

Questions

I) Current law and practice

- 1) What is the current rule/principle in your jurisdiction when assessing similarity between marks when one or both marks are composite trade marks? Please pick one of the following choices and provide your comments if any:
 - a) The “Anti-Dissection Rule” is the only rule/principle to adopt.
 - b) The “Rule of Dominant Feature” is the only rule/principle to adopt.
 - c) The “Anti-Dissection Rule” is the main rule/principle and the comparison is conducted mainly between the overall impressions of the conflicting trade marks when judging similarity.
 - d) The “Rule of Dominant Feature” is the main rule/principle and it is more important to compare the conflicting trade marks in respect of their dominant parts.

Danish Trade Mark Law is heavily influenced by the EU. Therefore, it is relevant to look to jurisprudence from the EU as well as Danish, national case law. It is clear from both sources of legal authorities that it is the overall impression of the marks/signs that is important, and that the overall impression is primarily formed by the dominant features and/or the distinctive features of the marks/signs¹.

Thus, when a figurative mark contains words it is important to ascertain whether the word(s) are dominant and distinctive in themselves. If the word(s) are not distinct/dominant, one must primarily focus on the figurative elements of the mark/sign. Importantly, the registration of a figurative mark (primarily) consisting of word(s) will not per se extend to give exclusive right to the word(s) as though it was a word mark. Thus, to infringe upon a figurative mark consisting of words with a word mark/sign, the way the words are written/presented must look like the figurative part of the figurative mark. To some extent, one discounts/dissects the words per se.

If the word(s) on the other hand are distinct and/or dominant, one uses the same principles as when comparing two word-marks. As an example, one can reference the Supreme Court judgement in U.2005.1704H regarding the figurative trademark shown

¹ C-251/95 (Sabel/Puma) paragraph 23, and C-342/97 (Lloyd Schuhfabrik), paragraph 25.

below on the left, which was not found to be infringed by word mark on the left as »tele« and »data« are both usual and descriptive phrases in the telecommunications sector:



These principles were also expressed in a decision from the Western High Court of 26 September 2022 in the case BS-21488/2022-VLR. In this case both marks contained similar terms, »Nordic Greens« and »Nothern Greens« respectively. The Court found these to not be distinctive as they were to some extent descriptive of the location and products sold – Danish (»northern«/»Nordic«) vegetables (»greens«). The marks also contained figurative elements that were more distinct. The court did, however, not discount the phrases used. These were compared as part of the overall impression, but due to the differences in figurative elements as well the placement of the text on the marks, the Court concluded that the marks were not similar.

- e) The “Anti-Dissection Rule” and “Rule of Dominant Feature” are equally important rules/principles.
 - f) Other, please clarify.
- 2) Is it the case that the non-distinctive element of trade marks is disregarded completely when assessing similarity between the marks in your jurisdiction? Please pick one of the following choices and provide your comments if any:
- a) Yes, it is very much the case.
 - b) Yes, it is the case but there are exceptions.
 - c) No, it is not the case.
 - d) Other, please clarify.

As stated above, Danish trade mark law is heavily influenced by the EU. There are, however, certain differences.

Under both regimes, one must take account of alle relevant factors of the given case, and the assessment must be made based upon the overall impression of the marks/signs, and it is indeed the case that dominant and distinct components of a mark/sign will certainly have the biggest influence on the overall impression of the mark/sign.

In the EU, the General Court has in some cases let a descriptive (and thus clearly non-distinct) element be part of its evaluation of the similarity of two marks/signs. In the case T-149/12 (MICRO) the General Court found that the word 'MICRO' in the two marks/signs shown below were the dominant parts though the court recognised that they are not distinctive.



Similarly in the case T-361/08. Here, the phrase »Thai silk« was seen as being the distinctive part of the mark applied for when compared to the previous mark which did not have a word element:

58. In that regard, as the Board of Appeal rightly noted in paragraph 23 of the contested decision, the signs at issue are also different. The mark applied for is composed of the word element 'Thai Silk', which does not appear in the earlier trade mark. Since the relevant public will use that word element to refer to the mark applied for, there is no aural similarity that could possibly ensue from the relevant public identifying the same animal in the two signs. It cannot be envisaged that the relevant public will refer to the mark applied for using – rather than its word element – the German word corresponding to the animal represented in its figurative element, which is, incidentally, somewhat imprecise, since it cannot be excluded that the relevant public will not directly recognise a peacock in that figurative element.

