

How the EUIPO assesses Likelihood of confusion

Article 8(1)(b) EUTMR

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

*(b) if, because of its **identity with, or similarity** to, the earlier trade mark and **the identity or similarity of the goods or services** covered by the trade marks there **exists a likelihood of confusion** on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.*

Change of practice - T- 349/22, 01.02.2023, HACKER/HACKER SPACE

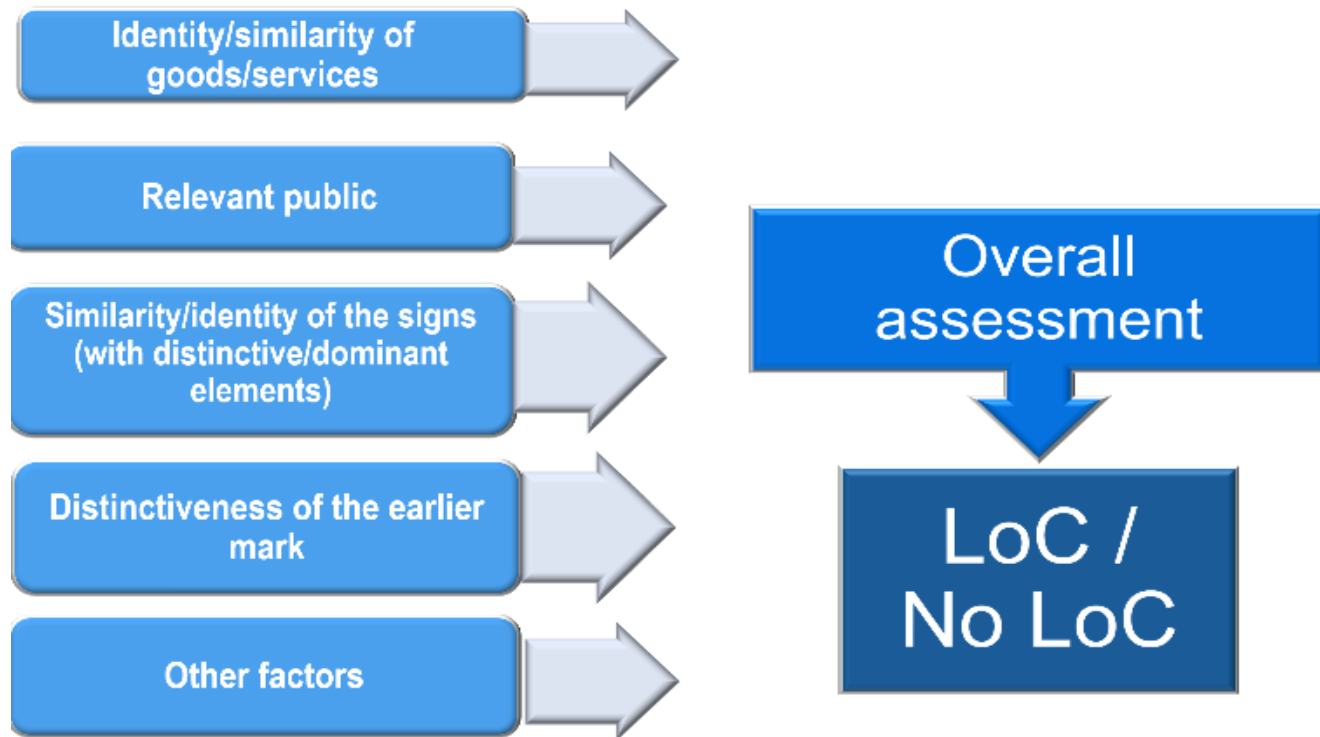
from the **NOTICE OF OPPOSITION**
(including documents *within the 3-month OPPO period*):

- Art. 8(1)(a)EUTMR - the only ground: **NO ASSESSMENT** under Art. 8(1)(b)EUTMR
- Art. 8(1)(b)EUTMR - the only ground: **ALSO ASSESSMENT** under Art. 8(1)(a)EUTMR

