LIKELIHOOD OF CONFUSION :
THE NATURE OF THE CRITERION OF AN INDEPENDENT DISTINCTIVE ROLE

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Abstract

Likelihood of confusion: the criterion of an independent distinctive role

The criterion of an independent distinctive appeared in the European case-law in the judgment MEDION (Case C-120/04 Medion AG v Thomson multimedia Sales Germany & Austria GmbH, 6 October 2005, annexe 2) in order to prevent a well-known trade mark from absorbing a lesser-known trade mark by juxtaposing the two in a composite sign (in this case: THOMSON and LIFE). The particular situation where this criterion was first applied led many observers to consider that this criterion was dedicated to only be used once, especially because it might woke up the discussion about the global assessment of the likelihood of confusion.

Indeed, this criterion appeared as an evolution of both the global and the analytic assessments of the likelihood of confusion in the European case-law. Those evolutions led to a wide development of the notion, the revelation of the conditions to apply it and potentially extend it more and more.

All those evolutions confirmed the necessity to firmly attach the criterion to the global assessment of the likelihood of confusion and helped the national judges of every States of the European Union to apply this new criterion, achieving its entry in the case-law and questioning its future transformation in the following years.
Introduction

1. In economics, consumerism refers to the belief that the free choice of consumers should dictate the economic structure of the society\(^1\). Even if such a consideration does not describe the market economy we are all living in, it is not disputed that the consumer has the ability to choose the products and services he wishes to buy. Consequently, to convince the public to buy its products, a company needs to have an image, a personality the consumer is able to know and cherish in order to catch a loyal and massive clientele. The perfect tool to create such a phenomenon is the trade mark. Since the origin of the goods beyond purely local markets is very hard to find, traders and purchasers are very attracted to the trade marks\(^2\), which help them to have some convictions about the goods they buy, even before they purchase them. Nowadays, the trade marks are more than an indication of origins, they convey a personal identity, a meaning to the consumer, their protection then became very complex and decisive in order to guarantee the efficiency in the global market.

2. **Definition of a trade mark.** In European law, a trademark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings\(^3\).

   The necessary quality of a trade mark is then its ability to be seen, by the consumers, as a guarantee of the identity of the origin and enable him to distinguish the product or service from others which have another origin\(^4\). It implies to choose a trade mark which is not devoid of any distinctive feature\(^5\), i.e. which is not descriptive of a characteristic of the goods it identifies and may not mislead by giving the product a quality it has not. Some originality or

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1 Article about consumerism on en.Wikipedia.org
2 SEVILE Catherine, *EU intellectual property law and policy*, ELGAR European Law, 1999, page 210
3 Article 4 of Regulation No 207/2009
4 Case C-299/99, Koninklijke Philips Electronics NV c Remington Consumer Products [2002], paragraph 39 and 40.
5 Article 7 of Regulation No 207/2009
even a minimum amount of distinctiveness is then not necessary, the rejected signs are only the ones which suffers not from a complete lack of distinctive character\textsuperscript{6}.

To preserve the guarantee of the origin attached to a trade mark, all the goods covered with a trade mark must come from the same undertaking. That is why the national law system’s and the Community Trade Mark regulation prevent any other people than the owner of a trade mark from using this trade mark without any authorisation: the proprietor of a trade mark has an exclusive right therein\textsuperscript{7}.

3. The monopoly attached to a trade mark. The monopoly implied by a trade mark is different from the one implied by another intellectual property right. Indeed, this monopoly is linked to the consumer’s mind. Then, there is only a link between a sign of some goods if the public is able to perceive it. Even if a sign looks a priori close to another one used as a trade mark, there would have infringement only if the consumer thinks that the two signs promote goods made by the same company. Consequently, the criterion provided by the Article 8(1) (b) of Regulation No 207/2009 to refuse the use of a trade mark is the likelihood of confusion that may rise in the consumer’s mind. That interpretation is confirmed by the tenth recital in the preamble to the Regulation, according to which “the likelihood of confusion ... constitutes the specific condition for such protection\textsuperscript{8}”. The likelihood of confusion has to be proved except in case of identity between the goods and the signs, according to an interpretation of the Article 8(1)(a) and 9(1)(a) of Regulation No 207/2009\textsuperscript{9} in the light of the Article 8(1)(b) and 9(1)(b) of the same legislation.

\textsuperscript{6} Catherine Seville, *EU intellectual property law and policy*, previously cited (Note 2), page 234
\textsuperscript{7} Article 9 of Regulation No 207/2009
\textsuperscript{8} Case C-251/95 Sabel v Puma (SABEL), 11 November 1997
\textsuperscript{9} Article 8(1) of Regulation No 207/2009: 1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) if it is identical with the earlier trade mark \textbf{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;

(b) if because of its identity with, or similarity to, the earlier trade mark \textbf{AND} the identity or similarity of the goods or services covered by the trade marks \textbf{there exists a likelihood of confusion} on the part of the public in the territory in which the earlier trade mark is protected \textbf{, the likelihood of confusion includes the likelihood of association with the earlier trade mark.}
4. **Definition of the likelihood of confusion.** The likelihood of confusion is defined as "the risk that the public might believe that the relevant goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings".

5. **Definition of the global assessment.** By three basic judgments (SABEL, CANON and LLOYD), the Court of Justice of the European Union has set down the principle of a global assessment of the likelihood of confusion. This assessment implies that the judge takes into account all factors relevant to the circumstances of the case to reach a conclusion about the existence of a likelihood of confusion between two marks. Thus, there are several factors – the recognition of the trade mark on the market, the association a consumer may make with another trade mark – but the two main factors are the similarity between the goods and the services covered by the trade marks and the similarity between the signs. Those two factors are interdependent which means that a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa.

6. To analyze the similarity between the goods and services, the judge uses several factors: their nature, their purpose, their method of use or their complementarity. The judge is also helped by the classification created by the Nice Agreement of 1957 despite its administrative purpose, i.e. that the goods from the same classes may be considered as not similar when goods from different classes may be considered as similar by the judge.

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10 Case C-39/97 Canon Kabushiki Kaisha and Metro-Goldwyn-Mayer Inc. (CANON) 29 September 1998, paragraph 29 and SABEL, previously cited (Note 8), paragraph 16 to 18.
11 SABEL, previously cited (Note 8)
12 CANON, previously cited (Note 10)
13 Case C-342/97 Lloyd Schuhfabrik Meyer (LLOYD), 22 June 1999
14 SABEL, previously cited (Note 8), paragraph 22; CANON, previously cited (Note 10), paragraph 16; LLOYD, previously cited (Note 13), paragraph 18
15 Tenth recital in the preamble to Regulation 207/2009
16 CANON, previously cited (Note 8), paragraph 17; LLOYD, previously cited (Note 13), paragraph 19
17 See Canon, previously cited (Note 10), paragraph 23
18 Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed in 1957, now used by the Trademarks offices of 147 States (according to the WIPO official website).
19 Rule 2(4) of the Implementing Regulation No 40/94 of 23 December 1995 on the Community Trade Mark
7. While the similarity between the goods covered is relatively easy to apply or is even not in dispute, the similarity between the signs leads to much more difficulties. Indeed, a sign may be simple (one word) but may also be more complex (several words, a figurative element or even several), the combinations are infinite but a tiny difference between two signs can not be satisfying. Because of the conditions to apply the (a) of the article 8(1) of Regulation No 207/2009 (i.e. the identity between the goods and the signs), the applicant can easily use a little alteration of the earlier trade mark in order to avoid this text to be applied. Many times, to create a new trade mark, people uses an element of an earlier mark to which they add another element. Consequently the judge has to compare the signs to determine if they are too close to coexist because of a likelihood of confusion. Considering the specific aspect of the likelihood of confusion, the judge has to determine if the consumer may take one sign to another or if he distinguishes the two signs but believe that they are used by the same company.

8. To show the similarity between two signs, the judge had to find some notions, especially where the signs have a common component. One of the notion used by the judges is named the criterion of an independent distinctive role. The judged used this criterion for the first time in the judgment MEDION, delivered 6th October 2005.

8-1. Presentation of the MEDION case. In the MEDION case, Thomson multimedia Sales Germany & Austria GmbH (Thomson) marketed some of his leisure electronics devices under the name “THOMSON LIFE” in Germany. Medion, owner in Germany of the trade mark “LIFE” registered for the same kind of goods, brought an action in Germany for trade mark infringement to prevent Thomson from using the word “LIFE” in a trade mark.
According to the case-law of the Bundesgerichtshof, based on the theory known as the “Prägetheorie” (theory of the impression conveyed), the action should have been dismissed, which was exactly what the Landricht Düsseldorf decided in the First Instance. Indeed, on the ground of “die Prägetheorie”, there is only infringement where the common component of the signs (“LIFE”) characterises the latter trade mark to the extent that the other components are largely secondary to the overall impression created by the sign.

In this case, the word “THOMSON” is an essential element in the overall impression conveyed by the trade mark because this company has a great reputation on the market of leisure electronics devices but “LIFE” has some importance in the sign.

This fact plus the different approach advocated by some writers and the case-law of other States of the European Union decided the German judge to stay the proceedings and to refer a question to the Court of Justice.

The question was very specific: when the goods of two trade marks are identical, is there a likelihood of confusion where the common component, although it does not determine by itself the overall impression conveyed by the composite sign, has an independent distinctive role? The Court of Justice answered affirmatively, the independent distinctive role of a common component provokes a likelihood of confusion.

9. Early analysis of the criterion of an independent distinctive role. This judgment was the first to use this criterion in the European case-law but it was in a particular case. As the advocate general Jacobs wrote in its opinion, in some sectors, the companies have the

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25 MEDION, previously cited (Note 23), paragraph 8
26 MEDION, previously cited (Note 23), paragraph 12 ; EU Focus 2005, 176, 22
27 MEDION, previously cited (Note 23), paragraph 13
28 MEDION, previously cited (Note 23), paragraph 14
29 MEDION, previously cited (Note 23), paragraph 18
30 MEDION, previously cited (Note 23), paragraph 37
31 Opinion of Advocate General Jacobs delivered on 9 June 2005 about MEDION
habit to indicate the manufacturer as a mark. That indication always dominates the overall impression conveyed by the sign so this factor was the only way to prevent from this situation. The judgment MEDION has been then interpreted as a reaction to the theory known as “swamping”\textsuperscript{32} to prevent the owner of a powerful trade mark absorbing another one by adding it to a composite trade mark\textsuperscript{33} : this judgment founded a protection against the owner of a well-known trade mark or commercial name\textsuperscript{34} !

9-1. As a result, this criterion was first considered as having a narrow scope and as becoming rarely used\textsuperscript{35}. Nevertheless, since 2008, the Tribunal of First Instance and the Court of Justice used the criterion of an independent distinctive role several times every year. This use implied an evolution of the criterion, which lead to the question of the nature of this criterion.

9-2. The notion of independent distinctive role had a logical evolution which led to the determination of the conditions of application (I). This evolution was possible because of the respect of a method based on the global assessment, which also permitted to the national judges to apply the criterion (II).

\textsuperscript{32} D. Stone, ECJ overrules German Prägetheorie, \textit{European Intellectual Property Review}, 2006, 28(1), N4-5
\textsuperscript{33} A. Folliard-Monguiral, CJCE, affaire Thomson Life : l’assouplissement du risque de confusion en cas de reproduction avec adjonction, Propriété industrielle n° 1, Janvier 2006, comm. 2
\textsuperscript{34} HIPE, ‘Life’ et ‘Thomson life’ devant la CJCE, solution d’espèce fondée sur l’élément dominant, Hipe database, 11 October 2005
\textit{Isabelle Meunier-Coeur, Notoriété et renommée de la marque, Propriété industrielle n° 4, Avril 2006, étude 12, paragraph 69
\textsuperscript{35} HIPE, ‘Life’ et ‘Thomson life’ devant la CJCE, solution d’espèce fondée sur l’élément dominant, previously cited (Note 34)
I. The evolution of the criterion of an independent distinctive role

Even if the criterion of an independent distinctive role was revealed in European law as a reaction to “swamping”, this use was logical as regard to the previous case-law (A), which explains the development of this criterion, used in different way (B).

A. The logical revelation of the criterion

MEDION is an evolution in the framework of two types of case-law: the first strictly based on the global assessment of the likelihood of confusion (1), the second influenced by the analytic assessment (2).

1) The method strictly based on the global assessment

10. Presentation. The assessment of the likelihood of confusion implies to take account on the consumer’s way to see a sign. But the settled case-law states that “the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details”\(^{36}\), especially since he “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”\(^{37}\). Then, a consumer does not analyse a sole component but a whole sign, his vision is global, so is the assessment of the likelihood of confusion.

But because the consumer has an imperfect image of the sign, the settled case-law also states that the “global appreciation of the visual, aural and conceptual similarity must be based on the overall impression given by the marks, bearing in mind, in particular, their

\(^{36}\) SABEL, previously cited (Note 8), paragraph 23
\(^{37}\) LLOYD, previously cited (Note 13), paragraph 26
distinctive and dominant components”\(^{38}\). Then, the global assessment, in its own principle, implies to see a sign as an combination of elements with different importance. But the assessment remains global while all of those elements may have an impact on the way a consumer perceive a sign.

In fact, there are three types of elements, each corresponding to a type of impact it has on the consumer perception of the signs. An element may be dominant (a) or negligible (b) in the impression convoyed by the sign. But it may also be between the two, in a third category\(^{39}\) with an impact named “an independent distinctive role” (c).

\[\text{a) The major influence of the dominant element}\]

11. One of the first time the judge looked for a dominant element was in the frame of the FIFTIES case\(^{40}\).

The Court of First Instance considered that the word element “miss fifties” was the predominant component of the earlier mark because of its grand size comparing to the other verbal components (“eccellente nella tradizione”, exactly under the word element “miss fifties”)\(^{41}\).

The consequence of such qualification was showed by the judge when he compared the component to the latter mark. The judge considered that the dominant element was so important in the way the consumer would see the trade mark that the difference brought by

\(^{38}\) SABEL, previously cited (Note 8), paragraph 23
\(^{39}\) Composed by the elements which are not in one of the two other categories.
\(^{40}\) Case T-104/01 Claudia Oberhauser v OHIM - Petit Liberto (FIFTIES), 23 Octbober 2002
\(^{41}\) FIFTIES, previously cited (Note 40), paragraph 36
the addition of the other elements’ in the earlier mark was not significant enough to eliminate its influence. Consequently, the dominant element of the sign, because it is the common component of the two signs, would lead the consumer to think that the goods covered by the sign come from the same undertaking and then, creates a likelihood of confusion.

12. The standardize definition of the dominant element. The same day, the Court gave a real definition to the notion of “dominant element” in the very important MATRATZEN case while it consecrated the “Prägetheorie” (theory of the impression conveyed) the Court of Justice finally rejected in MEDION case.

It must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.

Then, a dominant component is an element so important that it has a major impact on the way the consumer perceives a sign. In the framework of the “Prägetheorie”, this impact is so important than no other element is able to change the consumer’s perception, they are negligible.

b) The exclusion of the negligible elements

13. Definition of a negligible element. A negligible element is an element which has no influence on the impression conveyed by the sign and which, consequently, will not be remembered by the consumer.

