

OPPOSITION GUIDELINES

PART 2

CHAPTER 1:

IDENTITY

Draft, DIPP

Status: July 2006

Introduction to Part 2

Chapter 1 deals with the concept of identity, i.e. identity of the marks and the goods and services.

Chapter 2 focuses on the core concept of *inter partes* proceedings: likelihood of confusion.

Part A deals with general aspects relating to that concept. It sets out, in particular, the pertinent case law of the Court of Justice and explains how to assess likelihood of confusion.

Part B addresses similarity of goods and services. It discusses the various relevant factors, namely nature, purpose, method of use, complementary and competitive character, channels of distribution, the relevant public, and the usual origin of the goods and services. Part B also shows how to apply these factors to some specific categories of goods and services.

The subject of Part C is the similarity of the signs. It covers, in particular, the criteria that should be applied for the visual, phonetic and conceptual comparison. Part C also specifically elaborates on signs that are partly or wholly included in other signs.

The final Part D of Chapter 2 corresponds to the final part of decisions in opposition cases. It explains how the global assessment of all the factors that are relevant for determining likelihood of confusion must be made. Part D deals with, in particular, the distinctiveness of the earlier mark, the impact of the kind of goods and services on the assessment of the similarity between the signs and the degree of sophistication and attention of the relevant public.

INDEX

Introduction to Part 2.....	2
CHAPTER 1: IDENTITY ART. 8(1)(a) CTMR.....	4
I. THE NOTION OF IDENTITY.....	4
1. Identity as a condition for the application of Article 8(1)(a).....	4
2. Identity of goods and services.....	4
2.1. Terminology	5
2.2. Determining the wording of the goods and services to be considered	5
2.2.1. The proper language version of the specifications	5
2.2.1.1.Community trade marks	5
2.2.1.2.Earlier national marks and international registrations.....	6
2.2.2. The relevant scope of the specifications.....	6
2.3. Determining the meaning of the wording of the goods and services to be considered	8
2.3.1. In general	8
2.3.2. The use of identical terms or synonyms	9
2.4. The earlier mark includes the goods/services of the CTM application.....	9
2.5. The CTM application includes the goods/services of the earlier mark.....	10
2.6. One specification includes the goods/services of the other and the broader specification uses all or part of the indications of the class heading of one class	11
3. Identity of signs	12
3.1. Strict Identity	12
3.2. Word marks.....	13
3.3. Figurative marks	13
II. IDENTITY AS A GROUND.....	14
1. Relationship to Article 8 (1) (b) CTMR	14
2. Structure of Opposition decisions.	14

CHAPTER 1: IDENTITY ART. 8(1)(a) CTMR

Article 8 (1)(a) CTMR provides that upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected.

This is called double identity.

The criteria for identity (of goods and services or of the signs) are of course also of relevance for the application of Article 8 (1) (b) CTMR, namely for the finding of identity of signs where the goods are similar or vice-versa.

Furthermore, as regards goods and services, the general notions and definitions contained in this chapter are also of relevance in the context of similarity of goods and services, which is the subject of Part B of Chapter 2.

I. THE NOTION OF IDENTITY

1. Identity as a condition for the application of Article 8(1)(a)

The wording of Article 8(1)(a) requires an identity between both the signs concerned and the goods and services covered. Whether the respective marks are identical or not is an objective fact that can in principle be directly established from the comparison of the two conflicting trade marks (and the goods and services protected by them) as filed or registered. It is immaterial how the marks are used. (Except in the case where proof of use is required and the mark is deemed registered only for those goods for which use has been shown, see 2.2.2 below and Chapter 6.)

The protection conferred on the earlier mark by Article 8(1)(a) is absolute. The wording of this provision does not make its applicability dependent on any additional requirements. In particular, there is no need for any likelihood of confusion to be established.

It is sometimes said that in these situations confusion is inevitable because both the signs and the goods in dispute are identical, as the public will be in no position to distinguish between the marks.

48/1998 GALLUP / GALLUP (EN)

However, the provision in Article 8 (1)(a) CTMR is not based on factual considerations of this kind; rather, the double identity means that likelihood of confusion is irrebutably presumed.

2. Identity of goods and services

2.1. Terminology

A good is be any kind of item which may be traded

Example: Electricity and computer software are “goods” although not physically tangible.

Salt and water are “goods” although not man-made.

