¹ This determination by the ECJ answered the Bundesgerichtshof's question affirmatively, recognizing that the distinctive character of a senior trade mark, e.g., its reputation, can be taken into account when determining the similarity between the goods or services covered by the rival trade marks, and can be sufficient to give rise to the likelihood of confusion.

In assessing the similarity of the goods and services, all relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, the purpose for which they are used and their method of use, and

⁷⁰ Canon, *supra* note 68, at paragraph 16 (. Conducting this "global assessment" involves a consideration of the relationship between the relevant factors, such that a lesser degree of similarity between the trade marks may be offset by a greater degree of similarity between the goods or services, and vice versa.

⁷¹ Canon, *supra* note 68, at paragraphs 18 and 19 (citing *Sabèl*, at paragraph 24).

whether they are in competition with each other or are complementary.⁷² Further criteria to be observed in the assessment of similarity of goods and services are the product's manufacturers and their relevant distribution channels and retail outlets.⁷³

Moreover, there is interdependence between the relevant factors and in particular a similarity of the marks and the similarity of the goods. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the facts and circumstances of the case.⁷⁴

In particular, the distinctive character of the senior mark and in particular its reputation must be taken into account when determining whether the similarity between the goods and services is enough to give rise to the likelihood of confusion.⁷⁵ Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character. Consequently, a lesser degree of similarity between the goods and services covered may still cause risk of confusion if the marks are very similar and the senior mark, in particular because of its reputation, is highly distinctive. It also follows that registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the senior mark has a reputation and is highly distinctive.⁷⁶

Furthermore, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion. By contrast, there can be no such likelihood where the public does not think that the goods come from the same undertaking (or from economically linked undertakings).⁷⁷

72 Canon, *supra* note 68, at paragraph 23.

73 Canon, *supra* note 68, at paragraph 28.

74 Canon, *supra* note 68, at paragraph 17.

75 Canon, *supra* note 68, at paragraph 24.

76 Canon, *supra* note 68, at paragraphs 18 and 19.

77 Canon, *supra* note 68, at paragraphs 29 and 30.

C. Lloyd Schuhfabrik Meyer v. Klijsen Handel BV

Unlike the Sabèl and Canon decisions, Lloyd Schuhfabrik Meyer v. Klijsen Handel BV (hereinafter, “Lloyd”⁷⁸) arose from a trade mark infringement action and was referred from Germany. The German owner of the LLOYD trade mark for shoes sued the Dutch manufacturer of LOINT’S shoes alleging a likelihood of confusions based on aural similarity between the marks.⁷⁹

The District Court Munich I (Landgericht München I) decided to stay proceedings and to refer the following questions to the Court of Justice for a preliminary ruling: Does it suffice, for there to be a likelihood of confusion due to the similarity between the sign and the trade mark and identity of the goods or services covered by the sign and the mark, that the mark and the sign each consist of a single syllable only, are identical in sound at the beginning, in their combination of vowels and in the single final consonant ("t" instead of "d") which includes an "s"? Specifically, do the designations "Lloyd" and "Loint's" for shoes conflict? Is a trade mark to be taken to have an enhanced distinctive character simply because it has no descriptive elements?

Accordingly, by its questions, where it is appropriate to examine together, the German national court is seeking clarification from the European Court on the following matters:

- The criteria to be applied in assessing the likelihood of confusion within the meaning of Article 5(1)(b) of the Directive;
- The significance to be attached to the wording that the likelihood of confusion includes the “likelihood of association” with the senior mark; and
- The effect to be ascribed, in assessing the likelihood of confusion, to the fact that the mark is highly distinctive.

78 Case C-342/97, Lloyd Schuhfabrik Meyer v. Klijsen, 1999 E.C.R. I-3819.

79 Canon, *supra* note 68, at paragraphs 29 and 9.

In that regard, the national court raises, first, the question whether a likelihood of confusion can be based solely on the aural similarity of the marks in question and, second, whether the mere fact that a mark has no descriptive elements is sufficient for it to have an enhanced distinctive character.

In determining the distinctive character of a mark and accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods and services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.⁸⁰ However, it is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character.⁸¹

Furthermore, the level of attention of the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, varies according to the category of the goods and services in question. Account should also be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.⁸²

80 Lloyd, *supra* note 78, at paragraph 23.

81 Lloyd, *supra* note 78, at paragraph 24.

82 Lloyd, *supra* note 78, at paragraph 26.

Finally, when assessing the degree of visual, phonetic and conceptual similarity it can be appropriate to evaluate the importance attached to each by reference to the category of goods and the way they are marketed. It is possible that mere aural similarity could lead to a likelihood of confusion.⁸³

D. Marca Mode CV v. Adidas AG and Adidas Benelux BV

The main issue to be decided in *Marca Mode v. Adidas*⁸⁴, referred to the ECJ by the Dutch Hoge Raad (Supreme Court of the Netherlands), was the influence of a particularly distinctive character on the risk of confusion. In this case, the Dutch Hoge Raad inquired whether in the case of a particularly distinctive mark and where a third party uses a similar sign for similar goods, a likelihood of confusion could be presumed to exist due to the likelihood of association between the sign and the trade mark.

The Court stressed that even where an identity of goods, a high reputation and a possibility of association are given, confusion cannot be presumed. There must always be a positive finding of a likelihood of confusion by the national court on the basis of the facts and evidence put forward in the proceedings.⁸⁵ That is, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion in the strict sense, even if a trade mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public, or even where a third party, without the consent of the owner of the mark, uses, in the course of trade in goods or services which are identical with, or similar to, those for which the trade mark is registered, a sign which so closely corresponds to the mark as to give the possibility of its being associated with that mark.⁸⁶

E. Criteria for the assessment of a likelihood of confusion

⁸³ Lloyd, *supra* note 78, at paragraph 28.

⁸⁴ Case C-425/98, *Marca Mode v. Adidas*, 2000 E.C.R. I-4861.

⁸⁵ *Marca Mode*, *supra* note 84, at paragraph 39.

⁸⁶ *Marca Mode*, *supra* note 84, at paragraph 41.

In conclusion, the criteria developed by the European Court of Justice in these four cases are summarized below:

1. Global appreciation

The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. The appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”.

2. Interdependence between the factors

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Therefore, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa.

It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the senior mark, in particular its reputation, is highly distinctive. Also, there may be a likelihood of confusion, notwithstanding a low degree of similarity between the marks, where the similarity of the goods or services covered is high and the senior mark possesses a strong distinctive character.

Moreover, the more distinctive the senior mark, the greater will be the likelihood of confusion.

Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive

character. It is therefore possible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the senior mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.

However, when the senior mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.

3. Average consumer

For the purposes of global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect.

However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.

It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

4. Visual, aural or conceptual similarity

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The reason is that the average consumer normally perceives a mark as a whole and does not proceed to analyze its various details.

In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements,

taking account of the category of goods or services in question and the circumstances in which they are marked.

Mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5(1)(b) of the Directive.

5. Similarity of goods or products

It is important to stress that, for the purposes of applying Article 9(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered.

In assessing the similarity of the goods or services concerned all the factors relevant to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

6. Distinctive character

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make 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.

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

chambers of commerce and industry or other trade and professional associations.

It follows that it is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character.

7. Association is not tantamount to confusion

A likelihood of confusion cannot be inferred, but must be proved. Even where an identity of goods, a high reputation and a possibility of association are given, confusion cannot be presumed. There must always be a positive finding of a likelihood of confusion by the national court on the basis of the facts and evidence put forward in proceedings.



Chapter 4 - Elements for the assessment of a likelihood of confusion in the Community trade mark Courts

There is no single court system ending up in one court of last instance that is competent for infringement cases, but there are in fact 27 national court systems with different sets of procedural law, and as to the remedies for infringement (damages, provisional measures), also diverse provisions of substantive law. Rulings as to the validity of the trade mark, however, can have effect in all Member States of the European Union. Thus, different national court systems might be an obstacle to the achievement of consistent jurisprudence throughout the European Union.⁸⁷

Spain has designated one Community Trade Mark Court of First Instance and one of Second Instance; Great Britain has designated two of each category, and Germany eighteen of each. Due to the language barrier, in this thesis The author only focused on the Community trade mark Court cases of Spain, UK and Germany. In this chapter, eleven Spanish cases have been analyzed. These cases consist of all Spanish Community trade mark Court cases between 2007 and 2009 that are related to the analysis of a likelihood of confusion for the CTM. A total of seven United Kingdom cases were analyzed, consisting of those United Kingdom Community trade mark Court cases after 2004 that concern the likelihood of confusion for the CTM. Lastly, ten German Community trade mark Court cases were analyzed, consisting of those German Community trade mark Court cases after 2007 that are related to the likelihood of confusion for the CTM.

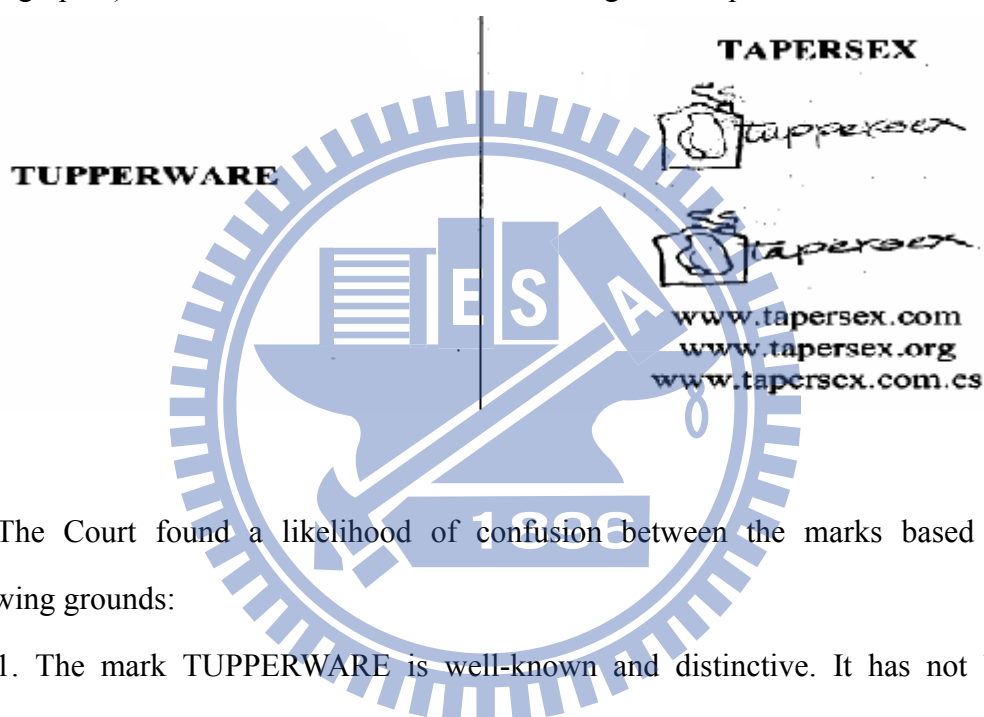
A. Spain

1. Dart Industries v. Eva Moreno Arjona (16 June 2009)

⁸⁷ Lutz van Raden, *Community Trademark Courts – German Experience*, 34(3) *International Review of Intellectual Property and Competition Law* 270-277, at 275 (2003)

Juzgado de lo Mercantil No. 2 de Alicante

The claimant Dart Industries is the owner of the CTM “TUPPERWARE” for hermetic plastic containers for food and also for services that organize meetings allowing consumers to examine and purchase its food containers in their own homes. Defendant organizes meetings for the purpose of promoting and selling products in relation to sex under the signs “TUPPERSEX” and “TAPERSEX”, both word-marks and mixed (word-graphic) marks. Claimant’s and defendant’s signs are represented below:



The Court found a likelihood of confusion between the marks based on the following grounds:

1. The mark TUPPERWARE is well-known and distinctive. It has not become generic even through widespread use of TUPPERWARE for hermetic plastic containers for food.

2. Similarity of the marks: it should be noted that the identification, delimitation and distinction between complex (mixed) marks should not be determined graphically, but through studying and analyzing their denomination (grammatical-conceptual), because it is the nomenclature that defines these type of marks. Therefore, when examining these marks, the phonetic-grammatical analysis prevails over the graphical analysis.⁸⁸ That is, when determining the distinctiveness of the senior mark, the graphic element is not the

88 Sentencia AP Caceres, 17 May 2005.

one that singularizes and differentiates the complex mark when it is graphic-denominative, since it is evident that “things are asked by their names” and “signs are not pronounced”. Therefore, when comparing a complex mark and a word mark, the dominant element in the mixed mark is the word element, which prevails over the graphic element.⁸⁹ Moreover, when the element that dominates the mixed mark as a whole is identical to the element that dominates the other sign, then they are similar.⁹⁰

In the present case, TUPPERWARE and TUPPERSEX are, evidently, graphically similar. They are also phonetically similar when taking in account the English pronunciation of the word TUPPER. However, there is a conceptual difference between the two marks. In conclusion, even though the marks are not identical, they are similar due to the same beginning “TUPPER”, which is distinctively strong.⁹¹

3. With no doubt, the services are similar. Defendant organizes meetings for the purpose of promoting and selling erotic products at consumers’ homes, which coincide with claimant’s services, which organizes meetings allowing consumers to examine and purchase its food containers in their own homes.⁹²

4. Association: There is a risk that the public might think that the services come from the same company.⁹³

5. The relevant average consumer: in this case the relevant consumers are women of any age, willing to offer their homes for these meetings. It is not a specific public with concrete interests, since the services are targeted at all women in general and all are potential consumer of such services.⁹⁴

In conclusion, the signs TUPPERSEX and TAPERSEX infringe claimant’s CTM rights under CTMR 9(1)(b).

89 Sentencia AP de Valencia, sec.9, 20 June 2005.

90 Case T-6/01, Matratzen Concord v. OAMI, 2002 E.C.R. II-4335.

91 Dart Industries v. Eva Moreno Arjona (16 June 2009), at 14 & 15.

92 Dart Industries, *supra* note 91, at 15.

93 Dart Industries, *supra* note 91, at 16.

94 Dart Industries, *supra* note 91, at 16.

2. The O Company NV v. Aigues del Montseny SA (09 September 2008)

Juzgado de lo Mercantil No. 1 de Alicante

The claimant is the owner of the three-dimensional CTM registered for “mineral waters, sodas, and others non-alcoholic drinks enriched with oxygen; drinks and fruit juices enriched with oxygen, etc.” in Class 32.⁹⁵

The CTM is represented below:



Taking into account the product's price and their being supplied at high-class restaurants, they are regarded as luxury products. They are marketed in this form:⁹⁶



The claimant accuses the defendant Aigues el Montseny of infringing its CTM since there is a likelihood of confusion under CTMR Art. 9(1)(b). Defendant markets its waters

⁹⁵ The O Company NV v. Aigues del Montseny SA (09 September 2008), at paragraph 9.

⁹⁶ The O Company, *supra* note 95, at paragraph 9.

in the bottle that is reproduced below:⁹⁷



The Court found a likelihood of confusion between the marks based on the following grounds:

1. The CTM is distinctively strong, even though it is a simple geometrical form. The distinctiveness depends on multiple factors, for example, how intensive, geographically widespread and long-standing use of the mark has been.⁹⁸

2. Similarity of the marks: First of all, it is to be noted that the comparison should be made between the defendant's bottle and claimant's CTM without taking into account the denomination OGO on its bottle.⁹⁹ The bottle mark of the claimant and the bottle used by the defendant are highly similar, although not identical. Both present a spherical body with a rounded hollow base. Moreover, the differences, for example a smaller size of bottleneck, are not visually dominant. Thus, the Court concluded that there was a high degree of similarity between the products in question because the visual similarity is the determining element in three-dimensional marks.¹⁰⁰

3. Similarity of products: both products are of the same kind, namely water. Moreover, as is the claimant's product, defendant's products are also regarded as

97 The O Company, *supra* note 95, at paragraph 9

98 The O Company, *supra* note 95, at paragraph 14

99 The O Company, *supra* note 95, at paragraph 11

100 The O Company, *supra* note 95, at paragraph 13

“designer waters”. Therefore, the products are identical.¹⁰¹

4. The intensity of the external similarity between the products causes a risk that consumers believe both products come from economically-linked undertakings.