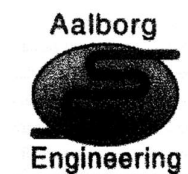


It thus seems clear that non-distinct elements can to some extent play a role in the assessment.

In other decisions, the General Court has, however, largely discounted descriptive/non-distinct elements. In T-129/01 the Court even stated that »generally« descriptive elements will not be dominant or distinctive:

53. Accordingly, the suffix MEN in the mark claimed is likely to carry a suggestive or even descriptive connotation for the relevant public that the clothing, footwear and headwear covered by that mark are intended for male customers. *The Court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark.* [My emphasis].

In Danish practice, it does, however, seem quite clear that descriptive elements will not be considered dominant or distinctive, and they thus cannot lead to two marks/signs being seen as similar. This follows from particularly two judgments from the Danish Supreme Court: U.2007.2393H and U.2005.1704H (see above, under question 1). These cases both concerned descriptive elements that were not deemed distinctive and were thus not given any weight in the assessment of similarity. U.2007.2396H concerned inter alia the similarity of the two marks shown below:



Both companies sold and serviced the same products in the energy sector. The Supreme Court found that the mark applied for on the right was not similar to the registered mark on the left on the basis that »Aalborg« is a town in Denmark, where the companies were based, and the »industries« and »engineering« were found to be adequately different. The mark applied for in the middle did, however, despite consisting of simple, basic shapes, infringe upon the mark on the left.

In conclusion, it is theoretically possible for non-distinct elements to be distinct (and even dominant, see question 3 below). As this is established in the EU, it must necessarily also be the case under Danish Law, but Danish practice has up until this point been reluctant to recognise this. The jurisprudence has primarily concerned

descriptive elements, but the principles concerned in the jurisprudence ought to apply to all cases of non-distinct elements. It is however important to have in mind that the assessment is always dependent on the concrete circumstances of a given case and must concern the overall impression of the mark.

3) Is it possible for a non-distinctive element of a trade mark to be viewed as the dominant feature of the mark in your jurisdiction? Please pick one of the following choices and provide your comments if any:

a) Yes, it is possible but rarely happens.

Yes. It is rare, but the General Court of the EU has recognised this in at least one case, and though we are unaware of any Danish cases that recognise the principle, it should thus be theoretically possible under Danish law as well.

In the case T-149/12 (MICRO) the General Court found that the word 'MICRO' in the two marks/signs were the dominant parts though the court recognised that they are not distinctive.

52. In the present case, as was stated in paragraph 48 immediately above, the mark applied for consists of a black rectangle on which are represented, in white, a non-figurative design and the word element 'micro'. That design covers a quarter of the surface, while the other three quarters are occupied by the word element. In that specific context, the public eye is necessarily attracted, not by the colours used or the design, *but by the word element*, the position of which is predominant. *It can therefore only be considered as dominant, even assuming that it is descriptive, as the Board of Appeal found. [My emphasis].*

b) Yes, it is possible and occurs frequently.

c) No, it is excluded by law.

d) Other, please clarify.

4) Does the nature of the non-distinctive element affect its influence on similarity of two trade marks containing the non-distinctive element, in your jurisdiction? For instance, a non-distinctive element which is the generic name of the goods/services may be less relevant in similarity judgment than a non-distinctive element being descriptive of the characteristic of

the goods/services in some jurisdictions. Please pick one of the following choices and provide your comments if any:

- a) Yes, the nature of non-distinctive elements makes a difference.

Comments: Although wholly descriptive elements as a clear main rule are not considered to be dominant and cannot in themselves lead to two marks being considered confusingly similar, the nature of the descriptive element is given importance for the overall impression. Inter alia, if the non-distinctive element common to two trade marks constitutes a description of the of the relevant goods it would in most cases be considered less relevant to the evaluation of similarity than a non-distinctive element that is able to designate the geographical origin.

- b) No, the nature of non-distinctive elements does not make a difference.
c) Depends on the circumstances – please explain what those circumstances include.
d) Other, please clarify.

- 5) In terms of factors to consider in a trade mark registrability context as opposed to a trade mark infringement context, are there the same or different factors to consider in your jurisdiction, when assessing trade mark similarity involving non-distinctive elements, in the two contexts? Please pick one of the following choices and provide your comments if any:

- a) There are different factors to consider.
b) The same factors are considered.
c) Depends on the circumstances – please explain what those circumstances include.

