

AIPPI Q290
CONFLICTS BETWEEN COMPOSITE TRADEMARKS
INCLUDING NON-DISTINCTIVE ELEMENTS

National Group

The Netherlands

Contributors

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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.
- (e) The “Anti-Dissection Rule” and “Rule of Dominant Feature” are equally important rules/principles.
- (f) Other, please clarify.

YES.

In the Benelux, and in the Netherlands for that matter, trade mark law is largely harmonized by European Union (EU) trade mark law. In the EU, similar principles to the “Anti-Dissection Rule” and the “Rule of Dominant Feature” are applied even though they are not commonly known under these names.

When assessing similarity between marks, including when one or both marks are composite trade marks, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those

marks, bearing in mind, in particular, their distinctive and dominant components (CJEU 11 November 1997, C-251/95 (Puma/Sabel)). In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (CJEU 4 March 2020, C-328/18 P (Equivalenza), more recently in the Benelux: Benelux Court of Justice of 28 June 2023, C 2022/6 (The Gillette Company/Fontaine)). Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue. The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components (CJEU 12 June 2007, C-334/05 P (Limoncello); CJEU 20 September 2007, C-193/06 P (Nestlé/Quick Restaurants)).

As a general rule, when a composite mark includes non-distinctive elements, the public will not consider the non-distinctive elements forming part of a composite mark as the distinctive and dominant element in the overall impression conveyed by that mark (General Court 3 July 2003, T-129/01 (BUDMEN); General Court 6 October 2004, T-356/02 (Vitakraft-Werke Wührmann/Krafft)).

However, the weak (or non-)distinctive character of an element of a composite mark does not necessarily imply that that element cannot constitute a dominant element. It may, because, in particular, of its position in the sign or its size, make an impression on consumers and be remembered by them (General Court 20 July 2016, T-745/14 (TeamBank/Easy Asset Management); General Court 12 November 2008, T-210/05 (Nalocebar/Liminana y Botella)).

Normally, where the marks coincide in an element that is weakly (or non-) distinctive, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks. It will take into account the similarities/differences and distinctiveness of the non-coinciding components (in line with the Common Practice covering this specific topic as agreed by the IP Offices in the EU: CP5 - Relative Grounds Likelihood of Confusion (Impact of non-distinctive/weak components). Additionally, the global assessment of the likelihood of confusion does not often lead to a finding that such likelihood exists (CJEU 18 June 2020, C-702/18 P (Primart/EUIPO); General Court 18 January 2023, T-443/21 (Yoga Alliance)).

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

YES

When assessing similarity between marks, the comparison must be based on the overall impression given by those marks. The comparison should cover signs in their entirety and, as a result, non-distinctive elements cannot be discarded (see for the Benelux: Benelux Court of Justice of 15 June 2022, C-2021/8, para. 26 (Milk Company/MJN)). See further the Dutch Group's answer under 1 above. Even though this is the applicable rule, the Dutch Group notes that there are over the years a few judgments by Dutch (lower) courts where the court did discard non-distinctive word elements when assessing similarity between two composite marks. However, the Dutch Group believes that this is incorrect (see also our answer to question 10 below).

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

As a general rule, when a composite mark includes non-distinctive elements, the public will not consider the non-distinctive elements forming part of a composite mark as the distinctive and dominant element in the overall impression conveyed by that mark (General Court 3 July 2003, T-129/01 (BUDMEN); General Court 6 October 2004, T-356/02 (Vitakraft-Werke Wührmann/Krafft)).

However, the weak (or non-)distinctive character of an element of a composite mark does not necessarily imply that that element cannot constitute a dominant element. It may, because, in particular, of its position in the sign or its size, make an impression on consumers and be remembered by them (General Court 20 July 2016, T-745/14 (TeamBank/Easy Asset Management); General Court 12 November 2008, T-210/05 (Nalocebar/Liminana y Botella)).

Normally, where the marks coincide in an element that is weakly (or non-) distinctive, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks. It will take into account the similarities/differences and distinctiveness of the non-coinciding components (CP5).

Additionally, the global assessment of the likelihood of confusion does not often lead to a finding that such likelihood exists (CJEU 18 June 2020, C-702/18 P



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(Primart/EUIPO); General Court 18 January 2023, T-443/21 (Yoga Alliance).

