

# The Trademark Reporter®



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## BOOK REVIEW

*By Désirée Fields\**

**The Confusion Test in European Trade Mark Law.** Ilanah Fhima and Dev S. Gangjee. 2019. Pp. 320. £125 (hardback); electronic version available. Oxford University Press, Great Clarendon Street, Oxford, England, OX2 6DP, UK.

In the context of most trademark disputes, a finding of trademark infringement will heavily depend on the outcome of any likelihood of confusion analysis. This analysis is often simplified or short-circuited by focusing heavily on the comparison of the marks concerned and the goods and services that they cover. In reality, however, this area of the law is much more complex. A comprehensive likelihood of confusion analysis involves a much more nuanced approach and requires consideration of a number of additional factors, such as the level of distinctiveness of a mark, whether the marks at issue are complex or composite marks, and the role that factors such as trade channels and perceptions of consumers in particular sectors may play (among many others).

Voted IPKat Best Book on Trade Mark Law 2019, *The Confusion Test in European Trade Mark Law* by Ilanah Fhima and Dev S. Gangjee provides a clear and comprehensive overview of the likelihood of confusion analysis under European trademark law, touching on all aspects and nuances of the law without delving into too much detail. The authors provide case examples with references to source materials, enabling the reader to dive deeper into any areas that could be relevant in the context of a particular infringement assessment. The book primarily considers how the likelihood of confusion test is applied by the European Union Intellectual Property Office (“EUIPO”) and the Court of Justice of the European Union (“CJEU”). Written by authors based in the United Kingdom (“UK”), the book includes numerous cases from England and Wales. Where appropriate, the authors also refer to case law of the European Union (“EU”) Member States. Indeed, the book includes a significant number of references to German jurisprudence, especially where nontraditional trademarks are concerned. The authors invite readers to contact them with suggestions of relevant case law in EU Member States for inclusion in subsequent editions of this book.

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*The Confusion Test in European Trade Mark Law* is divided into eight chapters. After a clear introduction to the concept of the likelihood of confusion in Chapter 1, seven further chapters deal with the multifactor assessment that needs to be adopted in carrying out a confusion analysis. The authors contend that while there appears to be some contradiction between some of the factors, an analysis of the relevant case law in this area leads to the conclusion that it is nonetheless possible “to articulate a clear set of rules that are being consistently applied by European courts and tribunals in order to analyse the differen[t] forms of similarity and confusion overall.”

Chapter 2 discusses the various tests in relation to the similarity of marks and, in particular, the visual, aural, and conceptual similarity tests. As the authors note, the test of the similarity of two marks has changed very little since it was first laid down by the CJEU in *SABEL BV v. Puma AG*,<sup>1</sup> where the court held that a “global appreciation of the visual, aural or conceptual similarity of the marks in question[ ] must be based on the overall impression created by the marks, bearing in mind, in particular, their distinctive and most dominant components,” with a view to determining whether the signs in question are similar enough to lead to a likelihood of confusion in the minds of the average consumer of the goods and services concerned. Referencing a large number of actual cases where marks have been found to be similar or dissimilar, the authors cover a variety of hot topics, such as whether visual, aural, or conceptual similarity should be given most weight in the analysis, whether the beginning of the mark is more important than the ending, and what role families of marks may play in the assessment. Although these general principles are, of course, well known to the seasoned trademark practitioner, there are several useful refreshers and nuances to the analysis that may ordinarily not be given so much weight when carrying out a quick relative grounds or infringement assessment. There are also some case examples with somewhat surprising outcomes that may be useful to refer to in complex assessments. Particularly helpful are the illustrations of junior and senior marks. Disappointingly, some of the analysis in the chapter is, perhaps, short. By way of example, the authors devote a lot of analysis to examples of cases where two marks coincide in the senior mark at the beginning and end in a different suffix. There is, however, no detailed analysis of the converse situation, where the senior mark constitutes the second element of the junior mark. Rather, the authors comment only briefly that in such cases similarity is less often found, highlighting a couple of cases in the footnotes. Overall, however, despite the

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<sup>1</sup> Case C-251/95, *SABEL BV v. Puma AG, Rudolf Dassler Sport* (CJEU) EU:C:1997:528, [23].

importance of some of the nuances highlighted by the authors, it is true that a comparison of marks should not be an overly complex and evidence-intensive process. The important point is to try to apply an objective benchmark while bearing in mind, to some degree, the reality of consumer perception.