As a main rule the same factors are to be considered regardless of whether the assessment is carried out in a registrability context or an infringement context. However, Danish court practice clearly illustrates that often more factors are included in infringement procedures, and that the courts tend to put more weight on whether there is an actual risk of confusion in practice rather than a mere theoretical risk as well as subjective factors like bad faith, knowledge etc.

- d) Other, please clarify.

- 6) What factors are considered when judging whether trade marks including non-distinctive elements are considered confusingly similar or otherwise conflicting, in the registrability assessment of the later trade mark, in your jurisdiction? Please pick one or more choices from the following list and provide your comments if any:

- a) The nature of the non-distinctive elements.

- b) The structure of the marks, for instance how severable the distinctive and the non-distinctive parts are and the proportion in size between the distinctive part and the non-distinctive part.
 - e) The industry field of the concerned marks
 - f) The sophistication of the relevant public.
 - k) The other marks of the earlier mark holder.
 - m) The perception of the consumer (as to the non-distinctive element).
- 7) What factors are considered when judging whether trade marks including non-distinctive elements are considered confusingly similar or otherwise conflicting in trade mark infringement assessment, in your jurisdiction? Please pick one or more choices from the following list and provide your comments if any:
- a) The nature of the non-distinctive elements.
 - b) The structure of the marks, for instance how severable the distinctive and the non-distinctive parts are and the proportion in size between the distinctive part and the non-distinctive part .
 - c) The history and use status of the registered/common law mark.
 - d) The history and use status of the suspected infringing mark.
 - e) The industry field of the concerned marks.
 - f) The sophistication of the relevant public.
 - g) The practices and conventions as to the use of the trade mark in the market for the relevant goods or services.
 - h) The relationship between the holders of the two marks.
 - i) The background and history of the holder of the registered/common law mark.
 - j) The background and history of the alleged infringer.
 - k) The other marks of the holder of the registered/common law mark.
 - l) The other marks of the suspected infringer.
 - m) The perception of the consumer (as to the non-distinctive element).
 - n) Others, please clarify.

In their assessment the courts put more emphasis on the possible subjective knowledge of the alleged infringer (e.g. if the trademark has been composed in bad faith to imitate the earlier trademark, etc.)

- o) Is it likely that the trade mark (A) in the following scenarios would be viewed as sufficiently dissimilar from the trade mark (B), in your jurisdiction?

Scenario 1: A trade mark (A) is a combination of an entire earlier mark (B) or a mark similar to an earlier mark (B) and some non-distinctive element(s) when assessing whether the later mark can be registered. Please pick one of the following choices and provide your comments if any:

- a) No, it is definitely not a straightforward registration.
It is unlikely that trade mark (B) in this scenario would be considered as sufficiently dissimilar to trade mark (A), as the only differing element(s) are non-distinctive and therefore will play a significantly smaller role in the assessment.
- b) Yes, it is very straightforward.
- c) It depends on the non-distinctive element.
- d) Other, please clarify.

Scenario 2: A trade mark (A) consists of the distinctive elements of an earlier mark (B) which also includes some non-distinctive element(s) when assessing whether the later mark can be registered. Please pick one of the following choices and provide your comments if any:

- a) No, it is definitely not a straightforward registration.
In Denmark, the assessment of likelihood of confusion is based primarily on the distinctive element(s) of the marks, which will almost always be determined to be the dominant element(s). Any non-distinctive element(s) will according to Danish practice up until now be disregarded and set aside in the assessment (this is not necessarily the case in EU law), and therefore the inclusion of non-distinctive element(s) in trade mark (A) likely does not make it sufficiently dissimilar from trade mark (B) to allow registration.
- b) Yes, it is very straightforward.
- c) It depends on the non-distinctive element.
- d) Other, please clarify.

Scenario 3: In a trade mark infringement action, a trade mark (A) used by another party is a combination of a protected earlier mark (B) or a mark similar to a protected earlier mark (B) and some non-distinctive element(s). Please pick one of the following choices and provide your comments if any:

- a) No, it is definitely not a straightforward infringement case.
- b) Yes, it is very straightforward.