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42 FIFTIES, previously cited (Note 40), paragraph 37
44 A. Folliard-Monguiral, CJCE, *affaire Thomson Life*: l’assouplissement du risque de confusion en cas de reproduction avec adjonction, previously cited (Note 33)
45 MATRATZEN, previously cited (Note 43), paragraph 33
On the basis of judgment MATRATZEN, the Court gave some precisions about the effects of the dominant and the negligible elements of the signs. In the very complicated SHAKER case\(^{46}\), the Court of Justice indicated that the global assessment prevented from comparing two signs by only taking account the dominant component of a complex trade mark. Only the negligible component may be set aside by the judge in order to compare two signs:

*Assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components\(^{47}\).*

*It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element\(^{48}\).*

This statement insists on the basic principle of the global assessment of the likelihood of confusion: every elements may have an impact on the impression conveyed by a sign, then the judge has to take account of the larger amount of element to compare two signs. Consequently, because only one element may be dominant in a sign and because all the other can not be considered negligible, there is another category of elements.

**14. Illustration.** The Court of First Instance gave an example of an element of this category, which were neither dominant, nor negligible in the HUBERT case\(^{49}\).

![Image of SAINT-HUBERT and HUBERT marks](image-url)

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46 Case C-334/05 P OHIM v Shaker – Limiñana y Botella (SHAKER), 12 June 2007  
47 SHAKER, previously cited (Note 46), paragraph 41  
48 SHAKER, previously cited (Note 46), paragraph 42  
49 Case T-110/01 Vedial v OHIM – France Distribution (HUBERT), 12 December 2002
The judge considered that “SAINT-HUBERT” was the dominant element of the sign but he also considered that the other element - “41” - was not negligible and had a secondary position\(^\text{50}\). This secondary position had not a lot of influence on the comparison of the two signs. But in other cases, an element of the third category may have much more impact on the consumer's perception.

c) The third category between a neutral effect and a possible independent distinctive role

15. Definition. The category of the elements which are nor dominant, neither negligible has different effects on the comparison of the signs. Most of them have a limited influence\(^\text{51}\).

15-1. Illustration of an element of the third category without many influence. In the MATRATZEN case, the word “MATRATZEN” is dominant while “Markt” is negligible and “CONCORD” and has a central position\(^\text{52}\).

But the strength of the common component, the word “MATRATZEN”, - based on its pronunciation and its originality - prevents the word “CONCORD” from having enough impact to exclude a likelihood of confusion between the signs\(^\text{53}\). Here, “CONCORD” has no influence as a negligible element would have had.

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\(^{50}\) HUBERT, previously cited (Note 49), paragraph 53

\(^{51}\) Case T-7/04 Shaker v OHIM - Limiñana y Botella (Limoncello della Costiera Amalfitana shaker), 15 June 2005, paragraphs 60 to 64

\(^{52}\) MATRATZEN, previously cited (Note 43), paragraph 42

\(^{53}\) MATRATZEN, previously cited (Note 43), paragraph 43
15-2. Illustration of an element of a third category which is important: the MEDION case. Nevertheless, some elements of the third category have much more importance as MEDION case showed:

It is quite possible that the sign of an earlier mark used by a third party in a composite sign still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.\(^{54}\)

16. Practical consequence of MEDION. A non-dominant element may have an impact on the way the consumer perceives a sign. This statement was admitted a long time ago when the judge considered that an element which is not dominant is not necessarily negligible.

But more important is the fact that an element of the third category might have such influence whereas the presence of a dominant component. This consideration brought back the definition of a dominant element to what it was before the MATRATZEN case (before the consecration of “die Prägetheorie”). Consequently, it marks an evolution in the global assessment of the likelihood of confusion.

Such an evolution was explicit due to the references to the paragraph 23 of SABEL which was retaken in the paragraph 32 of MATRATZEN.\(^{55}\)

17. Explanation. A sign is composed by several element. Each element may impress the consumer in different ways, especially where a sign is seen as an association of several elements.\(^{56}\) Then, the consumer may be influenced on the one hand by the impression conveyed by the dominant element and, on the other hand, by another impression, independent and conveyed by a non dominant element – i.e. an element of the third category.\(^{57}\) This second impression may lead the consumer to think of another trade mark and may lead him to believe that the goods covered by the two trade marks come from the same undertaking when the element of the third category is the common element. It is

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54 MEDION, previously cited (Note 23), paragraph 30
55 MEDION, previously cited (Note 23), paragraph 28
56 The “juxtaposition” observed in MEDION is a perfect example.
57 The word “independent” in the name of the criterion shows that the element has its own power of attraction. See A. Folliard-Monguiral, previously cited (Note 33)
especially the case where the latter sign appears as a juxtaposition of two elements – for example in MEDION case.

18. **Theoretical consequence of MEDION : the reinforcement of the global assessment.** More than a simple evolution, this case is a new affirmation of the basic idea of the global assessment of the likelihood of confusion: what matters is not the sole dominant element but the impression conveyed by the whole sign.

Indeed, by admitting that a non-dominant element can create a likelihood of confusion, the Court showed that every elements of a sign should be taken in account. It is logical because the dominant element is not the only which influences the impression conveyed by a sign, every non-negligible parts of a sign is important.

The criterion of an independent distinctive role might be seen as a justification of the necessity, for the judge, to go further than a dominant element by analysing every components of a signs, what the case-law often repeats.

19. **Transition.** But this judgment can not only be seen as an evolution of the global assessment of likelihood of confusion. It also has links with some case-law influenced by the analytic assessment of the likelihood of confusion.

2) **The method influenced by the analytic assessment**

20. The directive rejected the analytic assessment of the signs which permits to take account on a sole element of a sign and proclaimed the global assessment, but some judges, especially the French ones, did not give up their old case-law immediately and continued to use their system based on the analytic assessment, which led the Court of Justice to mark the rejection in the ARTHUR ET FELICIE case (a). But the Court of First Instance and the OHIM, showed their need to keep some of the logical elements of that method to reason by trying to build several analytic methods (b). The recognition of the

58 SHAKER, previously cited (Note 46), paragraph 42 and development above, n°13
59 Case C- 291/00 LTJ Diffusion v OHIM – Verbaudet (ARTHUR ET FELICIE), 20 March 2003
criterion of an independent distinctive role can clearly be seen as a little insertion of the analytic assessment in the European case-law (c).

a) The analytic assessment of the likelihood of confusion and its rejection by the Court of Justice

21. The old French practice. The analytic assessment is based on a comparison of the most important part of a sign. The French judge based his case-law on this theory during a long time. Indeed, if he found that a sign was a partial reproduction of an earlier trade mark, the French judge applied a kind of assessment equivalent to the Article 8(1)(a) of Regulation No 207/2009 – L713-2 of the Code de la propriété intellectuelle – which does not imply to bring the evidence of a likelihood of confusion, to refuse a sign or condemn for infringement. Then, the analytic assessment (the apprehension of only a part of a sign) was attached to a legal presumption.

22. The French notion of inoperative adding. The French case-law developed several notions to characterise the different reasons to apply the Article 8(1)(a) instead of the Article 8(1)(b). Only one will be exposed in order to understand the criterion of an independent distinctive role. This notion, called “ajdonction inopérante” or inoperative adding, corresponded to the case where a trade mark is composed by the most important elements of an earlier trade mark to which are added new elements which are not able to erase the influence of elements of the earlier registered trade mark.\(^{60}\)

23. Problems and abandon of this case-law. This case-law was too systematic / automatic because of the presumption and because it was applied in too many cases. Then the French Courts begun to abandon this case law\(^ {61}\), even if the Cour de Cassation - the French Supreme Court - tried to force its conservation\(^ {62}\). Indeed, the border of each notion

\(^{60}\) See, J. Passa, Traité de droit de la propriété intellectuelle, LGDJ, 2\(^{nd}\) edition, page 396
\(^{61}\) Cour d'appel de Versailles (FRANCE), 24 janv. 2002, PIBD 2002, n° 740, III, 194 ; Georges Bonet , Contrefaçon d'une marque complexe par reproduction servile ou quasi servile d'un signe distinctif avec ou sans ajout d'autres éléments , Revue trimestrielle de droit européen 2004 p. 115
\(^{62}\) Cour de Cassation, Chambre commerciale (FRANCE), 14 janvier 2003, PIBD n°760, III, p155
was hard to find and depended in a large way on the judge's mood. Then, the case-law was often unpredictable and unfair.

**23-1.** The abandon was finally forced by the Court of Justice with the judgment ARTHUR ET FELICIE\(^63\) which considered that the Article 8(1)(a) should only be applied where the latter sign is the strict reproduction of the earlier sign. The only admission about its application is the cases where the signs are not identical is where their differences are so insignificant that the consumer would not be apple to perceive them.

Finally, this judgment appears more as a rejection of the use of the equivalent of the Article 8(1)(a) in the French law than a condemnation of the French reasonings - e.g. the theory of the inoperative adding. This feeling is reinforced by the study of some European judgments.

**b) The conservation of logical close to the one developed in the analytic assessment**

**24.** The French legal presumption never existed in European law, The evidence of a likelihood of confusion is only unnecessary where the signs and the goods are both identically reproduced\(^64\). Nevertheless, a dose of analytic assessment - the other part of the French old case-law - exists in some European case-law. The MATRATZEN case\(^65\) is the first illustration:

*Two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects. As the Court's case-law indicates, the visual, aural and conceptual aspects are relevant (SABEL, paragraph 23, and Lloyd Schuhfabrik Meyer, paragraph 25)*\(^66\).

**24-1. The scope of the references to SABEL and LLOYD.** The references to SABEL and LLOYD only concern the second sentence. The first one - the important one ! - is a creation of the judge as the reading of this reference shows:

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\(^{63}\) Previously cited (Note 59)  
\(^{64}\) Article 8(1) of Regulation No 207/2009, previously cited and analysed (Note 9)  
\(^{65}\) previously cited (Note 43)  
\(^{66}\) MATRATZEN, previously cited (Note 43), paragraph 30
In addition, the global appreciation of the likelihood of confusion must, as regards, the visual, aural or conceptual similarity of the marks in question, be based on, the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 5(1)(b) of the Directive - ‘... there exists a likelihood of confusion on the part of the public ...’ - shows that the perception of marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.67

SABEL and LLOYD never mentioned that two trade marks are similar when they are partially identical, so this paragraph can not be an evolution based on those case-law. Such a consideration is far from the global assessment.

Indeed, the Court did not consider that two signs are similar where their overall impression is partially identical (then similar) - which would have been quite classical - but stated that the presence of exact common components lead to find the signs similar. Then, the Court bases its analysis not on the overall impression conveyed by a trade mark but by one or two components of it : this paragraph is a pure application of the analytic assessment.

The latter case-law, based on this paragraph, showed that the judge needed some logical to reason in a more simple and quick way, while the global assessment implies a global and complicated analysis of the signs.

25. First application of this statement. The first judgment to apply this principle is KIAP MOU.68

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<th>MOU</th>
<th>KIAP MOU</th>
</tr>
</thead>
<tbody>
<tr>
<td>Earlier mark</td>
<td>Latter mark</td>
</tr>
</tbody>
</table>

67 SABEL, previously cited (Note 8), paragraph 23 ; LLOYD, previously cited (Note 13), paragraph 25
68 Case T-286/02 Oriental Kitchen v OHIM — Mou Dybfrost (KIAP MOU), 25 November 2003
After using MATRATZEN paragraph 30, SABEL and LLOYD\textsuperscript{69}, the Court of First Instance stated a new principle to adapt the basic principle of MATRATZEN to the case.

*Where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar within the meaning of Article 8(1)(b) of Regulation No 40/94.* \textsuperscript{70}

**26. Problem.** In this case, the relevant aspects are the visual and the aural similarities\textsuperscript{71}. However, the domain of application is not the signs but the two elements considered.

In a regular application of the global assessment of similarities, the other word – the one which is not common element – might have leaded the judge to consider that the signs were visually and aurally dissimilar. Then, the judge could have concluded to an absence of likelihood of confusion.

This case-law is finally not very far from the old French case-law denounced in ARTHUR ET FELICIE because the evidence to bring is not the evidence of a similarity between the signs, but the one of a dissimilarity. Then, the applicant has to prove the absence of likelihood of confusion, as if the judge used a presumption.

**27.** In this judgment, the judge, after he observed that “MOU” is the common component\textsuperscript{72}, considered that “MOU” and “KIAP” has no particular meaning\textsuperscript{73} and are equally dominant\textsuperscript{74} to conclude that the signs are similar and reject the application for the registration of “KIAP MOU”\textsuperscript{75}. The visual and aural impact of half of the sign is not taken in account, even though it did not look particularly irrelevant.

\textsuperscript{69} See KIAP MOU, previously cited (Note 68), paragraph 38
\textsuperscript{70} KIAP MOU, previously cited (Note 68), paragraph 39
\textsuperscript{71} Application of MATRATZEN paragraph 30, previously cited (Note 66)
\textsuperscript{72} See KIAP MOU, previously cited (Note 68), paragraph 40
\textsuperscript{73} See KIAP MOU, previously cited (Note 68), paragraph 41
\textsuperscript{74} See KIAP MOU, previously cited (Note 68), paragraph 43
\textsuperscript{75} See KIAP MOU, previously cited (Note 68), paragraph 46
28. Second application. Another precision of the paragraph 30 of the MATRATZEN judgment has been given in the judgment TURKISH POWER.76

In this case, “POWER” is the common element but the latter mark has three components, the principle revealed by the judgment KIAP MOU can't be applied without evolution. But the judge found another principle.

There would be a likelihood of confusion if the element common to both signs were to be regarded as the dominant element of the sign sought.77

29. Analysis of the solution. While the signs are more complex than the one in the KIAP MOU case, the conditions are completely different. The condition is the domination of the common component.

The fact the judge creates a principle for each situation shows that he is in tension with the global assessment, which suppose not to follow such types of mini-rules and stay focus on the consumer way to see a sign.

This paragraph leads to the same difficulties than the one in the KIAP MOU case. A strict application implies that if the common element is dominant, there is a likelihood of confusion. But if the sign is composed by two other elements which are not negligible, they may lead the judge to the conclusion of an absence of likelihood of confusion.

30. In the judgment TURKISH POWER, the judge had not support such a problem because he did not apply its own principle. Indeed, he didn't look after the domination of the common element but used the regular method, based on a global assessment of the likelihood of confusion. He used the three comparisons – namely the visual, aural and

76 Case T-34/04 Plus Warenhandelsgesellschaft mbH v OHIM (TURKISH POWER) 22 June 2005
77 TURKISH POWER, previously cited (Note 76), paragraph 51
conceptual\textsuperscript{78} similarities -, found that the signs were different under those three frames\textsuperscript{79} and concluded of the absence of likelihood of confusion\textsuperscript{80}.

31. Problem brought by this kind of case-law. Even if this principle was not applied by the judge, this comportment shows that the judge wants to find a very clear method to compare the signs by adapting the principles to each kind of situation. Thus, the independent distinctive role used in the judgment MEDION may be seen as another adaptation, even if its nature is quite different from the previously cited principles.

c) The criterion of an independent distinctive role, the reconciliation with the global assessment

32. Parallel between the old French case law, KIAP MOU and the criterion. In the MEDION case\textsuperscript{81}, there is no reference to the paragraph 30 of the judgment MATRATZEN. But such a link appeared in many latter judgments\textsuperscript{82}. Anyway, the nature of the criterion implies to make a parallel with the methods previously cited, even if the judge took care basing its decision on the refusal of the “Prägetheorie”, rather than admitting the old French theories\textsuperscript{83}. Indeed, MEDION, as KIAP MOU or the French theory, are based on the same analytic approach, creating a tension with the global assessment of the similarity of the signs\textsuperscript{84}.

