2024 AIPPI World Congress – Hangzhou
Adopted Resolution
22 October 2024

Resolution

2024 – Study Question – Trade Marks

Conflicts between composite trade marks including non-distinctive elements

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Background:

1) This Resolution concerns what factors should be considered by courts, tribunals or IP offices in assessing similarity and likelihood of confusion between trade marks when one or both are composite trade marks including non-distinctive elements, and what role should these non-distinctive elements play in the assessment.

2) The subject of non-distinctive elements as constituent parts of trade marks and their impact in assessing trade mark similarity and likelihood of confusion, or asserting exclusive rights over a trade mark, was partially addressed in previous AIPPI Resolutions, such as Q127 "Evaluation of Confusion in Trademark Law" (1995) and "Limitations of Trademark Rights" (2007). At the AIPPI World Congress in 2022, a panel session entitled "How different is different?" dealt with the issue of composite trade marks and evaluation of their similarity and risk of confusion.

3) Determining similarities and likelihood of confusion between allegedly conflicting trade marks is a key issue in trade mark prosecution and enforcement. Since assessment of similarity is more difficult when one or both of the marks in conflict are composite, and even more challenging if non-distinctive elements are involved, and insofar as the previous work of AIPPI has not

covered the principles, factors or circumstances which may be relevant to this issue, more extensive study and this Resolution are justified.

4) 41 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (which can be found at www.aippi.org).

5) At the AIPPI World Congress in Hangzhou in 2024, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

1) Assessment of similarity and likelihood of confusion between trade marks, when at least one of them is a composite trade mark that includes at least one non-distinctive element, should be made on a case by case basis.

2) In assessing similarity and likelihood of confusion between such trade marks, the overall impression of the composite trade mark (the "Anti-Dissection" Rule) should be considered taking into account the dominant element of either trade mark (the "Dominant Element" Rule), along with the distinctiveness of the element(s) and any other factors or circumstances relevant to the specific case.

3) A non-distinctive element of a composite trade mark should not, as a general rule, be disregarded completely when assessing similarity and likelihood of confusion, though said non-distinctive element would typically be given less weight in the assessment.

4) Those factors or circumstances referred to in paragraph 2) of this Resolution include, but are not limited to:
   a. the structure of the composite trade mark(s), in particular:
      i. whether the distinctive and the non-distinctive elements would be regarded by the relevant public as severable;
      ii. the relative comparative size of those elements;
      iii. the distance and/or ratio between them;
   b. the perception of the relevant public;
   c. the history and use status of the earlier trade mark;
   d. the degree of sophistication of the relevant public;
   e. the practices and conventions relating to the use of trade marks in the relevant field;
   f. the nature of the non-distinctive elements within the composite trade mark(s);
   g. the nature and characteristics of the relevant goods or services;
   h. the industry/field of the concerned trade marks.

5) The approach referred to in paragraphs 1) to 4) of this Resolution should apply to both trade mark registration and infringement procedures when assessing similarity and likelihood of confusion between the allegedly conflicting trade marks.