In general, the assessment in an infringement case is very similar to the assessment of registrability for a trade mark application. This scenario therefore closely resembles scenario 1 above. Assuming that the goods and services of the earlier protected mark and the alleged infringing mark are identical or highly similar, a finding of infringement is to be expected in this scenario. If the goods and services are only slightly similar other factors will also have to be considered more closely such as how dominant the distinctive elements are in the use of the alleged infringing mark and whether the new composite mark has taken on a new meaning. In most cases though, also in this situation a finding of infringement is to be expected.

- c) It depends on the nature of all marks/signs.
- d) Other, please clarify.

Scenario 4: In a trade mark infringement action, a trade mark (A) used by another party consists of the distinctive elements of a protected earlier mark (B) or a mark similar to a protected earlier mark (B) which also includes some non-distinctive element(s). Please pick one of the following choices and provide your comments if any:

- a) No, it is definitely not a straightforward infringement case.
- b) Yes, it is very straightforward.

In general, the assessment in an infringement case is very similar to the assessment of registrability for a trade mark application. This scenario therefore closely resembles scenario 2 above. A finding of infringement can be expected.

- c) It depends on the nature of all marks/signs.
- d) Other, please clarify.

- p) Is it likely that the trade marks in the following scenarios would be found to be similar marks, in your jurisdiction?

Scenario 1: two trade marks share the same or very similar non-distinctive element but with different distinctive elements when assessing whether the later mark can be registered.

Please pick one of the following choices and provide your comments if any:

- a) No, the case law does not support a finding that they are similar.

If the only similar element(s) between the trade marks is/are non-distinctive element(s), then Danish case law shows that the trade marks will be found to be dissimilar.

- b) Yes, the case law would support a finding of similarity.
- c) It depends on the nature of the marks.

d) Other, please clarify.

Scenario 2: In a trade mark infringement action, two trade marks share the same or very similar non-distinctive element but contain different distinctive elements. Please pick one of the following choices and provide your comments if any:

a) No, the case law does not support a finding that they are similar.

In general, the assessment in an infringement case is very similar to the assessment of registrability for a trade mark application. Danish case law shows that there is no difference(s) between the assessment performed by the Danish Patent and Trademark Office and infringement cases handled by the courts. The office and courts apply the same principles and legislation.

In an opposition case at the Danish Patent and Trademark Office for application VA 2021 00122 (FELLOW FUNDERS vs FELLOW PAY) particular emphasis was placed on the fact that "FELLOW" was the strong element of both marks, as "FUNDERS" respectively "PAY" were weak (non-distinctive) elements. Therefore, the marks were found to be similar.

Reversely, in case U 2000 506 H (MEGASOL vs PIKASOL) the Danish Supreme Court put particular emphasis on the fact that the ending "SOL" was a weak non-distinctive element in both marks, as it referred to the Danish word for "sun". Therefore, the marks were found to be dissimilar because of the difference between MEGA and PIKA.

b) Yes, the case law would support a finding of similarity.

c) It depends on the nature of the marks.

d) Other, please clarify

II) Policy considerations and proposals for improvements of your Group's current law

10) Do you consider your Group's current law or practice relating to conflicts between composite trade marks including non-distinctive elements adequate or do you consider that the law should be changed? Please answer YES or NO and explain.

The trade mark regime should be focused on how a sign/mark is perceived by the consumers of the product/service on which the sign/mark is used. This is the reason for having the trade mark system, as seen by the fact that anything (be that a word, a 2D image/figure, a 3D shape, or even a colour) can serve as a trade mark if it can/does serve to distinguish between the

services/products of one company from another in the mind of the consumer². Following this reasoning, it seems only logical that all assessments of the trade marks should be carried out based on the awareness of the average consumer who is reasonably well-informed, observant, and circumspect.

Thus, It seems to us that the approach of comparing the overall impression of two marks/signs is the best approach to pursue the objectives of the trade mark system, as this is how the marks are perceived by the consumers. Similarly, it seems logical and fit for purpose that when comparing the overall impression of two marks/signs one would primarily focus on the dominant and distinct features of the marks/signs. It seems correct to assume that this is also how consumers perceive marks especially when considering that consumers rarely conduct an actual side-by-side comparison/analysis of two marks/signs.