\textsuperscript{78} See TURKISH POWER, previously cited (Note 76), paragraph 53 to 65
\textsuperscript{79} See TURKISH POWER, previously cited (Note 76), paragraph 72
\textsuperscript{80} See TURKISH POWER, previously cited (Note 76), paragraphs 73
\textsuperscript{81} Previously cited (Note 23)
\textsuperscript{82} See, for example:
- BARBARA BECKER, previously cited (Note 20), paragraph 28 (MATRATZEN §30) and and paragraph 37 (MEDION);
- Case T-16/08 Perfetti van Melle v OHIM - Cloetta Fazer (PERFETTI VAN MIELE), 1 July 2009, paragraph 38 (MATRATZEN §30) and paragraph 44 (MEDION).
\textsuperscript{83} HIPE, ‘Life’ et ‘Thomson life’ devant la CJCE, solution d’espèce fondée sur l’élément dominant, previously cited (Note 34); Bertrand GEOFFRAY, Les motifs de refus dans le cadre de la procédure d’opposition communautaire, Propriété industrielle n° 3, Mars 2006, Etude 7, point 6
\textsuperscript{84} Catherine Sevile, \textit{EU intellectual property law and policy}, previously cited (Note 2), page 258
The formula of the Court. In the answer of MEDION (the very end of the judgment) confirms this consideration:

*There may be a likelihood of confusion where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein*.\(^85\)

33. Other formulations of the criterion. The independent distinctive role is the character a common element of a complex sign and an earlier trade mark has where this element makes the consumer think about the earlier trade mark while watching the complex latter sign. Its effect is to create in the consumer's mind, the idea that the two marks, at the very last, may be owned by the same undertakings or economically-linked undertakings\(^86\).

By using other words, the addition of some elements is not sufficient to erase the impact of the earlier trade mark on the complex trade mark.

In this second formulation, the elements in bold are the same than in the theory of the inoperative addition studied before\(^87\). In the MEDION's paragraph, the principle of an addition is clearly marked by the word “juxtapose” while the word “still” shows that the element which has an independent distinctive role keeps a quality that should have been deleted in order to avoid any likelihood of confusion.

34. Analysis regarding to the earlier case-law. The criterion of an independent distinctive role appears as a new adaptation of the principles used in the previous case-law studied, namely the judgments ORIENTAL KITCHEN and TURKISH POWER\(^88\).

In ORIENTAL KITCHEN, the likelihood of confusion was found by using a mechanism close to a presumption where an element of a two word sign is an earlier mark. In TURKISH POWER, the presumption is cited but not used and the common component had to be dominant to lead to a likelihood of confusion\(^89\). In MEDION, the presumption was clearly set aside while the non dominance of the common component led the judge to specify its case-

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85 MEDION, previously cited (Note 23), paragraph 37
86 See Case C-51/09 P Becker v Harman International Industries (BECKER) 24 June 2010, paragraph 34
87 See development n°22
88 Which is MATRATZEN paragraph 30
89 See developments n°25 and the followings
law by using a new criterion. But here, the analysis led by a new adaptation of the analytic approach is made inside a complete use of the factors created in the framework of the global assessment of the comparison of the signs.\textsuperscript{90}

The logic between the two notions looks important but there is a major difference in the effects of their application which appears in the first words of the paragraph previously cited: “There may be a likelihood of confusion...”.

The recognition of an independent distinctive role leads to conclude that there is likelihood of confusion,\textsuperscript{91} so there is no use of the old presumption (which is underlined by the use of the modal verb “may”). Then, to consider that an element of a complex mark has an independent distinctive role, the judge has to use the methods used in the global assessment of the likelihood of confusion, especially the series of three comparisons.

35. Conclusion of the part, the double basement of the criterion. The MEDION case marks a reconciliation between the two approaches of the research of a likelihood of confusion. This double basement explains why it has some characteristics of the global assessment and some other of the analytic assessment.

35-1. The character coming from the global assessment is the necessity to use it inside the global method of the assessment of the likelihood of confusion as seen in the paragraph before. In a way, the criterion, coming partially from the analytic method has been bounded by the rules of the global assessment of the likelihood of confusion.

35-2. But in the other way, the criterion keeps a particularly important aspect coming of the analytic assessment by necessitating several conditions to be applied.

Indeed, the global assessment of the similarity is allergic to rules. Whatever counts is the global impression conveyed by of the signs, based on their similarity. And even if the signs are found similar, they might not be seen as creating a likelihood of confusion.\textsuperscript{92}

Then, the respect, by the latter case-law of many conditions (developed in the next part) can only be explained by the partially analytic nature of the criterion of an independent distinctive role.

\textsuperscript{90} See the further developments of those factors in the second part of this thesis
\textsuperscript{91} MEDION, previously cited (Note 23), paragraphs 30 and 31
\textsuperscript{92} See some examples in the second part of this thesis
B. The development of the criterion of an independent distinctive role

36. A temporary disappearing. After its insertion in the Court of Justice’s case law, the criterion was neglected. It only appeared in a few judgments during the three years following the MEDION case. And as a symptom of the ignorance it suffered from, the judge, in one of those judgments, applied the criterion without any reference to MEDION while another case mentioned an “independent distinctive function”.

Such a disappearance can be explained by the fact that such a modification of the case-law have first to be integrated in the arguments in several level of jurisdiction: the Cancellation Division, the Board of Appeal of the OHIM and in the arguments of the applicants, because the judge uses their reasonings to reach a verdict. Then, it is the necessary period for a case to go from the Cancellation Division to the Court of First Instance which explains the disappearance of the criterion, not an alleged lack of potential or interest.

37. The rebirth. The tiny domain of application of the criterion was impressively overlooked due to its potential and because of its transformation by the case law. By four judgments including two delivered the same day, the Court of First Instance started an important use of the criterion. After them, the criterion of an independent distinctive role was oftener mentioned.

In some of those cases, the criterion was not used but only mentioned by the parties (FITCOIN and X-TECHNOLOGY cases) to support their arguments, without any success. In others (DIETER WEILER case), the judge mentioned the criterion as an example to insist on the fact that the analysis of the signs implies to take account of every elements except the negligible ones.

93 See Case T-344/03 SAIWA v OHIM - Barilla Alimentare (ORO) 5 April 2006, paragraph 41
94 Judgments DIETER WEILER (12 November 2008), ECOBLUE (same day), BECKER (2 December 2008) and METRONIA (10 December 2008) see the references in further developments.
95 See annexe 1
96 Case T-249/08 Coin SpA v OHIM - Dinamiki Zoi AE (FITCOIN), 21 April 2010, paragraph 15
97 Case T-273/08 X-Technology R & D Swiss v OHIM - Ipko-Amcor (X-TECHNOLOGY), 28 October 2009, paragraph 46
98 Case T-242/07 Dieter Weiler v OHIM - IQNet Association – The International Certification Network (DIETER WEILER), 12 November 2008
38. Even where those cases are set aside, there are still many judgments which specified the domain of the criterion of an independent distinctive role.

This criterion is used in many ways, in many cases: the case law is hard to synthesize. Some judgments set several conditions about the criterion of an independent distinctive role (1), while some others enlarged its use (2).

1) The conditions applied about the criterion of an independent distinctive role

39. Before analysing those conditions, two remarks are necessary.

39-1. No necessity of a dominant element. Even if in MEDION, there was a dominant element – Thomson – and even if the judgment mentioned that the element did not determine alone the overall impression conveyed by the composite sign99, the application of the criterion of an independent distinctive role does not need the presence of a dominant element. This expression only means that the common component can be non-dominant. The useless character of such a component is clearly showed by the ECOBLUE100 case, where “eco” was found non-dominant101. This consideration did not prevent the judge from considering that “blue” – the common component – had an independent distinctive role.

39-2. The common element does not have to be a commercial name, even if it was clearly mentioned in the MEDION102 case. Indeed, such a condition never was applied in the latter case law even if the Court still mention it by making a reference to MEDION and even if the PRESTIGE103 case may have brought a doubt.

99See MEDION, previously cited (Note 23), paragraph 37
100Case T-281/07 Ecobue v OHIM – Banco Bilbao Vizcaya Argentaria (Ecobue), 12 November 2008, paragraph 33
101ECOBLUE, previously cited (Note 100), paragraph 32
102See MEDION, previously cited (Note 23), paragraph 37
103Case T-366/07 The Procter & Gamble Company v OHIM – Prestige Cosmetics SpA (PRESTIGE), 13 September 2010
This statement is confirmed by the LIFE BLOG\textsuperscript{104} case where the Court of First Instance implicitly considered that the Board of Appeal were wrong to mention the fact that the element to which was juxtaposed to the earlier trade mark was neither an earlier mark, nor a company name\textsuperscript{105}.

40. The first condition applied by the case-law which came latter than MEDION was that only a common component of two signs can have an independent distinctive role (a). This element should moreover have some necessary characters (b).

\textbf{a) The necessity of a common component}

This condition means that the element in the earlier and in the latter trade mark have to be the exact same component. But it does mean that the whole earlier trade mark has to be used in the latter sign.

\textbf{THE CONDITION OF AN EXACT SAME COMPONENT}

41. This condition never was a problem (at least for a nominative component\textsuperscript{106}) before the judgment G-STAR\textsuperscript{107}. In this case, the judge used this condition to refuse to apply the criterion of an independent distinctive role to compare the following signs:

\begin{center}
\begin{tabular}{|c|c|}
\hline
G-STAR & G-STOR \\
Earlier mark & Latter mark \\
\hline
\end{tabular}
\end{center}

The statement is quite clear:

\textit{MEDION “relates to the particular case of an earlier mark used in a composite sign which still had an independent distinctive role in that sign, without necessarily constituting the dominant element. It suffices to point out that, in this case, the mark applied for does not include any sign identical to the earlier mark”}\textsuperscript{108}.

\begin{flushleft}
\textsuperscript{104} Case T-460/07 Nokia Oyj v OHIM - Medion (LIFE BLOG), 20 January 2010  \\
\textsuperscript{105} See LIFE BLOG, previously cited (Note 104), paragraph 72  \\
\textsuperscript{106} See developments below, n° 55  \\
\textsuperscript{107} Case T-309/08 G - Star Raw Denim kft v OHIM - ESGW Holdings Ltd (G-STAR), 21 January 2010  \\
\textsuperscript{108} G-STAR, previously cited (Note 107), paragraph 37
\end{flushleft}
This condition is logical because the criterion of an independent distinctive role implies more than the fact that the consumers think about the earlier mark while watching the complex trade mark. The criterion also necessitate that the consumer is confused by the idea that the goods come from the same undertaking or economically-linked undertakings. This belief can only exist if the two components are identical.

42. A relaxation of the rule could have been admitted by the judge. In fact, even if the two elements are not exactly the same, the consumer might think that the goods come from the same undertaking if he doesn't perceive the tiny differences. Consequently, the criterion of an independent distinctive role could be applied where the owner of the latter trade mark reproduce the earlier mark in a complex sign by adding a tiny alteration (e.g. changed a sole letter) to escape from the application of the independent distinctive role.

But the strict application of the criterion of an independent distinctive role is still the one and only rule (at least for nominal trade marks) as it was implicitly reapplied in the recent judgment ENERCON.

43. A potential opposite case-law. This condition seemed not as obvious in a the PARFUM CHRISTIAN DIOR case, where a well-known trade mark was in question. The signs in question were radically different:

| First sign : J'ADORE | MANGO adorably |
| Second sign : ADIORABLE | |
| Earlier mark | Trade mark sought |

109 See developments below, No 52 and the followings
110 See OAMI-ONLINE - Newsletter 07 - 2010 - Luxembourg Case Law, paragraph A-2
111 Case T-472/07 Enercon v OHIM – Hasbro (ENERCON), 3 January 2010
112 Case T-308/08 Parfums Christian Dior v OHIM - Consolidated Artists (DIOR), 15 September 2009
In the latter sign, there is no entire component of the earlier trade marks but only a series of four letters from each earlier mark. Then the Court should have had quickly considered that, due to the absence of a common component, none of the elements of the latter mark can have an independent distinctive role.

But the Court didn't reject the action by answering that there was no common element. It only considered that:

“The comparison between the signs in conflict can't be done by taking account of only one element – adorably – from the sign sought for registration, even if this element might be considered as having an independent distinctive role”\footnote{DIOR, previously cited (Note 112), paragraph 32}.

“The arguments about the independent distinctive role the component “adorably” could have in the latter mark are not the kind which can question the conclusion relative to the absence of similarity between the signs in conflict”\footnote{DIOR, previously cited (Note 112), paragraph 70}.

Finally, the Court skipped the question by considering that the signs were so dissimilar according to the classic assessment of the likelihood of confusion\footnote{DIOR, previously cited (Note 112), paragraph 50}! Maybe the judge was uncomfortable because of the well-known earlier trade mark.

Anyway, the condition was not applied but the judge did not create an exception.

**The unnecessary reproduction of the whole earlier sign in the latter one**

In MEDION, the Court sanctioned the fact that a trade mark was juxtaposed to another\footnote{See MEDION, previously cited (Note 23), paragraph 34}. But as the Court mentioned, this only was an example of application of the criterion of an independent distinctive role!
44. The Court of First Instance revealed this statement in the OFFSHORE LEGENDS\textsuperscript{117} case, in which only a word of the complex earlier trade mark – “OFFSHORE” – was in the latter sign.

\begin{center}
\begin{tabular}{|c|c|}
\hline
Earlier mark & Trade mark sought \\
\hline
\end{tabular}
\end{center}

The Court approved the Board of Appeal of the OHIM which concluded to the existence of a likelihood of confusion. The Board of Appeal first considered that the public would memorise the word “OFFSHORE” by watching the earlier mark\textsuperscript{118}, especially because the other components (the figurative part and “1”) are not very distinctive\textsuperscript{119}. Then, it indicated that this element was not negligible in the latter mark. Finally, the Court approved the Board of Appeal which concluded that this element had an independent character in the latter mark\textsuperscript{120} and confirmed that it had an independent distinctive role\textsuperscript{121}.

45. Explanation: the idea of a summed up version of the sign memorised by the consumer. The consumer normally perceives a mark as a whole and does not proceed to analyze its various details. He only rarely has the chance to make a direct comparison between the different marks so has to place his trust in the imperfect image of them that he has retained in his mind\textsuperscript{122}.

Consequently, if the judge found that the consumer summed up the earlier sign in the sole element which was reproduced in the composite trade mark. This summed up version, as an element of the latter sign, may then have an independent distinctive role.

\textsuperscript{117} Case T-305/07 Offshore Legends v OHIM – Acteon (OFFSHORE LEGENDS), 16 September 2009
\textsuperscript{118} 29 mai 2007, R 1031/2006-2 and R 1038/2006-2, paragraph 39, OFFSHORE LEGENDS, previously cited (Note 117), paragraph 85
\textsuperscript{119} OFFSHORE LEGENDS, previously cited (Note 117), paragraph 86
\textsuperscript{120} OFFSHORE LEGENDS, previously cited (Note 117), paragraph 86
\textsuperscript{121} OFFSHORE LEGENDS, previously cited, paragraph 93
\textsuperscript{122} See SABEL, previously cited (Note 8), paragraph 23 and LLOYD, previously cited (Note 13), paragraph 26
Remark: the French judge admitted such a solution in the theory of the inoperative adding, applying the theory where the whole earlier sign or only a part of it was reproduced\(^{123}\).

b) The necessary characters of the common component

Two characters are necessary: the common component must have an independent meaning and a normal distinctiveness.

THE FIRST CONDITION: THE INDEPENDENT MEANING OF THE COMMON COMPONENT

46. In three cases, the judge refused to apply the notion of independent distinctive role because the common component, linked to another element of the sign formed a logical unit which made loose to the common component its individuality.

