Practice Paper

Likelihood of Confusion
(impact of non-distinctive/weak components)
Relative Grounds of Refusal

National Intellectual Property Center of Georgia - Sakpatenti

Note from National Intellectual Property Center of Georgia - Sakpatenti

This Practice Paper has been prepared in line with the Common Communication resulting of the Common Practice of Trade Marks developed by the European Union Intellectual Property Network (EUIPN) and aimed to give guidance regarding the impact of non-distinctive/weak components of the marks at issue on the assessment of likelihood of confusion. This has been tailor-made to the specificities of National Intellectual Property Center of Georgia – Sakpatenti, providing for an overview of the Office's quality standards for received oppositions.

This Practice Paper has been adopted at national level and made public with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

1. BACKGROUND

The subject of this Practice Paper is defining the approach regarding the impact of non-distinctive/weak components of the marks at issue on the assessment of likelihood of confusion.

This Practice is made public through this Practice Paper with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

The following issues are out of the scope of the practice:

- The assessment of enhanced distinctiveness and/or acquired distinctiveness through use and/or reputation: for the purpose of this practice, it is assumed that there is no evidence and/or claim and/or previous knowledge that any of the marks are reputed or have an enhanced distinctiveness acquired through use.

- Agreement on the factors that are considered when assessing the likelihood of confusion. Although there are many factors that may have an impact in the global appreciation of likelihood of confusion, such as dominance, degree of attention of the relevant public, coexistence, market situation, family of marks, etc., it is not the objective of the practice to determine which are these factors.

- Agreement on the interdependencies between the assessment of distinctiveness and all the other factors that are considered when assessing the likelihood of confusion. Neither the criteria for the assessment of other factors which may have an impact in the global appreciation of likelihood of confusion, nor the interdependency between them are objective of this practice, which does not deal with the overall assessment of likelihood of confusion, but with one of its essential parts.

- Language issues: It is considered for the sake of the practice that marks which contain word elements with no (or low) distinctiveness in English will be considered as having no (or low) distinctiveness in all languages and are understood by the national offices.

2. THE PRACTICE

In essence, the practice consists of four objectives:

Objective 1	*Define what marks are subject to assessment of distinctiveness: the earlier mark (and/or parts thereof) and/or the later mark (and/or parts thereof)*
Practice	When evaluating likelihood of confusion: • The distinctiveness of the earlier mark as a whole is assessed, taking into account that a certain degree of distinctiveness needs to be acknowledged. • The distinctiveness of all components of the earlier mark and of the later mark is also assessed, prioritising the coinciding components.

Objective 2	*Determine the criteria to assess the distinctiveness of the mark (and/or parts thereof)*
Practice	• When assessing the distinctiveness of the marks in relative grounds, the same criteria that are used to determine distinctiveness as in absolute grounds apply. However, in relative grounds, these criteria are used not only to determine whether a minimum threshold of distinctiveness is met but also to consider the varying degrees of distinctiveness.

Objective 3	*Determine the impact on likelihood of confusion ("LOC") when the common components have a low degree of distinctiveness*

Practice	• When marks share an element with a low degree of distinctiveness, the assessment of LOC will focus on the impact of the non-coinciding components on the overall impression of the marks. It will take into account the similarities/differences and distinctiveness of the non-coinciding components.
	• A coincidence in an element with a low degree of distinctiveness will not normally on its own lead to LOC.
	• However, there may be LOC if:
	  • the other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar
	  • or the overall impression of the marks is highly similar or identical.

Examples	*NO LOC*	*LOC*
	MORELUX vs. **INLUX** (Class 44: Beauty treatments)	**COSMEGLOW** vs. **COSMESHOW** (Class 3: Cosmetics)
	flexi solutions  flexi credit vs. (Class 9: Credit cards)	 vs. (Class 43: Holiday accommodation services)

Objective 4	*Determine the impact on likelihood of confusion ("LOC") when the common components have no distinctiveness*
Practice	• When marks share a component with no distinctiveness, the assessment of LOC will focus on the impact of the non-coinciding components on the overall impression of the marks. It will take into account the similarities/differences and distinctiveness of the non-coinciding components. • A coincidence only in non-distinctive components does 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.

Examples	*NO LOC*	*LOC*
	BUILDGRO vs. BUILDFLUX (Class 19: Building materials Class 37: Construction services)	**TRADENERGY vs. TRACENERGY** (Class 9: Solar energy collectors for electricity generation)
	BANCO MADRID INVEST BANCO INVEST vs. (Class 36: Financial services)	ECO ENERGY vs. ECO ENERGY (Class 9: Solar energy collectors for electricity generation)

The Practice

Likelihood of Confusion (impact of non-distinctive/weak components) – Relative Grounds of Refusal

Index

INTRODUCTION

This document is the reference for IP offices, user associations, applicants, opponents and representatives on the practice as regards non-distinctive/weak components of marks for the purpose of assessing likelihood of confusion, assuming that the goods and/or services are identical. It will be made widely available and will be easily accessible, providing a **clear and comprehensive explanation of the principles on which the practice will be based**. These principles will be generally applied, and are aimed at covering the large majority of cases. Since likelihood of confusion must be assessed on a case-by-case basis, the common principles serve as guidance in order to ensure that different offices come to a similar, predictable conclusion when the same marks and grounds are involved.