Products are individual items sold by an individual manufacturer that have the same properties/appearance.

Example: The Volkswagen Golf and the Opel Astra are identical goods (cars) but different products.

Sometimes in common parlance “products” is used for services, e.g. “financial products” instead of financial services. Whether a term is, in common parlance, described as a “product”, is not material for it being classified as a good or as a service.

Rather, the Nice Classification is controlling for considering an item a “good” or a “service”.

Service is the provision of activities in accordance with human needs.

Example: Repair is a service.

Being a pianist (the activity of playing piano) is not a service. Giving piano lessons (service rendered to the pupil) Giving a piano concert is a service rendered by the pianist to the organizer and the piano concert is a service rendered by the organizer to the public.

Advertising one’s own goods is not a service but running an advertisement agency (designing advertisement campaigns for third parties) is.

Terms appearing in specifications of services such as “advertisement” must therefore be meant to cover (only) the above definition of services.

Selling or distributing one’s own goods is not a service. “Retail services” are meant to cover the services around the actual sale of goods, such as providing the customer with an opportunity to conveniently see, compare or test the goods.

Using the term “products” as a synonym to “goods” should be avoided in OD decisions.

2.2. Determining the wording of the goods and services to be considered

2.2.1. The proper language version of the specifications

As a preliminary matter, the correct wording of the specifications under consideration must be identified.

2.2.1.1. Community trade marks

An application for a Community trade mark shall be published in all the official languages of the Community (Article 116(1)). Likewise, all entries in the Register of Community trade marks shall be made in all these languages (Article 116(2)). Publications of both applications and entries made in the Register are made in the Community Trade Marks Bulletin (Rule 85(1) and (2)).

In practice occasional discrepancies may be found between

- the translation of the wording of the specification of a Community trade mark (application or registration) published in the Community Trade Marks Bulletin, and
- the original wording as filed.

In case of such discrepancy, the controlling version of the list of goods and services is

– if the first language of the application is not one of the five languages of the Office, the text in the second language indicated by the applicant (see Article 116(3));

- if the first language is a language of the Office, the first language.

This applies indiscriminately whether the CTM (or CTM application) is the earlier right or the contested application.

R 203/2001-4 – JET AVIATION/ JET (ES)
1267-2001 MOVICOM / MOBILCOM (EN),
3091/2000 HOM / XOM (FR).

2.2.1.2. Earlier national marks and international registrations

In case of doubt the original language, and not the translation into the language of the proceedings according to Art. 115 and Rule 17(2), is controlling.

For international registrations under the Madrid Protocol, the language in which the international registration was registered is controlling (either French, English or Spanish).

2.2.2. The relevant scope of the specifications

The comparison of the goods and services must be based on the wording indicated in the respective specifications. The actual or intended way of use of the goods is not relevant for the examination.

503/1999 PLENUR (cl. 5) / PLENUM (cl. 5) (EN)

However, if proof of use of the earlier mark is validly requested and the submitted evidence is sufficient only for part of the goods in the specification, the earlier mark is deemed to be registered for only those goods (Article 43(2)), and consequently the examination is restricted to these goods.

However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks. The concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

If a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services covers the entire category for the purposes of the opposition.

Example:

In the case of providing proof of genuine use of a mark in respect of a 'product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)', which is a 'polish for metals' within the meaning of the sub-category of goods to which the earlier mark relates, the applicant properly establishes that the mark had been put to genuine use for sub-category 'polish for metals'. That description restricts, with regard both to the function of the goods concerned, polishing, and to their intended purpose, for metals, the category of goods covered under the Nice Agreement: 'cleaning, polishing, scouring and abrasive preparations' within Class 3 of the Nice Agreement, 'Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices'.

T-126/03 – ALADIN/ ALADDIN, para. 42 et seq.

When the opponent shows that there have been proper reasons for non-use, only those goods or services for which such proper reasons exist are to be compared.

Moreover, in the case of the earlier mark, only the goods and services on which the opposition is validly based are pertinent. Hence, no account will be taken of the goods/services

that cannot be taken into account for reasons of admissibility, that have not been properly substantiated (e.g. only a partial translation of the specification was filed), or on which the opposition is not, or no longer, based.

Similarly, only those goods and services of the contested application against which the opposition is directed are taken into consideration. Consequently, restrictions during the proceedings of either the specification of the application, or the scope of the opposition, or of both, will limit the goods and services to be compared.