46-1. The first case which refused on this ground is the METRONIA\(^{124}\) case. The signs in question were the followings:

<table>
<thead>
<tr>
<th>Earlier mark</th>
<th>Trade mark sought</th>
</tr>
</thead>
<tbody>
<tr>
<td>METRO</td>
<td>METRONIA</td>
</tr>
</tbody>
</table>

The Court indicated that the word part of METRONIA is not seen as "the word ‘metro’ with the component ‘nia’ tagged onto the end". Since, the Court rejected the application of the criterion because of the "logical and conceptual unit" the word "METRONIA" formed on its own which led the consumer to see the mark METRONIA "as an indivisible, euphonic whole\(^{125}\)".

\(^{123}\) Presentation of the theory of the inoperative adding at No 22
\(^{124}\) Case T-290/07, MIP Metro Group Intellectual Property v OHIM - Metronia (METRONIA), 10 December 2008
\(^{125}\) See judgment METRONIA, previously cited (Note 124), paragraph 24
46-2. The second case was FERERRO\textsuperscript{126}. The signs in question were the followings:

<table>
<thead>
<tr>
<th>Earlier mark</th>
<th>Trade mark sought</th>
</tr>
</thead>
<tbody>
<tr>
<td>KINDER</td>
<td>KINDERJOGHURT</td>
</tr>
</tbody>
</table>

In this case, the judge indicated that the visual aspects of a sign may accentuate the unit of two of its elements.

*First, the word ‘kinder’ is merged with the word ‘joghurt’, which means that they have no specific, independent existence. Not only do the words ‘kinder’ and ‘joghurt’ have the same visual significance, but the stylised unevenness of the dancing, undulating font used for the word ‘kinderjoghurt’ turns them into a harmonious unit in which the two constituent words have become barely perceptible.\textsuperscript{127}*

The style of the font isolates the word from the rest of the sign. Consequently, the consumer won't see in this sign two words but only one, then he would probably not think of the earlier trade mark “KINDER” while watching the latter sign.

46-3. In the third case, MEMORY\textsuperscript{128}, the Court of First Instance went a little further by considering that two words may form a logical unit which prevented from the use of the criterion.

<table>
<thead>
<tr>
<th>Earlier mark</th>
<th>Trade mark sought</th>
</tr>
</thead>
<tbody>
<tr>
<td>MEMORY</td>
<td>EDUCA</td>
</tr>
</tbody>
</table>

---

\textsuperscript{126} Case T-140/08 Ferrero v OHIM - Tirol Milch (FERERRO), 14 October 2009
\textsuperscript{127} FERERRO, previously cited (Note 126), paragraph 56
\textsuperscript{128} Case T243/08 Ravensburger v OHIM - Educa Borras (MEMORY), 19 May 2010
In this case, the words “memory” and “game” are in the same rectangle below another rectangle with the word “EDUCA”, written in capital letters. Those elements lead to isolate the words “memory” and “game”, especially because, according to the Court, the public would perceive it as a compound word 129.

47. An application of the necessity of a common component. This condition seems clearly to be the extension of the condition of the existence of a real common component. Indeed, if the consumer perceives, in this case, “memory game” as a unique component, it is this whole which should be compared to the supposed common component “MEMORY”. Those two elements are clearly not identical, then “memory game” can't have any independent distinctive role. The idea is that the common element necessarily loose its independence while it is seen by the consumer not as an element, but as a part of a larger component in the sign.

**THE SECOND CONDITION : THE NORMAL DISTINCTIVENESS OF THE COMMON COMPONENT**

48. This condition was revealed by MEDION but had no real importance in the judgment:

*There may be a likelihood of confusion where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein* 130.

49. Application. This condition was explicitly applied in the recent judgment F1-LIVE 131 in which the Court considered that the element “F1” would be seen as a descriptive element of the mark 132. But it also was applied implicitly in the judgment GATEWAY 133. This second case is anyway a perfect example.

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129 MEMORY, previously cited (Note 128), paragraphs 36 and 37
130 See MEDION, previously cited (Note 23), paragraph 37
131 Case T-10/09, Formula One Licensing v OHIM - Global Sports Media (F1-LIVE), 17 February 2011, paragraph 51; see other developments about this judgment in the second part of the thesis, No 73-1 and 86
132 See developments below, n°88
133 Case T-434/05, Gateway v OHIM - Fujitsu Siemens Computers (GATEWAY), 27 November 2007
In this judgment, the goods linked to both signs were electronic devices:

<table>
<thead>
<tr>
<th>First sign:</th>
<th>Second sign:</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image" alt="Gateway" /></td>
<td><img src="image" alt="Gateway" /></td>
</tr>
<tr>
<td>ACTIVITY Media Gateway</td>
<td>Trade mark sought</td>
</tr>
</tbody>
</table>

The word element “Gateway” was the common component. The Court considered that this part of the sign, without being dominant, may hold the attention of the public but is too descriptive to have an independent distinctive role\(^{134}\). That is to say that the public, by seeing the latter mark, would notice the word “Gateway” without making a link with the earlier trade mark.

It is another example of an element which is neither dominant, nor negligible – so which is a part of the “third category”\(^{135}\) – and has finally not a great impact of the overall impression conveyed by the trade mark.

**50. Interest.** By this judgment, the Court refused that the criterion of an independent distinctive role permitted a too wide protection for weak trade marks. But in some other judgment, the solution wasn't so simple and the risk of an uncontrolled reinforcement of the protection of the mark – especially for the weakest ones – was clearer. It will be studied in the following section.

**2) The enlargement of the domain of the criterion of an independent distinctive role**

**51.** The enlargement of the domain had two effects. The first is a certain “infringement” of some conditions revealed before (a). The second is a tendency to substitute the criterion of an independent distinctive role where the judge used to research a dominant element (b).

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134 GATEWAY, previously cited (Note 133) paragraph 49
135 See developments n°15 and the followings
a) The infringement of the conditions revealed about the criterion of an independent distinctive role

Three conditions were questioned by the latter case law: the condition of an exact same component, the one of a normal distinctiveness of the common component and even the necessity of a common component. All of those appeared in two judgments delivered by the Court of First instance: GOLDEN EAGLE\(^\text{136}\) and PHILDAR\(^\text{137}\).

THE INFRINGEMENT OF THE NECESSITY OF AN EXACT SAME COMPONENT

52. In the GOLDEN EAGLE case, the following figurative trade marks were in conflict:

![Image]

The common component considered in this case was the red mug on a bed of coffee beans. The Court of Appeal found nine points of similarity between the different pictures: all of them represent a red handled mug with white inner surface showing its content, full of a hot beverage which let steam rising in a bed of coffee beans in front of a brown and orange-golden background with a halo\(^\text{138}\).

The dominant element of the latter trade marks is the word part - "Golden Eagle" - plus the image of the eagle in the first latter trade mark\(^\text{139}\).

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\(^{136}\) Joined Cases T-5/08 to T-7/08 Nestlé v OHIM - Master Beverage Industries (GOLDEN EAGLE), 25 March 2010

\(^{137}\) Case T-99/06 Phildar v OHIM - Comercial Jacinto Parera (PHILDAR), 23 September 2009

\(^{138}\) NESTLE, previously cited (Note 136), paragraph 26

\(^{139}\) NESTLE, previously cited (Note 136), paragraph 40
53. The idea of a reproduction of the description of the picture. Even if those figurative elements are quite close, they are not identical but only quite similar. Anyway, the Court decided to apply the criterion of an independent distinctive role\textsuperscript{140}.

In fact, the Board of Appeal considered\textsuperscript{141} that the common element is not the figurative part of the sign itself, but the description made from its. In the latter sign, it is not the figurative part which was reproduced but the nine points of similarity cited over. Indeed, the Court of First Instance didn't disapprove this analyse and used it as it owns\textsuperscript{142}.

In a way, the Court applied for figurative trade mark what it refused for word trade marks\textsuperscript{143}. It admitted to apply the criterion even if there was no strict common component. The perception of the consumer - who would not, in this case, pay attention to the tiny differences between the two pictures - finally overwhelmed the application of the criterion. This evolution might be seen as a new adaptation of the criterion to the global assessment of the similarity of the signs.

54. Interest and justification of the solution. This idea of the reproduction of the essence of the figurative part of the sign is a good and innovative extension of the criterion of an independent distinctive role. It permits the translation of the criterion to the figurative elements of complex signs.

The settled case law shows that the word part of a sign normally predominates its figurative part, because the average consumer would more likely make a reference to a trade mark by citing its name\textsuperscript{144}. Anyway, the idea that a figurative part could be the dominant element never was rejected\textsuperscript{145} and was even sometimes admitted\textsuperscript{146}. Then, it is logical that a figurative element may have an independent distinctive role.

\textsuperscript{140} NESTLE, previously cited (Note 136), paragraph 60
\textsuperscript{141} See NESTLE, previously cited (Note 136), paragraph 27 : “The nine elements of the earlier marks are reproduced in their entirety in the marks applied for”.
\textsuperscript{142} The Court used some expression as : “the representation of a red mug on a bed of coffee beans” several times in the case as an real element of the sign. See, NESTLE, previously cited (Note 136), paragraphs 40, 44, 45, 58, 63, 66, 71...
\textsuperscript{143} See developments about the G-STAR case, No 42.
\textsuperscript{144} See Case T-74/4 Nestlé v OHMI – Quick (QUICKY) 22 February 2006, paragraph 50
\textsuperscript{145} See over, the definition of a dominant element, developments n°25 and the followings
\textsuperscript{146} See SHAKER, previously cited (Note 51), paragraph 65
But, way more than in the case of a word mark, an applicant or a counterfeiter can easily reproduce something close but not identical to an earlier figurative trade mark without losing the advantage of the potential association the consumer would make between the two trade marks. Indeed, by changing a very tiny part of a figurative element, it is possible to avoid the Article 8(1)(a) of Regulation 207/2009, it would be to simple if it lets avoid the application of the criterion too. Consequently, without this extension of the criterion, the problem solved by MEDION\(^{147}\) with word trade mark will be unsolved for the figurative ones but also semi-figurative ones\(^{148}\).

55. **Risks brought by the solution.** Anyway, this important softening of the condition may lead to a too much enlargement of the use of the criterion. In this case, the Board of Appeal was very rigorous and based its description on a large number of elements to consider the description as an element of the sign.

A good application of the criterion of an independent distinctive role absolutely needs such a rigor! Indeed, this approach implies to focus on an undefined number of similarities between the signs. Then, a tiny description composed with two or three common points might seem enough to consider this description as an element of the sign and apply the criterion. Such an application will lead to an important and reinforced protection of the figurative parts of the trade marks, while the figurative part can be a non negligible element of a complex sign\(^{149}\).

55-1. **Illustration.** In a recent case - POLO SANTA MARIA\(^ {150}\) -, the Court of First Instance illustrated this risk. The common element considered was a “horseman wielding a polo mallet”, even if there was many differences between the two pictures as the position of the horsemen, of the horses.

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147 The practice of “swamping”: see D. Stone, ECJ overrules German Prägetheorie, previously cited (Note 32)
148 See, to that effect, F1-LIVE, previously cited (Note 131), where the judge did no consider that the criterion was inapplicable by applying the condition of a exact common component, even if the discrete figurative part of the earlier trade mark was not reproduced.
149 See:
   - TURKISH POWER, previously cited (Note 76), paragraph 62
   - Case T- 99/01 Mystery Drinks v OHIM - Karlsberg Brauerei (MYSTERY), 15 January 2003, paragraph 44
   - Case T-242/06 Cabrera Sánchez/OHMI - Industrias Cárnicas Valle (CHARCUTERO), 13 December 2007, paragraph 48
150 Case T-376/09 Glenton España v OHIM - The Polo/Lauren Company (POLO SANTA MARIA), 18 May 2011
But in this case, the Court only mentioned the judgment GOLDEN EAGLE\textsuperscript{151}, he did not apply the criterion of an independent distinctive role, considering that this criterion can only be applied when the earlier mark has been reproduced identically.

\textbf{THE INFRINGEMENT OF THE NECESSITY OF A NORMAL DISTINCTIVENESS OF THE COMMON COMPONENT}

\textbf{56.} In the GOLDEN EAGLE case, the Court also applied the criterion while it recognised the low degree of distinctiveness of the representation of the red mug on a bed of coffee beans.

Such an application is the exact opposite of the GATEWAY\textsuperscript{152} case and is quite dangerous, especially because the Court admitted the high degree of distinctiveness of the word and the image of a golden eagle, which can potentially be considered as bringing enough to the impression conveyed by the sign to erase the influence of the earlier mark.

\textbf{57. Difficulties brought by the solution.} Moreover, this condition seems important in order to apply the criterion of an independent distinctive role. Indeed, as an element with a weak distinctive character may rather be perceived by the consumer as a description of the product than seen as a part of a trade mark, the public may perceive a trade mark with a weak distinctive character in the same way\textsuperscript{153}, preventing him from making a link between the element of the composite sign and the earlier trade mark.

But further the questioning of this condition, it is more the way the judge assesses the distinctive character of the common component which brings problems\textsuperscript{154}.

\textsuperscript{151} POLO SANTA MARIA, previously cited (Note 150), paragraph 34
\textsuperscript{152} Previously cited (Note 133)
\textsuperscript{153} See F1-LIVE, previously cited (Note 131), paragraph 49
\textsuperscript{154} See development below, n°85 and the followings
THE INFRINGEMENT OF THE NECESSITY OF A COMMON COMPONENT

58. An odd decision. In the judgment PHILDAR, the following figurative trade marks were in conflict:

<table>
<thead>
<tr>
<th>Earlier mark</th>
<th>Trade mark sought</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image" alt="Phildar" /></td>
<td>FILDOR</td>
</tr>
</tbody>
</table>

The judge confirmed the reasoning of the Board of Appeal which concluded that the figurative part of the earlier mark had an independent distinctive role (the English version mentions an autonomous distinctive position, due to the translation from the French expression “position distinctive autonome”)\(^{155}\).

The problem was that PHILDOR was a word mark. Then, there was no equivalence of the figurative element of the earlier trade mark in the latter sign. In fact, the Court used the criterion not to insist on a similarity between the signs, but on a dissimilarity\(^{156}\)!

59. A reasoning far from a genuine application of the criterion. The independent distinctive role recognised in this case was not based on the fact that the consumer would think, by watching in the earlier trade mark, that the goods in question came from the same undertaking than the goods linked with the latter trade mark. Such a use was only a way to insist on the fact that the figurative part of the earlier sign was not negligible\(^{157}\)!

This formulation is clumsy/odd, because the figurative element brought something to the overall impression conveyed by the sign which is not exterior of the trade mark, which has no autonomy. The figurative element only participated to this overall impression, it was not confusing this impression by leading the public to think of another trademark. A better formula would have been, classically, that the figurative element influenced the overall impression conveyed by the trade mark.

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155 PHILDAR, previously cited (Note 137), paragraph 43
156 PHILDAR, previously cited (Note 137), paragraph 44
157 PHILDAR, previously cited (Note 137), paragraph 48
b) The progressive substitution of the criterion of the dominant element to the one of an independent distinctive role

The criterion of an independent distinctive role was first used as an alternative to the criterion of the dominant element, then a substitute and finally was sometimes used as an unrevealed substitute.

THE CRITERION OF AN INDEPENDENT DISTINCTIVE ROLE AS AN ALTERNATIVE TO THE CRITERION OF THE DOMINANT ELEMENT

60. In the PERFETTI VAN MIELE\textsuperscript{158} case, the signs in question were the followings:

<table>
<thead>
<tr>
<th>CENTER</th>
<th>CENTER SHOCK</th>
</tr>
</thead>
<tbody>
<tr>
<td>Earlier mark</td>
<td>Trade mark sought</td>
</tr>
</tbody>
</table>

The Court of First Instance considered that CENTER - the common component - was dominant. The judge first remarked that the signs are visually, aurally and conceptually similar owing to their dominant common component\textsuperscript{159}, agreeing with the considerations reached by the Board of Appeal\textsuperscript{160}.

