

CP11: Questionnaire for User Associations - Examination of relative grounds

QUESTIONNAIRE FOR USER ASSOCIATIONS

The project aims to harmonise the practice in the examination of formal requirements and grounds for refusal of new types of marks in order to prevent misalignments, multiplicity of practices and legal uncertainty as a consequence of different solutions being found to unprecedented issues. For the purposes of this questionnaire and this convergence project (CP11), the concept of new types of trade marks refers to sound, motion, multimedia and hologram marks.

The overview of all responses will serve as a basis for the discussions by the CP11 Working Group.

The following questions aim to identify and address issues regarding the criteria for the (visual, aural and conceptual) **comparison of signs in the assessment of relative grounds for refusal or invalidity** where these issues are specific to new types of marks. In particular:

- Applicability of certain types of comparison for certain types of marks (such as the applicability of aural comparison for motion marks which involve words, aural comparison of multimedia marks which involve both written words and spoken sounds or words, visual comparison for sound marks represented by notation, etc.).
- Applicability of the notion of overall impression to new types of marks and their components.
- Assessment of distinctiveness of components in new types of marks and its impact on the comparison.
- Assessment of dominance of components in new types of marks and its impact on the comparison.

The documents prepared for the CP11 Working Group, as well as the minutes of the CP11 Working Group meeting may contain reference to the replies provided, and will be shared with MS IPOs, European IPOs and the user representatives in the EUIPO User Group. The following questions are related to the examination of relative grounds for refusal or invalidity.

The comparison between the signs will include those between new types of marks themselves, and between new types of marks and all other types of marks (word, figurative and shape marks). It is assumed in all cases below that the English-speaking public is the relevant public, and **GERIVAN** does not have any particular meaning.

BASIC QUESTIONS

Please indicate the User Association that you represent:

Please write your answer here: **International Trademark Association (INTA)**

Please indicate your name and email address (in case clarification is needed regarding any of your answers):

Please write your answer here:

Carolina Oliveira, Policy Officer - Europe, coliveira@inta.org

EXAMINATION OF RELATIVE GROUNDS - SOUNDS

1. Would you consider it possible for a sound mark to have a dominant element?

Please choose **only one** of the following:

Yes, please elaborate

No

Other

Make a comment on your choice here:

It depends on the circumstances of the case but it may happen that a word or melody is the dominant element in a sound mark.

2. During the assessment of similarity between signs in a relative grounds proceeding, would you expect any element in the mark below to be found dominant?

Class 25: Clothing, footwear and headgear

<https://www.youtube.com/watch?v=Ulqhi4YxydE>

Please write your answer here:

We believe that the word "gerivan" is more clearly identifiable and therefore dominant.

3. How would you expect the similarity between the signs below to be assessed? What would you expect the outcome of the aural comparison between those signs to be?

Earlier mark

<https://www.youtube.com/watch?v=VWJ2jjElhuM>

(voice reproducing “GERIVAN”)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

GERIVAN

Class 25: Clothing, footwear and headgear

Word mark

Please write your answer here: **The marks are aurally similar.**

We believe that a visual comparison is not possible. According to both aural and conceptual comparisons, we would deem the marks to be similar.

4. How would you expect the similarity between the signs below to be assessed? What would you expect the outcome of the aural comparison between those signs to be?

Earlier mark

<https://www.youtube.com/watch?v=7zbSvPSECol>

(voice singing GERIVAN)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

GERIVAN

Class 25: Clothing, footwear and headgear

Word mark

Please write your answer here:

The aural similarity is significant. Although the expression means differ, the main (and only) element – word “GERIVAN” is the same.

5. Would you expect a difference in approach to the assessment of the degree of similarity between the signs in the two cases below (the difference between the cases being the representation of the earlier mark):

Situation 1:

Earlier mark 1

<https://www.youtube.com/watch?v=hfLHyOT6rPw>

(Melody played with piano)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark 1

<https://www.youtube.com/watch?v=pX4ldF-ITX8>

(The same melody played with violin)

Class 25: Clothing, footwear and headgear

Sound mark

We believe that there is aural similarity. The goods are identical and there is an overall similarity.

Situation 2:

Earlier mark 2



(Same melody as in the case above, but no indication of instrument)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark 2

<https://www.youtube.com/watch?v=pX4ldF-ITX8>

(Same melody played with violin)

Class 25: Clothing, footwear and headgear

Sound mark

Please write your answer here:

We believe that in both cases the signs are similar, regardless of their representation or how they are performed.

6. Would you expect the signs below to be considered aurally similar?

Earlier mark

<https://www.youtube.com/watch?v=Gmuuh9JoK6E>

(Voice singing GERIVAN)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=VWJ2jjElhuM>

(GERIVAN with robot voice)

Class 25: Clothing, footwear and headgear

Sound mark

Please choose **only one** of the following:

Yes, please specify the degree of similarity

No

Other, please elaborate

Make a comment on your choice here

We believe that the signs are aurally similar as “GERIVAN” is easily recognizable in both instances.