Furthermore, a grammatical interpretation of the wording of the specification might be required to determine the scope of the goods and services of the two specifications. This is especially true where terms such as “in particular”, “namely”, or equivalents are used in order to show the relationship of an individual product with a broader category. The term “in particular” (or “for example”, “such as”, or other equivalent) indicates that the specific products are only examples of items included in the category, and that protection is not restricted to them. On the other hand, the term “namely” (or “exclusively” or other equivalent) is exclusive and restricts the scope of the registration only to the specifically listed goods.

For example, in the case of *chemicals used in industry, namely raw materials for plastics* only the *raw materials for plastics* have to be compared with the goods of the other mark.

546/1999 SYS (cl. 1) / SYSTOL (cl.1) (EN).

2.3. *Determining the meaning of the wording of the goods and services to be considered*

2.3.1. *In general*

Once the wording of the goods and services to be considered has been identified, their meaning must be determined.

In some cases the exact meaning is immediately obvious from the specification of the marks where a more or less detailed description of the goods and services will often be given. For example, the wording *belts, being articles of clothing* excludes by definition safety or industrial belts.

97/1999 MOTOR JEANS (cl.25) / MOTO (cl.25) (EN)

In cases of doubt about the exact meaning of the terms used in the specification, these terms have to be interpreted both in the light of the Nice Classification and from a commercial perspective.

10/1999 M(cl.39) / M (cl.20, 22, 25) (EN),
964/1999 THE GREY LINE (cl.39) / GREYLINE (cl.18, 25, 28) (EN).

Where the meaning of terms in semantic context, commercial context and /or under the Nice Classification differs, the meaning it has under the Nice Classification prevails. *Clothing*, for instance, may or may not be interpreted as including *footwear*. It is standing practice of the Opposition Division and in BoA and CFI case-law that footwear is *not* included in clothing, the essential reason being that footwear appears as a separate item in the same class 25.

2831/2001, Underground, Underground Shoes / London Underground (fig) (EN),
3175/2000, UNDERGROUND, Underground Shoes / London Underground (fig) (EN).

1087 / 2001, a (fig) / a (fig) confirmed in this point by BoA R 634/2001-1 of 11.2.2002 and CFI T-115/02 - a/ a.

2.3.2. *The use of identical terms or synonyms*

Identity between the goods or services in dispute must be established on the basis of the wording of the relevant parts of the specifications of the two marks that have been identified in accordance with the principles set out above. Identity is obvious where the goods or services to be compared are listed in both specifications in exactly the same terms.

35/1998 SIENA / LA SIRENA (FR).

Where this is not the case, the terms of the respective specifications must be interpreted in order to show that they are in fact synonyms, i.e. that their meaning is the same. The interpretation must be made from a commercial perspective.

Examples:

Interpretation of the goods or services

Bicycle is a synonym for *cycle*.

1548/2001 DRIVE (fig) / I-DRIVE (EN)

Interpretation of other terms used in the specification

The meaning of the words “articles” and “requisites” is identical. Therefore, the goods *smokers’ requisites* in class 34 and *smokers’ articles* that are also included in class 34 are identical.

1109/2001 EXPRESS / STATE EXPRESS (EN)

In doubt the conclusion should be against identity.

2.4. *The earlier mark includes the goods/services of the CTM application*

Where the specification of the earlier right includes a generic term that covers the goods or services of the contested application in their entirety, the goods and services will be identical.

Automobiles and parts and fittings thereof (CTMA) were considered to be included in *motor land vehicles and parts and fittings therefor* (earlier right) and, therefore, were considered identical.

R 969/2000-1 S-TYPE / S-CLASS (EN)

Pasta (the applicant’s specification) designates any of several variously shaped edible preparations made from a flour and water dough, such as

spaghetti, and thus belongs to the general category of *preparations made from cereals* (protected by the opponent's trade marks). Therefore, the conflicting goods were considered identical.

1769/2001 MEGABITE/MEGABITE (fig) (EN)

2.5. *The CTM application includes the goods/services of the earlier mark*

If one or more goods/services specifically designated in the earlier mark are covered by a generic term used in the CTM application, the goods/services must be considered identical unless

- the applicant restricts the list or
- the Office can split the list.

If the applicant does not specify/restrict the list of goods, or does so in an insufficient way, the Office will treat the application's broad term as a single unit and reject it as a whole.