1. THE PRACTICE SCOPE

The **scope** of the practice reads:

*"This paper will set the practice regarding **non-distinctive/weak components of marks** for the purpose of **assessing likelihood of confusion (LOC)**, assuming that the **goods and/or services are identical.** In particular it will:*

- *Define **what marks are subject to assessment of distinctiveness**: the earlier mark (and/or parts thereof) and/or the later mark (and/or parts thereof);*
- *Determine the **criteria to assess the distinctiveness** of the mark (and/or parts thereof);*
- *Determine the impact on LOC when the **common components have a low degree of distinctiveness***
- *Determine the impact on LOC when the **common components have no distinctiveness**."*

The appreciation of likelihood of confusion depends on numerous elements and, as the case-law has repeatedly asserted, it must be appreciated **globally**, taking into account all factors relevant to the circumstances of the case.

In accordance with the Article 15 (5) of the Instruction "on Procedures Related with Filing and Registration and Trademark Application" aproved on 19.08.2014 by order N05 of the Chairman of National Intellectual Property Center of Georgia - Sakpatenti- while comparison of signs, the main criteria of identifying the similarity of the signs can be aural (phonetics, musical sound),

visual (graphics, colour combination), conceptual (semantics, essence) similarity. In comparison of the signs the overall impression has the crucial significance. (case- FIAC S.p.A. vs Fiat Group Marketing & Corporate Communication S.p.A. (FIAC vs FIAT, ФИАТ) 2019/11/14 Decision of Appeal Board of Sakpatenti N135-3/2019 p. 5); Case -2016/07/05 Decision of Appeal Court of Tbilisi Chamber of Civil Cases N2b/59995-15 case - The coca-cola company" vs LTD „Luzi company" p. 26-28).

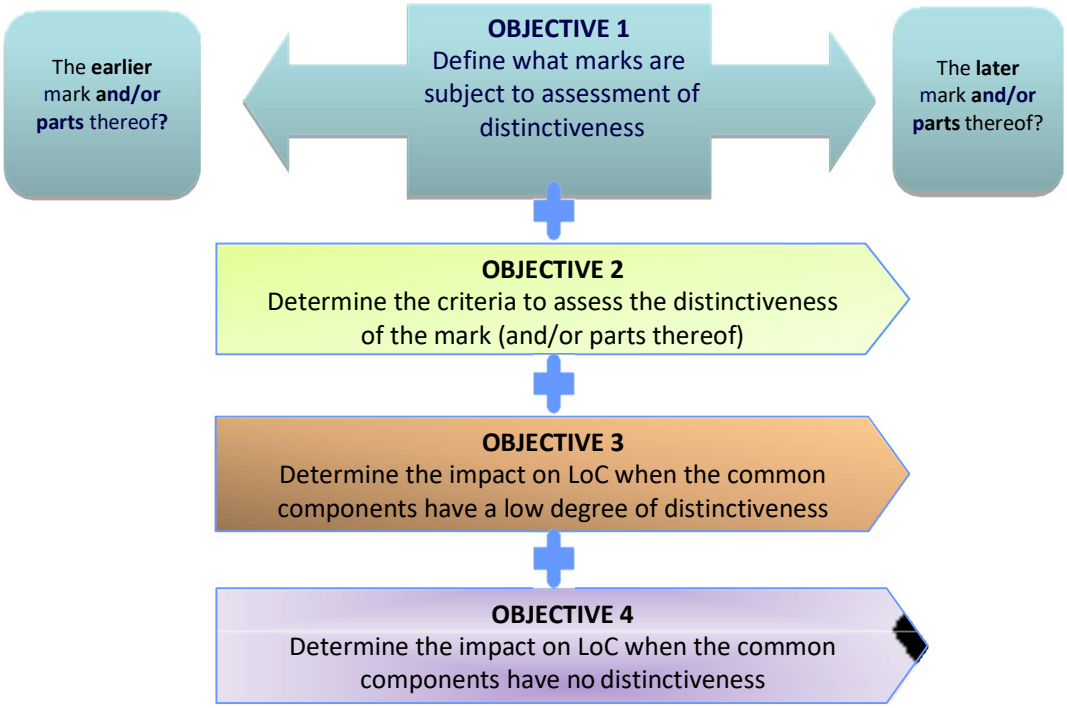
As already mentioned, the practice analyses the **impact of the non-distinctive/weak components** of the marks at issue as one of the factors to be taken into account for the assessment of likelihood of confusion.

