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COMBIT AND COMBI dissimilar because of different meanings? Yes says the German Federal Patent Court

Bettina Clefsen (b/cl IP) · Wednesday, August 2nd, 2017

Where the marks differ in only a single additional letter at the end of one of the marks, can the resulting similarity be “neutralized” by the conceptual differences? The German Federal Patent Court decided on 19 June 2017 that the opposing mark “Combit” and the attacked mark



were overall dissimilar and that, even if there was aural similarity, this was neutralized by the conceptual differences between the marks (decision in [Case 27 W \(pat\) 12/16](#)). A likelihood of confusion was therefore excluded, even with regard to identical services.

In an earlier decision, the same senate at the Federal Patent Court has confirmed likelihood of confusion between the two trademarks EAGLE and



(decision of 8 November 2011 in [Case 27 W \(pat\) 602/10](#)). In this decision the Federal Patent Court held that the signs were aurally very similar and also to certain extent conceptually similar. In its auxiliary considerations the Court stated that even if the signs were conceptually dissimilar, the conceptual dissimilarities were not able to neutralize the striking aural similarity. It cautioned in its decision that taking “neutralization” of similarities based on conceptual differences too far would result in a massive restriction of trademark protection, which was not desirable. Also in further decisions, the Federal Patent Court had expressed reservations towards the so-called neutralization doctrine (see for instance [Federal Patent Court of 13 February 2014 in Case 30 W \(pat\) 43/12](#)).

Knowing these earlier decisions, one actually wonders why a likelihood of confusion between the



signs “Combit” and was ruled out with regard to identical services. As pointed out initially, the Federal Patent Court even held that the signs were overall dissimilar by considering:

- The signs differed substantially when comparing them visually. It did not help the opponent that

its opposing mark was a word mark which could be used in any possible graphic representation: the Court still held that the coloring of the attacking mark and the way the letter “O” was embraced by the letter “C” made them visually dissimilar.

- The signs were also conceptually dissimilar, as the term “Combi” had a clear meaning for the German public (namely, an abbreviation for “combination”), which was not shared by the earlier mark “Combit”.
- The signs were also aurally sufficiently dissimilar. Although more emphasis is generally given to the beginning of the signs, the letter “t” at the end of the opposing mark would not be overheard.

In its auxiliary considerations, the Court held that even if the signs were aurally similar as argued by the opponent (and as had been found to be the case for “Eagle” and “Eaglet”), this similarity was neutralized by the clearly different meaning of “Combi”.

Certainly every case has to be decided on its own merits. But the level of aural similarity of “Combi” and “Combit” seems equally as high as that of “Eagle” and “Eaglet” (setting aside that the court had also accepted a certain level of conceptual similarity between “eagle” and “eaglet” which was, however, not taken into account in its auxiliary considerations).

Both cases show therefore that it is sometimes very hard to predict which level of overall (visual or aural) similarity is required to rule out a “neutralization” based on conceptual differences.

Most likely there will not be another word by the Federal Supreme Court on this opposition, as the Federal Patent Court did not allow the further appeal to the Federal Supreme Court, and while a complaint can be lodged with the Federal Supreme Court to obtain leave to appeal, chances of that being granted are rather limited.

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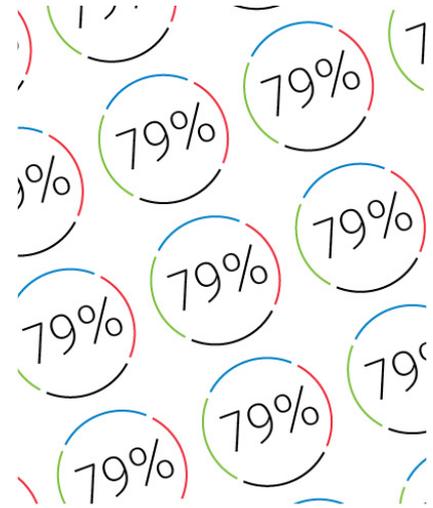
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