- (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 nondistinctive 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.
- (b) No, the nature of non-distinctive elements does not make a difference.

YES

- (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.

YES

As a preliminary remark, the Dutch Group notes that both the Benelux Office for Intellectual Property (the “BOIP”, in case of Benelux trade marks) and the European Union Intellectual Property Office (the “EUIPO”, in case of EU trade marks) do not assess the similarity of trade marks during the registration phase, but solely as part of opposition proceedings filed by a third party. During the registration phase of a trade mark, both Offices merely check whether there are absolute grounds for refusal. After publication of a trade mark application, the holder of an earlier trade mark can oppose the registration of the trade mark on relative grounds and only in those cases, the BOIP and the EUIPO assess trade mark similarity in the registration context.

When comparing the assessment of similarity between trade marks made in an opposition context with the similarity assessment made in infringement context, the Dutch Group concludes that the same factors are considered. In both contexts the visual, aural and conceptual similarity of the trade marks are considered. And in both contexts, the similarity of the marks must be based on the overall impression made by those marks on the relevant public, bearing in mind, in particular, their distinctive and dominant components (CJEU 11 November 1997, C-251/95, ECLI:EU:C:1997:528 (Sabèl), para. 23). Nevertheless, account must be taken of the intrinsic qualities of the marks at issue (CJEU 4 March 2020, C-328/18, ECLI:EU:C:2020:156 (Equivalenza Manufactory/EUIPO), para. 71).

The Dutch Group does note that a small difference lies in the fact that in an opposition context, the earlier mark is compared with the opposed trade mark application, whereas in an infringement context, the earlier trade mark is compared to the allegedly infringing sign as used in the market. Also, we see in practice that lower courts when comparing trademarks in an infringement setting tend to attach more weight to the points of similarity than to the points of difference. However, this does not influence the factors that are considered but the weight that is given to those factors.

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

(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:**

Confusing similarity in the opposition context (see the Dutch Group's answer to question 5 above) is based on the assessment whether there is a likelihood of confusion. The assessment of a likelihood of confusion consists of three phases. In phase 1, the marks at issue are compared based on the criteria outlined under question 5 above and if there is any similarity, however slight, phase 2 commences. Phase 2 is the comparison of the goods and services and if there is any similarity between them, phase 3 has to be assessed. Phase 3 is the global appreciation of the likelihood of confusion, taking into account all relevant facts and circumstances, however, the main factors to consider are (i) the degree of similarity between the signs, (ii) the degree of similarity between the goods and services, (iii) the relevant public and their degree of attention, (iv) the distinctiveness of the earlier trade mark and (v) certain other factors, which are explained in more detail below.

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

NO



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- (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.

YES

The signs are compared visually, aurally and conceptually (see also the Dutch Group's answer to question 5 above). As part of this comparison the structure of the mark is taken into account. In that regard, it is determined that in general the beginning of a sign has a significant influence on the general impression made by the mark. The Dutch Group also notes that when signs consist of both verbal and figurative components, in principle the verbal component of the sign has a stronger impact on the consumer than the figurative component, because the public will more easily refer to the signs by their verbal element (General Court 14 July 2005, T-312/03, EU:T:2005:289 (Selenium-Ace), para. 37). In determining the overall phonetic impression of a trade mark the key elements are the syllables and their particular sequence and stress. For the conceptual comparison it is examined whether two signs have the same or analogous semantic content (CJEU 11 November 1997, C-251/95, ECLI:EU:C:1997:528 (Sabèl), para. 24).

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

YES

If the earlier mark has a high distinctive character, either by nature or by reputation, it enjoys broader protection than trade marks with less distinctive character (CJEU 9 September 1998, C-39/97, EU:C:1998:442 (Canon), paras. 18, 24). This degree of distinctiveness is taken into account in the context of the global assessment of the likelihood of confusion (CJEU 23 January 2014, C-558/12 P, EU:C:2014:22 (WESTERN GOLD / WeserGold et al.), paras. 42-45): the more distinctive the earlier mark, the greater will be the likelihood of confusion (CJEU 11 November 1997, C-251/95, ECLI:EU:C:1997:528 (Puma/Sabel), para. 24).

