

EUIPO

Relative Grounds of Refusal

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*Technical Training on Trademarks for Examiners and
Engagement with IP Agents of ARIPO Member States*

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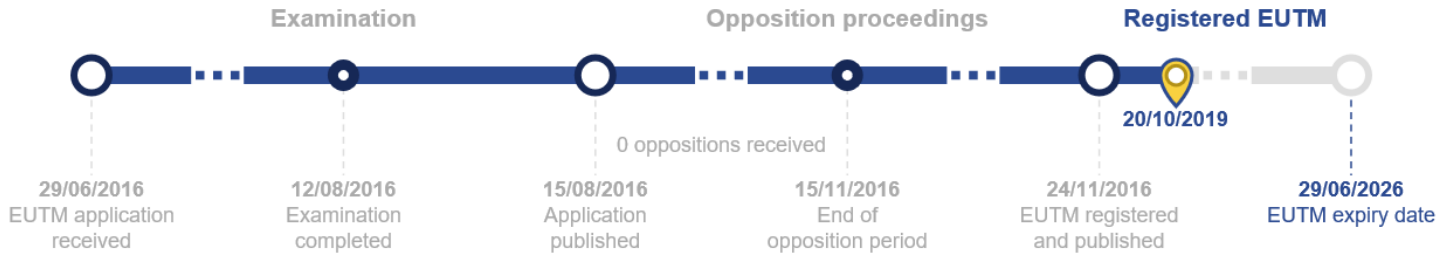
Harare, Zimbabwe

Overview

1. Absolute grounds vs Relative grounds for refusal
2. Article 8 EUTMR
3. Earlier marks for the purposes of Article 8(1) EUTMR
4. Double identity (Article 8(1)(a) EUTMR)
5. Likelihood of confusion (Article 8(1)(b) EUTMR)
 - Comparison of goods and services
 - Relevant public and degree of attention
 - Comparison of signs
 - Distinctiveness of the earlier mark
 - Overall assessment and other factors
6. Unauthorised filing by agent/representative (Article 8(3) EUTMR)
7. Unregistered marks and other signs (Article 8(4) EUTMR)
8. Trade marks with reputation (Article 8(5) EUTMR)
9. PGI/PDO (Article 8(6) EUTMR)
10. Proof of use

Absolute Grounds vs Relative Grounds for refusal

Timeline




ABSOLUTE
grounds for refusal


RELATIVE
grounds for refusal

Absolute Grounds vs Relative Grounds for refusal

AG
Article 7 EUTMR



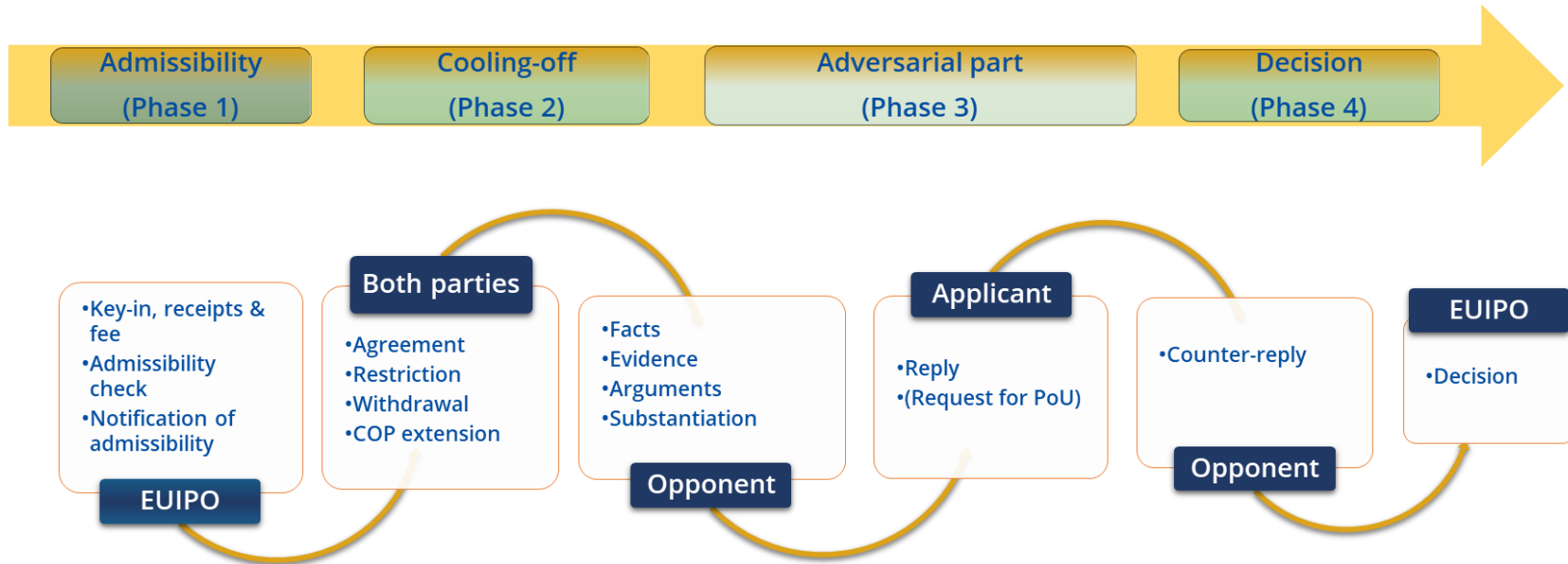
RG
**Opposition and cancellation
proceedings**