But the judge also approved the reference made by the Board of Appeal to the judgment MEDION and to the criterion of an independent distinctive role\textsuperscript{161}. This reference, confirmed by the Court of Justice\textsuperscript{162}, was used as a justification of the reasoning of the Board of Appeal. Indeed, the judge explained that the element “CENTER” is dominant but that even if it was not the case, it would have an independent distinctive role because the element “SHOCK” is not sufficient to prevent the public from thinking that the goods linked to the two trade marks come from the same undertaking.

\textsuperscript{158} Previously cited (Note 82)
\textsuperscript{159} CENTER SHOCK, previously cited (Note 82), paragraph 43
\textsuperscript{160} CENTER SHOCK, previously cited (Note 82), paragraph 42
\textsuperscript{161} Board of Appeal. Case R 149/2006-4, paragraph 38 ; CFI, PERFETTI VAN MIELE, previously cited (Note 82), paragraph 44
\textsuperscript{162} Case C-353/09 P Perfetti van Melle v OHIM - Cloetta Fazer (CENTER SHOCK), 15 February 2011, paragraph 36
61. Remarks. This complementary application clearly appears in the judgment X-TECHNOLOGY in which the dominant element is also considered as having an independent distinctive role\textsuperscript{163}. Such a use is not very surprising because if an element is dominant, i.e. is so important that it influences the impression conveyed by the sign, it necessarily lead the consumer to think of an earlier trade mark and confuse the two. Then, the criterion of an independent distinctive role might replace the criterion of a dominant element in the case-law.

THE CRITERION OF AN INDEPENDENT DISTINCTIVE ROLE AS A SUBSTITUTE TO THE CRITERION OF THE DOMINANT ELEMENT

62. The criterion of an independent distinctive role was used instead of the criterion of dominance in several other judgments because of the difficulty to determine the dominant element in the case.

62-1. In the BECKER\textsuperscript{164} case, the judge used the criterion of an independent distinctive role to avoid transforming into a dominant / non-dominant debate, the tough question of the relative importance of a forename and a surname in a sign\textsuperscript{165}. The signs in conflict were the followings:

<table>
<thead>
<tr>
<th>First sign</th>
<th>BECKER</th>
</tr>
</thead>
<tbody>
<tr>
<td>Second sign</td>
<td>BECKER ONLINE PRO</td>
</tr>
<tr>
<td>Earlier mark</td>
<td>BEBARA BECKER</td>
</tr>
<tr>
<td>Latter mark</td>
<td></td>
</tr>
</tbody>
</table>

The Court did not analyse whether the common element – BECKER – was dominant or not and directly concluded that it had an independent distinctive role\textsuperscript{166} which helped him not to prioritize the forename and the surname, since an independent distinctive role does not mean that the element is more important than the others in the overall impression conveyed by the sign, but means that it has a particular, autonomous influence.

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163 X-TECHNOLOGY, previously cited (Note 97), paragraphs 33 and 46
164 Previously cited (Note 20)
165 See BECKER, previously cited (Note 20), paragraph 34 ; T. Lancrenon, Les « similitudes conceptuelles » entre marques intégrant un nom de famille, JCP E n°34, 26 August 2010, 1715.
166 BECKER, previously cited (Note 20), paragraph 34
65-2. In the ZERO INDUSTRY\textsuperscript{167} case, the Court did the same for the close reason.

![Diagram of earlier and latter marks]

The judge could not reach a conclusion about the dominance of the word “zero” - the common component - because of the non-negligible impact of the element “rh+” for a part of the public. Then, he used the criterion of an independent distinctive role\textsuperscript{168} to conclude to the existence of a likelihood of confusion.

63. **Interests of those use.** Such a use is ambivalent. In a way, it leads the judge to run away from some questions which is not necessarily very good for the case-law. It also might reinforce the protection of the trade marks even if in those cases, the likelihood of confusion is hard to contest.

But on the other side, and a bit ironically\textsuperscript{169}, it helps a better application of the global assessment by avoiding the creation of mini-rules the judges might automatically follow. It also, as already cited, lead to a better justification of the decision.

**THE CRITERION OF AN INDEPENDENT DISTINCTIVE ROLE AS AN UNREVEALED SUBSTITUTE TO THE CRITERION OF THE DOMINANT ELEMENT**

64. In the POLO\textsuperscript{170} case, the Court first considered that the decision of the Board of Appeal was not based on the fact that the element “POLO” was dominant and that the analysis made by the OHIM was not based on this only component of the trade mark sought. Then, it insisted on the fact that the Board of Appeal based its analysis on the insufficiency of the other elements of the sign to remove the similarity between the signs\textsuperscript{171} but did not conclude that the common component had an independent distinctive role.

\textsuperscript{167} Case T-400/06 Zero Industry v OHIM - zero GERMANY (ZERO INDUSTRY), 16 September 2009
\textsuperscript{168} ZERO INDUSTRY, previously cited (Note 167), paragraphs 51 and 52
\textsuperscript{169} because of the rejection the criterion suffers from by the aficionados of a pure application of the global assessment of the likelihood of confusion which militates for its withdrawal.
\textsuperscript{170} Case T-228/09 United States Polo Association v OHIM - Textiles CMG (POLO), 13 April 2011
\textsuperscript{171} POLO, previously cited (Note 170), paragraph 33
This consideration shows that the criterion of an independent distinctive role can not be used by itself but should be used with other elements, like the analysis of the visual, aural and conceptual similarities between the signs, according to the global assessment of the signs\(^{172}\).

65. Transition. After studying the definition of the independent distinctive role and the necessary conditions to apply the criterion, its practical application will be studied. Before concluding that an element of a complex sign has an independent distinctive role, the judge or the OHIM has to prove that the public would make a link between the earlier and the latter trade marks which would lead him to think that the goods linked to both trademarks come from the same undertakings or economically-linked undertakings. It is only if the judge reaches the conclusion that the element has such an effect that he could conclude that the element has an independent distinctive role which leads to a likelihood of confusion\(^{173}\).

To do so, the judge needs to follow a method based on the principles of the global assessment of the likelihood of confusion, several steps which goes to help him to prove the existence of an independent distinctive role. This method is the subject of the followings developments.

II. The use of the criterion of an independent distinctive role

The respect of a method based on the global assessment of the likelihood of confusion (A) is very important because the criterion of an independent distinctive role is complex as seen before. A sure and easy way to apply the criterion is indeed the best way to help, not only the other European judge and the OHIM, but also the national judges to help them specify its application (B).

\(^{172}\) See, LLYOD, previously cited (Note 170), paragraph 27
\(^{173}\) MEDION, previously cited (Note 23), paragraph 26
A. The determination of a standardised method based on the global assessment of the likelihood of confusion

According to the global assessment of the determination of the likelihood of confusion, there is an interdependence between the relevant factors used by the judge. Then, a standardised method implies the determination of a series of relevant factors (1) which will help to find the most effective method (2).

1) The determination of a series of factors in order to apply the criterion of an independent distinctive role

66. Preliminary remarks. The analysis provided in this section is not an exhaustive study of the way to characterise a likelihood of confusion but only an analysis of the aspects and factors linked to the criterion of an independent distinctive role. Consequently, the factors considered in the present section are linked to the appreciation of the similarities between the signs of two trade marks.

Then factors which have to be used at the very beginning of the analysis and which are not directly linked to the comparison of the signs – for example the relevant section of the public and its degree of attention - will not be developed. In the same idea, the similarity between the goods and services covered by the trade mark, with which a similarity of the signs in interdependent, will not be studied.

Finally, this analysis will not deeply consider the great variety of factors used by the judge, especially in the framework of the decomposition he is applying to the signs.

67. In order to apply the criterion of an independent distinctive role, some factors are barely unavoidable (a), while some are not (b).

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174 SABEL, previously cited (Note 8), paragraph 22 ; CANON, previously cited (Note 10), paragraph 17
175 See LLOYD, previously cited (Note 13). The formula now used is the “relevant public”, see MATRATZEN, previously cited (Note 43).
176 See LLYOD, previously cited (Note 13), paragraph 26
177 CANON, previously cited (Note 10), paragraph 17
a) **The unavoidable factors**

Those factors are particularly relevant in general but specially to apply the criterion of an independent distinctive role, so they are barely always taken in account\(^\text{178}\).

**THE VISUAL, AURAL AND CONCEPTUAL COMPARISONS**

68. The public sees a sign, pronounces it mentally and perceives it as an idea. Then, the consumer analyses the sign in three ways. This is why the main factor to compare two signs is the visual, aural and conceptual comparison. This factor was the first pushed by the Court of Justice which even considered it as an obvious factor to compare the signs\(^\text{179}\).

The application of those factors is really dependent of the signs present in the cases. Then the problems of application could be very different.

69. **Difficulties to apply the comparisons.** There is no problem to apply those comparisons when the signs are simple, i.e. are composed by a sole element\(^\text{180}\). Such a comparison is more difficult where the signs are composed by several elements because a comparison between the signs implies to take account of elements which can be different the ones from the others in the same sign. That is why the Court directly considered that:

> That 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\(^\text{181}\).

This consideration is based on the fact that the consumer can't remember the details of a sign and then is more likely to remember the most important of its elements. In order to determine the distinctive and dominant elements, the judge has to decompose the signs in question, i.e. analyse a sign to separate the different elements it contains.

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178 Reference to SABEL, previously cited (Note 8), paragraph 22 : “The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.”

179 The Court makes a logical link between the analysis of the perception of the sign by the public and the use of the three comparisons (see LLOYD, previously cited (Note 13), paragraph 25)

180 See, for example, the ALCON case (Case T130/03 Alcon Inc. v OHIM – Biofarma (TRAVISTAN), 22 September 2005 with the comparison of TRAVISTAN and TRAVATAN.

181 SABEL, previously cited (Note 8), paragraph 23
69-1. Another problem to apply these comparisons is that they can lead to opposite conclusions. Indeed, words composed by different letters might be pronounced in the same way\textsuperscript{182}, while words written with similar letters might lead the consumer to think to very different things\textsuperscript{183}. A balance sheet with those elements is then necessary.

**THE DECOMPOSITION OF THE SIGN**

70. This step is necessary to determine the distinctive and dominant components of the signs\textsuperscript{184}, i.e. the distinctive, weak, dominant and negligible components. The distinctive elements are the one which gives the most to the impression conveyed by the trade marks, in contrary to weak elements. The dominant elements are the one the consumer keeps in mind when he sees the trade mark.

This determination implies to separate the signs into several elements to focus on every word, every image which may bring something to the impression conveyed by the sign.

71. The distinctive and dominant components are often the same, because the element which brings the most to the impression conveyed by the sign – the most distinctive element – is often the one the public will perceive, i.e. the dominant element. Thus, the Court considered that the distinctive character of “SHOWALL” in the trade mark “BINGO SHOWALL” reproduced on the left inside the table implies that this element was dominant because, in contrary to the element “BINGO”, it has no link with the products registered\textsuperscript{185}.

72. And a weak component is often negligible. In the same way, the weak distinctive character of an element can lead the Court to consider that it is negligible because another element of the sign would impress the public. For

\begin{tabular}{|c|c|}
\hline
Sign & BINGO SHOWALL \\
\hline
Goods & games \\
registered & \\
\hline
\end{tabular}

\begin{tabular}{|c|c|}
\hline
Sign & OLYMP \\
\hline
Goods & clothes \\
registered & \\
\hline
\end{tabular}

\textsuperscript{182} See MYSTERY and MIXERY, Case MYSTERY, previously cited (Note 149), paragraph 45
\textsuperscript{183} See BINGO SHOWALL / SHOW BALL, Case T-179/10 Zitro IP v OHIM - Show Ball Informática (GAME SHOWALL), 13 April 2011
\textsuperscript{184} Mentioned in SABEL, previously cited (Note 8), paragraph 23
\textsuperscript{185} See GAME SHOWALL, previously cited (Note 183), paragraph 32
example, in the sign reproduced on the right, the figurative part – the “particular” way the words are written – is negligible comparing to the word himself\textsuperscript{186}. Indeed, the consumer can not remember the font which is too common to retain its attention: the figurative element is weak and negligible.

73. But the two notions are different.

73-1. The analysis of the distinctive character of an element implies to focus on the element itself. It leads to consider the intensity of its arbitrary dimension, its originality, its intellectual dimension or its well-known character.

According to the judgment INEX\textsuperscript{187}, the analysis of the distinctive character of an element can be determined by its ability to identify the goods or services for which the mark was registered as coming from a particular undertaking. If this ability is found, then the element will help the consumer to distinguish the goods from the one produced by other undertakings. Consequently, must be found the descriptive or distinctive character of the sign comparing to the goods or services for which the mark has been registered: the perception of the consumer has no influence.

For example, in the recent judgment, the Court of First Instance analysed the distinctive character of the element “F1” in the sign reproduced on the right\textsuperscript{188}. The Court insisted on the fact that “F1” is the common abbreviation of “Formula 1”, which designates a category of racing car and, by extension, races involving such cars and which is commonly used in everyday language. Consequently, “F1” is used in a descriptive context, the Court concluded that it has a weak distinctive character\textsuperscript{189}.

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\textsuperscript{186} See Case T-204/09 Olymp Bezner & Co. KG v OHIM – Miguel Bellido (OLYMP), 5 May 2011, paragraph 50
\textsuperscript{187} Case T-153/03 Inex v OHIM – Robert Wiseman & Sons (INEX), 13 June 2006
\textsuperscript{188} F1-LIVE, previously cited (Note 131)
\textsuperscript{189} F1-LIVE, previously cited (Note 131), paragraph 42 to 49
73-2. The analysis of the importance (dominant / negligible / third category) of an element supposes to analyse its relative strength, comparing to the other element of the sign. It leads to insist on the nature, the position, the size, the pronunciation of the element. There are numerous factors that the judge may use but none of them is necessary relevant or true. For example, the fact that an element is at the beginning of the word part of a sign does not mean that he is necessarily more important that the word after.

74. The case of a weak but dominant element. The judge considers now that even if an element has a weak distinctive character, it might impress the consumer who will remember it, making from this element the dominant part of the sign. Consequently, the importance of a weak distinctive element must be studied in every situation, which leads the judge to never consider an element as negligible.

Example: the AVEX case:

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190 A word element is often more important than a figurative one: see QUICKY, previously cited (Note 144), paragraph 50
191 The first element often predominates: see Case T-183/02 and T-184/02 El Corte Inglés/OHMI - González Cabello et Iberia Líneas Aéreas de España (MUNDICOR), 17 March 2004, paragraph 81 and OFFSHORE LEGENDS, previously cited (Note 117), paragraph 92
192 A bigger element is more likely to impress the public: see SHAKER, previously cited (Note 51), paragraph 56
193 An element which is hard to pronounce may impress the public: see MATRATZEN, previously cited (Note 43), paragraph 43
194 Case T-292/01 Phillips-Van Heusen v OHIM - Pash Textilvertrieb und Einzelhandel (BASS) 14 October 2003, paragraph 50 and Case T-117/02 Grupo El Prado Cervera v OHMI - Héritiers Debuschewitz (CHUFAFIT), 6 July 2004, paragraph 48
195 Case T-491/04 Merant v OHIM - Focus Magazin Verlag (FOCUS), 16 May 2007, paragraph 49; PHILDAR, previously cited (Note 137), paragraph 42
196 The study of the case-law of 2011 shows that this word is rarely used in the last judgments
197 Case T-115/02 AVEX v OHIM - Ahlers (AVEX) 13 July 2004, paragraph 20
In this judgment, the Court first admitted that a single letter may be devoid of any distinctive character but considered that the lower case white letter “a” was the dominant component because it made an immediate impression and is remembered. In contrary, the background of the sign and the difference of the font used have been considered minor and unable to be remembered by the consumer.