7. Would you expect the signs below to be considered aurally similar?

Earlier mark

<https://www.youtube.com/watch?v=hfLHyOT6rPw>

(5 second melody played with piano)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=pX4ldF-ITX8>

(Same melody played with violin)

Class 25: Clothing, footwear and headgear

Sound mark

Please choose **only one** of the following:

- Yes, please specify the degree of similarity
- No
- Other, please elaborate

Make a comment on your choice here:

In this case the fact that the melody is played with different instruments does not influence the general impression that the melodies are very similar.

8. Would you consider the mark below to have a concept?

Class 25: Clothing, footwear and headgear

<https://www.youtube.com/watch?v=vy9-YE-vePs>

Please choose **only one** of the following:

- Yes, please elaborate
- No
- Other, please elaborate

Make a comment on your choice here:

In our opinion, the barking of a dog, which is identifiable, is the mark's concept.

9. Would you consider the mark below to have a concept?

Class 25: Clothing, footwear and headgear

<https://www.youtube.com/watch?v=hfLHyOT6rPw>

Please choose **only one** of the following:

- Yes, please elaborate
- No
- Other, please elaborate

Make a comment on your choice here:

The sound of the piano is identifiable and therefore, in our opinion, it is the mark's concept.

10. Would you consider the mark below to have a concept?

Voice singing “Premium quality”

Class 25: Clothing, footwear and headgear

<https://www.youtube.com/watch?v=F7BAZCxph24>

Please choose **only one** of the following:

Yes, please elaborate

No

Other, please elaborate

Make a comment on your choice here:

The terms “premium quality” are identifiable. We believe this is the mark’s concept.

11. Would you expect the signs below to be considered conceptually similar?

Earlier mark

https://www.youtube.com/watch?v=HbOPV2H_7Cg

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=Tpu1y6bAdR4>

(Sound of thunder)

Class 25: Clothing, footwear and headgear

Sound mark

Please choose **only one** of the following:

Yes, please specify the degree of similarity

No

Other, please elaborate

Make a comment on your choice here:

Both signs refer to weather conditions including thunder. They are conceptually similar.

12. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark



Class 25: Clothing, footwear and headgear

Sound mark

Contested mark



(extended version of the earlier mark)

Class 25: Clothing, footwear and headgear

Sound mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

The bars and musical notations are all the same. Thus we believe that the marks are visually and aurally similar.

13. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=hfLHyOT6rPw>

(5 second melody played with piano)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=Frw2SFetIF0>

(Other piano melody)

Class 25: Clothing, footwear and headgear

Sound mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

In our opinion, from an aural perspective there is no similarity as the melodies are very different. From a conceptual perspective there is a low degree of similarity as both sounds are reproduced by pianos. Therefore, we believe that overall the marks are not confusingly similar.

14. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark



Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=hfLHyOT6rPw>

(5 second melody played with piano)

Class 25: Clothing, footwear and headgear

Sound mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

Aural perspective, i.e., comparing the melody represented by the earlier mark with that represented by the contested mark. We would also expect the marks to be compared from a conceptual perspective as both sounds are reproduced by a piano. We would expect the comparison's outcome to be that there is overall similarity between the marks.

15. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

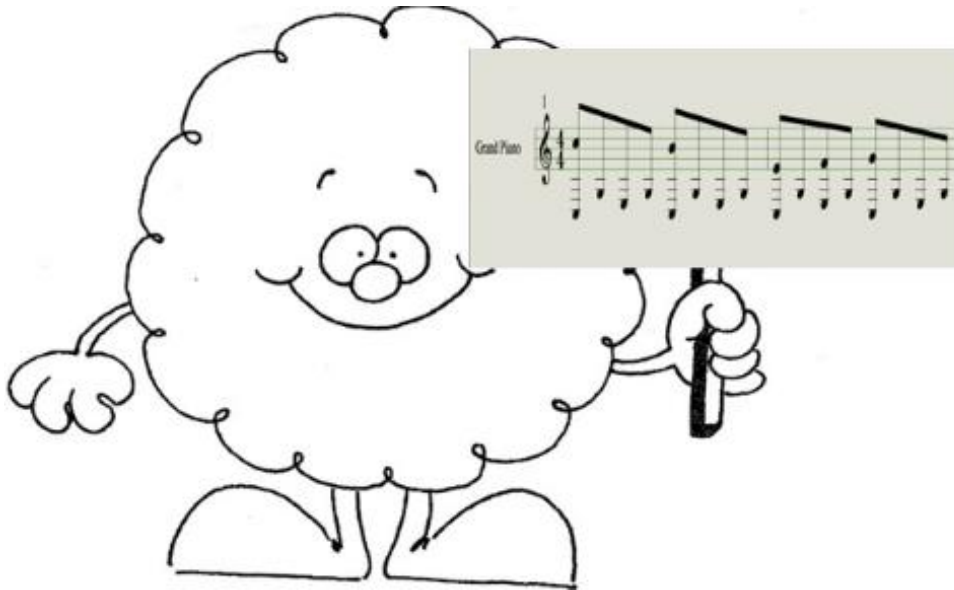
Earlier mark



Class 25: Clothing, footwear and headgear

Sound mark

Contested mark



Class 25: Clothing, footwear and headgear

Figurative mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

We would expect the marks to be compared from an aural and conceptual perspective as both contain a representation of an identical melody. While this would have to be carefully examined on a case by case basis, we would expect the comparison's outcome in the case above to be that there is NO overall similarity between the marks.

16. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=Ulqhi4YxydE>

(Melody with voice singing GERIVAN)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=Frw2SFEtIF0>

Class 25: Clothing, footwear and headgear

Sound mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
 - Other, please elaborate

We believe that the marks would be considered similar if compared from an aural perspective, as the melody is the same in both of them and from a conceptual perspective as both marks contain a sound played by a piano. We believe the marks are overall similar.

17. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=Ulqhi4YxydE>

(Melody with voice singing GERIVAN)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

GERIVAN

Class 25: Clothing, footwear and headgear

Word mark

Please choose all that apply and provide a comment:

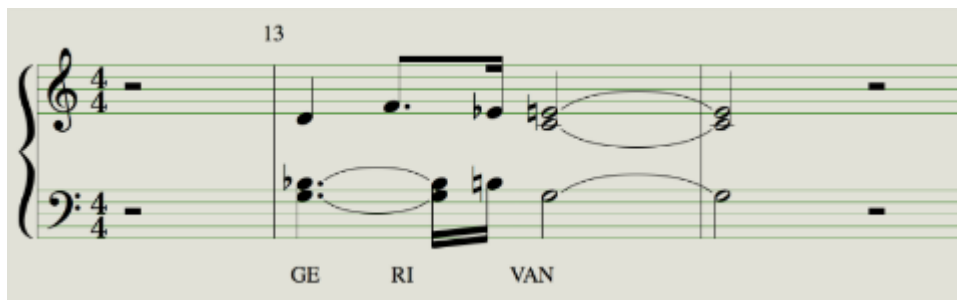
- Aural perspective

- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

From an aural perspective, the marks should be consider similar as a word mark can be spoken or sung. From a conceptual perspective, there is a similar concept in so far as they both represent GERIVAN. We believe the marks are overall similar, based on aural comparison.

18. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark



Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

GERIVAN

Class 25: Clothing, footwear and headgear

Word mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

The marks are conflicting because of the presence of the term GERIVAN.

From an aural perspective, the marks are similar as a word mark can be spoken or sung. From a conceptual perspective, there is a similar concept in so far as both represent GERIVAN. We believe that the marks are overall similar.

19. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=Ulqhi4YxydE>

(Melody with voice singing GERIVAN)

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark



Class 25: Clothing, footwear and headgear

Figurative mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

We would expect the comparison's outcome to be that the marks are similar. Both contain the distinctive term GERIVAN.

20. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=Ulqhi4YxydE>

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=DJnXDYsGrXs>

Class 25: Clothing, footwear and headgear

Motion mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

From the aural perspective the marks are nearly identical; from a visual perspective there is similarity as the word moves in an upward direction just as the voice singing rises; from a conceptual perspective there is near identity. We would expect the comparison's outcome to be that there is overall similarity between the marks.

21. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=Ulqhi4YxydE>

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=9ATKNqUmKsc>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

Each mark represents GERIVAN in different a form: from both the aural and conceptual perspective, we believe that the marks are very similar as the dominant part (the voice) is identical.

22. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=hfLHyOT6rPw>

Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=sEbqXDWV8B4>

Class 25: Clothing, footwear and headgear

MULTIMEDIA mark with same melody

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above

Other, please elaborate

The marks appear similar to us from an aural perspective. We believe that there is similarity also from a conceptual perspective as both marks share the same piano melody. We would deem the marks overall similar.

23. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark



Class 25: Clothing, footwear and headgear

Sound mark

Contested mark

<https://www.youtube.com/watch?v=aXLv0o8y1hE>

Class 25: Clothing, footwear and headgear

Motion mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

The same melody is either played or shown. The earlier mark is entirely contained in contested mark. Therefore, we would deem the marks to have a degree of similarity.

EXAMINATION OF RELATIVE GROUNDS - MOTION

24. Would you consider it possible for a motion mark to have a dominant element:

Please choose **only one** of the following:

Yes, please elaborate

No

Other

Make a comment on your choice here:

In a motion mark there can be visual (or aural) elements that are more striking or memorable than others.

25. What would you expect to be considered as dominant element in the motion mark below?

Class 25: Clothing, footwear and headgear

Motion mark

<https://www.youtube.com/watch?v=DJnXDYsGrXs>

Please write your answer here:

We would consider the dominant element to be the word element "GERIVAN".

26. What would you expect to be considered as dominant element in the motion mark below?

Class 25: Clothing, footwear and headgear

Motion mark

https://www.youtube.com/watch?v=0kbSH0_8a18

Please write your answer here:

We would consider the dominant element to be the movement of kicking the ball.

27. What would you expect to be considered as dominant element in the motion mark below?

Class 25: Clothing, footwear and headgear

Motion mark

<https://www.youtube.com/watch?v=P3IOHt0hhDQ>

Please write your answer here:

We would consider the dominant element to be the enhancing motion of the letter "P" in red.

28. What would you expect to be considered as dominant element in the motion mark below?

Class 25: Clothing, footwear and headgear

Motion mark

<https://www.youtube.com/watch?v=Faot96H8tFk>

Please write your answer here:

We would consider the dominant element to be “CP11”.