ARTICLE 8 EUTMR

- **Art. 8(1) EUTMR - Double identity / Likelihood of confusion**
- **Art. 8(2) EUTMR - Definition of “earlier marks”**
- **Art. 8(3) EUTMR - Unauthorised filing by agent/representative**
- **Art. 8(4) EUTMR - Unregistered marks and other signs**
- **Art. 8(5) EUTMR - Marks with reputation**
- **Art. 8(6) EUTMR - PGI/PDO**

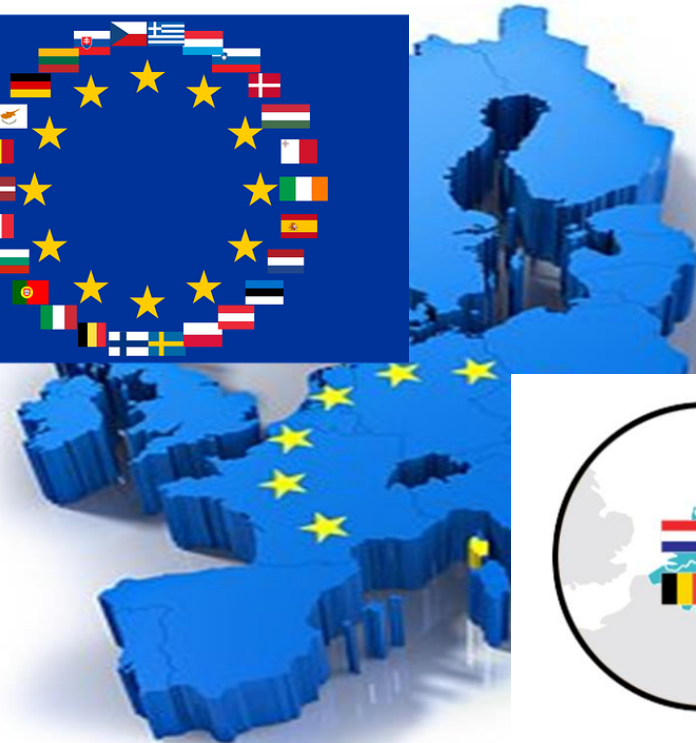
Introduction – Quick overview of opposition proceedings