Unitary character EUTM



Article 8(1)(b) EUTMR



The goods and services - Canon (C-39/97)

Chocolate goods v. Cocoa



- nature • Identical
- purpose • Different: end /raw product
- method of use • Different: eating/drinking, cooking
- distribution • Identical: same retail outlet
- public • Identical: general consumer
- origin • Identical: same companies
- complementary • In a way yes
- competition • Not really

SIMILARITY



The goods and services - Canon (C-39/97)

Chocolate goods v. Coffee, tea, ice, sugar, salt



- | | |
|---------------|--------------------|
| nature | • Different |
| purpose | • Different |
| method of use | • Different |
| distribution | • Different |
| public | • Identical |
| origin | • Different |
| complementary | • Different |
| competition | • No competition |



DISSIMILARITY

The goods and services - Canon (C-39/97)



Flour Confection



Sugar Confection



Chocolate Confection



Other Confection

Confectionary includes chocolate goods so
IDENTITY

Similarity tool

Similarity

[Home](#) [Compare terms](#) [Compare list of terms](#)

▼ Similarity » Compare terms

Search language <input type="text" value="English (en)"/>	Term <input type="text" value="Search term"/>	Term <input type="text" value="Search term"/>	Degree of Similarity <input type="text" value="Any"/>
Results language <input type="text" value="English (en)"/>	Nice Class <input type="text" value="1-45"/>	Nice Class <input type="text" value="1-45"/>	Pair ID <input type="text" value="123-456"/>
* Advanced criteria		VS	

Results

 Download as Excel file

Show <input type="text" value="25"/> entries							
Pair ID	Office	Class 1	Term 1	Similarity	Class 2	Term 2	
0047463-0046914	EUIPO (EM)	29	Dried fruit	Identical	29	Fruit, preserved	
0046500-0036097	EUIPO (EM)	16	Stationery	Identical	16	Stickers [stationery]	
0046410-0029607	EUIPO (EM)	30	Sweetmeats [candy]	Identical	30	Fondants [confectionery]	
0046340-0012553	EUIPO (EM)	16	Bookbinding material	Identical	16	Paper	
0046162-0035467	EUIPO (EM)	30	Sugar	Identical	30	Glucose for culinary purposes	
0042510-0015006	EUIPO (EM)	16	Debit cards without magnetic coding	Identical	16	Printed matter	
0042465-0035568	EUIPO (EM)	38	Telecommunication services	Identical	38	Rental of telephones	

Relevant public

RELEVANT PUBLIC



Similarity of the signs

Visual – what you see

Aural – what you hear

Conceptual – what you think

Weak or non-distinctive elements?

Dominant = visually outstanding



Distinctiveness of the earlier mark - CP5

COSMEGLOW

VS.

COSMESHOW

(Class 3: Cosmetics)

Distinctiveness of the earlier mark

When evaluating likelihood of confusion:

- ✓ The distinctiveness of the earlier mark as a whole is assessed (at least certain degree).
- ✓ The distinctiveness of all elements of the earlier mark and of the later mark is also assessed, prioritising the coinciding elements.