29. Would you expect a degree of similarity to be found in the example below, where the motion is similar in the two marks but the elements subject to the motion are different:

Earlier mark

<https://www.youtube.com/watch?v=2mH8ySH3SZ0>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

<https://www.youtube.com/watch?v=DJnXDYsGrXs>

Class 25: Clothing, footwear and headgear

Motion mark

Please choose **only one** of the following:

Yes

No

Other, please elaborate

Make a comment on your choice here:

We believe that there is a very low degree of similarity. The words are different, and so the relevant consumer will consider these first. In our opinion, the relevant consumer would only wonder if there is a connection between the marks in view of the identical typeface, coloring, the same motion (circular) and the same speed of motion.

30. Would you expect a degree of similarity to be found in the example below, where the motion is similar in the two marks but the elements subject to the motion are different?

Earlier mark

<https://www.youtube.com/watch?v=Faot96H8tFk>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

<https://www.youtube.com/watch?v=bsWlr8ftndk>

Class 25: Clothing, footwear and headgear

Motion mark

Please choose **only one** of the following:

Yes

No

Other, please elaborate

Make a comment on your choice here:

The verbal elements are the most prominent and they are different.

31. Would you expect a degree of similarity to be found in the example below, where the motion is different in the two marks but the elements subject to the motion are similar?

Earlier mark

https://www.youtube.com/watch?v=gdAFyd7cD_E

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

<https://www.youtube.com/watch?v=DJnXDYsGrXs>

Class 25: Clothing, footwear and headgear

Motion mark

Please choose **only one** of the following:

Yes

No

Other, please elaborate

Make a comment on your choice here:

The word mark is the most prominent feature of the mark (same typeface, same color, and same speed of motion). The signs are similar.

32. How would you expect the similarity between the signs below to be assessed in a relative grounds proceeding?

Earlier mark

<https://www.youtube.com/watch?v=DJnXDYsGrXs>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

GERIVAN

Class 25: Clothing, footwear and headgear

Word mark

Please write your answer here:

We believe that similarity should be assessed from visual and conceptual comparison tests. Here the word elements of the signs are the most prominent. Near identity exists as the words are the same, pronounced the same way and look almost identical. The relevant consumer will see the motion mark as a variant on the plain word mark. We believe that the marks are likely to be deemed confusingly similar as a result.

33. How would you expect the degree of similarity to be assessed in relation to the two examples below?

Situation 1:

Earlier mark 1



Class 25: Clothing, footwear and headgear

Motion mark

Contested mark 1

<https://www.youtube.com/watch?v=5EgxAITXhO8>

Class 25: Clothing, footwear and headgear

Motion mark

Situation 2:

Earlier mark 2



Class 25: Clothing, footwear and headgear

Figurative mark

Contested mark 2

<https://www.youtube.com/watch?v=5EgxAITXhO8>

Class 25: Clothing, footwear and headgear

Motion mark

Please write your answer here:

We would expect the degree of similarity to be assessed visually, aurally and conceptually. In our opinion, there is a risk of confusion (association) between the marks.

34. Would you expect a difference in approach to the assessment of the degree of similarity between the signs in the two cases below (the difference between the cases being the representation of the earlier mark)?

Situation 1:

Earlier mark 1



Class 25: Clothing, footwear and headgear

Motion mark

Contested mark 1

<https://www.youtube.com/watch?v=bsWlr8ftndk>

Class 25: Clothing, footwear and headgear

Motion mark

Situation 2:

Earlier mark 2

<https://www.youtube.com/watch?v=5EgxAITXhO8>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark 2

<https://www.youtube.com/watch?v=bsWlr8ftndk>

Class 25: Clothing, footwear and headgear

Motion mark

Please write your answer here:

No, we would not expect a difference in approach based on the same visual, aural and conceptual comparisons.

35. Would you expect the motion marks below to be visually similar?

Earlier mark

<https://www.youtube.com/watch?v=Faot96H8tFk>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

<https://www.youtube.com/watch?v=bsWlr8ftndk>

Class 25: Clothing, footwear and headgear

Motion mark

Please choose **only one** of the following:

Yes, please specify the degree of similarity

No

Other, please elaborate

Make a comment on your choice here:

No, in our opinion there is no similarity between the marks.

36. Would you expect the motion marks below to be aurally similar?

Earlier mark

<https://www.youtube.com/watch?v=DJnXDYsGrXs>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

<https://www.youtube.com/watch?v=5EgxAITXhO8>

Class 25: Clothing, footwear and headgear

Motion mark

Please choose **only one** of the following:

Yes, please specify the degree of similarity

No

Other, please elaborate

Make a comment on your choice here:

We believe that the degree of similarity is very high.

37. Would you consider the mark below to have a concept?



Please choose **only one** of the following:

- Yes, please specify
- No
- Other, please elaborate

Make a comment on your choice here:

Yes, the concept of the mark above is the appearance of each letter of the word one after another, in various colors as well as the combination of colors and the writing style.