5. The relevant consumers are expected to have a higher degree of attention when they encounter luxury goods.¹⁰²

6. The defendant didn’t act in bad faith. However, this is not a necessary condition for a finding of a likelihood of confusion.¹⁰³

7. The bottle design used by defendant is registered as a national industrial design. However, this is not a factor in determining the inexistence of a likelihood of confusion.¹⁰⁴

3. George V Restauration v. Compañía Hostelera Maktub (04 June 2008)

Juzgado de lo Mercantil No. 2 de Alicante

The claimant is the owner of two registered CTMs: first, the word mark BUDA BAR for various products and services, including restaurant and food services, clothing, furniture; second, the word mark BUDDHA BAR for the same products and services as the first. The claimant alleges that defendant’s use of “BUDDHA DEL MAR”, “BUDDHA DEL SOL” and “BUDDHA HOME” for bar-restaurant and services, clothing articles and furniture stores infringes claimant’s CTM.

The Court found that there was a likelihood of confusion, and consequently infringement under Art. 9(1)(b), based on the following reasons:¹⁰⁵

101 The O Company, *supra* note 95, at paragraph 13

102 The O Company, *supra* note 95, at paragraph 14

103 The O Company, *supra* note 95, at paragraph 15.

104 The O Company, *supra* note 95, at paragraph 16.

105 George V Restauration v. Compañía Hostelera Maktub (04 June 2008), at 12 – 15.

1. The claimant's mark is well-known. Moreover, the mark has an increased distinctive strength with respect to services so far away from its own philosophical and religious meaning, like discotheques and restaurants.

2. Similarity between the marks: in the present case, which concerns complex (mixed) marks, if the dominant element which gives the overall impression is identical to the dominant element in the other sign, then there is similarity of marks.¹⁰⁶ There is no doubt that in the present case, in each and every mark the dominant element is the term BUDA or BUDDHA. This is always the beginning part in the mixed mark and it is distinctive by itself. It is obvious that the marks are phonetically and conceptually very similar.

3. Similarity between products and services: some factors that need to be considered when determining similarity of products are services are their nature and purpose for which they are used. There is identity in restaurant services and clothing articles. Moreover, discotheques and restaurant services are complementary of each other.

4. The likelihood of association has also been taken into account.

5. The relevant public is used to night life leisure, young and with a medium-level of purchasing power. Moreover, dancing often follows dinner, and many establishments offer both services.

4. L'ORÉAL SA v. Yesensy España SL (04 December 2007)

Juzgado de lo Mercantil No. 1 de Alicante

The claimant L'Oreal is the owner of the CTM "DOUBLE EXTENSIÓN" (word mark) for Class 3 products, which includes cosmetic products. It alleges that defendant infringes its trade mark by using the expression "DOUBLE EXTENSION YESENSY" on its mascara products.

106 Matratzen, *supra* note 90.

The Court concluded that there is a likelihood of confusion between defendant's sign "DOUBLE EXTENSION YESENSY" and claimant's CTM "DOUBLE EXTENSIÓN" based on the following reasons:¹⁰⁷

1. The registered mark is of average distinctive character and is well-known.
 2. There is an identity of products (mascara).
 3. Similarity of marks: both marks are similar. The sign of the defendant reproduces the claimant's CTM with only insignificant differences that might be overlooked in the eyes of the average consumer.
 4. Association: Since the consumers usually do not have the chance to compare both marks side-by-side, they must rely on the imperfect impression that they have of the mark and might associate "DOUBLE EXTENSION YESENSY" with "DOUBLE EXTENSION" by L'Oreal, thinking that they come from the same or economically-related undertakings.
 5. Relevant consumer: The relevant consumers for this type of products buy them without the assistance of sellers through self-service and in massive quantities.
 6. There have been no incidences of actual confusion.
- Therefore, defendant infringed claimant's CTM.

5. WV Beheer BV v. Arfasy SL and Disconet Salou SL (05 November 2007)

Juzgado de lo Mercantil No. 1 de Alicante

The claimant is the owner of the CTM "COOLDOWN CAFÉ" registered for services in Class 42 (accommodation reservations, hotel services, bar, café, and related services.). The claimant alleged that defendant infringed its CTM by using, in its business premises and advertising, the sign "COOLDOWN CROCS" and sometimes only "COOLDOWN" for the same services in a discotheque/party hall in Salou.¹⁰⁸

¹⁰⁷ L'Oréal v. Yesensy (04 December 2007), at 3 – 5.

¹⁰⁸ WV Beheer v. Arfasy (05 November 2007), at 2.

The Court concluded that there is a likelihood of confusion between defendant's sign "COLDDOWN CROCS" and claimant's CTM "COOLDDOWN CAFÉ" based on the following reasons:

1. Similarity of the marks: the Court held that defendant's sign is similar to the claimant's mark. "COOLDDOWN" is prominently displayed and therefore is the one that leaves the impression on the relevant public. The essential part, "COOLDDOWN", appears on both signs, where the only difference is between the generic term CAFÉ and the expression CROCS.

2. The products or services protected by the CTM and those of the sign are substantially identical. The services are places for leisure with music and drinks, called either bars, pubs, or discos.

3. Association: It is very likely that the average consumer considers that the products or services come from the same undertaking or from economically-linked undertakings.

4. The average consumer is the Dutch public.¹⁰⁹

6. Sogico SA v. Bambus 2000 SL, et al. (13 July 2007)

Juzgado de lo Mercantil No. 1 de Alicante

The claimant is the owner of the CTM "HYDROSTAR" which is shown below and is protected for the services of car reparation, construction, car wash, car cleaning, machinery installation, and car maintenance. The services exclude the construction, installation and assembly of hydraulic equipment and automobile tires, as well as their maintenance and reparation.¹¹⁰

HYDROSTAR

¹⁰⁹ WV Beheer v. Arfasy (05 November 2007), at 2 – 3.

¹¹⁰ Sogico SA v. Bambus 2000 SL, et al. (13 July 2007), at 3.

The defendant applied to register the sign depicted below for services of representation of machinery and its accessories, as well as its export and import. The sign was also applied for construction, installation and assembly services of hydraulic equipment and automobile tires, as well as their maintenance and reparation.¹¹¹



The defendant used this sign in connection with car wash installation, and the claimant alleges that by doing so, it infringes claimant's CTM.

The Court concluded that there is a likelihood of confusion between defendant's complex (mixed) sign "HIDROSTAR" and claimant's CTM "HYDROSTAR" based on the following reasons:

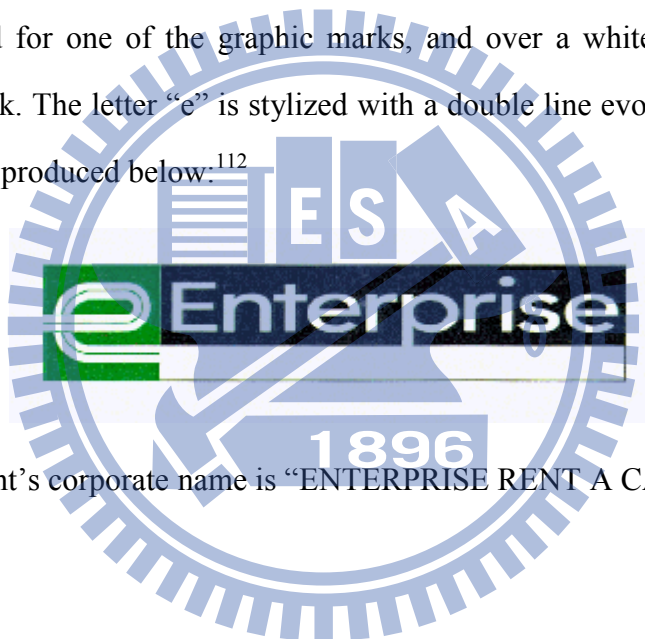
1. The services are similar.
2. The signs are conceptually, visually and phonetically similar, because in both signs the dominant element is the word HIDROSTAR, which provokes an identical impression under a global appreciation. Regardless of the difference of spelling between "Y" and "I", both marks are phonetically alike because they are pronounced the same. Moreover, the two small circles at the left side of the "H" in defendant's sign and the different style in the words usually stay unnoticed in the overall impression.
3. The public might believe that both services come from the same or from economically-linked undertakings.
4. The relevant average consumer in the concerning category of products and services, deemed to be reasonably informed and attentive, will perceive the marks as a whole, without analyzing their different details. Moreover, the level of attention of these kinds of consumers will not be especially high regarding these services.

¹¹¹ Sogico, *supra* note 110, at 3.

7. ENTERPRISE RENT-A-CAR COMPAÑY v. ENTREPRISE RENT-A-CAR SL (12 July 2007)

Juzgado de lo Mercantil No. 1 de Alicante

The claimant ENTERPRISE RENT-A-CAR COMPANY is the owner of the CTM: first, the word mark ENTERPRISE and second, two graphic marks ENTERPRISE, all registered for classes 12 (vehicles and terrestrial locomotive machinery), 36 (insurance and financial services related to vehicles) and 39 (among others, vehicle rental service). The graphic marks are comprised by the word enterprise written in lower-case over a black background for one of the graphic marks, and over a white background for the other graphic mark. The letter “e” is stylized with a double line evoking a road. The first graphic mark is reproduced below:¹¹²



The defendant’s corporate name is “ENTERPRISE RENT A CAR, S.L.” and it rents vehicles.

The Court held that defendant infringes claimant’s word-mark and also his graphic mark:

(a) The use of “enterprise” by the defendant in its corporate name infringes claimant’s word mark under CTMR Art. 9(1)(a) because of the identity of services and identity of marks (since the elements “cars” or “rent a car” are descriptive and therefore lack distinctiveness). By double identity (of services and signs), there necessarily follows an infringement of the CTM, since there is no need to assess the existence of a likelihood

¹¹² Enterprise Rent-a-Car Compañy v. Enterprise Rent-a-Car SL (12 July 2007), at 5 – 6.

of confusion because the protection of the CTM is absolute in this case.¹¹³

(b) There is also a likelihood of confusion, and consequently infringement of claimant's graphic marks under Art. 9(1)(b) for the following reasons:¹¹⁴

1. There is no absolute identity between the signs, but they are almost identical from the visual, phonetic and conceptual point of view, because the dominant and distinctive element in the claimant's mark is clearly the word "enterprise". That is the part that stays in the consumer's impression and memory. There is the difference that the defendant incorporates the expressions "rent a car" or "cars", but this difference has no distinctive strength due to its descriptive nature.

2. There is identity of services.

3. It is evident that the public might think that the services come from the same or economically-linked undertakings.

4. The relevant average consumer is the average European consumer of these services, who as a reasonably informed and attentive consumer, perceives the mark as a whole and does not examine the different details,

8. Fibertex A/S v. Fibres Fibertex SL (02 July 2007)

Juzgado de lo Mercantil No. 1 de Alicante

The claimant is a leader in the manufacture of fabric (cloth) for industrial and technical application. It is the owner of the CTM for the word "FIBERTEX". The defendant is Fibres Fibertex SL, who transforms textile fibers and who without authorization makes use of the sign FIBERTEX as its corporate name and on its webpage. In its webpage, the expression "FIBRES FIBERTEX SL" is written in capital letters.¹¹⁵

113 Enterprise Rent-a-Car, *supra* note 112, at 7.

114 Enterprise Rent-a-Car, *supra* note 112, at 7 – 8.

115 Fibertex A/S v. Fibres Fibertex SL (02 July 2007), at 3.

It is evident that the expression FIBERTEX used by defendant is confusingly similar to the mark FIBERTEX due to the following reasons:¹¹⁶

1. The claimant is one of the fabric market leaders.

2. There is similarity between the signs. The difference is that the defendant incorporates the expressions “FIBRES” and “SL”, but they are descriptive in character and thus, do not distinguish the defendant’s sign from the claimant’s mark. Likewise, the addition of “.es” in defendant’s domain name has no distinctive strength, since it neither dominates the image nor is part of the impression that the public keeps in its impression of the mark.

3. There is identity between the products.

4. Being claimant one of the market leaders in the fabrics sector, there is an increased risk that the consumers link defendant’s products with those offered by the claimant, so association between the two is present.

5. The relevant average public is the consumer of this kind of products.

9. Les Editions Albert Rene S.A.R.L. v. Las Tabernas de Asterix SL (15 March 2007)

Juzgado de lo Mercantil No. 1 de Alicante

The claimant is the owner of the CTM for the word ASTERIX, registered for products and services which include, among others, accommodation and restaurant services.¹¹⁷

The defendant uses the corporate name “Las Tabernas de Asterix SL” (which is the Spanish expression for “Asterix’s Tavern”) for restaurant-bar services, stores, and establishments for the preparation and sale of food products. Defendant also uses this name in its restaurant, in advertisements and brochures, as well as having the graphic

¹¹⁶ Fibertex, *supra* note 115, at 3 – 5.

¹¹⁷ Les Editions Albert Rene S.A.R.L. v. Las Tabernas de Asterix SL (15 March 2007), at 4.

representations of Asterix and Obelix at his business location and on the menu.¹¹⁸

The Court found a likelihood of confusion between the marks:

1. The CTM is highly distinctive due to its general widespread and knowledge.¹¹⁹

2. There is absolute identity between the services covered by the claimant's CTM and those offered by the defendant under the sign "Las Tabernas de Asterix", as both offer restaurant services.¹²⁰

3. Similarity between the marks: For complex marks, one mark can be similar with another mark only when the dominant element in the overall impression of the sign is also the same as the dominant element in the overall impression of the complex trade mark. In such cases, the rest of the components of the mark are insignificant within the overall impression given by the complex mark.¹²¹ When determining which is the dominant element, we should consider the ability of this element to identify the products or services for which the mark was registered, and thus, to distinguish these products or services from those of other undertakings. At the same time, all the intrinsic qualities of this element should be considered, namely, whether it is descriptive of the products or services in question. Generally, the public will not consider a descriptive element of the complex mark to be its dominant element.¹²² In the present case, the dominant element in defendant's sign is "ASTERIX", as opposed to "La Taberna de", which remains unnoticed by the consumer since it is descriptive of restaurant services. In both signs, the dominant element is identical: "ASTERIX". Moreover, both marks are phonetically and visually similar because the principal element is identical. Also, conceptually both marks refer to a comic character of generalized and widespread knowledge.¹²³