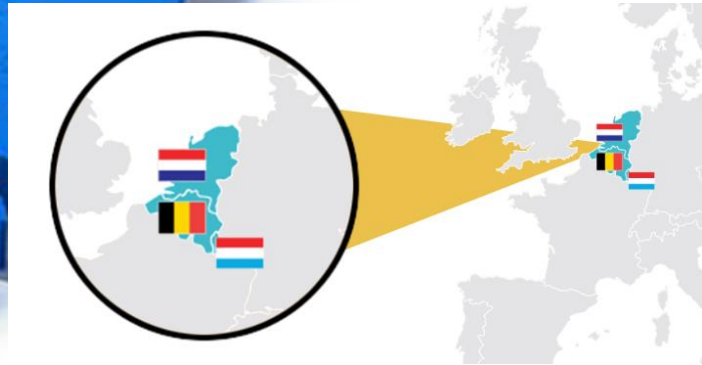
ARTICLE 8 EUTMR

Article 8(2) EUTMR

- trade mark of the country of origin
- EUTM
- Natio
- application
- well-known

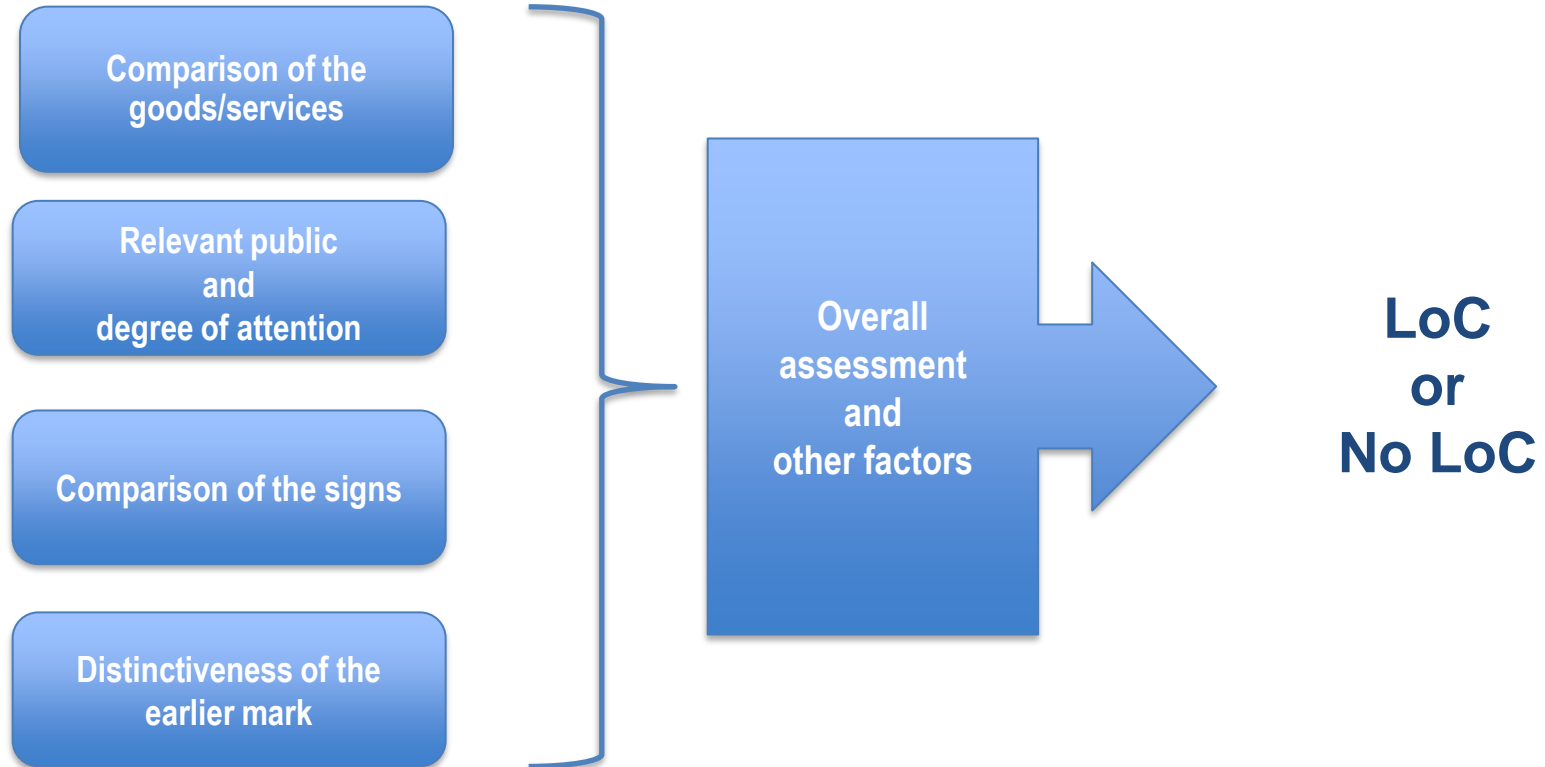


application
ities:



IX

LIKELIHOOD OF CONFUSION : ARTICLE 8(1)(b) EUTMR



COMPARISON OF GOODS AND SERVICES

Identity is generally defined by the nature, properties, or in particular

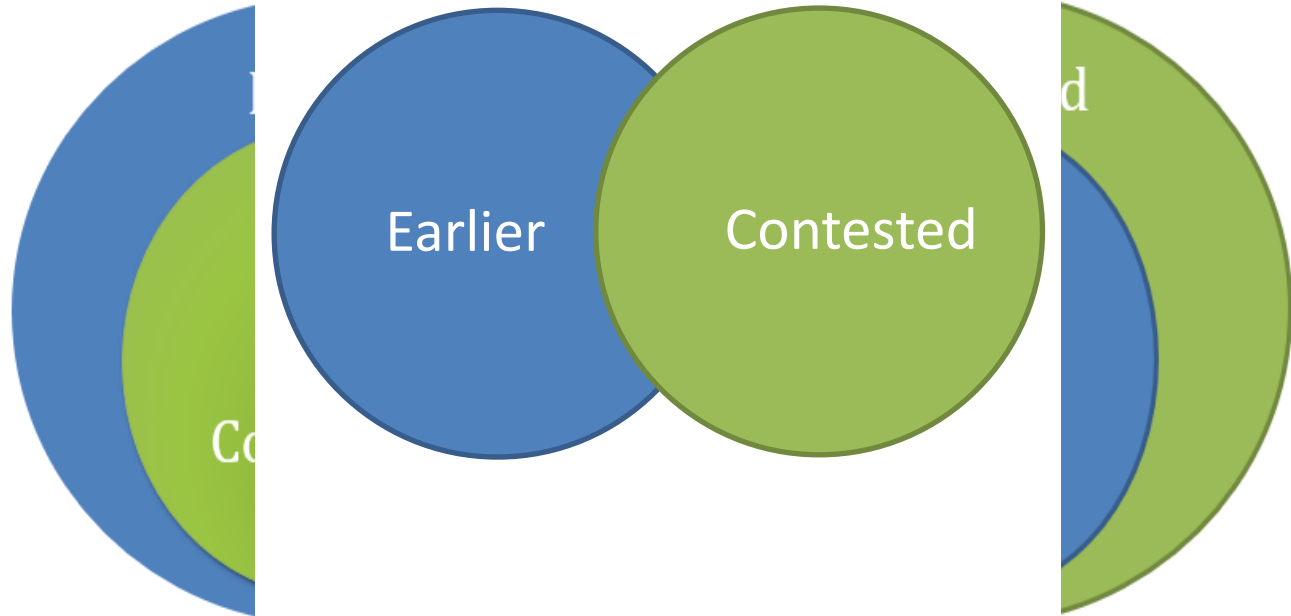
Identity exists when:

the goods and services compared (used)