Though the system ought not offer the possibility of gaining exclusive rights to descriptive elements it does seem correct that even non-distinct elements can have a rather large impact on the overall impression of the mark/sign in the mind of the consumer, and thus discounting them in their entirety as a matter of principle does not seem in line with the object of marks being based on their perception in the mind of the consumer. This will of course, as it already has, lead to a certain degree of legal uncertainty as when and to what extent non-distinctive elements play a role in the assessment will always come down to the judgement of the administrative organs (and the courts if necessary). This legal uncertainty is increased further by the fact that basing the entire assessment system on the legal fiction that is the view of the average consumer also in the end simply comes down to the judgement of the administration.

This legal uncertainty does, however, seem to me to be a necessary evil if the trade mark regime is actually going to effectively protect that which is perceived as a distinguishing feature. Only a system based on the overall impression of the mark as perceived by the consumer offers the necessary flexibility to, when presented with marks/signs, make a decision based on all relevant facts of the case.

- 11) As a matter of policy, does your Group believe that it would be better to require each combination of distinctive and non-distinctive elements for which protection is sought to be

² There are also other positive requirements, but they primarily serve administrative purposes of ensuring that the mark can be meaningfully recreated and applied for.

registered, instead of permitting the “disassembly” of registered marks into elements and protection being given to at least the disassembled distinctive elements? Please explain why the policy is preferred.

No. As stated above, it should be possible to use any sign that in the mind of the consumer could, or actually does, serve to inform the consumer of the origin of the product. If one had to register every element of a composite mark this would run counter to that most central consideration behind the idea of trade mark protection. Therefore, we believe that permitting the “disassembly” of registered marks into elements and providing protection to at least the disassembled distinctive elements is preferable to requiring registration for each combination of distinctive and non-distinctive elements.

Secondly, it seems impossible in practice to implement this system as it would likely require too many uncertain guesses on the part of the trader wishing to register their mark (that would become multiple different marks all consisting of various combinations of the composite mark), and it would carry a heavy administrative burden on the traders as well as the relevant trade mark authority.

Thirdly, it would be a too strict system (this would however alleviate the legal uncertainty that would be a part of the approach described under question 10). Once again, it must be underlined that the point of trade marks is to protect that which the consumer actually perceives as a distinguishing sign³. This is context-sensitive, and the system must room for this if it is to actually be fit for purpose. For example, descriptive, non-distinct text may play a large (even dominant) part in the overall assessment of a mark in the mind of the consumer, either because of its typeface, colour, placement, or some other reason that may be described as non-distinctive. It would in such cases run counter to the purpose of the system to not protect the proprietor of the mark simply because they have not registered the correct combination of elements of the composite mark. As an example, one may compare the two marks/signs above containing a peacock. Though the text is descriptive, one could argue that its placement and shape do make up a large part (probably not a dominant part) of the overall impression of the mark. Even as it is shown above, where the text is hardly legible due to the poor quality of the picture.

³ Even if this is not a literal mark/sign.

It could, however, be advantageous – as is the case in some jurisdictions – to have a requirement to add disclaimers for any descriptive parts of the trade mark to allow registrability, as this would create more legal certainty in some situations.

12) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question? Please answer YES or NO and explain.

No.

III) Proposals for harmonisation

13) Do you believe that there should be harmonisation in relation to issues regarding conflicts between composite trade marks including non-distinctive elements? Please answer YES or NO. Yes. As with all areas of trade mark law harmonisation is desirable: An international market necessitates international solutions.

14) What should be the rule/principle when assessing similarity between composite trade marks? Please pick one of the following choices and provide your comments if any:

d) The “Rule of Dominant Feature” should be the main rule/principle.

We understand this option choice to mean that it is the »main« but not only principle.

15) Should the non-distinctive element of trade marks be disregarded completely when assessing similarity between the marks? Please pick one of the following choices and provide your comments if any:

c) No.

16) Should it be possible for a non-distinctive element of a trade mark to be viewed as the dominant feature of the mark? Please pick one of the following choices and provide your comments if any:

a) Yes. but it should only be possible in exceptional cases – if so, please explain what can be such exceptional cases.

17) Should the nature of the non-distinctive elements affect its influence on the similarity judgement of the conflicting trade marks which contain the said non-distinctive elements? Please pick one of the following choices and provide your comments if any:

The answer is likely yes, as we, generally, believe that as many circumstances as possible should be allowed to play a role in the assessment.