In addition, the history and use status of the earlier mark can also be relevant in opposition proceedings in case a non-use argument is put forward by the defendant. The proprietor of the earlier mark then needs to provide evidence that his trademark was genuinely used for the relevant goods and services for the proprietor to be able to rely on the earlier mark for those goods and services in the opposition proceedings. If such evidence cannot be provided, the opposition will be rejected (Article 2.16bis BCIP in conjunction with Article 2.23bis(1) BCIP. See also Art. 47(2) EUTMR).

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

NO

(e) The industry field of the concerned marks.

YES

The nature of the consumer and of the goods and services determines the degree of attention of the consumer. The consumer is generally more attentive if the relevant goods or services are more expensive or have high technological character (CJEU 12 January 2006, C-361/04, ECLI:EU:C:2006:25 (Picasso/Picaro), para. 59 and CJEU 3 September 2009, C-498/07, ECLI:EU:C:2009:503 (La Española), paras. 74-76). Furthermore, if relevant goods or services are mainly directed at professional consumers, the relevant public will also have a higher than average level of attention, for example with pharmaceuticals (General Court 13 February 2007, T-256/04, ECLI:EU:T:2007:47 (Respicur), paras. 46-47 and Court of Appeal Amsterdam 23 February 2010, IEF 8613 (Solvay/Novartis). In such cases where the consumer can be said to be more sophisticated, the consumer will be more likely to notice differences between the marks than the average consumer, leading to the conclusion that the trade marks are less likely to being considered confusingly similar. In contrast, in case of everyday, rather low-priced consumer goods, such as socks or supermarket goods, the consumer will be generally less attentive and will be less likely to notice differences between the marks, resulting in the marks being considered confusingly similar sooner.

Moreover, the (degree of) similarity of the goods and services is an important factor. In assessing the similarity of goods or services all relevant factors relating to those goods or services should be taken into account, including, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (CJEU 9 September 1998, C-39/97, EU:C:1998:442 (Canon), para. 23). Additional factors are distribution channels, relevant public and the usual origin of the goods. By their nature, goods are generally dissimilar to services. They can, however, be complementary to or in competition with goods. Under certain circumstances similarities between goods and services can thus be found. However, in the opposition context, the goods and services shall be considered in the terms set out in the register and not the actual or intended use (General Court 16 June 2010, T-487/08, ECLI:EU:T:2010:237 (Kremezin), para. 71).

(f) The sophistication of the relevant public.

YES

See also under factor (e) above.

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

YES



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When the goods covered by the marks are sold in self-service stores where consumers remove the goods from the shelves themselves, and must therefore be able to rely primarily on the representation of the mark affixed to the product, visual similarity between the marks will generally be more important. However, if the goods are primarily sold orally, greater weight should be given to the phonetic similarity between the marks (General Court 15 December 2009, T-412/08, EU:T:2009:507 (Trubion), para. 40; and General Court 25 March 2009, T-109/07, EU:T:2009:81 (Spa Therapy), para. 30.).

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

NO

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

NO

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

NO

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

YES

Although the earlier trade mark as registered and the contested sign as applied for should be compared, the existence of several trade marks which share common characteristics allowing them to be considered as belonging to the same 'family' or 'series' of trade marks may be of influence. Likelihood of confusion can arise from the fact that the consumer may mistakenly believe that the later trade mark is part of the family or series of the earlier trade marks (CJEU 13 September 2007, C-234/06, ECLI:EU:C:2007:514 (Bainbridge/The Bridge), paras. 63-64). For this factor to be of influence, the proprietor of the earlier trade mark must show that there is a series of trade marks (at least three), and that the conflicting sign displays characteristics capable of associating it with the series.