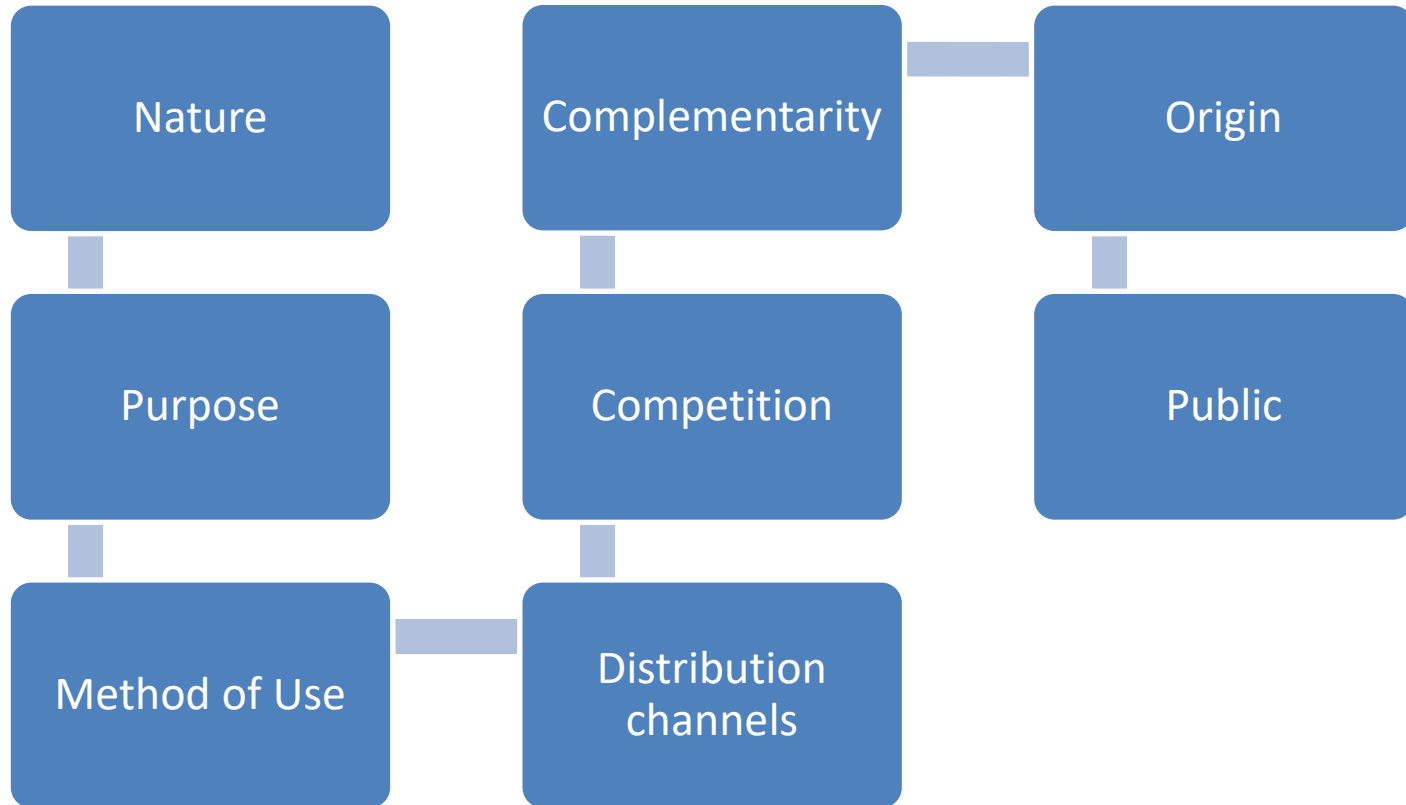
a broader term of the contested

the contested mark's goods/services

two broad categories under comparison



COMPARISON OF GOODS AND SERVICES: SIMILARITY – CANON CRITERIA



COMPARISON OF GOODS AND SERVICES



Similarity

Milk and cheese (both in Class 29) have a different purpose and method of use; they are not in competition or complementary. However, the fact that they share the same nature (dairy goods) and usual origin (dairy company) is decisive for a finding of similarity. Not all factors have the same weight.

COMPARISON OF GOODS AND SERVICES

Dissimilarity

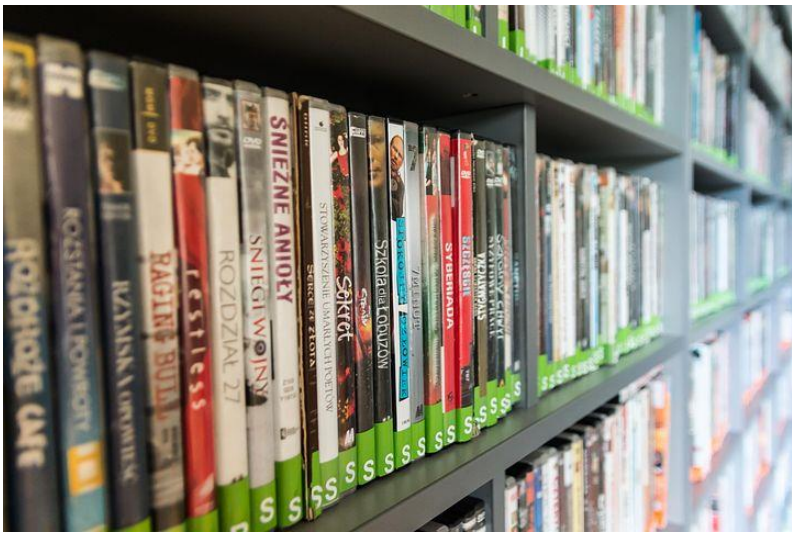
Explanation: The mere fact that a certain product can be composed of several components does not automatically establish similarity between the finished product and its parts. Similarity will only be found in exceptional cases and requires that at least some of the main factors for a finding of similarity, such as producer, same public and/or complementarity, are present. Goods (or services) are complementary if there is a close connection between them, in the sense that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking. E.g. 'milk' and 'coffee' are not complementary in this sense, since – although they are often consumed together – they are not indispensable or important for the use of the other.