4. Association: The marks refer to a comic character of generalized and widespread

118 Asterix, *supra* note 117, at 4.

119 Asterix, *supra* note 117, at 9.

120 Asterix, *supra* note 117, at 7.

121 C-6/01, Matratzen Concord GMBH/OAMI, 2002

122 Case T-171/03, New Look v. OAMI, 2004 ECR II-3471

123 Asterix, *supra* note 117, at 8 & 9.

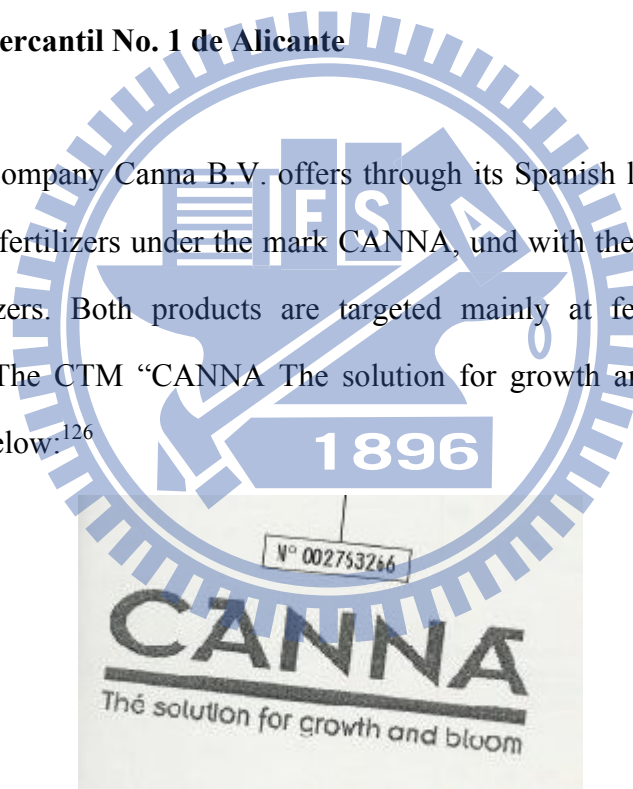
knowledge, and considering that it is customary the existence of restaurant chains that share the same corporate original, it is inevitable that they will be associated by the consumers, thinking that the services come from the same or economically-linked undertakings.¹²⁴

5. The relevant average consumer is the general European public, since the products and services are of daily consumption and are not targeted to a specialized circle.¹²⁵

10. Canna B.V. v. Servideu S.L. y Productos Flower S.A. (27 February 2007)

Juzgado de lo Mercantil No. 1 de Alicante

The Dutch company Canna B.V. offers through its Spanish licensee in the Spanish market chemical fertilizers under the mark CANNA, and with the addition BIO it offers biological fertilizers. Both products are targeted mainly at fertilizing the cannabis (hashish) plant. The CTM “CANNA The solution for growth and bloom” is a mixed mark as shown below:¹²⁶



Defendants also commercialize fertilizers for the cannabis plant under the junior mark Bio-Canna, which is purely a word mark and is registered in the Spanish Patent and Trade Mark Office. Claimants allege that defendant infringes their CTM.¹²⁷

124 Asterix, *supra* note 117, at 9.

125 Asterix, *supra* note 117, at 8.

126 Canna B.V. v. Servideu S.L. y Productos Flower S.A. (27 February 2007), at 3 – 4.

127 Canna, *supra* note 126, at 4.

The Court held that there is a likelihood of confusion between the marks:

1. There is no doubt that in the composition of the mark “CANNA The solution for growth and bloom”, the element CANNA stands out and makes the complementing phrase “The solution for growth and bloom” irrelevant. It is settled that the global appreciation of the likelihood of confusion must be based on the overall impression that the marks produce, taking into particular account its distinctive and dominant elements. In this case, the dominant element is “Canna”. Even though the CTM “CANNA The solution for growth” is a mixed mark, and defendant’s sign “Bio-Canna” is purely a word mark, a graphic similarity is still possible, since both marks have a graphic configuration that can produce a visual impression.¹²⁸ There is almost a phonetic identity between the marks, since the dominant element is CANNA, even though the defendant’s sign begins with “Bio” since it is a word root with a common meaning, that is, it is generic and descriptive. As a result, there is a strong similarity from the visual and phonetic point of view, as the dominant element is the word Canna.¹²⁹
2. The products are of identical nature, that is, plant fertilizers.¹³⁰
3. The relevant consumers of these products are the same and must be taken into account.

11. Christ Juweliere und Uhrmacher Seit 1863 GMBG v. Ramesh Jeswani Jeswani and Gold Kramer SL (02 February 2007)

Juzgado de lo Mercantil No. 1 de Alicante

The claimant, the German company CHRIST JUWELIERE UND UHRMACHER SEIT 1863 GMBH (CHRIST Jewelers and Watchmakers Since 1863) is the owner of the CTM for the word CHRIST for precious metals and articles made thereof, jewelry,

128 T-110/01, Vedral S.A./OAMI (Hubert), 2002, at paragraph 51; T-352-02, Creative Technology Ltd./OAMI (PC WORKS/W WORK PRO), 2005, at paragraph 33.

129 Canna, *supra* note 126, at 9 – 10.

130 Canna, *supra* note 126, at 11.

precious and semi-precious stones, and watches. The claimant alleges that defendant have infringed its CTM by using in relation to commercialization of jewelry the name GOLD CHRIST as its establishment's name.¹³¹

There is a likelihood of confusion between the claimant's CTM CHRIST and the sign GOLD CHRIST used by defendant, therefore infringing the CTM. The reasons are set out below:¹³²

1. The CTM is not well-known in Spain, but this is not relevant, since it is well-known to the German public. Moreover, the defendant's business is located in San Bartolomé de Tirajana (Spain), which is frequently visited by German tourists.

2. Although there is no absolute identity between the signs due to the addition of the word GOLD (and therefore, Art. 9(1)(a) is not applicable), this extra element (which is descriptive of these type of products and which is not unknown to the average Spanish consumer) provides no distinctiveness at all. The defendant's sign entirely includes the claimant's mark, where the dominant element is CHRIST. This is the word that the public retains in its overall impression of the mark, since generally the public will not consider that a descriptive element in a complex mark is the distinctive and dominant element in the overall impression left by the mark.¹³³ Phonetically they are also similar, since the principal element is identical, causing visual and conceptual similarity as well.

3. The services are identical.

4. The public might believe that the jewelry marketed by defendant come from the claimant, or that both undertakings are economically-linked.

5. The relevant average consumer is the European public in general, since the products are not targeted at a luxury market nor are of very high prices.

131 Christ Juweliere und Uhrmacher Seit 1863 GMBG v. Ramesh Jeswani Jeswani and Gold Kramer SL (02 February 2007), at 6.

132 Christ Juweliere, *supra* note 131, at 8 – 9.

133 T-171/03, New Look/OAMI – Naulover, ECR II-34712004

In sum, from the eleven Spanish cases analyzed, the Court always considered the similarity of the marks and goods or services. When assessing the degree of similarity between the marks, the Spanish Community trade mark Courts assessed the phonetic and conceptual similarity, and also took into account the dominant elements of the marks. When the dominant elements are identical, there is similarity of marks. Moreover, in the case of complex (mixed) marks, the Courts considered that the phonetic and denominative similarities are decisive, not the visual similarity, because things are asked by their names. This means that special emphasis was put on the phonetic and denominative similarities more than on the visual similarity between the marks. This way of assessing the similarity of the marks was actually developed by the Spanish Court itself.

Moreover, in all cases the Spanish Courts analyzed the association that the public might make between the two marks. Emphasis was also put on the degree of attention of the relevant average consumer and the distinctiveness of the senior mark. However, the degree of distinctiveness of the senior mark was analyzed in only about sixty percent of the eleven cases.

From the above observations we can see that the Spanish courts were not entirely consistent with the view of the seventh recital of the CTMR and of the case law of the ECJ, which state that the appreciation of a likelihood of confusion depends on numerous elements but, 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. Not all of the eleven cases analyzed assessed the distinctive character of the senior mark.

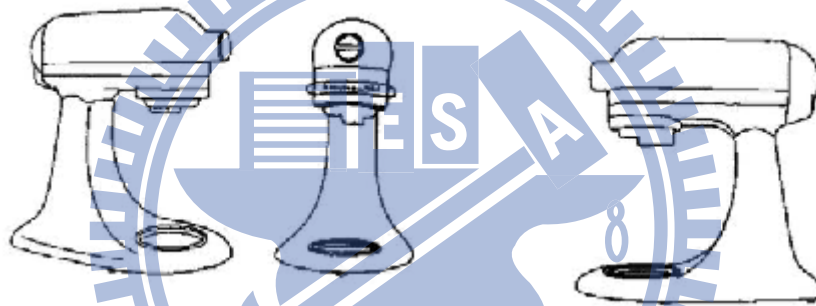
Furthermore, the Spanish Community trade mark Courts considered in only one of the cases analyzed whether there were actual incidences of actual confusion and whether the defendant acted in bad faith.

B. United Kingdom

1. Whirlpool Corporation & Ors v. Kenwood Ltd [2008] EWHC 1930 (Ch) (04 August 2008)

High Court of Justice Chancery Division

The plaintiffs are members of the Whirlpool group of companies (hereinafter, collectively referred as “Whirlpool”) and manufacture KitchenAid products.¹³⁴ Whirlpool is the owner of the registered CTM consisting of an electric beating and mixing machine on which the word KitchenAid appears. It is represented below¹³⁵:



The ultimate question in the action is whether Whirlpool is entitled on the basis of the rights conferred by registration of its CTM to prevent defendant Kenwood from marketing stand mixers having the shape and appearance of its kMix mixer.¹³⁶ That is, the issue is whether the shape of Kenwood’s kMix is sufficiently similar to that of the KitchenAid Artisan for the necessary link to be established in the mind of the average consumer between the CTM and the sign consisting of the shape of the kMix.

This is a KitchenAid Artisan mixer:¹³⁷

134 Whirlpool Corporation v. Kenwood Ltd [2008] EWHC 1930 (Ch) (04 August 2008), at paragraph 1.

135 Whirlpool, *supra* note 134, at paragraph 8.

136 Whirlpool, *supra* note 134, at paragraph 2.

137 Whirlpool, *supra* note 134, at paragraph 5.



And this is a Kenwood kMix mixer:¹³⁸



The High Court of Justice Chancery Division found no likelihood of confusion based on the following reasons:

1. Distinctiveness of the senior mark: In the Court's opinion, there is a degree of specific individuality in the finished appearance of the KitchenAid Artisan mixer which Whirlpool has successfully capitalized on by making the finished appearance of the Artisan a point of reference for such consumers in the stand mixer market, so much that there is a not insubstantial body of design conscious consumers in the United Kingdom (and expectably also in France and Germany) for whom the finished appearance of the Artisan functions as an indication of trade origin even without assistance from the denomination KitchenAid.¹³⁹ The Court considered that the presence of a mark identical or similar to the denomination KitchenAid is not essential for a finding that the rights conferred by the CTM registration have been infringed. In the United Kingdom the Artisan mixer is a strong and well-established trade mark for mixers.¹⁴⁰

138 Whirlpool, *supra* note 134, at paragraph 6.

139 Whirlpool, *supra* note 134, at paragraph 68.

140 Whirlpool, *supra* note 134, at paragraph 71.

2. The products are identical: they are both kitchen mixing machines.
3. Similarity of marks: the shape of both mixers is very alike.
4. Association: a mixer replicating the finished appearance of the Artisan would, thanks to being known and recognized, be thought to have a commercial origin linked to that of the KitchenAid product, whether or not it carried a denomination that was identical or similar to the denomination KitchenAid. There is clearly enough similarity for each to remind people of the other.¹⁴¹

However, the Court could see no likelihood of confusion occurring during the process leading from selection through to purchase of a kMix product. The kMix is not a replica of the Artisan, and it requires no real effort to appreciate that the Artisan is a KitchenAid product and that the kMix is a Kenwood product. No one who was actually contemplating the possibility of spending more than £300 on the purchase of either product would be under any misapprehension as to their true trade origin.¹⁴² There will be nothing more than awareness that the product they are looking at is not the one it reminds them of.¹⁴³

5. Relevant average consumer: The question of liability for infringement can properly be determined by taking the presumed expectations of the relevant consumers into account. The Artisan and the kMix are both premium priced products and are targeted at design conscious consumers.¹⁴⁴

6. Incidences of actual confusion: Public reaction in UK stores was monitored. There were, however, no reports of any instances of confusion between Whirlpool's KitchenAid Artisan mixer and Kenwood's kMix mixer.¹⁴⁵

As a result, the Court concluded that there was no likelihood of confusion between the two products in the mind of the relevant average consumer.¹⁴⁶

141 Whirlpool, *supra* note 134, at paragraph 71.

142 Whirlpool, *supra* note 134, at paragraph 71.

143 Whirlpool, *supra* note 134, at paragraph 75.

144 Whirlpool, *supra* note 134, at paragraph 69.

145 Whirlpool, *supra* note 134, at paragraph 59.

146 Whirlpool, *supra* note 134, at paragraph 75.

2. Hotel Cipriani SRL v. Cipriani (Grosvenor Street) Ltd 2008 EWHC 3032 (Ch) (9 December 2008)

High Court of Justice Chancery Division

The three claimants are members of the Orient Express Hotels Group of companies: the first claimant, “Hotel Cipriani”, owns and operates the Hotel Cipriani in Venice, the second claimant owns and operates the Ristorante Hotel Cipriani at the Lapa Palace Hotel in Lisbon, and the third claimant owns and operates the Ristorante Villa Cipriani at the Reid's Palace Hotel in Madeira.¹⁴⁷

Hotel Cipriani is the owner of the registered CTM for the word CIPRIANI in respect of various goods and services including the following: “Hotels, hotel reservation, restaurants, cafeterias, public eating places, bars, catering; delivery of drinks and beverages for immediate consumption.”¹⁴⁸ Hotel Cipriani has primarily used the CTM so far as hotel and restaurant services are concerned in Venice. More recently, it has also used the CTM in relation to restaurant services in Lisbon and in Madeira.¹⁴⁹ Hotel Cipriani is also the owner of CTM for the words HOTEL CIPRIANI applied for and registered for the same goods and services as the first CTM.¹⁵⁰

On 21 November 1997 defendants applied to register the following words and devices as CTMs in Classes 29 and 30 (FOOD) and 39 and 42 (SERVICE) respectively, representations of which are shown below:¹⁵¹

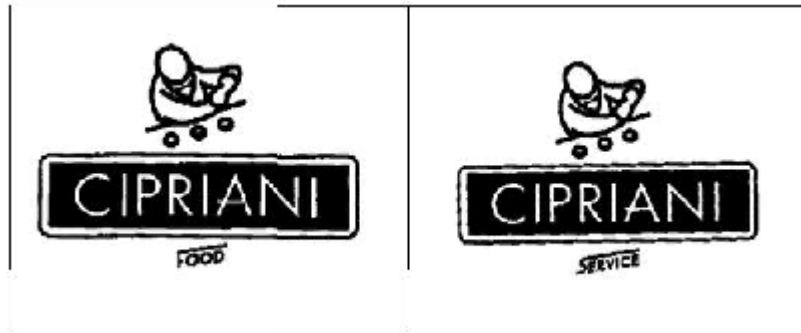
147 Hotel Cipriani SRL & Ors v. Cipriani (Grosvenor Street) Ltd & Ors [2008] EWHC 3032 (Ch) (9 December 2008) at paragraph 1

148 Hotel Cipriani, *supra* note 147, at paragraph 8.

149 Hotel Cipriani, *supra* note 147, at paragraph 117.

150 Hotel Cipriani, *supra* note 147, at paragraph 10.

151 Hotel Cipriani, *supra* note 147, at paragraph 78.



The applications were published and Hotel Cipriani filed notices of opposition to both applications on grounds raised under CTMR Article 8(1)(a) and (b), relying upon its various Community and other European national registrations.¹⁵²

In April 2001, the Opposition Division of OHIM refused the application for the CIPRIANI SERVICE mark in its entirety holding that the mark applied for was not identical to any of Hotel Cipriani's marks, but concluded that:

1. The mark “CIPRIANI” enjoys considerable international esteem and notoriety in relation to hotel services.

2. The identical word “CIPRIANI” is the dominant and distinctive component of the marks in comparison, both visually and phonetically. It is the part in which the distinctiveness of the CTM application lies, as it is much stronger than the directly descriptive word “SERVICE” and the allusive graphic element. The different features of the CTM application have only a secondary impact on its overall impression. Moreover, the CTM application reproduces in its entirety the senior mark. Therefore, the two marks are highly similar.