18) In terms of factors to consider in a trade mark registrability context as opposed to a trade mark infringement context, should there [be] the same or different factors to consider, when assessing trade mark similarity involving non-distinctive elements in the two contexts? Please pick one of the following choices and provide your comments if any:

c) Depends on the circumstances – please explain what those circumstances include.

Generally, it will likely be the same factors (as we generally believe that everything plays a role), but the weighing of the relevant factors may be generally different, as the situation of registration generally is different than that of assessing infringement.

19) In the assessment of registrability of a later trade mark, what factors should be considered when judging whether trade marks including non-distinctive elements are considered confusingly similar or otherwise conflicting? Please pick one or more choices from the following list and provide your comments if any:

As we generally believe that all factors could play a role in how the average consumer perceives a mark/sign, and we believe that this should be the point of departure for all assessments of trade marks, all the listed factors could conceivably be relevant if the concrete circumstances of a case were such that the given factor played a role in the mind of the consumer. Granted, some of the factors should likely be weighed more heavily and applied in more cases than others, but none can by definition be discounted.

a) The nature of the non-distinctive elements.

This will likely be quite impactful in the cases where it does play a role, but it may not play a role in very many cases.

b) The structure of the marks, for instance how severable the distinctive and the non-distinctive parts are and the proportion in size between the distinctive part and the non-distinctive part.
Will likely often be relevant. This seems to

c) The history and use status of the earlier mark.

Will likely often be relevant.

d) The history and use status of the later mark.

Will likely often be relevant. Whether the mark, for example, has gained a reputation is hugely important.

- e) The industry field of the concerned marks.

Will likely often be relevant. This is connected with f) and g) below. Defining the relevant average consumer naturally plays a large role in determining what in a given sector is actually perceived as a distinguishing feature. The average person does not know much about plumbing, but if the 'average consumer' of a given product is found to be a plumber, what they perceive to be a distinguishing feature will likely include at least some different than rest of us.

- f) The sophistication of the relevant public.

Defining the relevant public is and should be a central part of defining the average consumer and their perception – the place from which all trade mark protection springs. An example could be the pharmaceutical industry. Here, the 'average consumer' is highly specialised and two marks can thus likely be more similar to each other without the average consumer confusing them.

- g) The practices and conventions as to the use of trade marks in the market for the relevant goods or services.

Will likely often be relevant. See e) and f) above.

- h) The relationship between the holders of the two marks.

Will rarely (if ever) be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.

- i) The background and history of the earlier mark holder.

Will rarely (if ever) be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.

- j) The background and history of the later mark holder.

Will rarely (if ever) be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.

- k) The other marks of the earlier mark holder.

Will rarely be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.

- l) The other marks of the later mark holder.

Will rarely be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.

- m) The perception of the consumer (as to the non-distinctive element).

This is central.

- n) Others, please clarify.

20) In the assessment of trademark infringement, what factors should be considered when judging whether trade marks including non-distinctive elements are considered confusingly similar or otherwise conflicting? Please pick one or more choices from the following list and provide your comments if any:

As we generally believe that all factors could play a role in how the average consumer perceives a mark/sign, and we believe that this should be the point of departure for all assessments of trade marks, all the listed factors could conceivably be relevant if the concrete circumstances of a case were such that the given factor played a role in the mind of the consumer. Granted, some of the factors should likely be weighed more heavily and applied in more cases than others, but none can by definition be discounted.

- a) The nature of the non-distinctive elements.

This will likely be quite impactful in the cases where it does play a role, but it may not play a role in very many cases.

- b) The structure of the marks, for instance how severable the distinctive and the non-distinctive parts are and the proportion in size between the distinctive part and the non-distinctive part.
Will likely often be relevant. This seems to

- c) The history and use status of the earlier mark.
Will likely often be relevant.

- d) The history and use status of the later mark.
Will likely often be relevant. Whether the mark, for example, has gained a reputation is hugely important.

- e) The industry field of the concerned marks.
Will likely often be relevant. This is connected with f) and g) below. Defining the relevant average consumer naturally plays a large role in determining what in a given sector is actually perceived as a distinguishing feature. The average person does not know much about plumbing, but if the 'average consumer' of a given product is found to be a plumber, what they perceive to be a distinguishing feature will likely include at least some different than rest of us.