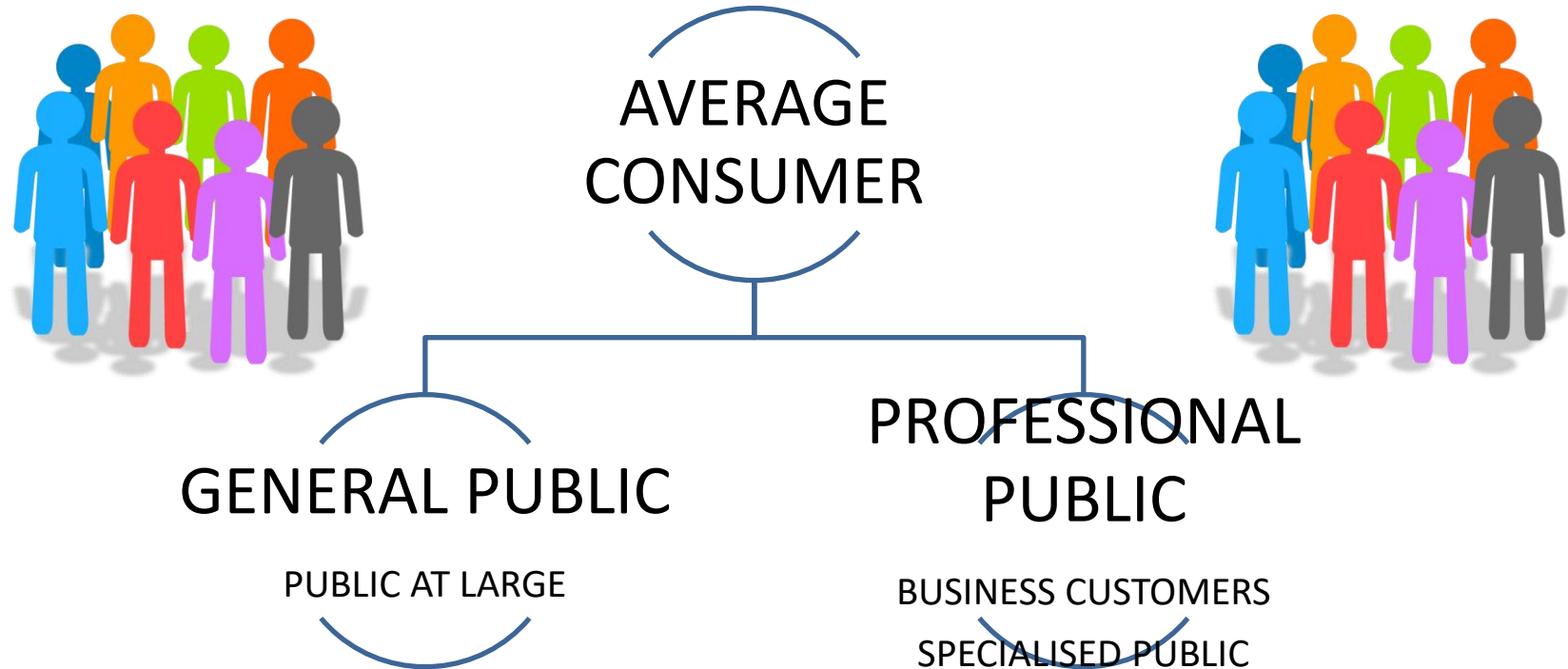
COMPARISON OF GOODS AND SERVICES

Dissimilar

Explanation: Goods and services can never be identical due to their different nature. Rental/leasing services are in principle always dissimilar to the goods rented/leased. Exceptions exist only where it is common for the manufacturer of the goods to provide rental services (e.g. the ‘rental of automatic vending machines’ is similar to a low degree to ‘automatic vending machines’).



RELEVANT PUBLIC AND DEGREE OF ATTENTION



RELEVANT PUBLIC AND DEGREE OF ATTENTION

Medicine in class 5.

The general public **as well as** professional consumers.

Explanation: The relevant public comprises both the general public and health professionals, such as doctors and pharmacists. Consequently, even though the choice of those products is influenced or determined by intermediaries, a likelihood of confusion can also exist for the general public, since they are likely to be faced with those products, even if that takes place during separate purchasing transactions for each of those individual products at various times. In practice, this means that the likelihood of confusion will be **assessed against the perception of the general public, which is more prone to confusion** (the more vulnerable group).



RELEVANT PUBLIC AND DEGREE OF ATTENTION

Only the professional public

Application applies for **'Polish for metals'** which is sold both to professional consumers (i.e. the metal working industry) and to the public at large e.g. in order to clean their silverware. By contrast, the earlier right has registered 'preparations for cleaning pipes for the metal-working industry' which do not target the general public. Therefore, the relevant public that is likely to encounter both marks consists **only of the professional public**.



Costume jewellery

When purchasing expensive goods, the consumer will generally exercise a higher degree of care and will buy the goods only after careful consideration. Furthermore, a higher degree of attention can be the consequence of brand loyalty. However, **costume jewellery** is jewellery made from cheap materials, therefore, the relevant public will **not be** highly attentive.