3. The respective services are identical.

4. Association: There are sufficient grounds to suggest that the average consumer may directly mistake the one mark for the other or at least associate the two assuming that they indicate origin from the same or connected undertakings.

Hence, the Opposition Division concluded that the reproduction of the senior mark in the CTM application in its entirety generates sufficient visual and phonetic similarities

¹⁵² Hotel Cipriani, *supra* note 147, at paragraph 79.

between the marks to give rise to confusion on the part of the public in the Community.¹⁵³

As for the CIPRIANI FOOD mark, the Opposition Division refused the application for some foodstuffs but allowed it in respect of others for the following reasons:

1. The mark “CIPRIANI” enjoys considerable reputation in relation to hotel services, as the identifier of one of the most prestigious and highly esteemed hotels in Italy, being ranked for decades among the best of the sector in specialized directories, both because of the quality of its services and its imposing site in the Venetian lagoon. The international press attested to the fame of the HOTEL CIPRIANI.

2. The identical word “CIPRIANI” is the dominant and distinctive component of the marks in dispute, both visually and phonetically, as it is much stronger than the directly descriptive words “HOTEL” and “FOOD” and the allusive graphic element. Therefore, the marks are highly similar.

3. Some goods were complementary to the opponent’s (namely, jellies, jams; preserved and cooked fruits and vegetables; fruit sauces; milk products; pastry and confectionery, etc.), but on the other hand, some of the applicant's goods (meat, fish, poultry and game; meat extracts; dried fruits and vegetables; eggs, milk, etc.) have been found to be clearly dissimilar to the opponent's services. Being the similarity of goods an indispensable condition for the finding of a likelihood of confusion, it follows that for those dissimilar goods there can be no likelihood of confusion, notwithstanding the high degree of similarity between the signs and the reputation of the opponent's marks.

4. For those complementary goods, combined with the close similarity of the signs and the high distinctiveness of the senior marks, they may indeed justify an assumption on the part of the public that such goods either originate directly from the opponent, or that the opponent is somehow involved in their production or is ultimately responsible for their quality.¹⁵⁴

153 Hotel Cipriani, *supra* note 147, at paragraph 80.

154 Hotel Cipriani, *supra* note 147, at paragraph 81.

Despite the Opposition Division's opinion, defendants later on began operating a restaurant since April 2004 under the name Cipriani London, but which is commonly referred to simply as Cipriani.¹⁵⁵ As a consequence, claimants filed this complaint in Court.

The High Court of Justice Chancery Division found that there was a likelihood of confusion for the following reasons:

1. The mark CIPRIANI would have been fairly distinctive to a UK consumer at that date even if it had not acquired a reputation. In fact, the CTM has a high reputation.

2. CIPRIANI LONDON is a sign which is similar to the CTM CIPRIANI. The dominant and distinctive element in the defendants' sign is CIPRIANI since the additional word LONDON is non-distinctive, particularly for a restaurant in London. This is self-evident, but confirmed by the fact that both the Defendants and third parties often drop the word LONDON. Thus the dominant and distinctive elements of the mark and the sign are identical.

3. The services are identical.

4. Association: Even if the CTM did not have a reputation, the average consumer would think that the services denoted by the mark and the sign came from the same or economically-linked undertakings.¹⁵⁶

5. The average consumer is representative of the adult general public which patronizes restaurants, and in particular the more expensive class of restaurant. While some care is taken over the selection of restaurant services, these are not specialist services or ones over which especial care is taken.

In conclusion, the Court's opinion is consistent with the two decisions of the OHIM Opposition Division discussed above.

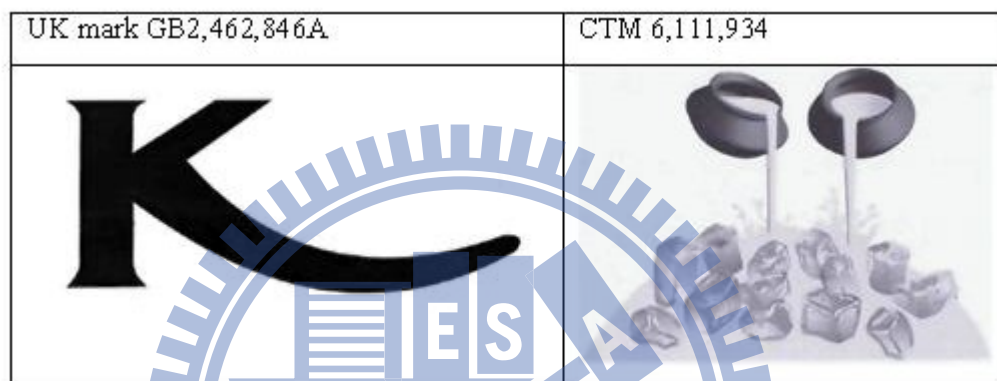
¹⁵⁵ Hotel Cipriani, *supra* note 147, at paragraph 2.

¹⁵⁶ Hotel Cipriani, *supra* note 147, at paragraph 124.

3. Tubzee Ltd v. Safron Foods Ltd [2008] EWHC B15 (Ch) (07 October 2008)

High Court of Justice Chancery Division

Tubzee is the registered owner of a UK trade mark in respect of the “K” and a CTM for a design comprising 2 matka pots pouring a white liquid over some ice cubes. The trade marks are represented below:¹⁵⁷



There are 4 characteristics of the get up which are relied on by Tubzee:

- The "K" before "ulfi": The "K" had a very distinctive and eye catching dropped “tail” to the bottom of the letter that swept under part of the rest of the letters “ulfi”.
- The 2 pots: A device comprising two brown circular pots pouring a white fluid in a vertical stream.
- The swirl: A swirl of one or more shades of color.
- The cubes: A stylized image of 6 to 12 ice cubes.¹⁵⁸

Tubzee manufactures and sells Kulfi ice, which is a generic term applied to a popular South Asian desert made with boiled milk. It comes in many flavors – including pistachio, malai and mango.¹⁵⁹

Tubzee claims that Safron infringes its registered CTM because Safron’s get up is

¹⁵⁷ Tubzee Ltd v. Safron Foods Ltd & Ors [2008] EWHC B15 (Ch) (07 October 2008), at paragraphs 28, 29.

¹⁵⁸ Tubzee, *supra* note 157, at paragraphs 3 – 7.

¹⁵⁹ Tubzee, *supra* note 157, at paragraph 1.

confusingly similar to Tubzee's get up.¹⁶⁰ There are 5 Tubzee product ranges – 1 liter tubs, 120 ml cups, screwball cones, 5 pack ice lollies and individual lollies. In December 2005 the new design was introduced for the 1 liter tubs, the screwball cone packaging and the 5 pack ice lolly packaging. The 120 ml cup packaging was introduced in January 2008.¹⁶¹

Safron also manufactures Kulfi. There can be no doubt that there are differences between Tubzee's get-up and Safron's new get -up. In particular all of Safron's designs incorporate the yellow Safron logo. The Safron liter tubs are circular rather than the rectangular tubs used by Tubzee. Safron's liter tubs have the words "Unlock the Secret of the East" whereas Tubzee's have "A True Taste of the East" on them.¹⁶² But it also adopts a "K" with a dropped tail extending under the letters "ulfi", shows 2 circular pots pointing inwards pouring a white liquid in a vertical stream and incorporates a swirl device.¹⁶³

The Court found that there was a likelihood of confusion for the following reasons:¹⁶⁴

1. The dropped tail of Tubzee's "K" is a distinctive feature.
2. Similarity of marks: The matter has to be considered globally. Thus the fact that there are differences between Safron's "K" and Tubzee's "K", and Safron's matka pots and Tubzee's matka pots is by no means conclusive. The matter has to be looked at globally taking account of all relevant circumstances including my finding that Safron decided to live dangerously.

There are considerable conceptual similarities between the 2 "K"s and the 2 matka pots. The concept of the dropped tail of the "K" is identical. Similarly the concept of the matka pots pouring a white liquid vertically in Safron's get up is exactly the same as that

160 Tubzee, *supra* note 157, at paragraph 2.

161 Tubzee, *supra* note 157, at paragraph 34.

162 Tubzee, *supra* note 157, at paragraph 61.

163 Tubzee, *supra* note 157, at paragraphs 63 – 65.

164 Tubzee, *supra* note 157, at paragraph 89.

of Tubzee. The matka pots give the idea of something from India or Pakistan and the liquid falling vertically gives the idea or concept of the use of milk. There is a difference in that Tubzee's liquid falls on ice whereas Safron's falls on the swirl. Conceptually, the marks are very similar.

3. The goods sold by Tubzee and Safron are identical and thus a lesser degree of similarity between the marks can give rise to a risk of confusion.

4. Average consumer of ice cream: it is assumed that he or she is reasonably well informed, reasonably observant and circumspect but did not have the opportunity to make a direct comparison between Tubzee's marks and Safron's get up and has to rely on "imperfect recollection". A significant part of the market is the senior Asian market that does not have good literary skills in English. Thus the concept of the matka pots is more important than the Safron logo in Safron's get up.

5. Evidence of confusion: Shortly after Safron introduced its new get up, Tubzee received 2 letters showing confusion from members of the public.¹⁶⁵

Taking all these matters into account, the Court concluded that there is a likelihood of confusion caused by Safron's use of the "K" with the dropped tail and the 2 matka pots with a white liquid falling vertically, infringing Tubzee's CTM.

4. Julius Sämann Ltd & Ors v. Tetrosyl Ltd [2006] EWHC 529 (Ch) (17 March 2006)

High Court of Justice Chancery Division

The claimants are owners of the CTM registered in class 5 with respect to air fresheners ("the Tree" mark),¹⁶⁶ which comprises the outline of a stylized fir or pine tree on a base ("the Tree product"). It has been used continuously over very many years in

¹⁶⁵ Tubzee, *supra* note 157, at paragraph 67.

¹⁶⁶ Julius Sämann Ltd & Ors v. Tetrosyl Ltd [2006] EWHC 529 (Ch) (17 March 2006), at paragraph 2.

relation to a range of air freshener products called the "Magic Tree" range, made of cardboard which carries the scent which is used as the air freshener and whose shape remains the same no matter what fragrance, color or pattern it bears. Although the Tree products are sold in a variety of different packs and displays, there is a consistent theme, and the Tree product is always visible through the packaging.¹⁶⁷ The Tree product is often used and seen in motor cars and other vehicles, dangling from the rear view mirror. The mark is depicted below:¹⁶⁸



The defendant ("Tetrosyl") makes a wide range of products, mainly for use in the car care sector. One of the brands under which it sells car care products is "CarPlan". Tetrosyl began to market an air freshener for cars and other vehicles in the shape of a fir tree, decked out festively with snow and with flashing lights that can be switched on and off ("the Christmas Tree product"), but in actual use therefore the lights will often not be switched on. It bears the brand CarPlan on its base and is sold in a box which has an illustration of the product on the outside. It has primarily been sold in a counter display unit ("CDU") placed on a retailer's counter, with an example of the product (not in its box) attached to the CDU. It has also been supplied on a "clip strip". The Christmas Tree product is depicted below, together with a sample Tree product.¹⁶⁹

167 Julius Sämann, *supra* note 166, at paragraphs 13 & 15.

168 Julius Sämann, *supra* note 166, at paragraph 3

169 Julius Sämann, *supra* note 166, at paragraph 5



The claimants contend that the sale of the Christmas Tree product amounts to an infringement of their CTM under CTMR Art. 9(1)(b).

The High Court of Justice Chancery Division found that there was a likelihood of confusion for the following reasons:

1. Distinctiveness of the tree mark: When the Tree marks are used in a normal and fair way the average consumer would not see them as describing or designating a characteristic of the products. It is rather distinctive in its shape and form of the goods of the claimant. It is also relevant that it cannot be said that the Tree marks resemble the shape that air fresheners for cars and other vehicles are likely to take. There is no normal shape for such fresheners. In any event, however, the Tree marks have acquired distinctiveness. As a matter of fact, the Tree products have now been sold for very many years. Sales have been very substantial, achieving wide retail distribution and commercial success to the extent that third parties, i.e. Volkswagen, have wished to adopt them in connection with the promotion of their own products and services. The Tree product range is the market leader and is particularly distinctive when used in relation to and as the shape of air fresheners for cars and other vehicles as a result of the use which has been made of them over the years by the claimants.¹⁷⁰

2. The products are identical: car air fresheners.¹⁷¹

170 Julius Sämann, *supra* note 166, at paragraphs 40 - 43.

171 Julius Sämann, *supra* note 166, at paragraph 53.

3. Similarity of the marks: The comparison to be made is between, on the one hand, the Tree marks and, on the other, the Christmas Tree product itself and the picture of it which appears on the box. Tetrosyl's sign should be considered as the whole tree including the tub and the roundel including the words "CarPlan Air Care". The tree is fixed into the tub and the two are presented as a composite whole. The case is concerned with graphic marks and the products to which they are applied are selected by purchasers from a shelf or display unit rather than by oral request. It is therefore the visual and conceptual similarities and differences which are particularly important. Even though there are differences between the marks, there is a marked visual and conceptual similarity between the Tree marks and the sign when considered as a whole in that they all comprise as a distinctive and dominant component the device of a fir tree.¹⁷²

4. Association: the average consumer would think of the product as a Magic Tree product even though it does not bear the words Magic Tree upon it.¹⁷³ Seeing the Christmas Tree product stripped of the distinguishing material on the box and CDU in which it is sold, the average consumer is likely to think that it is either the Tree product or a Christmas version of the Tree product.¹⁷⁴

5. The average consumer includes all members of the public. The products are inexpensive items and generally bought on impulse. Customers do not spend more than a few moments deciding upon their purchase.¹⁷⁵

6. There is no one single witness of actual confusion. However, the Court does not consider this to be determinative.¹⁷⁶

In conclusion, there exists a likelihood of confusion between Tetrosyl's Christmas Tree product and claimants' CTM on the part of the public.

172 Julius Sämann, *supra* note 166, at paragraphs. 48, 52, 54 and 56.

173 Julius Sämann, *supra* note 166, at paragraph 45.

174 Julius Sämann, *supra* note 166, at paragraph 56.

175 Julius Sämann, *supra* note 166, at paragraphs 34 & 53.

176 Julius Sämann, *supra* note 166, at paragraph 58.

5. French Connection Ltd v. Fresh Ideas Fashion Ltd [2005] EWHC 3476 (Ch) (03 November 2005)

High Court of Justice Chancery Division

This is an application for a summary judgment in an action for trade mark infringement and passing off. The claimants form part of the French Connection group of companies which carry on business in the United Kingdom and elsewhere as fashion retailers. They are the owners of the following registered CTMs FCUK (an acronym derived from French Connection United Kingdom) and French Connection, both registered in respect of *inter alia* trunks and travelling bags, luggage, handbags, wallets, purses and hold alls, belonging to Class 18.¹⁷⁷

Bags were found to be in possession of the defendant, and two of them are relevant to this case.

The first bag bears the letters FCUK in lower case in a style very similar, if not identical, to that used by the claimants. That lettering appears in white on a black background. Above this white lettering appears the word "French" and below it the word "Collection". Both of these are in orange type, but again in a font and style at least extremely similar to those used by the claimants in connection with their bags. Of course, there is the difference that the defendants' bag bears the word "Collection" as opposed to the word "Connection". The second bag on which reliance is particularly placed today is a smaller bag which bears the letters FCUK in a stylized italic script.

The use of FCUK on this first bag falls within CTMR Article 9.1(a) since there is identity of goods and identity of marks.¹⁷⁸ As to the sign "French Collection" that appears on this bag, the Court determined that:

¹⁷⁷ French Connection Ltd & Ors v. Fresh Ideas Fashion Ltd [2005] EWHC 3476 (Ch) (03 November 2005), at paragraphs 2, 4.