38. Would you consider the mark below to have a concept?

Class 25: Clothing, footwear and headgear

<https://www.youtube.com/watch?v=qezdEFq5DiA>

Please choose **only one** of the following:

- Yes, please specify
- No
- Other, please elaborate

Make a comment on your choice here:

The concept is the hand, approving sign, i.e. “thumbs up” which has a laudatory meaning.

39. Would you consider the mark below to have a concept?

Class 25: Clothing, footwear and headgear

<https://www.youtube.com/watch?v=mPI4i7Sa-7c>

Please choose **only one** of the following:

Yes, please specify

No

Other, please elaborate

Make a comment on your choice here:

We would consider the concept to be the circles appearing from nothing, in a progressive circle.

39.a. If possible, please provide an example of other videos and the concepts assigned to them:

Only answer this question if the following conditions are met:
Answer was 'Yes, please specify' at question '41 [M17]' (39. Would you consider the mark below to have a concept? Class 25: Clothing, footwear and headgear)

Please write your answer here:

We believe that probably it is possible to find a concept in any image.

40. Would you expect the motion marks below to be conceptually similar?

Earlier mark

<https://www.youtube.com/watch?v=dsXWGGBDpuqQ>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

<https://www.youtube.com/watch?v=qezdEFq5DiA>

Class 25: Clothing, footwear and headgear

Motion mark

Please choose **only one** of the following:

- Yes, please specify the degree of similarity
- No
- Other, please elaborate

Make a comment on your choice here:

In our opinion, the marks portray the same meaning, i.e. an approval concept.

41. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=jHSdWmLxpGQ>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

<https://www.youtube.com/watch?v=q3rl0GDNs88>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose **only one** of the following:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other. Please elaborate

Make a comment on your choice here:

In our opinion, as the marks' word element is identical, there is likelihood of confusion (LOC).

42. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=DJnXDYsGrXs>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

<https://www.youtube.com/watch?v=yPRAfJ-BOs0>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose **only one** of the following:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other. Please elaborate

Make a comment on your choice here:

The earlier mark is a motion mark of the rotating word GERIVAN – no indication of pronunciation is provided, therefore this is subjective.

The contested mark is a multimedia mark comprising a rotating cello or other such musical instrument. Overlaid after at least one rotation is an audio track of what may be GERIVAN although owing to the rushed pronunciation this sounds more like “JERRYVUN”. As there is no word depicted in the multimedia mark this element is open to misinterpretation and/or subjective interpretation.

An examiner and/or trademark searcher is only likely to connect these two marks if they each confirm that GERIVAN is a component of the respective marks and this is not provided in the question. Hence, in our opinion:

- No visual similarity. Rotation of such differing elements insufficient to draw an association as actual elements rotating are so diverse and unconnected.

- No aural similarity. The first mark has no aural component as there is no audio track. The contested mark’s audio track is open to misinterpretation as no verbal description confirmed as being included in the application.

- Conceptually, this is the area of debate. If it was readily understood that both marks were GERIVAN marks then there would be some element of similarity due to this common factor but this is outweighed by the other elements of the respective marks hence no likelihood of confusion. Based upon a strict comparison of the respective

marks themselves then there is considered to be no conceptual similarity as it is not believed that each will be perceived as being a GERIVAN mark.

If both marks were considered to be, without a doubt, GERIVAN marks then the perspective to be compared would be the conceptual perspective. In such case, again, owing to the differing additional elements and as GERIVAN is not the dominant element in the respective marks there is no prospect of a likelihood of confusion, based on the information provided.

43. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=jHSdWmLxpGQ>

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark

GERIVAN

Class 25: Clothing, footwear and headgear

Word mark

Please choose **only one** of the following:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other. Please elaborate

Make a comment on your choice here:

The comparison must be asserted on all criteria (visual, aural, conceptual). However, we believe that in this case the visual criterion is more important and the marks are similar. LOC would likely be found.

44. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

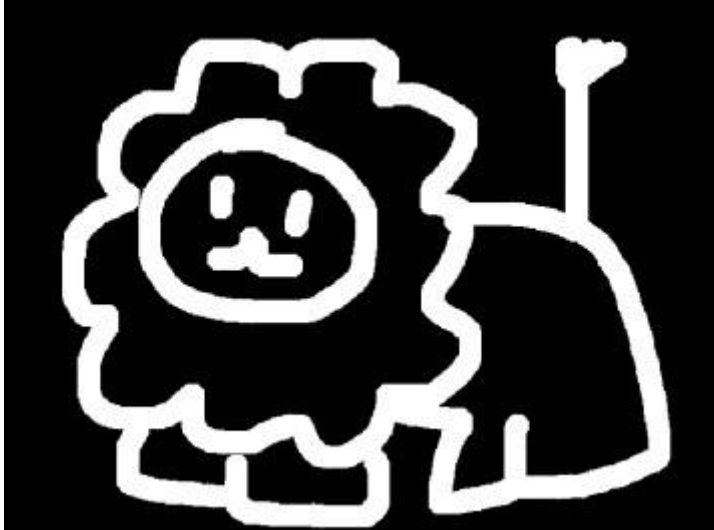
Earlier mark

https://www.youtube.com/watch?time_continue=1&v=TAGWmDRT8Vg

Class 25: Clothing, footwear and headgear

Motion mark

Contested mark



Class 25: Clothing, footwear and headgear

Figurative mark

Please choose **only one** of the following:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other. Please elaborate

Make a comment on your choice here:

The visual elements are the only elements that are common in both marks. The marks are similar to an average degree (identical presence of the lion in both signs). LOC unlikely.

45. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared? What would you expect the outcome of the comparison to be?

Earlier mark

<https://www.youtube.com/watch?v=LsuHWu0Whos>

Class 3: cosmetics

Motion mark

Contested mark



Class 3: cosmetics

Shape mark

Please choose **only one** of the following:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other. Please elaborate

Make a comment on your choice here:

The signs are mostly visual. Although the earlier mark is a motion mark, the later mark is an identical static representation of the earlier mark. They are confusing because they are similar to a very high degree. LOC is expected.

EXAMINATION OF RELATIVE GROUNDS - MULTIMEDIA

46. Would you consider it possible for a multimedia mark to have a dominant element?

Please choose **only one** of the following:

Yes, please elaborate

No, please elaborate

Other, please elaborate

Make a comment on your choice here:

Depending on the multimedia mark, it could have an element that is particularly dominant. For example, a visual background where nothing is happening and then a ball being kicked (using the ball example from above).

47. During the assessment of similarity between signs in a relative grounds proceeding, would you expect any element in the mark below to be found dominant?

Class 25: Clothing, footwear and headgear

Multimedia mark

<https://www.youtube.com/watch?v=iWmvBI9c9Qo>

Please write your answer here:

Yes, the word element GERIVAN. The sound emphasizes the word GERIVAN and therefore the word and sound are more dominant than the movement.

48. During the assessment of similarity between signs in a relative grounds proceeding, would you expect any element in the mark below to be found dominant?

Class 25: Clothing, footwear and headgear

Multimedia mark

<https://www.youtube.com/watch?v=3gbVrEv83EA>

Please write your answer here:

We believe that the element "CP11" is the most dominant as the average consumer is more likely to see the words as a trademark than the sound and images.

49. Would you expect the multimedia marks below to be found similar, where the sound is identical/similar in the two marks, but the images in the multimedia files are different:

Earlier mark

<https://www.youtube.com/watch?v=sEbqXDWV8B4>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

<https://www.youtube.com/watch?v=C8JSiTIX1wM>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose **only one** of the following:

- Yes, please specify the degree of similarity
- No
- Other, please elaborate

Make a comment on your choice here:

The use of completely different images is sufficient to make the respective marks different. The tune is not clearly identifiable and as such sound element is not dominant. If similarity exists it is to a very low degree that excludes the risk of confusion or association.

50. Would you expect the multimedia marks below to be found similar, where the images are identical/similar in the two marks, but the sounds in the multimedia files are different:

Earlier mark

<https://www.youtube.com/watch?v=2nDwuyUJMUA>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

<https://www.youtube.com/watch?v=ZQmKY69KvR4>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose **only one** of the following:

- Yes, please specify the degree of similarity
- No
- Other, please elaborate

Make a comment on your choice here:

The degree of similarity is high (the visual images are identical). We believe that these are conflicting marks and LOC should be found.

51. Would you expect the multimedia marks below to be found visually similar?

Earlier mark

<https://www.youtube.com/watch?v=Eg3Au9hjA-U>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

<https://www.youtube.com/watch?v=3gbVrEv83EA>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose **only one** of the following:

Yes, please specify the degree of similarity

No

Other, please elaborate

Make a comment on your choice here:

The animals pictured are the same in both marks but they are facing a different way. There are no animal sounds in the second mark and the verbal element "CP11" is present instead of "GERIVAN". In conclusion, we see a low degree of similarity which we would deem insufficient for finding of LOC.

52. Would you expect the multimedia marks below to be found similar?

Earlier mark

<https://www.youtube.com/watch?v=iWmvBI9c9Qo>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

<https://www.youtube.com/watch?v=yPRAfJ-BOs0>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose **only one** of the following:

- Yes, please specify the degree of similarity
- No
- Other, please elaborate

Make a comment on your choice here:

We believe that this reply involves a difficult judgement as both marks include the aural identical element GERIVAN but their respective visual elements are very different. It could be argued both ways but on balance, we believe the marks could be considered to be similar.

53. Would you expect the multimedia marks below to be found aurally similar:

Earlier mark

<https://www.youtube.com/watch?v=Eg3Au9hjA-U>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

<https://www.youtube.com/watch?v=3gbVrEv83EA>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose **only one** of the following:

- Yes, please specify the degree of similarity
- No
- Other, please elaborate

Make a comment on your choice here:

In our opinion, there is high aural similarity as both marks consist of the same tune/melody but with different instruments.

54. Would you expect the multimedia marks below to be found aurally similar:

Earlier mark

<https://www.youtube.com/watch?v=6PZ47P6AR0w>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

<https://www.youtube.com/watch?v=YG7nsuaTjtE>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose **only one** of the following:

Yes, please specify the degree of similarity

No

Other, please elaborate

Make a comment on your choice here:

In our opinion, the marks sound completely different. Therefore, there is no aural similarity and no LOC should be found.