Chapter 3 grapples with the subject of complex or composite marks. While such marks have not been clearly defined in jurisprudence or scholarship, these marks are commonly understood to be those that include word and figurative elements. Such marks give rise to interesting questions, such as whether it is the words or the image that should be afforded greater weight. Particularly challenging are those situations in which one of the aspects of the composite mark is similar (for example, where the logo element in each case is that of a crocodile), while the word elements differ. As such, there are many variables that need to be factored into a likelihood of confusion analysis. While reference to previous case law can be of assistance to some extent, unfortunately a one-size-fits-all approach does not work in this complex area. The authors provide a helpful toolkit, setting out all the aspects that need to be considered. They distill the essence of how courts, such as the CJEU, try to achieve the difficult balance of identifying the elements of a mark that consumers would pay most attention to and consider to be dominant—those that have independent distinctive character and can lead to consumer confusion where they are similar in the junior and the senior mark, and those that are more negligible in the assessment of similarity and can therefore be ignored for the purposes of comparing signs. While there are degrees of variation in each individual case, the authors nicely draw out common threads and themes, again helpfully supported with illustrations.

While it is generally quite straightforward to identify when goods are considered to be identical, the similarity analysis can be much more complicated. Chapter 4 is devoted to analyzing the relevant factors when assessing the similarity of goods and services, focusing on how to demonstrate the similarity of goods and analyzing those factors that tend to be considered most frequently by the CJEU and other administrative bodies in their assessments. While this analysis is generally more straightforward than the assessment of the similarity between two marks, the authors explain, again with reference to ample examples, how this involves an assessment and balancing of numerous factors that may lead to contradictory outcomes. The case examples provided are fascinating, in particular, where the authors highlight discrepancies between outcomes of the assessment of the similarity or complementary nature of goods and show how the outcome often depends on the particular sector concerned and the level of sophistication of the relevant consumer in that field. This makes

Chapter 4 one of the most illuminating and interesting chapters of *The Confusion Test in European Trade Mark Law*, starkly reminding trademark practitioners to treat classification in the same Nice class with caution when carrying out a similarity assessment, and not to succumb to the temptation to state that goods or services are similar or complementary without providing more detailed arguments and analysis in support. The authors also provide readers with practical tips, such as the availability of the EUIPO's "Similarity Tool" by which users can, and examiners must, conduct a similarity search.

Chapter 5 feels more academic and analytical than the rest of the book. It evaluates the least understood aspect of the likelihood of confusion analysis, namely, the extent to which the distinctiveness or strength of the senior mark influences the assessment. In doing so, the authors provide a useful checklist of the factors to be considered in assessing the level of distinctiveness of the mark. Interestingly, their analysis of case law shows that distinctiveness has relatively little impact on the likelihood of confusion analysis in the EU. In the vast majority of cases, distinctiveness is treated as a second-class factor and is not considered at all or is discounted. The authors' analysis shows that inherent distinctiveness is not mentioned in 68 percent of cases and acquired distinctiveness is not mentioned in 82 percent of cases. This is in sharp contrast to the United States, where, in 90 percent of the cases in which confusion was found to exist, the strength of the senior mark was a factor. The authors therefore conclude that "distinctiveness is an enigma of likelihood of confusion": too important to be ignored, yet often downplayed in importance.