¹⁷⁸ French Connection, *supra* note 177, at paragraph 18.

1. The claimants are well-known retailers and wholesalers of branded fashion clothing and accessories for men, women and children, as well as men's and ladies' toiletries, fragrances, eyewear, watches and shoes and other personal and household items.

2. Visually the two marks are extremely similar. Phonetically the two marks are similar and also conceptually.

3. There is identity of goods.

4. Association: the clear intention behind the adoption by the defendants of this mark is to conjure up the claimants' registered mark in the minds of consumers.

The Court concluded that, with no doubt, there exists a likelihood of confusion arising from the use by the defendants of this sign.¹⁷⁹

The second bag on which reliance is particularly placed today is a smaller bag which bears the letters FCUK in a stylized italic script.

1. The claimants are well-known retailers and wholesalers of branded fashion clothing and accessories for men, women and children, as well as men's and ladies' toiletries, fragrances, eyewear, watches and shoes and other personal and household items.¹⁸⁰

2. Similarity of marks: the letters FCUK in a stylized italic script are not used by the claimants, but are visually extremely similar to the registered mark FCUK.

3. There is identity of goods.

4. Association: it is quite clearly intended to conjure up the FCUK trade mark in the minds of consumers.

The conclusion was reached by the Court that the claimants established that there is no real prospect of the defendants successfully defending this claim.¹⁸¹

179 French Connection, *supra* note 177, at paragraph 20.

180 French Connection, *supra* note 177, at paragraph 6

181 French Connection, *supra* note 177, at paragraph 19.

6. Electrocoin Automatics Limited v. Coinworld Limited [2004] EWHC 1498 (Ch) (29 June 2004)

High Court of Justice Chancery Division

Claimants Electrocoin and its directors are owners of two registered CTMs: the first is **BAR-X** for Classes 9 (game, entertainment, recreational and amusement machines and apparatus; video games machines, etc) and 41 (services for the provision of gaming and entertainment machines and apparatus and of video games and amusement games and machines, etc.). The second CTM is **OXO** registered for Classes 9, 40 (upgrade, modification and rebuild of gaming, entertainment and amusement machines and apparatus) and 41.¹⁸²

This claim for infringement relates to the “amusement with prizes” (“AWP”) gaming machines conventionally referred to as “fruit machines”, which are the BEAR X and BIG BEN machines marketed and advertised in promotional leaflets by defendants.¹⁸³

The High Court of Justice Chancery Division found no likelihood of confusion based on the following reasons:

1. **BAR-X** is a famous name. It has for a long time served to distinguish machines supplied by Electrocoin from those of other suppliers. It is formally admitted that among traders in fruit machines the name **BAR-X** denotes machines from Electrocoin. AWP machines would need to have come directly or indirectly from Electrocoin in order to have been honestly and fairly called **BAR-X** machines at that point in time.¹⁸⁴

2. **BAR-X** and **BEAR X** are not merely similar, but distinctively similar denominations. In plain script the denominations are visually similar, aurally

182 Electrocoin Automatics Limited v. Coinworld Limited [2004] EWHC 1498 (Ch) (29 June 2004), at paragraphs 1 & 2.

183 Electrocoin, *supra* note 182, at paragraphs 3 – 5.

184 Electrocoin, *supra* note 182, at paragraph 40.

distinguishable and conceptually dissimilar. The question whether the similarities are outweighed by the differences depends upon whether the average consumer would be likely to notice and attach significance to the fact that the denomination **BAR-X** contains the meaningful word **BAR** and the denomination **BEAR X** contains the meaningfully different word **BEAR**.¹⁸⁵ The two marks are likely to have been distinguished by the persons concerned.

3. There is identity of goods.

4. Association: relevant consumers will generally have appreciated that **BAR-X** alluded to the traditional symbol of a **BAR** and that the denomination **BEAR X** alluded, by contrast, to bears. It appears that the denominations **BAR-X** and **BEAR X** are similar to a degree that might, at most, result in the use of one calling the other to mind in a way that would involve no cross-pollination between the two strains of use. That is, reasonably well-informed and reasonably observant and circumspect consumers will have taken the symbols to be origin neutral integers of the games played on the machines which carried them.¹⁸⁶

5. Reasonably well-informed and reasonably observant and circumspect persons would have noticed that the denominations were not identical.¹⁸⁷

6. There is no evidence has been given of any instances of apparent confusion.¹⁸⁸

In conclusion, the claims for infringement were dismissed.

7. Compass Publishing BV v. Compass Logistics Ltd. [2004] EWHC 520 (Ch) (24 March 2004)

High Court of Justice Chancery Division

The claimant Compass Publishing BV is part of a group of companies engaged in

185 Electrocoin, *supra* note 182, at paragraphs 120 & 121.

186 Electrocoin, *supra* note 182, at paragraphs 123 & 135.

187 Electrocoin, *supra* note 182, at paragraph 123.

188 Electrocoin, *supra* note 182, at paragraph 120.

business consultancy worldwide ("the Compass Group") and owns all the registered trade marks which are used by the group companies throughout the world, including the CTM "COMPASS" that is in issue in these proceedings. It is registered for: Class 9 (computer programs; computer software; pre-recorded data-carriers), Class 35 (business consultancy; business management consultancy; business organization consultancy; consultancy and advisory services based on comparative analysis) and for Class 42 (professional consultancy; consultancy in the field of information technology; comparative-analysis studies).¹⁸⁹

The defendant Compass Logistics Limited has traded under or by reference to the name or mark "Compass Logistics" although occasionally it has been abbreviated to "Compass" alone. The company offers management consultancy services, which involves advising clients in relation to logistics and the supply chain. It offers project management services to assist clients in the implementation of the consultancy recommendations it makes.¹⁹⁰ Defendant uses its sign on business consultancy services within Class 35.¹⁹¹

The claimant alleges infringement of its CTM by defendant, but claimant and defendant dispute as to whether the defendant uses a sign which is identical to the registered mark. The claimant argues, first, that the defendant uses "COMPASS" alone. This is the mark as registered. Second, it says that the sign "COMPASS LOGISTICS" is also identical to the registered mark.¹⁹²

First, the Court held that defendant infringed claimant's CTM by using the sign "COMPASS". From time to time, defendant has referred to itself and the services it offers by reference to the sign "COMPASS" alone. Furthermore the word "logistics" alludes to the type of work undertaken by the company. The most important part of the

189 *Compass Publishing BV v. Compass Logistics Ltd.* [2004] EWHC 520 (Ch) (24 March 2004), at paragraphs 1 – 2.

190 *Compass*, *supra* note 189, at paragraph 4.

191 *Compass*, *supra* note 189, at paragraph 10.

192 *Compass*, *supra* note 189, at paragraph 10.

company's name is the word "COMPASS". In these circumstances it is hardly surprising that the company refers to itself, both orally and in writing, as "COMPASS". It follows that, subject to the question of validity, defendant has infringed the CTM by the use of the sign COMPASS.¹⁹³

Second, the issue is whether defendant infringed claimant's CTM by using the sign "COMPASS LOGISTICS" under Article 9(1)(a) or under Article 9(1)(b). That is, are "COMPASS" and "COMPASS LOGISTICS" identical for the purposes of Article 9(1)(a)? The ECJ said that identity of the sign and the trade mark must be interpreted strictly, so the two elements compared should be the same in all respects without any modification or addition. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer." In those circumstances, identity means that a sign is identical to the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."¹⁹⁴

Under this approach, the Court held that "COMPASS LOGISTICS" is not identical to "COMPASS". The differences between these two are apparent and would be identified without difficulty or prior coaching by members of the public. There is no suggestion under this approach that noticeable differences should be ignored because they have only limited trade mark significance. It follows that the case of infringement under Article 9(1)(a) by the use of "COMPASS LOGISTICS" fails.¹⁹⁵

193 Compass, *supra* note 189, at paragraphs 11 – 14.

194 Case C-291/00, LTJ Diffusion SA v. Sadas Vertbaudet SA, 2003 ETMR 83, at paragraphs 50 – 54.

195 LTJ Diffusion, *supra* note 194, at paragraph 21.

Therefore, it is necessary to consider whether there is a likelihood of confusion and consequently infringement under the provisions of Article 9(1)(b). The Court held that there is a likelihood of confusion between defendant's sign "COMPASS LOGISTICS" and claimant's CTM "COMPASS" in relation to its business consultancy services based on the following reasons:

1. Similarity of the services: Defendant has used its sign on identical services, that is, business consultancy services within Class 35.

2. Similarity of the marks: The dominant part of defendant's mark is the word "compass". For many customers, the word "logistics" would add little of significance to it.

3. Association: It is likely that a significant section of the public would consider that "COMPASS LOGISTICS" represents the logistics branch of the "COMPASS" service.

4. There is no suggestion that there has been any confusion in the market place between the activities of defendant under the sign "COMPASS LOGISTICS" and the claimant under the mark "COMPASS". Moreover, the question of infringement has to be answered by assessing the existence of a likelihood of confusion were claimant to use the mark "COMPASS" in a normal way in respect of all services covered by the registration, including for business consultancy services in the field of logistics, that is to say the same specialist field defendant operates in. Therefore, a lack of actual confusion in the market is not surprising, since claimant's core activities are not in the logistics field and defendant's are.¹⁹⁶

In conclusion, defendant's use of "COMPASS LOGISTICS" infringes claimant's CTM under Article 9(1)(b).

In sum, from the seven United Kingdom decisions that were analyzed, the United Kingdom Community trade mark Courts always considered the similarity of the marks

196 *Compass*, *supra* note 189, at paragraph 25.

and goods or services, as well as the association that the public might make between the two marks. The distinctive character of the CTM was considered in most, though not all, cases.

However, the situation with the UK Community trade mark Courts was similar to the one with Spanish Community trade mark Courts. That is, not all of the seven UK cases analyzed assessed the distinctive character of the senior mark, even though this factor has been emphasized as one of the three factors on which the assessment of a likelihood of confusion particularly depends.

Moreover, the degree of attention of the relevant average consumer whether there were actual incidences of confusion were considered in most but not all the cases analyzed. One interesting fact worth mentioning is that whether the owner of the junior mark acted in bad faith was not considered in any of the cases, nor was the question whether there were any prior Community or national decisions involving conflicts between the same or similar marks.

C. Germany

1. Stella, 25 W (pat) 29/06 (07 August 2008)

German Federal Patent Court

The CTM “Stella” is registered for the products in Class 6 (products made of metal, in particular containers, bottles, packaging and packing foil, etc.), Class 8 (manually operated tools and devices, in particular hand-lever presses), Class 16 (paper, cardboard, and goods made thereof), Class 20 (goods made of synthetic material, bottles, containers, packaging), and Class 21 (containers and bottles made of glass, plastic, or a combination of the two).¹⁹⁷

¹⁹⁷ Stella, 25 (W) pat 29/06 (07 August 2008), at 3 – 4.

The owner of the CTM opposed the junior international application mark “STELLA” in Germany for Class 5 products (pharmaceutical, veterinary and hygienic products, dietary substances, surgical and medical instruments, etc.).¹⁹⁸

The German Federal Patent Court (Bundespatentgericht) concluded that there is no likelihood of confusion on the following grounds:

1. There is a very high degree of similarity between the marks.

2. There is no similarity between the products. In assessing the similarity of the goods and services, all relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, the purpose for which they are used and the method of use, and whether they are in competition with each other or are complementary. Further criteria to be observed in the assessment of similarity of goods and services are the product’s manufacturers and their relevant distribution channels and retail outlets. Moreover, there is interdependence between the relevant factors and in particular a similarity of the marks and the similarity of the goods. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa.

However, there is a point at which even the differences between the goods can be offset by the identity of the marks. As a general rule, pharmaceutical products and surgical and medical instruments will not be produced by the same manufacturer as bottles, packaging, containers, etc. Their components, texture, nature, purpose of use, and production methods are fundamentally different. Special packaging for medicines are usually not manufactured by the pharmaceutical industry, but is supplied. Almost all products are marketed in a packaging. This is also true for the pharmaceutical industry, which receives the packaging and bottles in which its products are then packed up.

The similarity between the goods will be negated when the relevant public does not

198 Stella, *supra* note 197, at 3 – 4.

believe that the products come from the same or from economically-linked undertakings.¹⁹⁹

3. In the present case, a consumer that buys from the drugstore a medicament that is bottled in a STELLA packaging, will not believe that the products come from the same undertaking.²⁰⁰

2. Smile v. SmileCompany, 25 W (pat) 17/06 (29 July 2008)

German Federal Patent Court

The holder of the senior registered CTM SMILE for the products and services “electric and electronic equipment for use in banking transactions; computer-assisted appliances for banking transactions; ATM, codified cards, finances, support for financial concerns, etc”. The holder of the CTM filed an opposition against the application for registration of the mark SmileCompany for the services “advertisement, administration of a business, administration of an undertaking, compilation of data-processing programs, marketing of products and technology on the internet, finance, real estate, monetary transactions, etc.”²⁰¹

The German Patent and Trade Mark Office (Deutsches Patent- und Markenamt) decided that there was a likelihood of confusion between the two marks and ordered the cancellation of the opposed mark SmileCompany.²⁰² The Office based its decision on the grounds that:

1. The opposing mark has an average distinctive strength.
2. The marks are similar: Because the word “Company” has no distinctiveness, it does not yield a new term or concept when in combination with the word “Smile” that would lead away from the distinctiveness that comes from the word “Smile” alone. The

199 Stella, *supra* note 197, at 8 – 9.

200 Stella, *supra* note 197, at 10.

201 Smile v. SmileCompany, 25 W (pat) 17/06 (29 July 2008), at 3 – 4.

202 Smile, *supra* note 201, at 3 – 4.

addition of “Company” means only that the products are offered and marketed under the “company” known as “Smile”.

3. The goods and services offered are partially identical and partially averagely similar. The Office also determined that the services for “finance, real estate, and monetary transactions” of the opposed mark were identical or highly similar to the opposing mark’s services for “finance”. Moreover, there is average degree of similarity between opposing mark’s “financial services” and the opposed mark’s “advertisement and administration of business or undertaking” services. Lastly, there is a lower degree of similarity between the opposing mark’s “computer-assisted appliances for banking transactions” and the opposed mark’s “compilation of data-processing programs” because the manufacturer of such computer-assisted appliances usually also produces such programs.

4. There is a risk that the two marks in question will be associated with each other due to the identical term “Smile” contained in both marks.²⁰³

The owner of the opposed mark appeals against the Office’s decision and requests its reversal.²⁰⁴

The German Federal Patent Court (Bundespatentgericht) agreed with the Patent and Trade Mark Office. That is, the Court concluded that the Office correctly found a likelihood of confusion within the meaning of Art. 9(1)(b) between the two marks based on the following reasons.²⁰⁵

1. The distinctiveness of the opposing mark is regarded as average. The meaning of the term “SMILE” does not exhibit the characteristics of the relevant goods and services, that is, it is not descriptive of the goods and services in question.²⁰⁶

2. When assessing the degree of similarity between the goods and services all

203 Smile, *supra* note 201, at 4.

204 Smile, *supra* note 201, at 5.

205 Smile, *supra* note 201, at 6.

206 Smile, *supra* note 201, at 6.

relevant factors that distinguish those goods or services themselves must be considered, namely, their nature, the purpose for which they are used and their method of use, and whether they are in competition with each other or are complementary, the product's manufacturers, their relevant distribution channels and retail outlets.

First, the financial services offered are identical. The opposed mark's "monetary transactions" is encompassed within the broader term "financial services".

Furthermore, the opposed mark's "real estate services" also displays a considerable similarity to the opposed mark's "financial services" because banks are also active in the area of real estate financing.

Moreover, there is an average similarity between the opposed mark's "administration of business, administration of undertaking" services and the opposing mark's "financial management, support for financial concerns" because a company's financial administration and organization are an essential component in the administration of a business or undertaking.