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

NO

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

YES

- (n) Others, please clarify

YES

- **Co-existence of conflicting marks in the same territory:** two situations can be distinguished: (i) coexistence between the two marks involved in the opposition and (ii) coexistence with many similar marks used by competitors. In situation (ii) the coexistence may affect the scope of protection of the earlier mark as it may be considered less distinctive. In situation (i) the coexistence might contribute to diminishing the likelihood of confusion between them (CJEU 3 September 2009, C-498/07, ECLI:EU:C:2009:503 (La Española), para. 82). The Dutch Group, however, does note that there is a very high threshold to establish coexistence. Also, a coexistence agreement will be taken into account like any other circumstance, but these are not binding.
- **Evidence of actual confusion:** whether trade marks are conflicting is in principle a legal test and as such, establishing actual confusion is not required (General Court 24 November 2005, T-346/04, ECLI:EU:T:2005:420 (Arthur e Felice), para. 69). Nonetheless, as part of the global assessment of confusion, evidence of actual confusion could play a role in proving conflict between the trade marks.
- **Prior decisions by EU or national authorities:** although the BOIP and the EUIPO are not bound by earlier decisions or by decisions of other authorities in similar cases and although the Offices consider each case on its own merits, precedents are usually duly considered when presented.

7. What factors are considered when judging whether trade marks including nondistinctive 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:

When assessing similarity in infringement context, the likelihood of confusion is assessed in the same way as in opposition context (see the Dutch Group's answer to question 6). In addition, certain additional factors are taken into account, mostly relating to the actual use of the earlier mark or the infringing sign on the market.

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

NO

(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.

YES

See further the Dutch Group's answer under 6 above.

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

YES



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See further the Dutch Group's answer under 6 above.

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

NO

- (e) The industry field of the concerned marks.

YES

- (f) The sophistication of the relevant public.

YES

See further the Dutch Group's answer under 6 above.

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

YES

See further the Dutch Group's answer under 6 above.

In addition, in the infringement context, the earlier trade mark as registered is compared with the suspected infringing mark as used. However, the circumstance that the proprietor of the earlier trade mark uses its mark in practice in a particular color plays a role in the assessment of risk of confusion, even if the mark is not registered in that particular color (CJEU 18 July 2013, C-252/12, ECLI:EU:C:2013:497 (Specsavers), para. 41).

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

YES

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

YES

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

YES

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



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YES

See further the Dutch Group's answer under 6 above.

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

YES

For example, a series of infringing trade marks may increase the risk of confusion in the overall impression. Moreover, under the doctrine of the so-called aftereffect, there could be a higher likelihood of confusion if the holder of the later mark had already infringed the earlier mark by making use of a similar trade mark, of which the holder ceased the use and which he replaced with the later mark (Dutch Supreme Court 20 March 2001, ECLI:NL:HR:2001:AB0607, NJ 2002/37, para. 3.4).

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

YES

- (n) Others, please clarify

YES

See further the Dutch Group's answer under 6 above. In addition, as a part of the perception of the consumer post-sale confusion is also relevant in assessing a possible infringement.

8. 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.

YES

- (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



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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.

YES

(b) Yes, it is very straightforward.

(c) It depends on the nature of the earlier mark.

(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.

NO (NB: 'No' is a direct answer to the main question 8 regarding this scenario, we find the subquestion confusing)

(b) Yes, it is very straightforward.

(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.

NO (NB: 'No' is a direct answer to the main question 8 regarding this scenario, we find the subquestion confusing)

(b) Yes, it is very straightforward.

(c) It depends on the nature of all marks/signs.

(d) Other, please clarify



9. 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.

YES

(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.

YES

(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.

YES

The Dutch Group considers the current law and practice in the Benelux/EU as generally satisfactory, especially considering the fact that it is mainly based on EU case law applicable in all European Union Member states. In particular, the Dutch Group considers that current principles as set out in the answer under question 1 above strike a fair balance between the overall impression as the decisive factor as well as the weight that the public may attach to (non)distinctive and (non)dominant elements. These principles reflect how the public perceives signs in practice.



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The Dutch group is, however, of the opinion that the practice of some (lower) courts to completely disregard non-distinctive word elements of lower courts (see our answer to question 2 above) is not in compliance with the Benelux/EU principles that elements cannot be completely disregarded when assessing the similarity of trademarks based on their overall impression.

- 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 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.**

The Dutch Group considers the “disassembly” of sign to be undesirable, given that the perception of the signs by the average consumers plays a decisive role. The average consumer perceives signs as a whole without artificially dissecting those.