75. Importance to apply the criterion of an independent distinctive role. To apply the criterion of an independent distinctive role, the most important element is the common component. The decomposition permits to light this component on. Indeed, this component has to be particularly studied in the composite sign. If the analysis leads to consider that the common component is dominant or negligible, the question of its independent distinctive role is not relevant. The same conclusion should also be reached if it has, in the composite mark, a weak distinctiveness. In contrary, the fact that it has a high distinctive character never prevent from applying the criterion of an independent distinctive role. Consequently, this step is one of the most important in order to apply the criterion of an independent distinctive role.

THE BALANCE SHEET OF THE RELEVANT ELEMENTS

76. Such a step in the reasoning of the judge is logical, even the criterion of the three comparisons set aside because the judge takes account of several factors which can lead to opposite conclusions, a balance sheet is necessary.

77. It implies, first, to list and make a separation between the factors which lead to the conclusion that there is a similarity between the signs and the ones which lead to consider that there is no similarity. Then, there is two way to use the balance sheet.

77-1. The consideration that the good conclusion (similarity or dissimilarity) is the one pointed by the more elements is the first way. It is often relevant.

198 AVEX, previously cited (Note 197), paragraph 20
199 Because such a quality can only be applied to an element of the third category, which is neither dominant nor negligible, see developments over, n°15 and the followings
200 Because of the condition of a normal distinctiveness, see developments over No 48 and the followings and MEDION, previously cited (Note 23), paragraph 37, even if it is more complex than that, see developments below No 82 and the followings
Example: the MUNDICOR\textsuperscript{201} case:

<table>
<thead>
<tr>
<th>MUNDICOLOR</th>
<th>MUNDICOR</th>
</tr>
</thead>
<tbody>
<tr>
<td>Earlier mark</td>
<td>Trade mark sought</td>
</tr>
</tbody>
</table>

In this judgment, the Court of First Instance considered that there was a visual similarity, due to the presence of the letters “MUNDICO” in both signs. Aurally, it concluded that the particular pronunciation of the Spanish people – the relevant public – and especially the strong pronunciation of the final letter – the “r” – would overshadow the small difference brought by the differences of the last syllables. Conceptually, the Court considered that the relevant public would understand the earlier mark as making a reference to a coloured world while the trade mark sought had no easy meaning: there was no conceptual similarity\textsuperscript{202}.

The Court used the method of the balance sheet by considering that the conceptual dissimilarity was not able to counteract the visual and aural similarities, there was a likelihood of confusion between the signs\textsuperscript{203}.

77-2. The idea of a counteraction of a sole factor. The fact that the judge considered that the visual dissimilarity couldn’t counteract the similarity found in the other comparisons shows that the judge sometimes does not bend on the side where the most factors are directed. In this kind of cases, the Court tries to hierarchy the different factors to reach a conclusion: it is the second way.

In the judgment MYSTERY\textsuperscript{204}, the Court applied this second consideration.

<table>
<thead>
<tr>
<th>MYSTERY</th>
<th>MIXERY</th>
</tr>
</thead>
<tbody>
<tr>
<td>Earlier mark</td>
<td>Latter mark</td>
</tr>
</tbody>
</table>

\textsuperscript{201} Previously cited (Note 191)
\textsuperscript{202} MUNDICOR, previously cited (Note 191), paragraph 80 to 91
\textsuperscript{203} MUNDICOR, previously cited (Note 191), paragraph 93 and 94
\textsuperscript{204} Previously cited (Note 149)
After considering that the particular form of the earlier mark and especially the capital letter “M” and that the evocative meaning of the signs were not sufficiently direct, the Court concluded respectively to a visual and a conceptual dissimilarity. Due to the pronunciation of the relevant public's language, composed by German and English, the Court to considered that the signs were aurally similar\textsuperscript{205}. Then the Court considered that the similarity of the goods and the aural similarity of the signs led to a likelihood of confusion\textsuperscript{206} because the goods were also ordered orally.

78. The necessity to order the factors. With this consideration, the judge showed that the different factors should be ordered to reveal their importance in the comparison of the signs. But the hierarchy created in a case does not influence the other judgments because, once again, whatever matters in the framework of the global assessment of the likelihood of confusion is the overall impression conveyed by the sign: it is always very factual.

Thus, the superiority of the aural comparison in the previous case did not prevent the judge from considering that the visual comparison\textsuperscript{207} or the conceptual one\textsuperscript{208} may be the most important in some other cases, to conclude to the existence of a likelihood of confusion or to its absence.

b) The avoidable factors

Two unnecessary factors, which concern the qualities of the earlier trade mark are not used but could a priori have been: it is the recognition of the trade mark in the market and the weak distinctive character of a trade mark. The other one is used but should not because of its effects, it is the fact that the signs are partially identical.

\textsuperscript{205} MYSTERY, previously cited (Note 149), paragraph 44 to 47
\textsuperscript{206} MYSTERY, Previously cited (Note 149), paragraph 48
\textsuperscript{207} See EL CHARCUTERO ARTESANO, previously cited (Note 149), paragraph 77
\textsuperscript{208} See BASS, previously cited (Note 194), paragraph 54
THE RECOGNITION OF THE EARLIER TRADE MARK IN THE MARKET : AN UNUSABLE FACTOR

79. This factor takes in account the “celebrity” a mark got in the market, i.e. the fact that a large part of the public knows a trade mark\(^\text{209}\). Such recognition implies an exploitation of the trade mark. Consequently, this factor can only be applied to the earlier mark – in the framework of an opposition against the registration of a trade mark. Even in the framework of a counterfeiting action – which imply an exploitation of the trade mark attacked – the possible recognition of the latter trade mark due to its exploitation can not be an argument of the absence of infringement! Such recognition would be an aggravating factor of the counterfeiting.

80. Potential importance to apply the criterion of an independent distinctive role.
This criterion implies that an element of the composite mark wakes up the memory of the earlier trade mark in the mind of the public. But the trade marks which are the more likely to be remembered are the one which benefit of an importance recognition on the market – especially the well-known trade marks\(^\text{210}\).

81. Real impact. Nevertheless, the recognition of the earlier trade mark on the market never had any influence on the application of the criterion of an independent distinctive role. Such a character is in fact unnecessary on the one hand to apply the criterion and never was useful on the other hand to obtain a greater protection by the criterion of an independent distinctive role.

81-1. The recognition of the trade mark is unnecessary because the appreciation of the memory of the earlier trade mark is particular. What the judge is looking for is if a consumer who knows the two trade mark would think that the goods marked with the two signs are coming from the same undertaking. Because the relevant consumer is suppose to know the two marks, the actual recognition of the earlier trade mark on the market is

\(^{209}\) Case C-375/97 General Motors v Yplon (GENERAL MOTORS), 14 September 1999

\(^{210}\) See a similar reasoning, leading to the conclusion that the well-known character of a trademark might improve the distinctiveness of an element to the extent that he became dominant: Case T-287/06 Miguel Torres v OHIM – Bodegas Peñalba Lopez, (MIGUEL TORRES), 18 December 2008, paragraph 52. As a symptom of what is developed next, the Court considered that this statement could not be applied in the case.
indifferent. This consideration is confirmed by the judgment MEDION which mentioned that the earlier trade mark does not have to be known:

This [the situation to apply the criterion of an independent distinctive role] would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known²¹¹.

81-2. The well-known character of the earlier trade mark can not have any effects.

Firstly because the application of the criterion of an independent distinctive role implies to consider that the public knows the mark, not that he is obsessed with it due to its recognition on the market, and that this obsession lead him to see the trade mark everywhere, in any sign in which it is partially reproduced. Such a consideration would lead to a too wide protection of the well-know trade mark.

Secondly because, in the framework of the Article 8(5) of the Regulation 207/2009 - which protects the well-known trade mark - a similar evidence to the criterion of an independence distinctive role has to be proved. Indeed, a well-known trade mark is protected from a sign since this sign lead the consumer to make a link²¹² between the earlier well-known trade mark and a latter sign. But the criterion of an independence distinctive role implies that the consumer thinks of the earlier trade mark so makes a link. This notion has then no interest in order to protect a well-known trade mark because the evidence is harder to bring.

This consideration is illustrated by several judgments²¹³ in which the recognition of the existence of an independent distinctive role is refused, as well as the application of the particular protection of the well-known trade mark²¹⁴ in two pleas which are both rejected. In those judgments, the two pleas never was crossed, there are no rapprochements which could lead to think that they may be applied cumulatively.

²¹¹ MEDION, previously cited (Note 23), paragraph 34
²¹² GENERAL MOTORS, previously cited (Note 209), paragraph 23
²¹³ FERRERO, previously cited (Note 126), F1-LIVE, previously cited (Note 131)
²¹⁴ Article 8(5) of Regulation No 207/2009
THE WEAK DISTINCTIVE CHARACTER OF THE EARLIER TRADEMARK: A FACTOR THE JUDGE CAN NOT APPLY ANYTIME

82. As seen below, this factor is a condition to apply the independent distinctive role but was questioned\textsuperscript{215}. More than a condition of the criterion, the weak distinctive character is above all a factor of the global assessment\textsuperscript{216} used in many other cases.

83. The absence of use of the weak distinctive character. The Court only use the high distinctive character of a trademark to enlarge the protection granted to a trade mark\textsuperscript{217}, according to the legislation which only predict a protection and a reinforced protection of the trade mark in case of high distinctive character or recognition of the trade mark in the market. Consequently, the weak distinctive character is not used to reduce the scope of the protection of the trade mark, which pushes several authors to consider that it leads to an “overprotection” of the weak trade marks\textsuperscript{218}.

84. The theory of a narrow protection of the weak trade mark. The authors are considering that a weak earlier trade mark should only be protected in case of an exact reproduction of the earlier weak trade mark and then denied to them the application of the Article 8(1)(b) of Regulation No 207/2009.

85. Two reasons lead to reject a so rude theory.

85-1. First, such a consideration leads to accept that a weak earlier trade mark could be reproduced since some elements are added, even if those new elements are less distinctive or even if the earlier trade mark is the dominant component of the composite mark\textsuperscript{219}, violating the principle of the global assessment of the likelihood of confusion because the analysis would only be based on the common component of the signs.

\textsuperscript{215} See developments over, n°51 and n°60 and the followings
\textsuperscript{216} See, for Example, INEX, previously cited (Note 187), ORO, previously cited (Note 93), KIAP MOU, previously cited (Note 68)
\textsuperscript{217} See SABEL, previously cited (Note 8), paragraph 24
\textsuperscript{218} José Monteiro, La surprotection des marques faibles dans la jurisprudence communautaire, Propriété industrielle n° 6, Juin 2009, étude 12, Arnaud FOLLIARD-MONGUIRAL, Florilège de jurisprudence 2004 en matière de droit communautaire des marques, Propriété industrielle n° 2, Février 2005, Etude 4
\textsuperscript{219} See FOCUS, previously cited (Note 195), paragraph 64
Then the General Court and the Court of Justice strictly rejected this theory by forcing the OHIM to make a comparison between the signs without paying any attention to a supposed weak distinctive character of the earlier trademark. The Court of Justice, in the judgment FLEXI AIR made this statement:

*Even in a case involving an earlier mark of weak distinctive character and a mark applied for which is not a complete reproduction of it, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered.*

This statement was applied by the General Court in another case brought by the company Medion in a case where the criterion of an independent distinctive role was in question.

85-2. The second reason is that, far from the idea to overprotect the weak trade marks, the Court neglect the weak character because its competence is limited. Indeed, in the framework of an opposition procedure, the judge does not have the ability to control the validity of the earlier trade mark. Consequently, he can not consider that the common element of the composite mark has a weak distinctive character so weak that the mark could not be protected, because if he claims such a consideration, he would indirectly judge the validity of the earlier trade mark (in the case where the two signs are linked to the same goods).

Then, because of its validity, the trademark has necessary a normal distinctiveness. Consequently, this factor can only be use in the framework of a counterfeiting action. The condition of a normal distinctiveness of the earlier trade mark is then real condition to apply the criterion of an independent distinctive role, but it is paralysed in a large amount of cases where this criterion is applied.

86. Incidence of the weak distinctive character where the weak element is only an element of the earlier trade mark. The judge only can consider that the element of the earlier trade mark reproduced in the composite one has a weak distinctive character when

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220 Case T-112/03 L’Oréal v OHIM - Revlon (FLEXI AIR), 16 March 2005, paragraph 61
221 LIFE BLOG, previously cited (Note 104), paragraph 70
222 See F1-LIVE, previously cited (Note 131), paragraph 47
this component is only a part of the earlier trade mark. In such case, its consideration has no
impact on the supposed validity of the earlier trade mark because the other elements can
give its distinctive character to the sign. That is why in the
judgment F1-LIVE, the Court could normally consider\textsuperscript{223} that “F1”, the common element of the marks, was
descriptive to designate magazines to the field of formula one. Indeed, in the earlier sign
(reproduced on the right), the figurative part is arbitrary, then distinctive.

\textbf{THE IDENTICAL REPRODUCTION OF A PART OF A SIGN : A FACTOR WHICH SHOULD BE BANNED}

87. The reproduction of a part of the earlier trade mark by the latter trade mark is a
condition to apply the criterion of an independent distinctive role as said in development
over\textsuperscript{224}. But this condition should not change the analysis. This factor is the consequence of
the old habit guided by the analytic assessment of the comparison between the signs\textsuperscript{225} and
appeared as a tension\textsuperscript{226} in the application of the global assessment of the similarity between
the signs.

88. \textbf{Drawbacks of this factor}. When the judge applies this factor, he considers that
the common component brings a high probability that the composite sign creates a likelihood
of confusion. Consequently, he only analyses quickly the differences between the signs.

In the framework of the application of the criterion of an independent distinctive role,
the judge should verify if the elements added to the common component are sufficient to
erase the influence of the earlier trade mark on the composite sign\textsuperscript{227}. Consequently, the
preliminary consideration that there is a high probability of the existence of a likelihood of
confusion is not really a problem. Even if this leads the judge to analyse the differences
between the signs rather than the similarities, such an analysis in the framework of the other
factors developed above permits a reconciliation of the global and the analytic assessment of
the likelihood of confusion\textsuperscript{228}.

\textsuperscript{223} And even consider that the Board of Appeal was wrong not to analyse the element “F1”, see F1-LIVE, previously cited (Note 131), paragraph 48
\textsuperscript{224} See developments n°42 and the followings
\textsuperscript{225} See developments above, No 24 and the followings
\textsuperscript{226} Catherine Sevile, \textit{EU intellectual property law and policy}, previously cited (Note 2), page 258
\textsuperscript{227} See developments n°33 and the followings.
\textsuperscript{228} See developments above, n°35
But as showed in the first part of this study\textsuperscript{229}, such a consideration leads the judge to minimize its justification and focus on the most important part of the sign, which gives the impression of the existence of a presumption. This problem can easily be solved by using the factors developed above in the framework of a logical method, by following several steps in the right order.

2) The determination of the most effective order of the factors to apply the criterion of an independent distinctive role

89. The three major factors developed in the previous section - respectively the three comparisons, the decomposition of the signs and the balance sheet - are generally used but it is not enough to have a clear and efficient development. The order of their use is also very important. For example, if the analysis of the aural similarity is made before the determination of the relevant public – and the languages he knows – the reasoning won’t be as convincing as the same analysis made in the opposite order.

In the framework of the criterion of an independent distinctive role, some judgments of the General Court used imperfect methods (a) which isolate them from the others which are quite stereotyped and generally shorter and more convincing because of a smart use of the decomposition of the signs (b).

a) The imperfect methods used by the General Court

90. The problems mentioned here are minor but their revelation permits to find the tiny modifications necessary to build a dominant method which could help the OHIM and the national judges to deliver their decisions.