55. Would you expect the multimedia marks below to be considered aurally similar?

Earlier mark

<https://www.youtube.com/watch?v=6PZ47P6AR0w>

Contested mark

<https://www.youtube.com/watch?v=RFeufBMieqk>

Please write your answer here:

We believe the marks are not aurally similar.

56. Would you consider the multimedia mark below to have a concept?

Class 25: Clothing, footwear and headgear

Multimedia mark

<https://www.youtube.com/watch?v=G0g-cO7MYIE>

Please choose **only one** of the following:

Yes, please elaborate

No

Other, please elaborate

Make a comment on your choice here:

The multimedia mark shows the image of hands clapping with the sound of hands clapping. This can be described as 'applause'. One could thus say that the mark is conceptually similar to the word (mark) APPLAUSE.

57. Would you consider the multimedia mark below to have a concept?

Class 25: Clothing, footwear and headgear

Multimedia mark

<https://www.youtube.com/watch?v=6PZ47P6AR0w>

Please choose **only one** of the following:

Yes, please elaborate

No

Other, please elaborate

Make a comment on your choice here:

The mark consists of the combination of the word "GERIVAN" with a piano tune in the background and a Star design slowly appearing, being colored in yellow. We believe that this is a fairly complex mark. A single or dominant concept cannot be found.

57.a. If possible, please provide an example of other multimedia files and the concepts assigned to them:

Only answer this question if the following conditions are met:
Answer was 'Yes, please elaborate' at question '60 [D12]' (57. Would you consider the multimedia mark below to have a concept? Class 25: Clothing, footwear and headgear Multimedia mark)

Please write your answer here:

58. Would you expect the multimedia marks below to be considered conceptually similar?

Earlier mark

<https://www.youtube.com/watch?v=ljZIIHzEJDY>

Class 41: Entertainment services

Multimedia mark

Contested mark

https://www.youtube.com/watch?v=F9oJAS_gHZ0

Class 41: Entertainment services

Multimedia mark

Please choose **only one** of the following:

- Yes, please specify the degree of similarity
- No
- Other, please elaborate

Make a comment on your choice here:

The first mark is a green hologram/3D football, spinning around, supported by the sound of applause. The second mark is a video of a soccer arena with a crowd cheering and a close up of a soccer player kicking a football. When described there are some conceptual similarities but we would not consider these marks, when compared as a whole, confusingly (conceptually) similar.

59. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared?

Earlier mark

https://www.youtube.com/watch?time_continue=1&v=SATX5_QNSJA

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

GERIVAN

Class 25: Clothing, footwear and headgear

Word mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

The first mark is a combination of an image ('tunnel explosion') that is moving and the word "GERIVAN" (sung) a cappella.

The second mark is the wordmark "GERIVAN". It is assumed the comparison would take place in the context of the assessment of possible likelihood of confusion. In that regard, the marks should be compared from both a visual, aural and conceptual angle. In our opinion, conceptually there is no similarity.

60. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared?

Earlier mark

<https://www.youtube.com/watch?v=q3rl0GDNs88>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

GERIVAN

Class 25: Clothing, footwear and headgear

Word mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

In our opinion, the comparison should take place in the context of the assessment of possible likelihood of confusion. In that regard, the marks should be compared from a visual, aural and conceptual angle. We believe that there is visual similarity but that aurally and conceptually the marks are not similar.

61. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared?

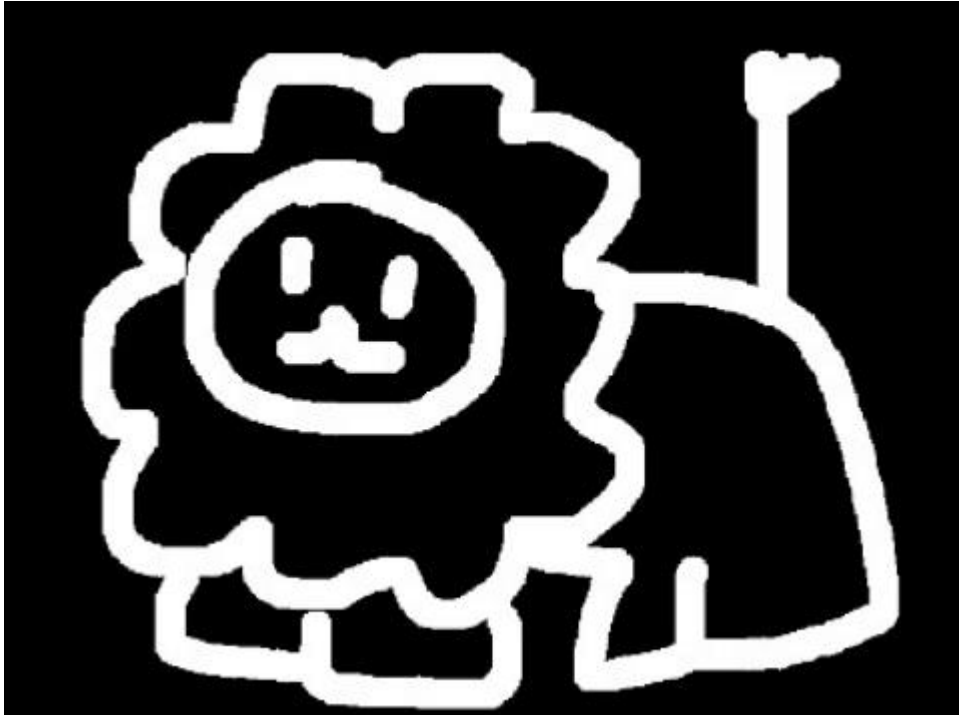
Earlier mark

<https://www.youtube.com/watch?v=Eg3Au9hjA-U>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark



Class 25: Clothing, footwear and headgear

Figurative mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
 - Other, please elaborate

The comparison should take place in the context of the assessment of possible likelihood of confusion. In that regard, the marks would be compared from a visual, aural and conceptual angle. From a visual/conceptual perspective, we believe that there is partial similarity (the lion representation among the other animals in the earlier trademark). We find no aural similarity between the marks.

62. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared?

Earlier mark

<https://www.youtube.com/watch?v=Eg3Au9hjA-U>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark



Class 25: Clothing, footwear and headgear

Figurative mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective;
- None of the above
- Other, please elaborate

The comparison should take place in the context of the assessment of possible likelihood of confusion. In that regard the marks should be compared from a visual, aural and conceptual angle. Aurally, we believe that there is no similarity.

From a visual perspective, the lion image and the verbal element "CP11" should be compared. From a conceptual perspective the comparison would involve the image of the lion and the roaring sound. We believe that there is no aural similarity.

63. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared?

Earlier mark

<https://www.youtube.com/watch?v=sEbqXDWV8B4>

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

<https://www.youtube.com/watch?v=C8JSiTIX1wM>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

The first mark is a video with the words LIVE, YOUR, DREAMS appearing in color, with a piano tune.

The second mark is a video of the image of animals (chicken, fish, lion and "CP11") with the same piano tune.

The comparison should take place in the context of the assessment of possible likelihood of confusion. The marks should be compared from a visual, aural and conceptual angle. In our opinion, visually and conceptually there is no similarity. Aurally near identity can be found.

64. From which perspective (visual/aural/conceptual) would you expect the following marks to be compared?

Earlier mark

https://www.youtube.com/watch?v=SATX5_QNSJA

Class 25: Clothing, footwear and headgear

Multimedia mark

Contested mark

<https://www.youtube.com/watch?v=q3rI0GDNs88>

Class 25: Clothing, footwear and headgear

Multimedia mark

Please choose all that apply and provide a comment:

- Aural perspective
- Visual perspective
- Conceptual perspective
- None of the above
- Other, please elaborate

The first mark is a combination of an image ('tunnel explosion'), that is moving and the word "GERIVAN" (sung) acapella.

The second mark is a video of the word/elements GE RI VAN slowly appearing, in color, sung acapella.

The comparison should take place in the context of the assessment of possible likelihood of confusion. The marks should be compared from a visual, aural and conceptual angle. In our opinion, there is no conceptual similarity. Aural similarity exists because of the spoken word element "GERIVAN".

EXAMINATION OF RELATIVE GROUNDS - HOLOGRAM

65. Would you consider it possible for a hologram mark to have a dominant element?

Please choose **only one** of the following:

- Yes, please elaborate
- No
- Other, please elaborate

Make a comment on your choice here:

If an element is more striking than another, especially if that other is allusive of the products at stake, a hologram mark can have a dominant concept.

It depends on the hologram but if, for example the hologram would depict the image of a jungle (as background) and very prominently in the foreground the image of a GORILLA was shown, the dominant element could be the GORILLA.

FINAL CONSIDERATIONS

66. Please indicate if there is any case law from any jurisdiction that you consider relevant to any issue on relative grounds for refusal or invalidity involving sound, motion, multimedia and hologram marks.

You may upload it as a Word document in its original language or in English if you have the document translated (please highlight the relevant paragraphs). Should you experience any problems, please email the file to Irene.MARUGAN@euipo.europa.eu

Please upload at most one file

We found no relevant case law in this respect.

67. What are the main issues that you foresee for users in relation to the relative grounds examination of new types of marks?

Please write your answer here:

Generally speaking, we believe that for those Trademark Offices that do have examination on relative grounds, it will be more complex to make a proper assessment of likelihood of confusion. Case law will have to develop in this regard. For users as well, it will be more complex to make this assessment.

Pragmatically speaking, technology will play a bigger role in the process of examining relative grounds.

Some issues may arise concerning the identification of the dominant element in new types of marks. For example, when comparing two images, one can almost instantly say whether they are similar or not, but explaining this may prove much more difficult.

68. Do you foresee any risks related to the agreement of a Common Practice on the relative grounds examination of new types of marks?

Please write your answer here:

There may be some challenges in the pragmatic and technological implementation of the Common Practice. Certainly in the beginning it may create some difficulties, given the different levels of technological preparation of the different Trademark Offices, with the risk of incorrect decisions. We estimate that such increased complexity may, in the beginning, somewhat delay the examination process.

Nevertheless, the advantages of agreeing on a Common Practice should outweigh any disadvantages as legal certainty and clarity for users will increase.