COMPARISON OF SIGNS

Comparison of the signs

COMPARISON OF SIGNS

The Court has held that the global appreciation of the visual, aural and 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 (Judgment of 11/11/1997, C-251/95, 'Sabèl', EU:C:1997:528, § 23)

Three aspects of the comparison:



- **Visual** – what the consumer sees
- **Aural** – how the consumer pronounces the element
- **Conceptual** – the concept(s) that the sign brings

Taking into account:

- **Distinctive elements** – **may vary depending on G&S**
- **Dominant elements** – **visually outstanding**

In the relevant territory



COMPARISON OF SIGNS

QUIZ TIME

Clothing in class 25 - LOC or no LOC ?



(earlier mark)



(contested sign)

NO LOC

Generally, in clothing shops, customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff.

Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is **generally made visually**.

Therefore, visual perception of the marks in question will generally take place prior to purchase. Accordingly, **the visual aspect plays a greater role in the global assessment of the likelihood of confusion**.

IMPACT OF VISUAL COMPARISON



Clothing in class 25 - LOC or no LOC ?



(earlier mark)



(contested sign)

LOC

The visual similarities led to a likelihood of confusion

IMPACT OF THE VISUAL SIMILARITIES



Goods in classes 32 and 33- LOC or no LOC ?



(earlier mark)



(contested sign)

LOC (Judgement of the GC of 14/12/2006, in cases T-81/03, T-82/03 & T-103/03)

Where the signs have the **same distinctive concept** in common **accompanied by visual similarities** between the signs, this may lead to a likelihood of confusion even in the absence of a particularly high distinctiveness of the earlier mark.

IMPACT OF THE CONCEPTUAL CONCEPT



Alcoholic drinks in class 33, LOC or no LOC

MIXERY

(earlier mark)

MYSTERY

(contested sign)

LOC Jugement GC of 15/01/2003, T-99/01, Mystery

Where goods are ordered orally, the phonetic perception of the sign may also be influenced by factors such as the likely presence of various other sounds perceived by the recipient of the order at the same time.

Such considerations are relevant where the goods in question are normally ordered at sales points with an increased noise factor, such as bars or nightclubs. In such cases, attaching particular importance to the phonetic similarity between the signs at issue may be appropriate.