\textsuperscript{229} See development above, n°26 and the followings and M. Dhenne, Appr éciation compar ée du risque de confusion entre marques en jurisprudence française et communautaire, previously cited (Note 43)
Three judgments would be particularly studied here: PERFETTI VAN MIELE\textsuperscript{230}, POLO\textsuperscript{231} and ZERO INDUSTRY\textsuperscript{232}.

\textbf{91. Case of a lack of justification.} In the PERFETTI VAN MIELE case, the problem was the way the judge used the decomposition of the sign. The Court begun by applying the three comparisons\textsuperscript{233}. It concluded that there were some visual and aural dissimilarity. Nevertheless, the judge concluded the overall impression conveyed by the signs is similar because of their common component:

\begin{quote}
Although, visually and phonetically, the trade marks at issue are of a different length and consist of a different number of words, the overall impression produced by those trade marks leads to the finding that there is a certain visual and phonetic similarity between them owing to their common component.
\end{quote}

Such a consideration implies to prove first that the common element is dominant or that the elements added to the common component are not sufficient to erase its independent influence on the sign. The Court considered, without any other research, that the common component had an independent distinctive role. Next, the judge only partially analysed the distinctive character of different components - including the common one - by answering the applicant's arguments but never demonstrated that the independent character of the common component still existed in the composite sign.

By proving neither the dominant character of the common component, nor its independent distinctive role, the judge took the risk that the applicant was not convinced enough and decided to submit an appeal to the Court of Justice, which finally happened. The Supreme Court of the European Union made a choice and decided to apply the criterion of an independent distinctive role. It considered that “the word ‘shock’ does not have a strong semantic value which, combined with that of the word ‘center’, produces a whole that is conceptually different from the CENTER mark\textsuperscript{234}”. The Court considered that the rest of the sign was not sufficient to convey a different impression than the one brought by the sole common element.

\begin{flushleft}
\textsuperscript{230} Previously cited (Note 82)
\textsuperscript{231} Previously cited (Note 170)
\textsuperscript{232} Previously cited (Note 167)
\textsuperscript{233} PERFETTI VAN MIELE, previously cited (Note 82), paragraph 43 and 44
\textsuperscript{234} PERFETTI VAN MIELE CJUE, previously cited (Note 162), paragraph 37
\end{flushleft}
92. Case of a late decomposition of the signs. In the POLO case, the problem is that the Court partially decomposed the sign in the middle of the three comparisons instead of applying this factor at the beginning. The judge begun to compare the signs to determine the visual and the aural (dis)similarities\(^{235}\). Then, he analysed the distinctive character of the elements “U.S.” and “ASSN” - the non common components - to analyse the conceptual similarities between the signs. The absence of analysis of those parts to provide the visual and aural comparisons led the judge to consider that the signs were visually and aurally similar to a medium degree... Then, the judge left the decision to its conclusion about the sole conceptual comparison but its decomposition - in which he found no dominant, no distinctive, no negligible and no weak elements - was useless. Finally, its reasoning led him to conclude that the signs were conceptually similar... to a medium degree\(^{236}\). Consequently, because the judge refused to make a genuine decomposition of the signs, his conclusion was not very convincing.

It was finally the similarity of the goods which led the judge to consider that there was a likelihood of confusion.

93. Case of a separation of the different part of the decomposition. In the ZERO INDUSTRY case, the problems are a little more important. In this judgment, first, the Court did not look for the distinctive\(^{237}\) and dominant element of the signs on a same block, i.e. not the one right after the other\(^{238}\). Even if those two notions are different as showed above, they are often interdependent, which gives logic to their close analysis.

Secondly, the Court concluded that the common element - “ZERO” - still had an independent distinctive role\(^{239}\) in the middle of the analysis and even before using the factor of the three comparisons\(^{240}\). This has two drawbacks. The first is a necessary repetition of some

\(^{235}\) See, POLO, previously cited (Note 170), paragraph 35 to 42
\(^{236}\) See, POLO, previously cited (Note 170), paragraph 50
\(^{237}\) ZERO INDUSTRY, previously cited (Note 167), paragraph 47
\(^{238}\) ZERO INDUSTRY, previously cited (Note 167), paragraph 67
\(^{239}\) ZERO INDUSTRY, previously cited (Note 167), paragraph 51
\(^{240}\) ZERO INDUSTRY, previously cited (Note 167), paragraph 55
analysis which leads to a long decision – 93 paragraphs – not so easy to read and understand, the second is an impression that the judge gave more his opinion than he delivers a solution based on juridical arguments.

The final problem is the absence of titles to separate the different part of the reasoning – comparison of the goods, of the signs, decomposition, visual similarity, aural similarity, conceptual similarity, balance sheet – which is a very efficient way the increase the readability of a judgment. This has an important effect on this long judgment and leads to the biggest difficulties to understand the reasoning of the judge,

Those cases shows some traps the judge have to avoid in order to deliver an efficient, logical and justified decision in the framework of the application of the criterion of an independent distinctive role.

**b) The dominant method based on an early use of the decomposition of the sign**

94. **Preliminary remarks.** A method is very used, especially since MEDION242. It is based on a particular order in the use of the three major factors previously studied. Its analysis will be, in parallel, illustrated by the judgment X-TECHNOLOGY243 which perfectly and completely uses this method. In many others judgment, because the judge approves the Court of Appeal in some points he is not reproducing, the whole developments does not appear, but is applied. In this judgment, the goods registered by both marks were clothes and underwear and the signs were the followings:

<table>
<thead>
<tr>
<th>First</th>
<th>First-On-Skin</th>
</tr>
</thead>
<tbody>
<tr>
<td>Earlier mark</td>
<td>Trade mark sought</td>
</tr>
</tbody>
</table>

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241 See, to that effect, PHILDAR, previously cited (Note 137), long of 105 paragraphs !
242 See for example : OFFSHORE LEGENDS (Note 117), DIOR (Note 112), DIETER WEILER (Note 98), SUNPLUS (Case C-21/08 P, Sunplus Technology Co v OHIM – Sun Microsystems (SUNPLUS), 26 March 2009), REVERIE (Case T-246/06 Redcats v OHIM – Manuel Revert & Cía (REVERIE), 6 May 2008)
243 Previously cited (Note 97)
95. **First step: the decomposition of the signs.** In this method, the judge begins to decompose the sign, which lead him to find the dominant and distinctive components, but also the negligible ones (even though this notion becomes rarely used as said before). He also can find if some elements form a logical and harmonious unit which imply to count a unique element, rather than two\textsuperscript{244}.

To do so, the judge can choose between plenty of dedicated factors, permitting to take in account every situation like the position of the element, its size, the way the public would perceive a word, a sign\textsuperscript{245}.

**95-1. Illustration.** In the judgment X-TECHNOLOGY, the Court noted that the common element was “SKIN” considered that it was the dominant element of the composite sign because it was its first element\textsuperscript{246}.

**95-2. Interest.** With all of that potential information, especially about the common components, the judge still has plenty of information. If the common component is dominant in the trade mark sought, the signs are likely to be similar. If the common component is negligible (it has no role), has a weak distinctive character (it is not distinctive) or has intrinsic meaning (it has no independence) because it forms a unit with another element, an independent distinctive role can not be found.

Anyway, the judge musts continue its analysis, because he has not enough information and in order to respect the principle of the global assessment of the likelihood of confusion, which implies to take account on every relevant factor in the case.

**96. Second step: the three comparisons.** Then, the judge can apply the three comparisons, namely the visual, aural and conceptual ones - in the light of the different elements he found. To do so, he can sort out the negligible elements and focus on the dominant and distinctive elements to guide his conclusions.

**96-1. Illustration.** After that, the judge has the three results of the comparisons. In X-TECHNOLOGY, the judge considered that the sign were visually, aurally and conceptually similar because of the impact of the dominant element\textsuperscript{247}.

\textsuperscript{244} See for example, MEMORY (Note 128) and METRONIA (Note 124), both previously cited
\textsuperscript{245} See developments n°75-2
\textsuperscript{246} X-TECHNOLOGY, previously cited (Note 97), paragraphs 32 and 33
\textsuperscript{247} X-TECHNOLOGY, previously cited (Note 97), paragraphs 34 to 41
97. Third step: the balance sheet. With those three elements, the Court is able to make a balance sheet and consider that the direction - similarity or dissimilarity - pointed in majority by the elements or make a hierarchy by considering that one of the element counteract the others.

97-1. Illustration. In X-TECHNOLOGY, the judge of course considered that the signs were similar but added, in order to justify even a little more his decision, that the common component still had an independent distinctive role. The analysis of the three comparisons showed, indeed, that the Court considered that the other components sufficient to exclude the similarity brought by the word “SKIN”.

98. Transition All of this analysis showed the difficulties the European Courts could have in order to apply the criterion of independent distinctive role. Their respect for this method is quite important, because it would help the national judges in their reasoning to rightly apply this young criterion and specify it. Indeed, the larger amount of case law the national judges may have comparing to the European judge, implies that they may be in contact with some new problems.

B. The application of the criteria by the national judges

99. Preliminary observation: this section is not supposed to show a precise image of the national case-laws due to their impressive complexity and all the time necessary to synthesise them. Nevertheless, it will use some national case-laws in order to illustrate the important role of the national judges in the application of the criterion of an independent distinctive and in the revelation, as result of its gigantic size, of the numerous problems this criterion will still bring.

248 X-TECHNOLOGY, previously cited (Note 97), paragraphs 42
249 X-TECHNOLOGY, previously cited (Note 97), paragraphs 46
100. The study of the history of this criterion may lead to imagine the reaction of some judges. Thus, the idea that the German judge, after seeing its case-law rejected, would try to enclose the domain of the new criterion looked realistic. In the same way, the French judge considering that its old case-law had got a new youth, could have returned to its old habits.

But contrary to those ideas, it was not the expected judges who got the more problems to apply the criterion (1) even if they finally solved some difficult cases, confronted to the apparition of new problems (2).

1) The arrival of the criterion in the national case-law

The German judge were very reactive to apply the young criterion (a), while the French first got problems to go further than the strict situation exposed in MEDION (b). In some cases, the judges had to be careful in order to prevent from a too wide application (c).

a) The impressive adaptation of the German case-law

The German judge, right after the judgment MEDION, got some occasions to test this new criterion, even before the European judges.

101. They first had a particularly friendly case in order to apply the new criterion, because of its proximity to MEDION : the INTERCONNECT²⁵⁰ case. Indeed, the signs in question were the followings :
Like in MEDION, the two companies acted in the same economic sector - data communication - and an earlier trade mark was juxtaposed to a well-known trade mark - the “T” element of the trade mark sought is the figurative trade mark of Deutsche Telekom, the biggest European company in telecommunication. Then, the judge was very likely to apply the criterion of an independent distinctive role\(^\text{251}\). But the Bundesgerichtshof already had applied it.

102. In the judgment MALTESERKREUZ\(^\text{252}\), the Bundesgerichtshof had to analyses the following signs:

<table>
<thead>
<tr>
<th>Earlier mark</th>
<th>Trade mark sought</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1.png" alt="Earlier mark" /></td>
<td><img src="image2.png" alt="Trade mark sought" /></td>
</tr>
</tbody>
</table>

This case is particularly complex. The common element is the figurative element named “Malteserkreuz”, a well-known and very distinctive symbol of various Christian orders since centuries. The Bundespatentgericht considered that the element “LAZARUS” brought a visual dissimilarity\(^\text{253}\) and a huge aural dissimilarity\(^\text{254}\) but it was not the name of the figurative part\(^\text{255}\). Indeed, the consumer, by watching the composite sign, sees the “Malteserkreuz”. Then, the application of the criterion seemed possible, the Bundesgerichtshof cited MEDION\(^\text{256}\) and applied the new criterion.

103. Such reasoning is now validated by the European judges, who applied the criterion to the figurative trade marks\(^\text{257}\), but at that time, it was not so easy.

\(^\text{251}\) INTERCONNECT, previously cited (Note 250), paragraph 33
\(^\text{252}\) Case I ZB 28/04 MALTESERKREUZ, delivered by the Bundesgerichtshof (GERMANY) on 11 May 2006
\(^\text{253}\) MALTESERKREUZ, previously cited (Note 252), paragraph 13
\(^\text{254}\) MALTESERKREUZ, previously cited (Note 252), paragraph 12; indeed, the earlier mark is named “Malteserkreuz”
\(^\text{255}\) MALTESERKREUZ, previously cited (Note 252), paragraph 14
\(^\text{256}\) MALTESERKREUZ, previously cited (Note 252), paragraph 18
\(^\text{257}\) See developments n°55 about GOLDEN EAGLE, previously cited (Note 136).
b) The hesitant application of the criterion by the French judge

104. This hesitant application is illustrated by the small number of judgments using this notion. There are only a few judgments, none delivered by the Cour de Cassation... And even in those judgments, the criterion is rejected most of the time258.

Moreover, some French Court seems like the criterion of an independent distinctive role is summed up by the judgment MEDION.

<table>
<thead>
<tr>
<th>LOTUS</th>
<th>GRAIN DE LOTUS</th>
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</thead>
<tbody>
<tr>
<td>Earlier mark</td>
<td>Trade mark sought</td>
</tr>
</tbody>
</table>

Thus, la Cour d'appel de Colmar259 mentioned the judgment MEDION with all its aspects and considered that “GRAIN DE” - literally “grain of” - has no distinctive character contrary to THOMSON in the judgment MEDION260. In this case, the criterion was not necessary to conclude that there was a likelihood of confusion because “LOTUS” was found dominant, but this kind of application is not satisfying.

105. This lack of application of the criterion, poorly translated in French by the words “position distinctive autonome” may be caused by the fact that the French judge still applies its own notion : l'adjonction inopérante (or inoperative adding). But it is not happening, this notion barely disappeared from the case-law as well.

This may in fact be explained by the rejection, by the judgment ARTHUR ET FELICIE261 which led the judge to abandon the synthetic assessment of the similarity between the signs. In this case, the method developed before may insist on the fact that the criterion of an independent distinctive role is firmly attached to the global assessment of the similarity.

258 See Case 05/24805 ABSOLUE, delivered by la Cour d'appel de Paris (FRANCE) on 11 May 2007 and a example where the application of the criterion is admitted Case 06/13426 UNOFI-CONFIANCE, delivered by la Cour d'appel de Paris (FRANCE) on 26th January 2007
259 Case 08/01233, LOTUS, delivered by la Cour d'appel de Colmar (FRANCE) on 11 September 2008
260 See LOTUS, previously cited (Note 259), in the end of the decision
261 Previously cited (Note 59)
c) The necessity for some judges to control the application of the criterion to contain its application

106. A sole example is enough to show the potential extension this criterion may permit in the national case-law without the control of the judge.

In the judgment NOVARTIS\textsuperscript{262}, the English judge had to react. The signs in question were the followings:

<table>
<thead>
<tr>
<th>Earlier mark</th>
<th>Trade mark sought</th>
</tr>
</thead>
<tbody>
<tr>
<td>ERIC CANTONA CANTO</td>
<td>CANTO</td>
</tr>
</tbody>
</table>

The goods in question were flowers and horticultural products.

107. An early admission of the application of the criterion where the earlier trade mark is not completely reproduced. This case-law permitted the first admission that the criterion could be applied in a case where the earlier trade mark is not totally reproduced in the latter trade mark, which was admitted later by the judgment OFFSHORE LEGENDS\textsuperscript{263}, but the registrar went so far.