Distinctiveness of the earlier mark

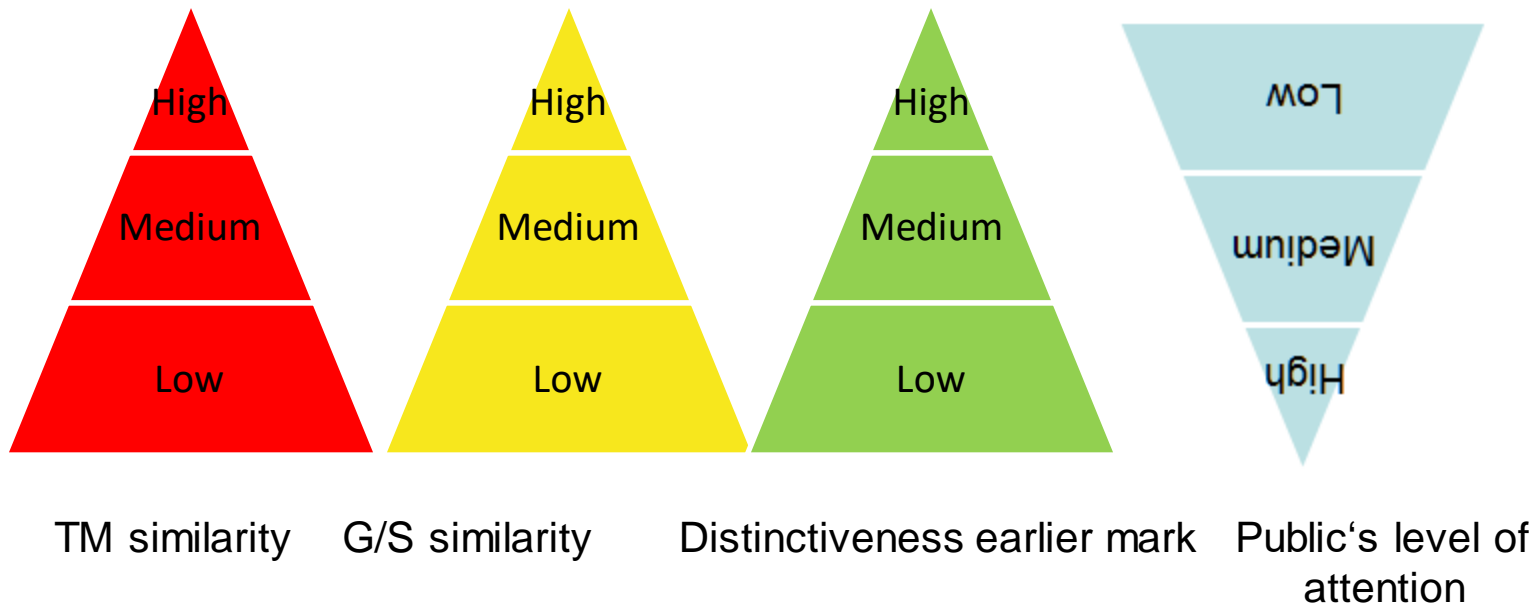


Overall assessment – method of purchase

The category of goods or services and the way they are marketed
(22/09/1999, [C-342/97](#), Lloyd Schuhfabrik, EU:C:1999:323, § 27).



Overall assessment - principle of interdependence



Overall assessment- CP5

COSMEGLOW

VS.

COSMESHOW

(Class 3: Cosmetics)

Overall assessment

- A coincidence only in a non-distinctive element will not lead to LOC
- When marks also contain other figurative and/or word elements which are similar, there will be LOC, if the overall impression of the marks is highly similar or identical.

COSMEGLOW

vs.

COSMESHOW

(Class 3: Cosmetics)

Distinctiveness of the earlier mark - CP5



(Class 30: Tea)

Other factors

- **Family/series of marks (at least 3)**
- **Evidence of actual confusion**
- **Prior decisions**

[T-301/09](#)

CITIBANK,
CITIGOLD,
CITICORP,
CITIBOND,
CITICARD,
CITIEQUITY, etc.

CITIGATE

Other factors

- **Coexistence agreement: not binding on the office**
- **Consent in invalidity**
 - **Possible to file before the application of invalidity**
 - **Only for already registered marks**
 - **Not required in inter partes proceedings**

TM5 – opposition study

TM5

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Lead Office



CNIPA



EUIPO

This project plans to deepen users' understanding of the practice of trademark opposition and appeal (review) provide information to the users on how to protect their legitimate rights and interests more effectively through system and practice of trademark opposition and appeal (review) in TM5 Partner offices and by typical cases.

New!

[Opposition: Legal system information study](#) PDF[Opposition: Typical opposition cases](#) PDF[Link to
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Thank you