

How protected are words in a combination mark?

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ECTA



Composite marks in context

- Classic example of composite mark is word + device
- Can be two word elements,
 - e.g. BARBARA BECKER; BIMBO DOUGHNUTS
- Distinction between composite and ‘normal’ marks overrated?
 - In all cases, tribunals begin by identifying distinctive & dominant components

The problem...

- *Sabel v Puma*
 - Consumers view marks as a whole BUT
 - Consumers attention drawn to particular aspects of marks
- Can both be true?
- What if different elements are pointing in different directions?

Conceptual tools: identifying the dominant component

- Need to look at mark as a whole, BUT sometimes, the overall impression will be dominated by one component

- MATRATZEN V.



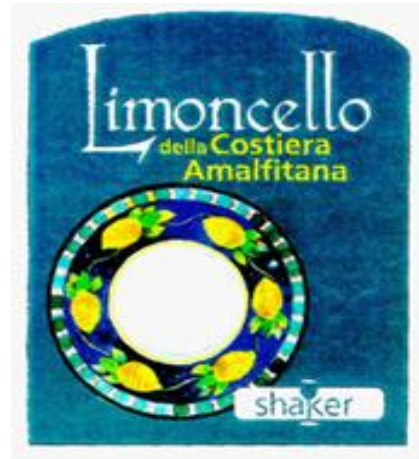
- Word element dominated, therefore similarity of marks

Conceptual tools: elements having an independent distinctive role

- Old German approach: confusion only present when shared element was the dominant element of the mark
- Medion: don't just compare dominant elements – also consider whether there are other elements with an **independent distinctive role**
- *THOMSON LIFE v LIFE*
 - German approach: Thomson = famous company, and so dominant. Thus, no similarity
- CJEU: can't discount LIFE because it has an independent distinctive role

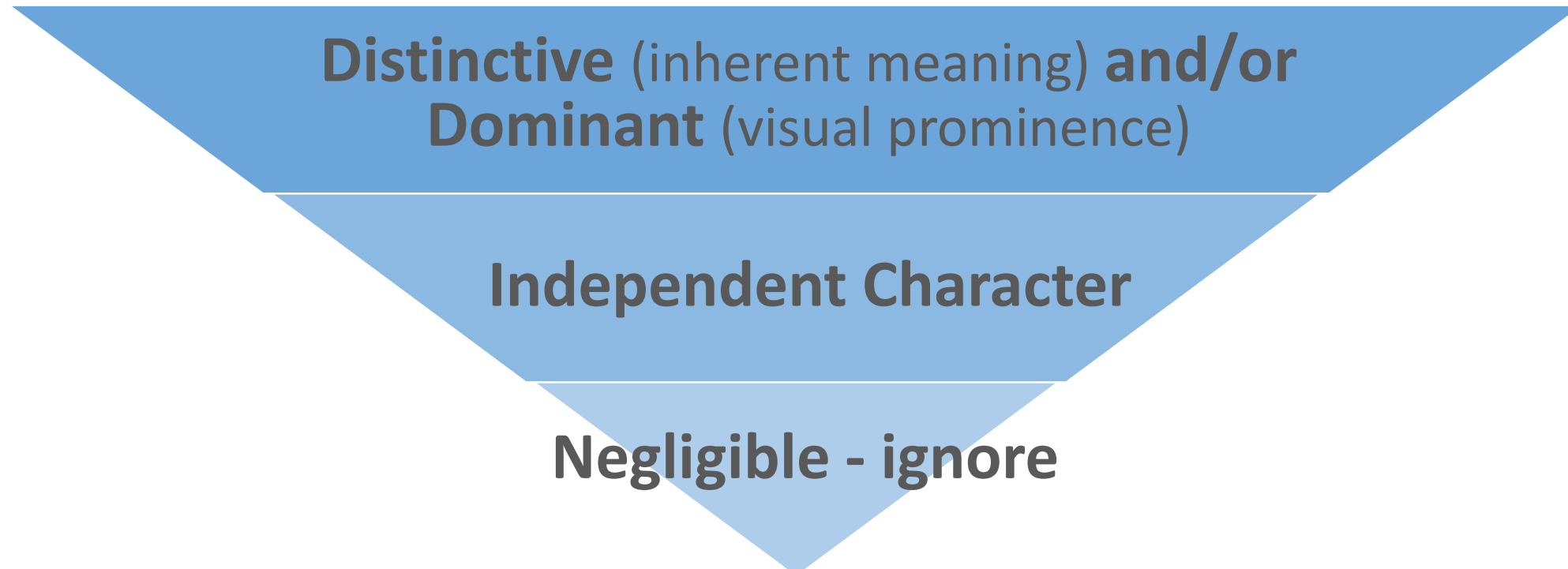
Conceptual tools: Discounting negligible elements