He used the young judgment MEDION to wake an old case-law up by considering that the earlier trade mark was in fact composed by two elements “ERIC CANTONA” and “CANTO” which are both distinctive enough to be an independent trade mark\textsuperscript{264}! He considered that “CANTO” would be perceived by the consumer as a nickname of Eric Cantona, the legendary player of the football team Manchester United, even if the goods in question were flowers. Even if the famous football player may still obsess some English football fans, it is quite sure that the consumer of horticultural products would not think of the player by seeing the trade mark CANTO.

107-1. Consequently, the English judge annulled the decision of the registrar by considering that the sole element “CANTO” was not likely to lead the consumer to remember the earlier trade mark. He added that he did not think that the unaccompanied

\textsuperscript{262} Case O-021-06, NOVARTIS, Lord Chancellor's Appointed Person (UNITED KINGDOM), 16 January 2006
\textsuperscript{263} Previously cited (Note 117)
\textsuperscript{264} NOVARTIS, previously cited (Note 262), paragraph 5, citing the decision of the registrar
word CANTO as being the first five letters of the surname CANTONA presented in the idiom of a nickname. This consideration may be interpreted as meaning that on a more appropriated market especially linked to football - “CANTO” be perceived by the consumer as referring to Eric Cantona as a nickname and would sum up the earlier trade mark in the consumer mind, leading him to confuse the two trade marks. This judgment then implicitly admitted that the reproduction of the whole earlier trade mark is not a condition to apply the criterion of an independent distinctive role.

108. This judgment and the German one about “das Malteserkreuz” shows that the national judges, because they may be exposed to new difficulties in the application of the criterion of an independent distinctive role, can also specify the way this criterion should be applied.

2) The possibility for the national judges to specify the case-law

109. The analysis of some case-law shows the difficulty the national judges may meet in order to apply the criterion of an independent distinctive role. For example, the enlargement brought by the judgment OFFSHORE LEGENDS, i.e. the admission that the reproduction of the all earlier sign is not necessary, needs many decisions to understand the limits of this admission and specify the case where an element of a sign may sum a all sign up. The condition, in the framework of the application of the global assessment and the method developed earlier, implies to analyse the common element in the earlier sign during the decomposition of the signs.

110. In some cases, especially where earlier sign is a semi-figurative trademark with a very simple figurative part, it is easy to consider that the word part can be the imperfect image the consumer would keep in mind.

265 NOVARTIS, previously cited (Note 262), paragraph 11
266 Previously cited (Note 117)
110-1. A good example is the judgment KINDERZEIT\textsuperscript{267}. The reproduction of the word element – “KINDER” – is obviously enough to apply the criterion of an independent distinctive role, because the word part is the dominant element.

110-2. In another cases, it is as obvious because the element reproduced has barely the same meaning that the earlier trade mark and has then the same conceptual content. In the judgment FEELING\textsuperscript{268}, it is obvious that the reproduction of “FEEL” is potentially sufficient to lead the consumer remembering the earlier trade mark if the composite trade mark is not different enough, which was the case because the latter trade mark was the sole element “FEEL”.

111. In contrary, in some other judgment, it is obvious that the element reproduced is not sufficient, the previous example of NOVARTIS\textsuperscript{269} with the reproduction of the sole element CANTO, brings no difficulties because the dominant element was Eric Cantona.

112. But in other cases, it is a little more delicate. In the judgment CITROSCOPIE\textsuperscript{270}, the reproduced component was CITRO which may look as the dominant element. The French judge considered that it was not enough because CITROPOLIS had more significations (idea of a place, a city). In this case, it should be noted that the judge considered in a parallel consideration, that the element CITRO lost its individuality in the composite sign – CITROSCOPIE – because also has more meaning (idea of a deep analysis).

\textsuperscript{267} Case I ZB 94/04 KINDERZEIT, delivered by the Bundesgerichtshof (GERMANY) on 20\textsuperscript{th} September 2007
\textsuperscript{268} Case 17 Ob 1/08h FEELING, delivered by the Oberster Gerichtshof (AUSTRIA) on 8 April 2008
\textsuperscript{269} Previously cited (Note 262)
\textsuperscript{270} Case 06/03056 , CITROSCOPIE, delivered by la Cour d'appel de Versailles (FRANCE) on 10 May 2007
In another French case²⁷¹, the judge rapidly gave the solution by considering that the signs were not similar enough to admit that the common component has an independent distinctive role. But in this case, the judge should have bring more precisions, in order to respect a good method.

The reproduced element was ADVANTAGE. The services registered were hotel services. The owner of the earlier trade mark is American Airlines. In this case, it is clear that consumer, by seeing the earlier trade mark, would think to the flight company American Airlines., because the consumer taken in account is supposed to know the trade marks²⁷². Then, the letters “AA”, in this particular representation, has a distinctiveness which make them the dominant element of the earlier sign. Then, the reproduction of the word “ADVANTAGE”, even if it is a large part of the earlier sign, was not sufficient.

²⁷¹ Case 09/07709 , AADVANTAGE, delivered by la Cour d'appel de Paris (FRANCE) on 16 October 2009
²⁷² See developments No 81-1
Conclusion

The criterion of an independent distinctive role is a young criterion, only used since three years in an effective way by the European judges. Consequently, it has to and will evolve. It will maybe know a new extension of its domain by taking the place of the criterion of the dominance in the comparison of the signs composed by a common component. Such an evolution would attack a little more the unity of the global assessment of the similarity of the signs but may be seen as a logical evolution.

Anyway, even if, hopefully, such an extent would not appear, several questions are still asked and some difficulties have to be solved.

The Courts of the European Union and the OHIM have, by their decisions, to help the judge and the registrars of every country to adapt their case-law to the evolutions of the European legislation. They especially have to be very rigorous in order to incite to make better and more justified decisions and also to prevent from a landslide to the analytic assessment, even if the analysis of the national case-laws shows no reason to fear such modification.

But they can not do everything and some difficulties, inherent to any evolution of a case-law need time and occasions will be solved by the national judges.

Thus, the relation of the criterion of an independent distinctive role on the one side, and the criterion of dominance on the other side, even though the first citing stop growing, will be very important. It will show if the criterion of an independent distinctive role is still used as a rescuers while it is hard to justify the dominance of an element in comparison of the other component of a complex sign. Maybe the example of the judgment BECKER\textsuperscript{273} will be followed and will keep helping the judge avoiding the creation of mini-rules which could be automatically applied in some circumstances.

\textsuperscript{273} Previously cited (Note 20) which used the criterion of an independent distinctive role to avoid saying that the name or the forename of someone is dominant
The future case law will also show the evolution of the criterion related to the figurative trade marks, especially by specifying the conditions of its application.

Finally, the future case-law will reveal the potential impacts of the new functions of the trade marks revealed by the judgment L'OREAL/BELLURE\textsuperscript{274}, even though the well-known trade marks have not a particular impact on the application of the criterion of an independent distinctive role.

\footnote{\textsuperscript{274} Case C-487/07, L'OREAL v OHIM - BELLURE (L'OREAL/BELLURE), 18 juin 2009}
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6. POLO SANTA MARIA : 18 May |
| 2011 | 6 judgments |
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Case C-120/04

Medion AG

v

Thomson multimedia Sales Germany & Austria GmbH

(Reference for a preliminary ruling from the Oberlandesgericht Düsseldorf)

(Opinion of Advocate General Jacobs delivered on 9 June 2005)

Judgment of the Court (Second Chamber), 6 October 2005

Summary of the Judgment

Approximation of laws — Trade marks — Directive 89/104 — Right of the proprietor of a registered trade mark to contest its unlawful use — Sign used for identical or similar goods — Likelihood of confusion — Criteria for assessment — Juxtaposing the company name of another party and a registered mark

(Article 5(1)(b) of First Directive 89/104)

Article 5(1)(b) of First Directive 89/104 relating to trade marks is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.

(see para. 37, operative part)

JUDGMENT OF THE COURT (Second Chamber)

6 October 2005 (*)

In Case C-120/04,

REFERENCE for a preliminary ruling under Article 234 EC from the Oberlandesgericht
Düsseldorf (Germany), made by decision of 17 February 2004, received at the Court on 5 March 2004, in the proceedings

**Medion AG**

v

**Thomson multimedia Sales Germany & Austria GmbH,**

THE COURT (Second Chamber),

composed of C.W.A. Timmermans, President of the Chamber, C. Gulmann (Rapporteur), R. Schintgen, G. Arestis and J. Klučka, Judges,

Advocate General: F.G. Jacobs,

Registrar: K. Sztranc, Administrator,

having regard to the written procedure and further to the hearing on 14 April 2005,

after considering the observations submitted on behalf of:

– Medion AG, by P.-M. Weisse, Rechtsanwalt, and T. Becker, Patentanwalt,

– Thomson multimedia Sales Germany & Austria GmbH, by W. Kellenter, Rechtsanwalt,

– the Commission of the European Communities, by T. Jürgensen and N.B. Rasmussen, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 9 June 2005,

gives the following

**Judgment**


2 This reference has been made in the course of proceedings between Medion AG (‘Medion’) and Thomson multimedia Sales Germany & Austria GmbH (‘Thomson’) regarding the use by Thomson in the composite sign ‘THOMSON LIFE’ of the registered trade mark LIFE, which belongs to Medion.

**Law**

3 In relation to the protection afforded by the trade mark, the 10th recital in the preamble to the directive states:
'... 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; ... the protection applies also in case of similarity between the mark and the sign and the goods or services; ... it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion; ... 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 ...

4 Article 5(1)(b) of the directive provides as follows:

'The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

...(b) 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, which includes the likelihood of association between the sign and the trade mark.'

5 This provision was transposed into German law by Paragraph 14(2)(2) of the Trade Mark Law (Markengesetz) of 25 October 1994 (BGBl. 1994 I, p. 3082).

The main proceedings and the question referred for a preliminary ruling

6 Medion is the owner in Germany of the trade mark LIFE, registered on 29 August 1998, for leisure electronic devices. It has a multimillion euro turnover per annum in the manufacture and marketing of these products.

7 Thomson belongs to one of the world’s leading companies in the leisure electronic devices sector. It markets some of its products under the name ‘THOMSON LIFE’.

8 In July 2002, Medion brought an action before the Landgericht (Regional Court) Düsseldorf for trade mark infringement. It requested that Thomson be prevented from using the sign ‘THOMSON LIFE’ to designate certain leisure electronic devices.

9 The Landgericht Düsseldorf rejected the application on the ground that there was no likelihood of confusion with the mark LIFE.

10 Medion appealed to the Oberlandesgericht (Higher Regional Court) Düsseldorf, seeking to have Thomson prevented from using the sign ‘THOMSON LIFE’ for television sets, cassette players, CD players and hi-fi systems.

11 That court, the referring court, states that the outcome of the litigation depends on whether there is a likelihood of confusion, within the meaning of Article 5(1)(b) of the directive, between the trade mark LIFE and the composite sign ‘THOMSON LIFE’.
It maintains that, according to the current case-law of the Bundesgerichtshof (Federal Court of Justice), which is based on the theory known as the ‘Prägetheorie’ (theory of the impression conveyed), in order to appreciate the similarity of the sign at issue, it is necessary to consider the overall impression conveyed by each of the two signs and to ascertain whether the common component characterises the composite mark to the extent that the other components are largely secondary to the overall impression. There will be no likelihood of confusion if the common component merely contributes to the overall impression of the sign. It will not matter whether the trade mark incorporated still has an independent distinctive role (‘kennzeichnende Stellung’) in the composite sign.

According to the Oberlandesgericht, in the sector of the goods at issue in the proceedings before it prominence is generally given to the name of the manufacturer. More specifically, in the main proceedings the name of the manufacturer ‘THOMSON’ contributes in an essential manner to the overall impression conveyed by the sign ‘THOMSON LIFE’. The normal distinctive character attaching to the element ‘LIFE’ is not sufficient to prevent the name of the manufacturer ‘THOMSON’ from contributing to the overall impression conveyed by the sign.

The referring court states, however, that the current case-law of the Bundesgerichtshof is not beyond debate. A different approach is favoured by some writers. It is in fact in line with the previous case-law of the Bundesgerichtshof itself, according to which likelihood of confusion must be found where the identical part has an independent distinctive role in the contested sign, is not absorbed by it, and is not relegated to the point of ceasing to call to mind the registered mark.

The Oberlandesgericht claims that if this theory is to be applied to the main proceedings it must be found that there is a likelihood of confusion as the mark LIFE still has an independent distinctive role in the mark ‘THOMSON LIFE’.

Finally, it is in doubt as to how, when applying the criterion of the overall impression conveyed by the signs, it is possible to prevent a third party from appropriating a registered mark by adding his company name.

In that context the Oberlandesgericht Düsseldorf decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

‘Is Article 5(1)(b) of [the directive] to be interpreted as meaning that where the goods or services covered by competing signs are identical there is also a likelihood of confusion on the part of the public where an earlier word mark with normal distinctiveness is reproduced in a later composite word sign belonging to a third party, or in a word sign or figurative sign belonging to a third party that is characterised by word elements, in such a way that the third party’s company name is placed before the earlier mark and the latter, though not alone determining the overall impression conveyed by the composite sign, has an independent distinctive role within the composite sign?’

The question referred for a preliminary ruling

The referring court asks essentially whether Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another and a registered mark which has normal distinctiveness and which,
although it does not determine by itself the overall impression conveyed by the composite sign, has an independent distinctive role therein.

Observations submitted to the Court

19 Medion and the Commission of the European Communities propose that the answer to the question posed should be in the affirmative.

20 Medion challenges the ‘Prägetheorie’, maintaining that it enables a registered mark to be usurped by simply adjoining to it the name of a manufacturer. Such usage of a mark defeats its purpose, which is to serve as an indication of the origin of goods.

21 The Commission argues that in circumstances such as those in the main proceedings the two terms used in the composite sign are equivalent. The term ‘LIFE’ does not have a wholly subordinate role. As the overall impression is thus not determined solely by the name ‘THOMSON’, the composite sign and the registered mark are similar for the purposes of Article 5(1)(b) of the directive. Likelihood of confusion is therefore possible, especially as the two companies sell identical products.

22 Thomson proposes that the answer to the question should be in the negative. It supports an interpretation of the directive in conformity with the ‘Prägetheorie’. The sign contested in the main proceedings cannot be confused with Medion’s mark as it includes the element ‘THOMSON’, the name of the manufacturer, which has the same prominence as the other element present. The term ‘LIFE’ serves only to designate certain goods of a marketed range. In any event, the element ‘LIFE’ cannot dominate the overall impression conveyed by the name ‘THOMSON LIFE’.

Reply of the Court

23 The essential function of the trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or service from others which have another origin (see, in particular, Case C-39/97 Canon [1998] ECR I-5507, paragraph 28, and Case C-371/02 Björnekulla Fruktindustrier [2004] ECR I-5791, paragraph 20).

24 The 10th recital in the preamble to the directive emphasises that the protection afforded by the registered trade mark has the aim of guaranteeing the trade mark as an indication of origin and that in the case of similarity between the mark and between the sign and goods or services, the likelihood of confusion constitutes the specific condition for protection.

25 Article 5(1)(b) of the directive is thus designed to apply only if, by reason of the identity or similarity both of the marks and of the goods or services which they designate, there exists a likelihood of confusion on the part of the public.

26 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 within the meaning of this provision (see, in particular, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 17).

27 The existence of a likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case (see Case C-251/95

28 The global appreciation of the likelihood of confusion, in relation to 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 perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, in particular, SABEL, paragraph 23, Lloyd Schuhfabrik Meyer, paragraph 25, and Matratzen Concord, paragraph 29).

29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see Matratzen Concord, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not
be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.

37 Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.

Costs

38 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Second Chamber) hereby rules:

Article 5(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.

[Signatures]