Lastly, there is average similarity between the opposed mark's "compilation of data-processing programs and marketing of products and technology on the internet" and the opposing mark's "electric and electronic equipment for use in banking transactions; computer-assisted appliances for banking transactions; ATM, codified cards, etc."²⁰⁷ They involve products or services in the electronic data processing area. The services of the opposed mark are not limited to a specific purpose and thus might encompass the products offered by the opposing mark. In light of fundamental differences between the provision of services and the manufacture of physical goods, the relevant consumers might get the impression that the goods are manufactured or supplied by the same company, which justifies more than a low similarity between the goods and services.²⁰⁸ However, for the opposed mark's "advertisement" services the Court was ambiguous.²⁰⁹

207 Smile, *supra* note 201, at 7 – 8.

208 BGH, GRUR 2004, 241, 243 – GeDIOS.

209 Smile, *supra* note 201, at 11.

3. The marks are similar. The addition of “Company” means only that the products are offered and marketed through a company. The elements “Smile” and “Company”, when connected, do not add to a new term whose overall concept would work against focusing on one single element.²¹⁰

4. Association: The senior mark (the CTM) is incorporated into a complex mark in which it retains its distinctive position. The risk is that the public will think that the products or services in dispute come from the same or economically-linked undertakings.²¹¹

5. The relevant average consumer is a general public that is accustomed to the English language and that will understand the meaning of the words “Smile” and “Company”.

In conclusion, the CTM Smile was infringed by use of SmileCompany on the relevant goods and services.

3. Bellawa v. Bellave, 24 W (pat) 64/06 (29 April 2008) **German Federal Patent Court**

The application to register the word-mark **Bellavé** for “cotton wool swabs and cotton wool for cosmetic use; cellulose facial tissues; cellulose cosmetic pads” was filed at the German Patent and Trade Mark Office (Deutsches Patent- und Markenamt) and was published.

This application was opposed by the owner of the word CTM **BELLAWA** registered for Class 3 (cotton wool, cotton wool pillows and cotton wool swabs for cosmetic purposes) and Class 5 (cotton wool, cotton wool pillows and cotton wool swabs for medical and health purposes; cotton for medical purposes, in particular for aseptic and anti-septic cotton; bandaging material especially bandaging cotton) products.

The Patent and Trade Mark Office ordered the cancellation of the opposed mark

210 Smile, *supra* note 201, at 10-11; Ströbele/Hacker, Markengesetz, 8. Aufl., § 9 Rdnr. 270.

211 Smile, *supra* note 201, at 12 – 13.

based on the CTM opposition, because there is a likelihood of confusion between the marks within the meaning of Art. 9(1)(b). On both sides, the goods are partially identical and partially highly similar. Moreover, the distinctiveness of the opposing mark is of average level, and both marks distinguish themselves from each other phonetically only in the final sound (“a”/“e”) because the consonant “v” in the junior mark generally is pronounced the same as “w”. Considering also that the beginning element is the distinctively weak word “Bella-” (“beautiful” in Italian), the difference between the marks is too low to prevent a likelihood of confusion. The marks also coincide visually. The accent over the “é” is not usually noticed and is easily overlooked. Besides, the beginning of a word is usually given more attention than the end of the word.²¹²

The Federal Patent Court concluded that there is a likelihood of confusion between the two marks in question in the sense of Art. 9(1)(b) for the following reasons:²¹³

1. The opposing mark has average distinctiveness. Considered in its entirety, the word BELLAWA is a fanciful word which has no descriptive element with respect to its protected goods. There is no evidence submitted of increased distinctiveness through intensive use. As long as the market recognizes “bella” as the Italian word for “beautiful”, the mark is not descriptive in relation to the cotton products.

2. In the assessment of similarity of the marks, the overall impression given by the marks is decisive. The phonetic similarity offsets the differences in the overall impression of the marks. Besides the different consonants “v”/“w” (which are usually pronounced the same), along with the different final sounds “a”/“e”, the two marks coincide. Furthermore, they have the same number and structure of syllables.

3. The goods are partially identical and partially highly similar.

4. The determination of similarity of marks must be assessed from the average end consumer’s perception. The junior mark “Bellavé” is pronounced with the accent in the

212 *Bellawa v. Bellave*, 24 W (pat) 64/06 (29 April 2008), at 2 – 3.

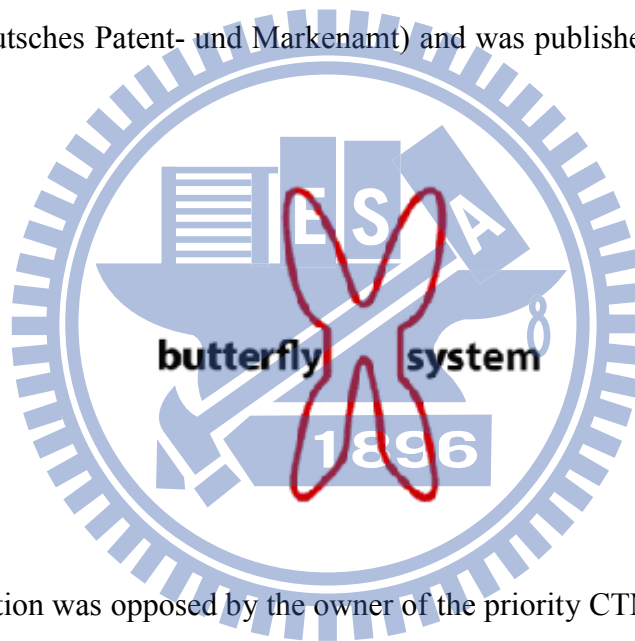
213 *Bellawa*, *supra* note 212, at 7 – 9.

last syllable. But knowledge of the French language is not generally widespread and therefore other intonations must be also considered, in particular an intonation on the first syllable, which is as likely as an intonation on the last one.

4. **Butterfly v. Butterfly System, 27 W (pat) 74/07 (28 April 2008)**

German Federal Patent Court

The application to register the word-graphic colored (red and black) mark **butterfly system** for “backpacks, travel bags, bags” was filed at the German Patent and Trade Mark Office (Deutsches Patent- und Markenamt) and was published. The mark is shown below:²¹⁴



This application was opposed by the owner of the priority CTM **Butterfly** registered for “sport bags; tennis shoes; sport and play equipment for ping-pong and tennis and their parts”.²¹⁵

The Federal Patent Court concluded that there is a likelihood of confusion between the two marks in question in the sense of Art. 9(1)(b) for the following reasons:²¹⁶

1. The senior CTM has average distinctiveness.
2. The sport bags of the opposing mark are partially identical and, for the rest, highly

214 *Butterfly v. Butterfly System, 27 W (pat) 74/07 (28 April 2008)*, at 2 – 3.

215 *Butterfly, supra* note 214, at 3.

216 *Butterfly, supra* note 214, at 7 – 9.

similar with the junior mark's application for "backpacks, travel bags, bags".

3. The two marks in question are similar. The two marks are noticeably different from the denominative-graphical perspective due to the colored elaboration of the word-graphic mark of the junior mark application and due to the element "system" that is present in the junior mark. However, from the phonetic point of view, the first component of the opposed mark "butterfly system" coincides with the opposing mark "Butterfly".

Furthermore, a likelihood of confusion can only be affirmed when the overall impression conveyed by the more complex mark is the same as the overall impression conveyed by the simpler mark, such that the rest of the components are left in the background and therefore overlooked. The ultimate question is then whether the overall impression that the junior mark conveys is solely "butterfly". In the present case, the element "system" exclusively is perceived as descriptive of the relevant goods. For backpacks and other bags, the side pockets could be organized or be detachable and separately stored under a certain system. The words "butterfly system" in combination do not convey a different overall meaning from "butterfly".

4. The two marks will be mentally associated through their common word element "butterfly". The public would recognize the two marks as different, however, due to the same dominant element the public would erroneously conclude that they come from the same or from economically-linked undertakings.

5. Beverage bottle, W (pat) 23/06 (23 April 2008)

German Federal Patent Court

The application to register the mark represented below for Class 32 "beer, shandy, mineral water, carbonated waters and other non-alcoholic drinks; sorbett and fruit juice; syrup and other compounds for the preparation of drinks" and Class 33 "alcoholic drinks (excluding beer)" was filed. The mark is shown below:



This owner of the senior CTM (shown below) registered for Class 32 “beer, mineral water, carbonated, sorbet and fruit juice; syrup and other compounds for the preparation of drinks” and Class 33 “alcoholic drinks (excluding beer), liquor, spirituous liquor, wine”.



The German Patent and Trade Mark Office rejected the opposition on the grounds that there is no likelihood of confusion between the two marks.²¹⁷

The Federal Patent Court affirmed the Office’s decision on the following grounds:

1. The CTM has a low degree of distinctiveness, which precludes a finding of a likelihood of confusion in the present case. The protected mark is a green bottle with a neck twisted in spiral-form. It is a fact that for the relevant products, a large number of

²¹⁷ Beverage bottle, W (pat) 23/06 (23 April 2008), at 2 – 4.

green long-neck bottles are used. The spiral-twisted bottleneck has only low degree of distinctiveness.

2. The goods in question are identical.

3. The marks are similar.

4. The end consumer will, from experience, think that a bottle or another packaging of a product works only as a functional and aesthetic design and not as indication of the origin or as distinctive characteristics of the products.²¹⁸ A special design of the product itself or of its packaging is therefore necessarily attributed more to the attempt for a functional and aesthetic design than to the intention to indicate its origin.²¹⁹

In conclusion, the Court found that the existence of a likelihood of confusion is negated despite the identity of the products and dismissed the appeal by the CTM holder because the CTM has a very low distinctiveness and therefore a very narrow scope of protection in which the opposed mark does not step in.²²⁰

6. Gallus v. Gaius, 26 W (pat) 89/07 (22 April 2008)
German Federal Patent Court

The application to register the word **Gaius** for the products “leather and fake leather, as well as goods made thereof; textile goods; clothing articles, shoes, headpieces” was filed at the German Patent and Trade Mark Office.

The claimant filed an opposition against the registration of the word Gaius based on two CTMs: First, the word-graphic mark shown below

218 BGH Mitt. 2000, 506 ff. - Likörflasche; Erdmann GRUR 2001, 609, 612

219 BGH GRUR 2004, 329, 330 – Käse in Blütenform; GRUR 2007, 780 ff., Rdn. 26 – Pralinenform

220 Beverage bottle, *supra* note 217, at 7 – 10.



and second, the registered word-mark GALLUS, both for the products “leather and fake leather, as well as goods made thereof”.²²¹

The Patent and Trade Mark Office rejected the opposition due to lack of a likelihood of confusion. The goods were partially identical. However, from the phonetic perspective, “Gaius” and “Gallus” convey a clearly different overall impression. The structure of the syllables is also different. “Gaius” will be pronounced as “Ga-jus”, where on the other side, “Gallus” is pronounced as “Gal-lus”. The phonetic difference is so pronounced that it will not be easily ignored. Furthermore, from the word-graphic point of view there is also no likelihood of confusion due to the graphic difference.²²²

The Federal Patent Court affirmed the Office’s decision of lack of a likelihood of confusion on the following grounds:²²³

1. The level of distinctiveness of the CTMs is average.
2. The goods of the junior mark are partially identical to the goods protected by the CTMs.
3. There is no similarity between the marks in question from the graphical point of view. The word-graphic CTM has a specific graphic arrangement and includes the element “SINCE 1880”. There is also no phonetic similarity, as the difference in pronunciation of “i” and “ll” are not to be ignored. The Office correctly determined that

221 *Gallus v. Gaius*, 26 W (pat) 89/07 (22 April 2008), at 2 – 3.

222 *Gallus*, *supra* note 221, at 4.

223 *Gallus*, *supra* note 221, at 5 – 7.

“iu” will be contracted into a “j” and so the junior mark will be pronounced as “Ga-jus”. On the other side, due to the “ll” in the senior mark, it will be pronounced as “Gal-lus”, which differs from the pronunciation of “Gaius”. Also graphically is the CTM different due to the “i” instead of the “ll”, the difference to be seen in particular when the word “GALLUS” is written in capital letters.

In conclusion, the Court found no likelihood of confusion between the marks in question, and therefore, no infringement of the CTMs.

7. SOGRAPE v. Sograf, 26 W (pat) 84/06 (05 March 2008)

German Federal Patent Court

The application to register the mark **Sograf** for the products “alcoholic drinks (excluding beers) from Bulgaria” was file at the German Patent and Trade Mark Office.

The claimant filed an opposition against the registration of the mark **Sograf** based on the senior registered CTM **SOGRAPE** for the products “alcoholic drinks (excluding beers)”.

The German Patent and Trade Mark Office concluded that there is a likelihood of confusion. Considering the identity of the goods and the average level of distinctiveness of the CTM, the marks were phonetically not different enough. The element “GRAPE” will not be recognized as an English word, therefore, the marks coincide in the part “Sogra” which is the dominant part against the unaccented word endings “f” and “PE”.²²⁴

The Federal Patent Court reversed the Office’s decision due to the lack of a likelihood of confusion based on the following reasons:²²⁵

1. The level of distinctiveness of the CTM is average.
2. There is identity of goods since the broader term “alcoholic drinks (excluding

224 SOGRAPE v. Sograf, 26 W (pat) 84/06 (05 March 2008), at 2 – 3.

225 SOGRAPE, *supra* note 224 , at 4 – 7.

beers)” encompasses the narrower term “alcoholic drinks (excluding beers) from Bulgaria”.

3. Concerning the degree of similarity between “Sograf” and “SOGRAPE”: there is not enough phonetic similarity to justify an existence of a likelihood of confusion. The reason is that the average consumers will notice the remaining differences in the overall impression left by the marks. Indeed both marks begin with the same syllable “SO”, and word-beginnings will generally be given more attention than the rest of the word.²²⁶ For that reason, the differences in the rest of the words will be less remembered. However, there are exceptions to this rule, and this case is one of these exceptions. The word “Sograf” gives no indications to recognize as a foreign language. It is important to consider the marks also from the English language since the relevant goods (wines) are also produced by some English-speaking countries, e.g. USA and Australia. A considerable proportion of the consumers will recognize the term “GRAPE”.

In the German pronunciation, the marks clearly differ phonetically, as they will be pronounced “So-graf” versus “SO-GRA-PE”. In an English language rendition, both marks coincide in the number and structure of the syllables. However, the different in the vowel “a” versus “e” and also in the end-consonant “f” versus “P” display a significant and substantial difference in the overall impression. If pronounced in German, the element “Graf” stands out, which contributes to the differences of the marks from the phonetic point of view. In case of an English pronunciation, the word component “GRAPE” also decreases the risk of confusion.

There is also not enough similarity from the visual point of view. Indeed they coincide in the part “Sogra”. But as opposed to this coincidence, there are still differences that decrease the visual similarity between the marks that are enough to prevent confusion when purchasing

4. The relevant average consumer, who is deemed to be reasonably informed,

226 BGH GRUR 1998, 924, 925 - salvent/Salventerol; GRUR 2003, 1047, 1049 – Kellogg’s/Kelly’s.

attentive of the relevant products. Purchasers will not always exercise special care or attention when purchasing alcoholic drinks.