- Only ignore elements which are negligible
- LIMONCELLO v




- Couldn't ignore the plate device because it was not negligible

Hierarchy of elements



The difficult border between negligible/low independent distinctive

Negligible examples:

- Figurative element in 

- 'by missako' in



- Figurative element in 

- Apostrophe in



The difficult border between negligible/low independent distinctive

Examples with independent distinctive character

- Figurative elements in



- 'EVENT MANAGEMENT SYSTEMS' in



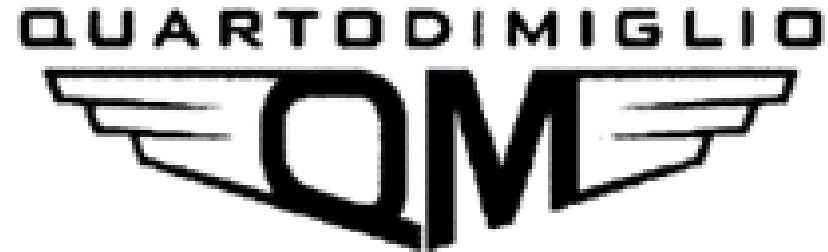
Partial identity

- Marks are presumptively similar where they are partially identity with regard to one or more aspects
 - For example, similarity between:
 - MOU and KIAP MOU
 - Various word and figurative marks containing the term DONUT and HOUSE OF DONUTS word and device mark
 - VOGUE and TEEN VOGUE

Principles in Practice

Word element usually dominates

- Average consumer will normally quote name of goods, rather than device
 - E.g.



Word element usually dominates

- Especially true when figurative elements are banal, e.g.



...but sometimes the device dominates

- Descriptive word element won't necessarily dominate, e.g.
CAR-FRESHNER ... and so similar to



...but sometimes the device dominates

- Particularly distinctive figurative element may dominate
- 'sense of order of modularity' except for out of alignment meant figurative element dominated



- ... and so not visually similar to



...but sometimes the device dominates

- Size also plays a role
 - Figurative element dominated



- ... and so no visually similarity to DUSCHO HARMONY

...and sometimes neither dominates

- Examples
 - both of same size/prominence
 - Where figurative and verbal elements express the same idea
 - E.g. HORSE and a picture of a horse

Comparing words and devices

- Words can be similar to devices, especially where the device is negligible, e.g. typeface or flourish

COMIT

The logo for 'Comet', featuring the word 'Comet' in a bold, red, italicized sans-serif font with a thin green underline.

- Even non-negligible figurative elements don't always stop marks being similar

STAR TV



- Note impact of word element in the aural comparison

Descriptive elements

- Descriptive elements will not generally dominate unless by virtue of size/position. E.g. CARBON CAPITAL MARKETS did not dominate



- ...but that doesn't mean that they are negligible (and so can be ignored)
- Descriptiveness depends upon language quirks of consumers
 - E.g. in BIMBO DOUGHNUT, 'doughnut' is not descriptive to the average Spanish consumer

Particularly distinctive elements

- Very likely dominate
 - E.g. KRAFFT dominates



Impact of size/colour/font

- Size/colour/font can overcome descriptiveness of element
 - E.g. TACK dominated



Impact of positioning

- Positioning may convey importance of element and lead to its dominance
 - E.g. border meant that EDUCA dominated



Numbers

- Numbers seen as having weak distinctiveness and often won't dominate
- Even where not dominant, may have some independent distinctive character
 - e.g.



Comparison with use in forms different to registered form

- Both ask the question - How similar are the two marks being compared?
- Same conceptual tools used:
 - Concentrate on dominant and distinctive elements
 - Discount negligible elements
- However, underlying questions different:
 - Infringement: are these marks similar enough to cause confusion?
 - Use: has the distinctive character of the earlier mark been altered?

Thank you

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