In Chapter 6, the authors identify the various additional factors that are relevant in assessing whether confusion is causatively likely to flow from those similarities. It starts by revisiting and building upon some of the concepts from earlier chapters in carrying out a global assessment, before considering the different types of confusion that are recognized, the nature of the hypothetical average consumer, and the extent to which proof of actual confusion is relevant. The analysis also addresses evidentiary questions, such as the value of survey evidence and the differences in assessment that may come into play when carrying out a relative grounds assessment and an infringement assessment, respectively. Other points that the authors address here are the role that families of marks can play in finding a likelihood of confusion and the scope of protection of marks that are weakly distinctive.

Chapter 7 considers the impact of timing on confusion, and, in particular, two variations of the traditional point-of-sale confusion, namely, initial interest (or pre-sale) confusion and post-sale confusion. Conducting an in-depth analysis of the doctrine and jurisprudence in this field, the authors argue that the label of the

type of confusion should not matter, but that the focus should be on the materiality of the confusion and whether the defendant's conduct causes material harm to the trademark owner in the marketplace. Surprisingly, there is no guidance from the CJEU in this controversial area, so the authors focus on the status of the doctrine in the UK and draw comparisons to U.S. jurisprudence to illuminate the issues. The authors conclude that to base infringement solely on initial interest or post-sale confusion goes too far and that, to the extent that such confusion influences, or is likely to influence, a consumer's transactional decision, it should be recognized within the likelihood of confusion test.

Drawing heavily on examples from CJEU and German jurisprudence, Chapter 8 assesses the extent to which the conventional likelihood of confusion test is modified and applied in relation to conflicts between nontraditional trademarks, such as colors and shapes. Despite relatively recent reforms to EU trademark law, which should, in theory, make it easier to register such trademarks, the number of such registrations is still very modest due to the uphill struggles that such marks face during the registration process to meet the requisite hurdle of distinctiveness. Once registered, the scope of protection of such marks is relatively underdeveloped. Several questions arise in relation to the likelihood of confusion assessment, such as whether colors can, in fact, serve as trademarks or are instead merely decorative, and whether consumers can distinguish between two shades of the same color and how to assess their similarity. Product shape marks face similar challenges with questions as to whether two product shapes can be sufficiently similar visually to satisfy the test, even where there are prominent and dissimilar elements on the product. It is clear the conventional likelihood of confusion test, as detailed in the preceding chapters of the book, applies. However, some adaptations may be necessary. For example, visual similarity is more important in the context of pure shape marks, as aural and conceptual similarities cannot be assessed for such marks.

The authors conclude Chapter 8 and *The Confusion Test in European Trade Mark Law* by reminding readers that nontraditional marks are especially susceptible to invalidation challenges on the grounds of lack of distinctiveness or on the basis of policy exclusions, but without providing a proper conclusion on the aspects of the likelihood of confusion test in this area. This gives the book a somewhat abrupt ending. Perhaps a future edition would benefit either from a conclusion to this chapter or from the addition of a final, concluding chapter, drawing together all the threads explored in the previous chapters.

That said, given the thorough and clear introduction, the absence of a clear conclusion does not detract from the fact that *The Confusion Test in European Trade Mark Law* constitutes an

excellent authority on the likelihood of confusion analysis in the EU, and has something to offer to everyone interested in this particular field. Written in clear and accessible language, and well balanced between academic analysis and practical guidance, it provides a good introduction to this area for more junior trademark practitioners who may choose to read the book cover to cover. With its clear headings and structure, it is also a good reference tool for the experienced trademark practitioner wishing to explore certain nuances of the likelihood of confusion analysis in more detail when carrying out brand clearances or when advising on trademark infringement and opposition matters. The wealth of references to source materials that may be explored for a deeper dive analysis is invaluable in that regard, as an exploration of these nuances may well assist a practitioner in nudging the outcome of a case in the desired direction when a trademark examiner or tribunal might be sitting on the fence.

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