8. BUENA VISTA v. Buena Vista, 27 W (pat) 92/07 (22 January 2008)

German Federal Patent Court

The application to register the mark **Buena Vista** for the Class 9 (audio cassettes, records, compact discs, video cassettes, laser video cassettes, DVDs; CD-ROMS; cinema films, DVD-Player, DVD-recorders, MP3-players; mini-discs, computers; computer games; computer software; computer hardware; computer keyboards; computer monitors, etc.) and Class 28 (gaming and entertaining machines with winning chances, betting machines, etc) products was filed at the German Patent and Trade Mark Office. Opposition was raised against this application based on the registered CTM **BUENA VISTA** registered for Class 9 and Class 41 (production, presentation, marketing and rental of films, etc) products.²²⁷

The German Patent and Trade Mark Office for Class 28 sustained the opposition based on the phonetic and visual identity of the marks and the average distinctiveness and the remote similarity of products and services justify a likelihood of confusion. The owner of the opposed mark appeals this decision, alleging that the goods protected by its mark are not similar to those protected by the opposing mark (by the CTM) because his goods are special goods that required governmental approval and are assigned to a completely different division of goods. Also their origin and marketing channels are different.²²⁸

In assessing the similarity of the goods and services, all relevant factors relating to those goods or services themselves should be taken into account, considering that there is

227 BUENA VISTA v. Buena Vista, 27 W (pat) 92/07 (22 January 2008), at 2 – 4.

228 BUENA VISTA, *supra* note 227, at 4.

interdependence between the relevant factors and in particular a similarity of the marks and the similarity of the goods. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa.

Under these rules, the Federal Patent Court affirmed the Office's decision that there is a likelihood of confusion between the marks in light of the following reasons:

1. The distinctiveness of the CTM is at least of average degree. It is not descriptive of the protected goods and services, but rather a fanciful designation that will be left in the impression on the public due to its peculiarity in relation to the relevant products and services. The question whether the mark has increased distinctiveness or whether it is even a well-known mark is left open.²²⁹

2. There is identity between the marks from the visual, phonetic and conceptual perspective.²³⁰

3. The degree of similarity between the marks in dispute is not so low as to preclude the existence of a likelihood of confusion. In light of the identity between the marks and the average distinctiveness of the senior CTM, a likelihood of confusion can only be negated when the relevant goods are totally different or when the degree of similarity is very low, both of which could not be established by the owner of the opposed mark.

In assessing the similarity of the goods and services, factors such as their nature, the purpose for which they are used and their method of use, whether they are in competition with each other or are complementary, the product's manufacturers and their relevant distribution channels and retail outlets must be considered.

In our present case, the degree of similarity cannot be considered less than slightly below average. The opposed mark's products fall within the broader term of electronic and computerized devices, to which also protected products in Class 9 belong, particularly, "computers, computer games, computer software, and computer hardware". The relevant goods from both sides belong equally to the so-called entertainment

229 BUENA VISTA, *supra* note 227, at 7.

230 BUENA VISTA, *supra* note 227, at 7.

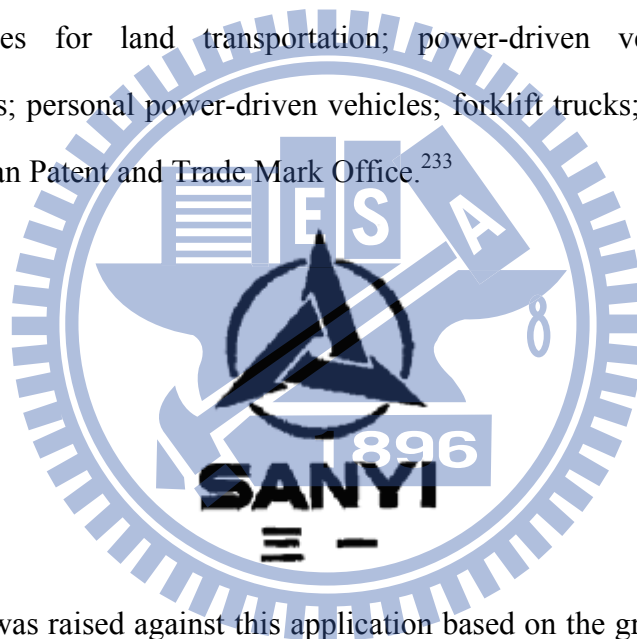
electronics sector, which serve the same purpose.²³¹

4. Association: the relevant public would likely believe that the products and services in question come from the same undertaking or from economically-linked undertakings.²³²

9. Mercedes Benz v. SANYI, 28 W (pat) 115/07 (05 December 2007)

German Federal Patent Court

The application to register the word-graphic mark shown below for the Class 12 products (vehicles for land transportation; power-driven vehicles; automobiles; omnibuses; trucks; personal power-driven vehicles; forklift trucks; car components) was filed at the German Patent and Trade Mark Office.²³³



Opposition was raised against this application based on the graphic CTM registered for Class 12 products (vehicles; devices for land, air and water transportation), represented below:



231 BUENA VISTA, *supra* note 227, at 7 – 8.

232 BUENA VISTA, *supra* note 227, at 9.

233 Mercedes Benz v. SANYI, 28 W (pat) 115/07 (05 December 2007), at 2 – 3.

The German Patent and Trade Mark Office found that even for identical products and for an increased distinctiveness of the CTM, there was no likelihood of confusion. The dominant element in the overall impression of the junior mark is the word SANYI, which follows from the case law principles that in a word-graphic mark the word will be attributed to influence overall impression of the mark due to its easiest and shortest designation. The only similarity between the marks is the combination of the trident star and a circle, which are, however, differently shaped. In the opposed mark, the radius of the circle is clearly smaller, so it crosses the star's three prongs. On the other side, the circle in the CTM circulates the star and touches the star at its points.²³⁴

The Federal Patent Court reversed the Office's decision and found an existence of a visual likelihood of confusion between the marks.²³⁵

1. The CTM enjoys a very high distinctiveness in the European Community market. Therefore, it enjoys a broader scope of protection.²³⁶
2. The products in question are either identical or highly similar.²³⁷
3. Similarity of the marks: Because of the greater protection conferred on the CTM due to its higher distinctiveness, the junior mark needs to keep a greater distance from the CTM so that a likelihood of confusion is precluded. In this case, this requisite is not satisfied because the junior comes close to a visual confusion with the CTM.

The opposed mark is a word-graphic mark, where the word element "SANYI" is of perceptible size and is at the center. Over the word element there is a figure with three identical prongs that are organized concentrically and are circled by a concentric circle whose radius is smaller than that of the prongs. Under the "A" there are three parallel lines and under the "N" there is one such line (which in the Chinese language mean "three-one", pronounced as "SANYI"), but the relevant average consumer will not

234 Mercedes Benz, *supra* note 233, at 3 – 4.

235 Mercedes Benz, *supra* note 233, at 6.

236 Mercedes Benz, *supra* note 233, at 7.

237 Mercedes Benz, *supra* note 233, at 7.

recognize the Chinese meaning of the lines under the word “SANYI”.²³⁸ These circumstances are the reasons to consider the upper element in the contested mark as a mark element with its own distinctiveness.²³⁹

Apart from this, the combined mark does not differ from CTM (which is a pure graphic mark) in any other way.

The graphic element in the opposed mark captures all the crucial elements in the mark, which are similar to that in the CTM. This coincidence suffices for a finding of a likelihood of confusion. The fact that the circle is smaller and does not touch the star’s prongs at their tips (but instead, run through the star’s prongs) is no crucial difference, since the circle runs also concentrically like the one in the CTM. The differences do not suffice to prevent a finding of a likelihood of confusion.

The case law principle that in a word-graphic mark the word will be attributed to influence overall impression of the mark due to its easiest and shortest designation is only valid on a possible phonetic likelihood of confusion. However, the case here concerns visual similarity between the marks.²⁴⁰

10. CANNABIS, 26 W (pat) 78/04 (11 October 2007)

German Federal Patent Court

The application to register the word-graphic mark shown below for the products (clothing articles, shoes, headpieces; beers with cannabis addition; mineral and carbonated water and non-alcoholic drinks, all with cannabis addition; fruit drinks and fruit juice, all with cannabis addition; syrup and other preparations for the preparation of drinks containing cannabis; alcoholic drinks excluding beers with cannabis addition) was filed at the German Patent and Trade Mark Office.

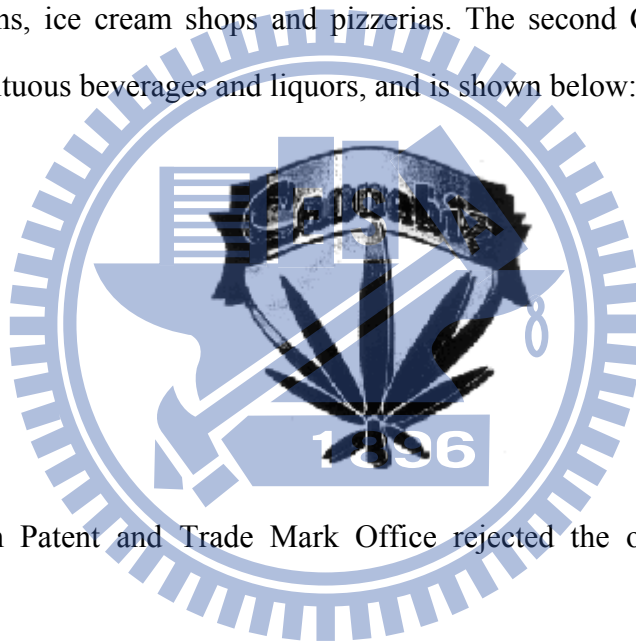
238 Mercedes Benz, *supra* note 233, at 8.

239 BGH GRUR 2006, 859 ff, ffNo. 19, 22 - Maltese cross.

240 Mercedes Benz, *supra* note 233, at 7 – 9.



Opposition was raised against this application by the owner of two CTMs. The first CTM, **CANNABIS**, is registered for the products beers, wines, spirituous beverages, liquors, champagne, sparkling wine, catering and operation of restaurants, self-service restaurants, taverns, ice cream shops and pizzerias. The second CTM is registered for beers, wines, spirituous beverages and liquors, and is shown below:²⁴¹



The German Patent and Trade Mark Office rejected the opposition of the two CTMs.²⁴²

The Federal Patent Court affirmed the Office's decision by finding a lack of a likelihood of confusion between the marks.²⁴³

There is no likelihood of confusion between the word-mark CANNABIS and the opposed mark:

1. For those identical products, the distinctive strength of the opposing mark "CANNABIS" is considerably weakened with respect to the products/services in question.

241 CANNABIS, 26 W (pat) 78/04 (11 October 2007), at 2 – 4.

242 CANNABIS, *supra* note 241, at 4.

243 CANNABIS, *supra* note 241, at 8.

“Cannabis” is the Latin scientific name for the hemp plant and is also used in colloquial language as the collective term for intoxicants made of that plant, in particular marijuana and hashish. “Cannabis” and “hemp” are often used synonymously.

Cannabis drinks (hemp drinks) have developed into popular drinks. In this way there are legalized uses of Cannabis, i.e. hemp. The descriptive characteristic of “Cannabis” as ingredient narrows the scope of protection of the word-mark “CANNABIS” in relation to drinks. Therefore, the word mark “CANNABIS” is not infringed.²⁴⁴

2. There is partial similarity between the products. As for the opposed mark’s products “clothing articles, shoes, headpieces”, there is no similarity between them and the opposing mark’s products.²⁴⁵

3. Similarity of the marks: the fact that the additional word elements “The” and “Sud” in the opposed mark are in an inferior position so that the word “Cannabis” stands out should not be taken into account. Because of the arrangement and display, as well the meaning of the words on top of one another, the mark is taken as a whole, with no reason to orient oneself to single components.²⁴⁶ The element “Club” is very common establishment designation and therefore has only low distinctiveness, so this does not prevent the mark from being taken as a whole.²⁴⁷

4. Association: Due to the low distinctiveness of “Cannabis” and also due to the assumption of the mark “Cannabis Club” as a whole, direct confusion and confusion by association can be precluded.²⁴⁸

There also is no likelihood of confusion between the word-graphic CTM and the opposed mark based on the following reasons:²⁴⁹

1. The word-graphic CTM as a whole displays by itself an average degree of distinctiveness. However, regarding that the element “Cannabis” has a descriptive

244 CANNABIS, *supra* note 241, at 9.

245 CANNABIS, *supra* note 241, at 9.

246 BGH GRUR 1999, 586, 587; 2004, 598, 599 - Kleiner Feigling

247 CANNABIS, *supra* note 241, at 10.

248 CANNABIS, *supra* note 241, at 10 – 11.

249 CANNABIS, *supra* note 241, at 11 – 12.

character of the relevant goods, the distinctive force of the CTM is reduced.

2. There is partial similarity between the products.

3. There is no visual similarity between the marks. Both marks display a stylized hemp plant which is only of descriptive character for the relevant goods.

In sum, the German Community trade mark Courts assessed the degree of similarity of the marks and the goods of services in each of the ten cases analyzed. Concerning the similarity of the marks, the German approach is that what matters is the overall impression made by the respective signs, with comparison not confined to their individual components. When one of two marks in question is part of the other, similarity is found only if the identical component dominates the more complex mark. In general, similarity is found only if the identical component "dominates" the more complex mark. Such domination is made possible if the component is more distinctive than the rest of the mark. Descriptive or associative components are normally not dominant.

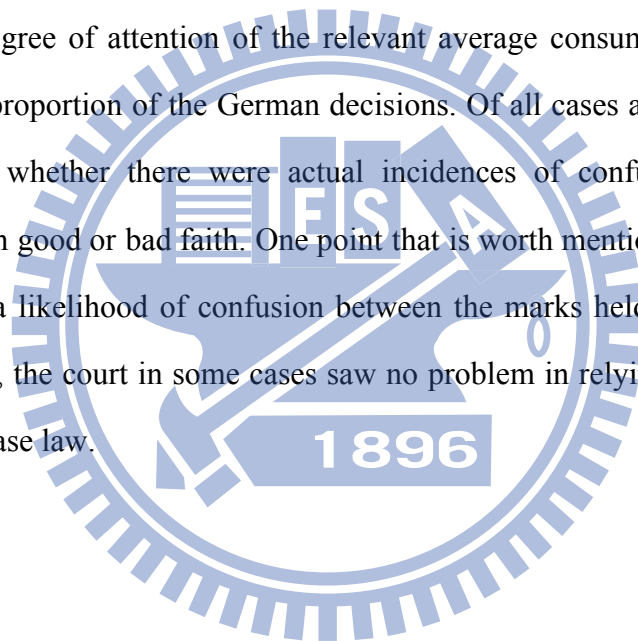
The German Courts also emphasized the distinctiveness of the senior mark, and to a slightly lesser degree, the association that the public might make between the two marks. The German Bundesgerichtshof (Federal Supreme Court) confirmed that the original distinctiveness of an senior trade mark, which is relevant for the question of whether a junior mark falls into its scope of protection, and which, in the affirmative, results in a confirmation of a likelihood of confusion, is also determined by the status of registration. If a number of more or less similar trade marks are registered for identical or similar goods and/or services without their owners taking any steps against the registration of more or less comparable trade marks, this might be an important indication that the mark at issue has a limited scope of protection only, because it consists of used-up word elements of minor original character.²⁵⁰

As with the Spanish and UK Community trade mark Courts, the German Community

250 BVerfG, NJW 1999, 361.

trade mark Courts did not assess in all ten cases analyzed the three factors that were emphasized in the CTMR recitals. These three factors are 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. The difference is that the German Courts analyzed the association which average consumers make between the two marks in question, whereas this same factor was considered in all Spanish and German cases. However, the distinctive character of the senior mark was analyzed in a higher proportion of German cases than of Spanish or UK cases.

Lastly, the degree of attention of the relevant average consumer was considered in only a very low proportion of the German decisions. Of all cases analyzed, there was no consideration of whether there were actual incidences of confusion or whether the defendant acted in good or bad faith. One point that is worth mentioning is that regarding the existence of a likelihood of confusion between the marks held by the parties under Art. 9(1)(b) CTR, the court in some cases saw no problem in relying on German as well as on European case law.