Although **there are many factors** that may have an impact in the **global appreciation of likelihood of confusion**, such as the dominant components, the degree of attention of the relevant public, coexistence, situation of the market, family of marks, etc., it is not the objective of this practice to determine which are all the factors, nor the criteria for their assessment, nor the interdependency between them. Consequently, the practice does not deal with the overall assessment of likelihood of confusion, but with one of its essential parts.

The following are out of the scope of the practice:

- *The assessment of enhanced distinctiveness and/or acquired distinctiveness through use and/or reputation: for the purpose of this practice, it is assumed that there is no evidence and/or claim and/or previous knowledge that any of the marks are reputed or have an enhanced distinctiveness acquired through use.*
- *Agreement on the factors that are considered when assessing the likelihood of confusion.*
- *Agreement on the interdependencies between the assessment of distinctiveness and all the other factors that are considered when assessing the likelihood of confusion.*
- *Language issues: It is considered for the sake of the practice that marks which contain word elements with no (or low) distinctiveness in English will be considered as having no (or low) distinctiveness in all languages and are understood by the national offices.*

It is possible to identify four different objectives, as represented in the following figure:



Objectives of the practice.

Several approaches are followed for the examination of likelihood of confusion, wherein the distinctiveness of the components may be assessed at different stages. Regardless of the performed approach, the practical outcome regarding the impact of the non-distinctive/weak components of the marks at issue will remain unaffected.

2. THE PRACTICE

3.1 Assessment of distinctiveness: the earlier mark and/or parts thereof, and/or the later mark and/or parts thereof (Objective 1)

When evaluating likelihood of confusion:

- The distinctiveness of the earlier mark as a whole is assessed.
- The distinctiveness of all components of the **earlier** mark and of the **later** mark is also assessed, prioritising the coinciding components.

When assessing likelihood of confusion the validity of earlier registered marks may not be

called into question. Therefore, “it is necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based.”

3.2 Criteria to assess the distinctiveness of the mark (and/or parts thereof) (Objective 2)

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.

Accordingly, and due to the lesser capacity of a weak mark to perform its essential function within the market, its scope of protection considering its non (or low) distinctive components should be narrow.

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

3.3 Impact on likelihood of confusion when the common components have a low degree of distinctiveness (Objective 3).

- When marks share an element with low distinctiveness, the assessment of LOC will focus on the impact of the non-coinciding components on the overall impression of the marks. It will take into account the similarities/differences and distinctiveness of the non- coinciding components.

- A coincidence in an element with a low degree of distinctiveness will not normally **on its own** lead to LOC.

  However, there may be LOC if:

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

    OR

  - The overall impression of the marks is highly similar or identical.

Examples:

* All the other factors which may be relevant for the global appreciation of likelihood of confusion are deemed not to affect the outcome. Also, it is considered that the goods and services are identical.

In all these examples the common component(s) is/are considered to possess a low degree of distinctiveness.

Earlier mark	Contested mark	Goods/services	Outcome
MORELUX	**INLUX**	Class 44: Beauty Treatment	NO LOC
DURALUX	**VITALUX**	Class 44: Beauty Treatment	NO LOC
		Class 32: Fruit juices	NO LOC
		Class 9: Credit cards	NO LOC
		Class 32: Fruit juices	NO LOC
		Class 30: Tea	NO LOC
		Class 9: Credit cards	NO LOC
COSMEGLOW	**COSMESHOW**	Class 3: Cosmetics	LOC
		Class 11: Refrigerators	LOC
		Class 43: Holiday accommodation services	LOC

3.4 Impact on likelihood of confusion when the common components have no distinctiveness (Objective 4)

- When marks share a component with no distinctiveness, the assessment of LOC will focus on the impact of the non-coinciding components on the overall impression of the marks. It will take into account the similarities/differences and distinctiveness of the non-coinciding components.
- A coincidence only in non-distinctive components **does 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.

Examples:

* All the other factors which may be relevant for the global appreciation of likelihood of confusion are deemed not to affect the outcome. Also, it is considered that the goods and services are identical.

In all these examples the common component(s) is/are considered to possess no distinctiveness.

Earlier mark	Contested mark	Goods/services	Outcome
GREENGRO	**GREENFLUX**	Class 19: Building materials Class 37: Construction services	NO LOC
BUILDGRO	**BUILDFLUX**	Class 19: Building materials Class 37: Construction services	NO LOC
	SMARTPHONES.NET	Class 9: Mobile phones	NO LOC
		Class 36: Financial Services	NO LOC
		Class 29: Fish	NO LOC
CRE-ART	**PRE-ART**	Class 41: Art gallery services	LOC

TRADENERGY	**TRACENERGY**	Class 9: Solar energy collectors for electricity generation	LOC
		Class 9: Solar energy collectors for electricity generation	LOC

Practice Paper.