Example:

The CTM application is for *articles of clothing*, the earlier mark protects *jeans*.

R 0260/1999-3 MOTO / MOTOR (fig) (EN)

A broadly defined category may consist of an indefinite number of goods/services which might be practically impossible to identify, and in this case the Office cannot split the list either.

Therefore, as long as the list is not limited by the CTM applicant, the Opposition Division should always treat the goods/services as identical.

Consequently, the practice to be followed is to consider the respective goods identical "because the specific product (X) is included in the general category (X+).

1123/1999 SETTIMA / CERTINA (EN),
1271/2000 NP / NATIONAL POWER (EN),
1267/2001 MOVICOM / MOBIL COM (EN).

Only if some of the specific goods/services included in the general category, e.g. an item of a class heading, are also listed independently in the CTM application, will it be necessary to extend the examination any further. In such cases, the result of each individual comparison does not depend on the finding concerning the general category and an identity may be denied if some of the independently listed goods of the CTM application are not identical to the goods of the earlier mark.

Example:

The CTM application covers *vehicles* (general category) as well as *buses, aircraft, trains* (included in *vehicles*), for example as follows: "vehicles, buses, aircraft, trains". Where, for instance, the earlier mark is protected for *buses*,

identity will be found with respect to *vehicles* and to *buses* but not for *aircraft* or *trains*.

The question arises how to proceed with the comparison of goods/services when the list of the CTM application consists of a general category, to which goods or services are not added independently of the general category but only as illustrations of the general category. To cover this situation, the example above can be amended, so that the specification of the CTM application reads: *Vehicles*, in particular *buses*, *aircraft*, *trains*. The earlier mark, as in the example above, is protected for *buses*.

The OD practice regarding this question is as follows: All specified goods (*buses*, *aircraft*, *trains*) are in the general category (*vehicles*). If the application is rejected for the general category, the remainder of the specified goods (*buses*, *aircraft*, and *trains*) will be rejected as well. The CTM applicant can avoid this result by deleting the general category "vehicles", the indication "in particular", and the specific category "buses".

2.6. One specification includes the goods/services of the other and the broader specification uses all or part of the indications of the class heading of one class

No different rules apply where the wording of the specification consists of the class heading provided for in the Nice Classification or one or several indications of the class heading. The Office does not object to the use of any of the class heading or one or several of its general indications as being too vague or indefinite, contrary to the practice which is applied by some national offices in the European Union and in third countries in respect of some of the general indications of the class heading or the class heading as a whole.

The Office interprets the scope of the class heading or part of it in specifications for *Community* trade marks as follows:

The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class.

- Similarly, the use of a particular general indication found in the class heading will embrace all of the individual goods or services falling under that general indication and properly classified in the same class. For example, the use of the general indication "pharmaceutical and veterinary preparations" in cl. 5 will embrace all pharmaceutical preparations regardless of their composition or indication.

- Furthermore, where it may not be obvious under which of several general indications particular goods or services fall, there is nevertheless a classification-based reasoning for the proper classification. For example, "computer software" is classified in cl. 9 because of the presence of the general indication "data processing equipment and computers" in that class, because computer software is seen as directly related to the corresponding

apparatus or equipment. Therefore, when a specification contains "data processing equipment and computers" as a general indication, this will be considered as embracing also computer software. On the other hand, where a specification lists general indications in cl. 9 but not "data processing equipment and computers", computer software will not be considered as falling within the specification.

The rule that the use of the class heading of a particular class means that all the goods/services within that class are included has the consequence that when earlier mark claims the class heading and the younger Community trade mark application contains goods or services properly classified in that same class, the goods or services are identical with the goods or services in the earlier mark.

In the opposite situation (earlier mark claims specific term falling under the class and younger application claims class heading), there is identity as regards the specific term and 2.5, above, applies (rejection as a whole unless the list is restricted).

When the specification does not include all of the general indications of a particular class heading, but only one or some of them, identity will be found only when the particular item falls under the general indication. For example, when the later mark is for "computer software", and the earlier mark is protected for "data processing equipment and computers", or when the earlier mark is protected for "pharmaceutical preparations" and the later mark is for a specific medicine, the goods will be identical.

3. Identity of signs

3.1. *Strict Identity*

The concept of identity is interpreted strictly as regards the signs.