- 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.**

YES

The Dutch Group believes that the practice of lower courts that tend to attach more weight to points of similarity than to differences when comparing trademarks in an infringement context (see the Dutch group's answers under 5 above), is not in line with the law and the interpretation thereof by the European Court of Justice. The latter is the case because in the case law of the European Court of Justice the starting point in such a comparison is the overall impression a trademark makes on the consumer. The Dutch Group believes that attaching more weight to similarities than to differences is incompatible with this European Court of Justice starting point.

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.**

*If YES, please respond to the following questions **WITHOUT** regard to your Group's current law or practice.*

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

YES

In general, the Dutch Group believes that harmonisation would be desirable in trade mark legislation within the context of global international trade.



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:

- a) The “Anti-Dissection Rule” should be the only rule/principle.
- b) The “Rule of Dominant Feature” should be the only rule/principle.
- c) The “Anti-Dissection Rule” should be the main rule/principle.
- d) The “Rule of Dominant Feature” should be the main rule/principle.
- e) The “Anti-Dissection Rule” and “Rule of Dominant Feature” should be equally important rules/principles.
- f) Other, please clarify.

YES

The Dutch Group refers the principles as set out under answer under question 1 above, as the Dutch Group is of the opinion that harmonisation efforts should follow the EU example for the reason set out in the Dutch Group's answer to question 10 above.

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:

- a) Yes.
- b) Yes except where justified (please clarify when it would be justified).
- c) No.

YES

- d) Other, please clarify.

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.

YES.



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The Dutch Group refers to the answer under question 3 above, as the Dutch Group is of the opinion that harmonisation efforts should follow the EU example for the reason set out in the Dutch Group's answer to question 10 above.

- b) Yes, it should be possible in non-exceptional cases.
- c) No, it should not be possible.
- d) Other, please clarify.

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:

- a) Yes, the nature of non-distinctive elements should make a difference.
- b) No, the nature of non-distinctive elements should not make a difference.

YES

- c) Depends on the circumstances – please explain what those circumstances include.
- d) Other, please clarify.

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:

- a) There should be different factors to consider.
- b) The same factors should be considered.

The Dutch Group refers to the answer under question 5 above, as the Dutch Group is of the opinion that harmonisation efforts should follow the EU example for the reason set out in the Dutch Group's answer to question 10 above.

- c) Depends on the circumstances – please explain what those circumstances include.
- d) Other, please clarify.

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:



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

NO

- 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.

YES

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

YES

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

NO

- e) The industry field of the concerned marks.

YES

- f) The sophistication of the relevant public.

YES

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

YES

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

NO

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

NO

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

NO

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

YES



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l) The other marks of the later mark holder.

YES

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

YES

n) Others, please clarify.

YES

The Dutch Group refers to the additional factors set out under question 6, as the Dutch Group is of the opinion that harmonisation efforts should follow the EU example for the reason set out in the Dutch Group's answer to question 10 above.

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:

a) The nature of the non-distinctive elements.

NO

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.

YES

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

YES

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

NO

e) The industry field of the concerned marks.

YES

f) The sophistication of the relevant public.

YES



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

YES

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

YES

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

YES

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

YES

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

YES

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

YES

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

YES

- n) Others, please clarify.

YES

The Dutch Group refers to the answer under question 7, as the Dutch Group is of the opinion that harmonisation efforts should follow the EU example for the reason set out in the Dutch Group's answer to question 10 above.

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.

YES



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- b) Yes, it should be the case in all but exceptional situations.
- 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.

YES

- b) Yes, it should be the case in all but exceptional situations.
- 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.

YES

- b) Yes, the unregistered mark should be determined to be dissimilar in all but exceptional cases.
- 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 trade mark should definitely not be determined to be dissimilar.

YES



- b) Yes, the unregistered trade mark should be determined to be dissimilar in all but exceptional cases.
- c) Yes, the unregistered trade 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.
YES
- b) Yes, they should be determined to be similar in all but exceptional cases.
- c) Yes, they should be determined to be similar only in exceptional cases.
- 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, they should definitely not be determined to be similar.
YES
- b) Yes, they should be determined to be similar in all but exceptional cases.
- c) Yes, they should be determined to be similar only in exceptional cases.
- d) Other, please clarify.

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

The Dutch Group has no further comments on this matter.

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



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The questionnaire and its answers have been shared with representatives from large and small/medium sized companies.