IMPACT OF PHONETIC SIMILARITIES



DISTINCTIVENESS OF THE EARLIER MARK



GLOBAL ASSESSMENT AND OTHER FACTORS

INTERDEPENDENCE PRINCIPLE

Similarity of the G&S

Degree of attention

Distinctiveness of
the earlier mark



Relevant public

Similarity of the signs

Other
Factors

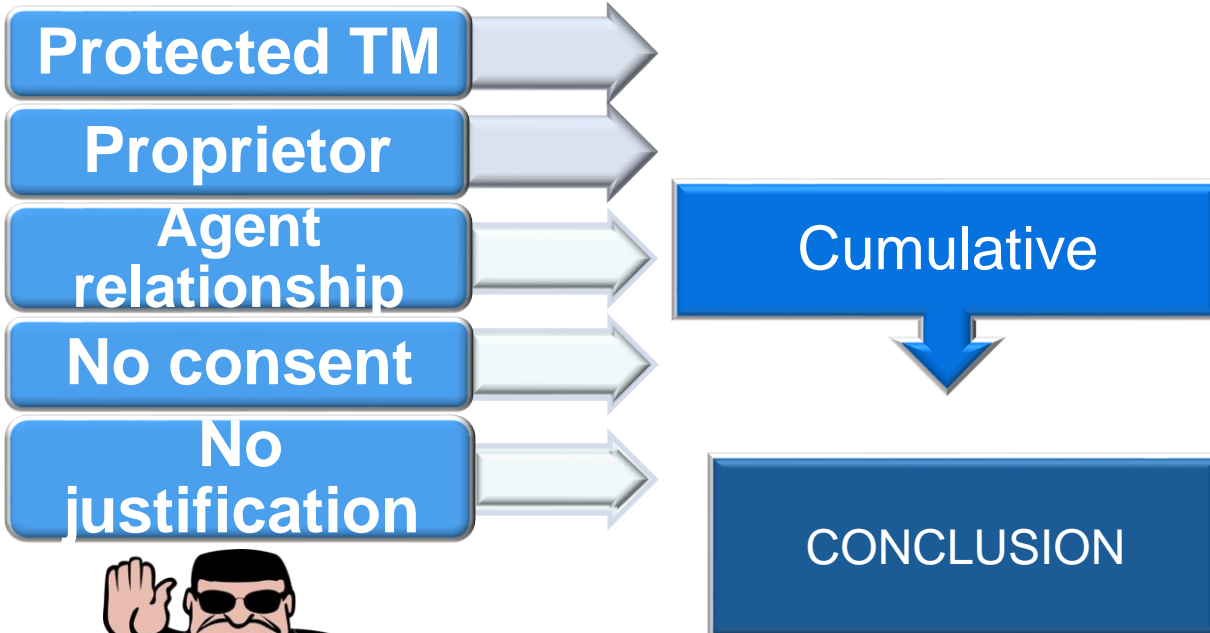
Market

Real
confusion

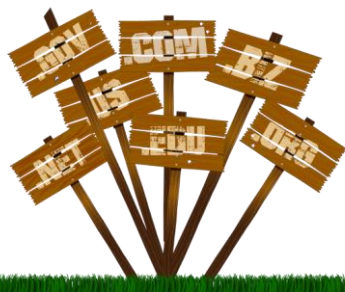
Co-
existence

Prior cases

(Article 8(3) EUTMR) - Unauthorised filing by agent/representative



Article 8(4) EUTMR - NON-REGISTERED MARKS AND OTHER SIGNS USED IN TRADE



Earlier right

Use in trade

More than mere
local significance

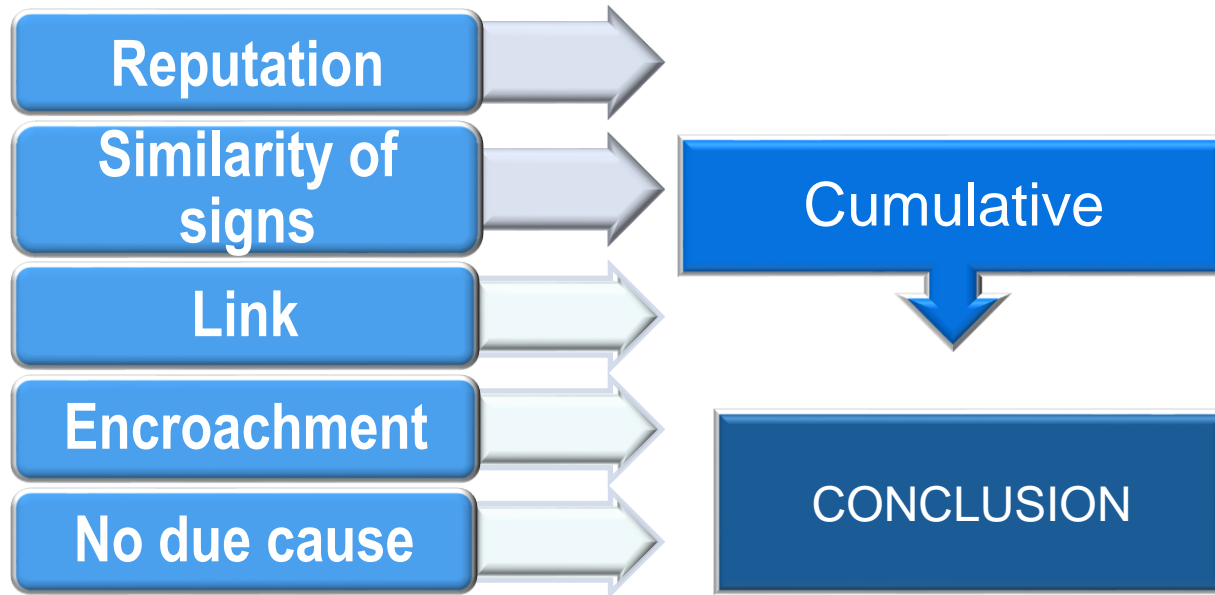
Right to prohibit

Cumulative

CONCLUSION



Article 8(5) EUTMR - TRADE MARKS WITH REPUTATION



Article 8(6) EUTMR - PDO / PGI

- A new specific ground for PGIs/PDO
- Article 8(6) EUTMR
- For oppositions filed on or after 23/03/2016
- Not required to prove use in the course of trade of more than mere local significance



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PDO



PGI

Article 47(2)-(3) EUTMR - PROOF OF USE



- Defence in opposition proceedings



- Attack in cancellation proceedings

- **If earlier mark registered for more than 5 years**
- **5 years preceding the filing/priority date of the EUTM application**
- **Genuine use (place, time....)**
- **Unless proper reasons for non-use**



thank you 😊

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