This approach has been confirmed by the 3rd Board of Appeal in its Decision R-1/2000-3 of 19/06/2002 *Arthur et Felicie*. The Board has argued that the concept of identity has to be defined in relation to the object of Article 8(1)(a), bearing in mind the nature and effects of the rights encompassed by the Community trade mark. The Board states that the protection granted by Article 8(1)(a) CTMR is of an absolute nature because it is not conditional on the existence of likelihood of confusion nor does it require consideration of the dominant elements of the sign.

In the light of this automatic and absolute protection, the Board concludes that the interpretation of the concept of 'identity' has to be strict in order not to contradict the difference the Regulation has introduced between the ground of Article 8(1)(a) CTMR and that of 8(1)(b) CTMR.

No other considerations follow from ECJ C-291/00 "*Arthur et Felicie*". which says (par. 53) that "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” and (par. 54) “that Article 5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with 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.”

On the other hand, “differences so insignificant that they may go unnoticed” are indeed to be set aside when judging identity. What is not noticed cannot influence the finding of identity. However, in applying this principle, the notion of “insignificant differences” must be interpreted narrowly so as not to blur the difference between identity and similarity.

3.2. *Word marks*

Marks are identical if they are both word marks and if they coincide exactly in the string of letters or numbers.

Word marks are marks consisting of letters, numbers and other signs reproduced in the standard typeface used by the respective office. This means that as regards these marks no particular figurative element or appearance is claimed. Where both marks are registered as word marks, the typeface actually used by the respective office in the Bulletin is immaterial. Differences in the use of small or capital letters are immaterial.

A difference in just one letter is enough for the finding of non-identity.







314/2000	EN	SEMCO	Semco	Identical
2451/2000	EN	SAVANNAH	savannah	Identical
44/1999	EN	TELIA	teeli	Not Identical
36/1998	FR	ENIGMA	ENIGMA ITALY	Not Identical
1525/1999	EN	NOVALLOY	NOVALOY	Not Identical

3.3. *Figurative marks*

Since partial identity is not accepted, any additional element, however trivial or secondary, is sufficient to conclude that the marks are not identical; it is immaterial whether the added element is a word, a device or a combination of the two.

In particular, if one of the marks is in a distinctive typeface, such as script typeface, so that the overall appearance of the word mark is changed to that of a figurative mark, consists of standard typeface before a figurative (coloured) background or is in standard typeface represented in coloured letters, and the other mark is a word mark, there is no identity.

No identity:

31/1998	EN		BURGO
92/2001	FR	EPOCA	
1270/1999	IT		
2455/2000	EN	SAVANNAH	
204/2001	ES		RENOVA

II. IDENTITY AS A GROUND

1. Relationship to Article 8 (1) (b) CTMR

Where Article 8 (1) (a) is the only ground claimed and an identity between the signs and/or the goods cannot be established, the opposition will nevertheless be examined on the ground of likelihood of confusion, Article 8(1)(b), because the grounds in Article 8 (1) are considered as so related that an opponent's claim to identity will be construed as also being a claim to likelihood of confusion and vice-versa.

The former practice of the OD, according to which the opposition was rejected, was held to be erroneous by the Board of Appeal.

R 165/1998-2 ENIGMA ITALY / ENIGMA (FR)

Other Board decisions have affirmed this approach.

Conversely, if Article 8 (1) (b) CTMR is the only ground invoked and there is double identity, the opposition will succeed on the ground of Article 8 (1) (a) CTMR, without further analysis of the factors influencing the overall assessment of likelihood of confusion, such as use of the earlier mark.

So, in fact, Article 8 (1) (a) CTMR as a ground for opposition embraces Article 8 (1) (b) CTMR and vice-versa.

2. Structure of Opposition decisions.

For the structure of Opposition decisions, this has the following consequences:

- Where double identity is found, the opposition shall be upheld on the basis of Article 8 (1) (a) CTMR and no further analysis of Article 8 (1) (b) CTMR needs be done.

Where there is no double identity (i.e. identity only of the signs, or only of the goods, or no identity at all), the Opposition decision shall start with the analysis of Article 8 (1) (b) CTMR. If the opposition is upheld, analysis of Article 8 (1) (a) CTMR is redundant. If the opposition is rejected, Article 8 (1) (a) is, logically, the less applicable.

This applies irrespective of which of the two grounds (Article 8 (1) (a) and/or Article 8 (1) (b)) was expressly invoked by the opponent.