- f) The sophistication of the relevant public.
Defining the relevant public is and should be a central part of defining the average consumer and their perception – the place from which all trade mark protection springs. An example could be the pharmaceutical industry. Here, the 'average consumer' is highly specialised and two marks can thus likely be more similar to each other without the average consumer confusing them.

- g) The practices and conventions as to the use of trade marks in the market for the relevant goods or services.
Will likely often be relevant. See e) and f) above.

- h) The relationship between the holders of the two marks.
Will rarely (if ever) be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.

- i) The background and history of the earlier mark holder.
Will rarely (if ever) be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.
- j) The background and history of the later mark holder.
Will rarely (if ever) be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.
- k) The other marks of the earlier mark holder.
Will rarely be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.
- l) The other marks of the later mark holder.
Will rarely be relevant, but should this in a given case actually have an influence on the perception of the mark/sign in the mind of the average consumer, it must be possible to include it in the assessment.
- m) The perception of the consumer (as to the non-distinctive element).
This is central.
- n) Others, please clarify.

21) Should trade mark (A) in the following scenarios be viewed as sufficiently dissimilar from the trade mark (B)?

Scenario 1: a trade mark (A) is a combination of an entire earlier mark (B) or a mark similar to an earlier mark (B) and some non-distinctive element(s) when assessing whether the later mark can be registered. Please pick one of the following choices and provide your comments if any:

- a) No, it should definitely not be registered.
- b) Yes, it should be, but only in exceptional cases.
If the overall impression is so different that it can be meaningfully distinguished from mark (B). This will likely only be the case in exceptionally rare instances.

- c) Yes, it should be but only in exceptional cases.
- d) Other, please clarify.

Scenario 2: a trade mark (A) consists of the distinctive elements of an earlier mark (B) which also includes some non-distinctive element(s) when assessing whether the later mark can be registered. Please pick one of the following choices and provide your comments if any:

- a) No, it should definitely not be registered.
- b) Yes, it should be but only in exceptional cases.

If the overall impression is so different that it can be meaningfully distinguished from mark (B). This could be the case if the non-distinctive elements are implemented in a manner that is so dominant that the overall impression of the two marks are different. This will likely only be the case in exceptionally rare instances.

- c) Yes, it should be but only in exceptional cases.
- d) Other, please clarify

Scenario 3: in a trade mark infringement action, a trade mark (A) used by another party is a combination of a protected earlier mark (B) or a mark similar to a protected earlier mark (B) and some non-distinctive element(s). Please pick one of the following choices and provide your comments if any:

- a) No, the unregistered mark should definitely not be determined to be dissimilar.
- b) Yes, the unregistered mark should be determined to be dissimilar only in exceptional cases.

How are the non-distinctive elements implemented? How large is their impact on the overall impression of mark (A)?

- c) Yes, the unregistered mark should be determined to be dissimilar only in exceptional cases.
- d) Other, please clarify.

Scenario 4: in a trade mark infringement action, a trade mark (A) used by another party consists of the distinctive elements of a protected earlier mark (B) which also includes some non-distinctive element(s). Please pick one of the following choices and provide your comments if any:

- a) No, the unregistered mark should definitely not be determined to be dissimilar.
- b) Yes, the unregistered trade mark should be determined to be dissimilar in all but exceptional cases.

How large is the impact on the overall impression of mark (B) of its non-distinctive elements?

- c) Yes, the unregistered mark should be determined to be dissimilar only in exceptional cases.
- d) Other, please clarify.

22) Should the trade marks in the following scenarios be found to be similar marks?

Scenario 1: two trade marks share the same or very similar non-distinctive element but with different distinctive elements when assessing whether the later mark can be registered. Please pick one of the following choices and provide your comments if any:

- a) No, they should definitely not be determined to be similar

If they only share non-distinct elements they should probably not be found to be similar.

(Difficult to assess in the abstract in our proposed regime, where practically everything can play a role in the assessment).

Scenario 2: In a trade mark infringement action, two trade marks share the same or very similar non-distinctive element but contain different distinctive elements. Please pick one of the following choices and provide your comments if any:

- a) No, they should definitely not be determined to be similar.

If they only share non-distinct elements they should probably not be found to be similar.

(Difficult to assess in the abstract in my proposed regime, where practically everything can play a role in the assessment).

23) Please comment on any additional issues concerning any aspect that you consider relevant to this Study Question.

24) Please indicate which industry sector views provided by in-house counsels are included in your Group's answers to Part III.