Chapter 5 – Analysis of the elements for a likelihood of confusion

Section 1 - Analysis of the Community trade mark Courts' judgments and observations of their differences

Even though all Community trade mark Courts should be consistent in assessing the existence of a likelihood of confusion and are required to follow the criteria set in the preliminary rulings of the European Court, this is in reality not the case. They are sometimes influenced by their national jurisprudence or give different interpretations to the sometimes uncertain legal concepts set by the European Court of Justice, and thereby arriving at different decisions. Therefore, even though the Community trade mark Courts' decisions cite the rules laid down by the European Court of Justice, there is still a possibility for different decisions and different results when faced with the question of assessing the existence of a likelihood of confusion.

The focus of this thesis is on the case law of the German, Spanish and UK Community trade mark Courts regarding the standards for the determination of a likelihood of confusion in infringement proceedings. In the table below, we can see in what proportion of the analyzed cases the Community trade mark Courts of these three Member States considered the distinct factors when assessing the existence of a likelihood of confusion.

	Factors	Spain	UK	Germany
1	Distinctive character of the senior mark	63.6%	85.7%	90%
2	Similarity of the marks	100%	100%	100%
3	Similarity of the goods/services	100%	100%	100%
4	Association	100%	100%	70%
5	Relevant average consumer	90.9%	71.4%	20%
6	Actual incidences of confusion	9.1%	71.4%	0%
7	Good faith	9.1%	0%	0%
8	Prior Community or national decisions	0%	0%	0%

[Table by author]

From those cases analyzed in the present thesis, the Spanish Community trade mark Courts always considers the similarity of the marks and goods or services. When assessing the degree of similarity between the marks, the Courts assess the phonetic and conceptual similarity, and also take account the dominant elements of the marks. When the dominant elements are identical, there is similarity of marks. Moreover, in the case of complex (mixed) marks, the Courts consider that the phonetic and denominative similarities are decisive, not the visual similarity, the reason being that things are asked by their names.

The Spanish Community trade mark Courts also considered in all cases analyzed the association that the public might make between the two marks. Moreover, emphasis was put on the degree of attention of the relevant average consumer and the distinctiveness of the senior mark. However, the Spanish Community trade mark Courts considered in only one of the cases analyzed whether there were actual incidences of actual confusion and whether the defendant acted in bad faith or not.

With respect to the United Kingdom Community trade mark Court decisions that were analyzed, the similarity of the marks and goods or services, as well as the

association that the public might make between the two marks, were always considered. The distinctive character of the CTM, the degree of attention of the relevant average consumer, and actual incidences of confusion were considered in most, though not all, cases.

A decision worth mentioning is the *Treat* case.²⁵¹ The *Treat* case was the first case of an English court in which the criteria regarding similarity of goods and services under the Trade Marks Act 1994²⁵² had to be considered. Here, Mr. Justice Jacob first dealt with similarity between the goods, denying risk of confusion owing to a lack of similarity between the goods and services at issue, without, however, taking into account the similarity between the two trade marks in question. Mr. Justice Jacob found it essential to separate confusion from similarity.

Regarding section 10(2) of the Trade Marks Act 1994, Justice Jacob emphasized the following:²⁵³ *The sub-section does not merely ask “will there be confusion?”; it asks: “is there similarity of goods”, if so, “is there a likelihood of confusion?”. The point is important. For is one elides the two questions, then a “strong” mark would get protection for a greater range of goods than a “weak” mark. For instance “Kodak” for socks of bicycles might well cause confusion, yet these goods are plainly dissimilar from films or cameras. I think the question of similarity of goods is wholly independent of the particular mark, the subject of the protection, or the defendant’s sign.*

Similarly, in another British case, *British Sugar*²⁵⁴, the approach was also to assess the likelihood of confusion in two stages. The first step was to decide whether there was

251 R.P.C. 281 (1996); E.T.M.R. 118 (1997).

252 The Trade Marks Act 1994 is the law governing trademarks within the United Kingdom and the Isle of Man. It implemented the First Trade Mark Directive and replaced an earlier law, the Trade Marks Act 1938.

253 S.10(1) of the UK Trade Marks Act 1994 is worded as follows: “A person infringes a registered mark if he used in the cause of trade a sign where because

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark”.

254 *British Sugar plc v. James Robertson & Sons*, 1996 RPC 281.

similarity of goods. If there was, it was then necessary to ask whether the marks were so similar as to engender a likelihood of confusion. That is, the British Sugar test says that likelihood of confusion is to be dealt with separately from and subsequently to the questions of whether the sign is similar to the registered mark and whether the goods on which the sign is used are similar to those for which the mark is registered.

Clearly, this view is entirely opposed to the assessment of risk of confusion as determined by the ECJ.²⁵⁵

Lastly, the German Community trade mark Courts assessed the degree of similarity of the marks and the goods of services in each of the cases analyzed. Concerning the similarity of the marks, the German approach is that what matters is the overall impression made by the respective signs, with comparison not confined to their individual components. When one of two marks in question is part of the other, similarity is found only if the identical component dominates the more complex mark. In general, similarity is found only if the identical component "dominates" the more complex mark. Such domination is made possible if the component is more distinctive than the rest of the mark. Descriptive or associative components are normally not dominant.

The German Courts also emphasized the distinctiveness of the senior mark, and in a slightly lesser degree, the association that the public might make between the two marks. The German Bundesgerichtshof (Federal Supreme Court) confirmed that the original distinctiveness of an senior trade mark, which is relevant for the question of whether a junior mark falls into its scope of protection, and which, in the affirmative, results in a confirmation of a likelihood of confusion, is also determined by the status of registration. If a number of more or less similar trade marks are registered for identical or similar goods and/or services without their owners taking any steps against the registration of more or less comparable trade marks, this might be an important indication that the mark at issue has a limited scope of protection, because it consists of used-up word elements of

255 Gert Wurtenberger, *A Risk of Confusion in Community Trade Mark Law: First Contours in Case Law of the European Court of Justice and the Harmonisation Office*, 21(10) E.I.P.R. 508-518 (1999)

minor original character.²⁵⁶

Moreover, the degree of attention of the relevant average consumer was considered in only a very low proportion of the German decisions. Of all cases analyzed, there was no consideration of whether there were actual incidences of confusion or whether the defendant acted in good or bad faith. One point that is worth mentioning is that regarding the existence of a likelihood of confusion between the marks held by the parties under Art. 9(1)(b) of the CTMR, the court in some cases saw no problem in relying on German as well as on European case law.

Also, in the Community trade mark Court cases analyzed, the three Member States Spain, UK and Germany assessed each factor in different proportions when determining the existence of a likelihood of confusion. The similarity between the marks in question and the similarity between the goods or services in question were factors that were always assessed in each of the Spanish, United Kingdom, and German cases analyzed in this thesis. The association that the public might make between the two marks in question was considered in all Spanish and UK cases analyzed, but only in 70% of the German cases analyzed in this thesis.

The distinctive character of the senior mark was analyzed in a very high proportion of the Community trade mark Court cases of these three Member States, being the highest percentage of 90% in Germany, followed by 85.7% in the United Kingdom, and 63.6% in the Spanish Community trade mark Courts.

The degree of attention of the relevant average consumer was a factor analyzed in only 20% of the German Community trade mark Court cases. However, the proportions of the analysis of this factor were much higher in Spain and in the United Kingdom, namely 90.9% and 71.4%, respectively.

Moreover, actual incidences of confusion were not a factor considered at all in the

256 German Federal Supreme Court [1999] N.J.W. 361.

German Community trade mark Court decisions analyzed in this thesis. In Spain, this factor was considered in only a very limited proportion of the cases, namely 9.1%. In the United Kingdom, however, this factor was assessed in a much higher proportion, namely 71.4%.

The factor of whether the owner of the junior mark acted in good faith was considered in only 9.1% of the Spanish Community trade mark Court decisions analyzed, while it was not considered at all in the United Kingdom and German Community trade mark Court decisions analyzed. Lastly, the existence of prior Community or national decisions involving conflicts between the same or similar marks was not considered at all in any of the analyzed cases of these three Member States.

Section 2 - Comparison between the EU standards and the US standards

The United States Courts of Appeals have devised various tests to determine the likelihood of confusion. Each Circuit Court looks at a different list of factors that are largely similar with only slight differences. The most famous the list of factors to be considered when determining a likelihood of confusion comes from *Polaroid Corporation v. Polarad Electronics Corporation*²⁵⁷, a case from the Second Circuit.

In the *Polaroid* case, the Second Circuit listed the following factors as being determinative of the likelihood of consumer confusion. These are commonly called the *Polaroid* factors, named after the Second Circuit case:

1. The strength of the senior mark;
2. The degree of similarity between the two marks;
3. The degree of similarity between the products or services covered by the marks;
4. The likelihood that the plaintiff will bridge the gap;
5. Evidence of actual confusion of consumers;

²⁵⁷ *Polaroid Corporation v. Polarad Electronics Corporation*, 287 F.2d 492 (2nd Cir.), cert. denied, 368 U.S. 820 (1961).

6. The defendant's good faith in adopting the mark;
7. The quality of the defendant's product or service; and
8. Consumer sophistication.

In the table below, the left column displays the Polaroid factors for the assessment of a likelihood of confusion, while the right column displays the factors for the assessment of a likelihood of confusion followed by the ECJ and the OHIM.

USA (Polaroid, 2nd Circuit)	European Union
All factors must be considered.	Likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. Likelihood of confusion depends in particular on: the recognition of the trade mark on the market, the association that the public might make between the two marks, and the degree of similarity between the signs and the goods (ECJ, OHIM).
The strength of the senior mark.	The recognition of the trade mark on the market (ECJ).
The degree of similarity between the two marks.	The degree of similarity between the signs (ECJ).
The degree of similarity between the products or services covered by the marks.	The degree of similarity between the goods (ECJ).

Evidence that the senior user may “bridge the gap” by developing a product for sale in the market of the alleged infringer’s product.	
Evidence of actual consumer confusion.	Incidences of actual confusion (OHIM). (Coexistence of the conflicting marks on the market in the same territory).
Evidence that the junior mark was adopted in bad faith.	
The respective quality of the products.	
The sophistication of consumers in the relevant market.	The degree of sophistication and attention of the relevant public (ECJ, OHIM).
	Prior decisions by Community or national authorities involving conflicts between the same (or similar) marks (OHIM).
	The association that the public might make between the two marks (ECJ).

[Table by author]

One basic difference between the factors applied by the Community trade mark Courts and the United States Courts when assessing the existence of a likelihood of confusion is that the US Courts put an emphasis on the degree of the strength of the senior mark. That is, the degree of distinctiveness of the senior mark is a very important factor and is always assessed. However, this was not a factor that was analyzed in every of the Community trade mark Court cases analyzed. As mentioned earlier, 90% of the German Community trade mark Courts, followed by 85.7% in the United Kingdom Community trade mark Courts and 63.6% in the Spanish

Community trade mark Courts considered this factor.

Moreover, in the case of the CTM, the appreciation of the likelihood of confusion depends in particular on the recognition of the trade mark on the market, on the association that the public might make between the two marks and the degree of similarity between the signs and the goods.²⁵⁸ That is, the association that the public might make between the two marks is a crucial factor that the Courts should apply when assessing the existence of a likelihood of confusion. Even though it is considered a crucial factor and it was applied in all Spanish and UK cases analyzed, it was only applied in 70% of the German Community trade mark Court cases that were analyzed in this thesis. However, this factor is not particularly mentioned by the United States Courts when determining a likelihood of confusion.

There is also the difference that in the European Community, a CTM is given protection when there is a “double identity”. That is, when the two marks are identical and also the goods or services are identical, the protection afforded by the registered CTM is absolute. The owner of the CTM is entitled in such a case to prevent any third party not having his consent from using in the course of trade any sign which is identical to its CTM in relation to goods or services which are identical with those for which the CTM is registered.²⁵⁹ However, the US Courts still apply all the factors even when there is a double identity. That is, protection for the registered CTM does not immediately follow from the identity between the two marks in question and the identity between the goods or services for which the CTM is registered and the other mark is used.

258 Sabèl, *supra* note 59, at paragraph 22.

259 CTMR, *supra* note 1, preamble 7 and Art. 9(1)(a).

Chapter 6 – Conclusions

In this thesis, the author has introduced the CTM system and the elements for the assessment of a likelihood of confusion developed by the ECJ and the OHIM.

The Member States of the European Union have all committed to trade mark law harmonization, which is crucial to achieving consistent jurisprudence throughout the European Union so that free movement of goods and freedom to provide services within the common market is not hindered.

The Community trade mark Courts, which are national courts designated by each Member State to hear cases related to CTMs, have to follow the rules set out in the CTMR and the case law of the European Court of Justice, where the European Court of Justice developed the factors for the assessment of a likelihood of confusion. Even though all Community trade mark Courts should have a unanimous and consistent parameter in assessing the existence of a likelihood of confusion and are required to follow the criteria set in the preliminary rulings of the European Court of Justice, in reality this is not the case.

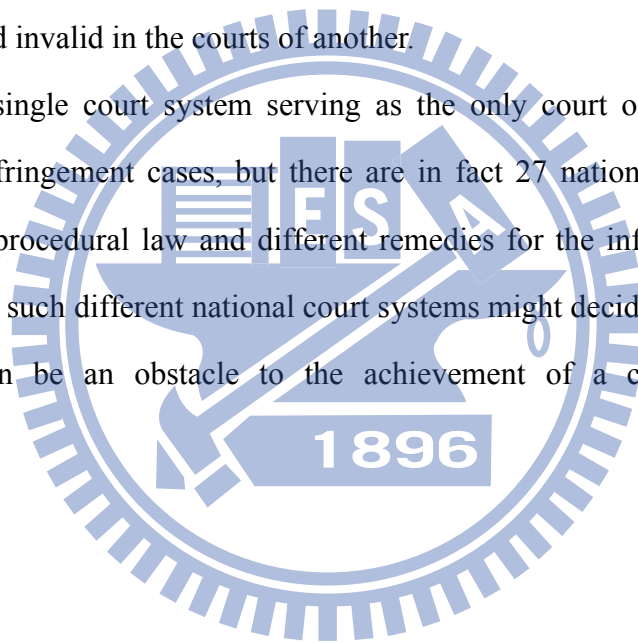
The Community trade mark Courts have to make an overall assessment taking into consideration various criteria for the assessment of a likelihood of confusion developed by the European Court of Justice. Since most of the criteria developed by the European Court of Justice are uncertain legal concepts, they still leave room for interpretation and it is very difficult to have every single court draw the same conclusions and assess the circumstances in the same way.

In this thesis, a total of twenty eight Community trade mark Court cases were analyzed: eleven Spanish cases, consisting of all Spanish Community trade mark Court cases between 2007 and 2009 that are related to the analysis of a likelihood of confusion for the CTM; seven United Kingdom cases, consisting of those United Kingdom Community trade mark Court cases after 2004 that concern the likelihood of confusion

for the CTM; and lastly, ten German Community trade mark Court cases, consisting of those German Community trade mark Court cases after 2007 that are related to the likelihood of confusion for the CTM.

When examining whether the public is likely to be confused, the ECJ has pointed out that the likelihood of confusion has to be "appreciated globally taking into account all factors relevant." However, from the cases analyzed in this thesis we observe that not in all cases were all relevant factors assessed. Each of the three Member States' Community trade mark Courts assessed the different relevant factors in different proportions. This implies that it would be possible for a trade mark to be declared valid in the courts of one Member State and invalid in the courts of another.

There is no single court system serving as the only court of last instance that is competent for infringement cases, but there are in fact 27 national court systems with different sets of procedural law and different remedies for the infringement of a CTM. The reality is that such different national court systems might decide in different ways for a same case can be an obstacle to the achievement of a consistent trade mark jurisprudence.



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