

Should different meanings outweigh the similarities of non-distinctive elements?

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In our view they should, but the General Court held otherwise on January 27, 2021 in Case T-817/19, basically finding that coincidence in a non-distinctive element will still lead to a finding of likelihood of confusion.

OmniVision GmbH, owner of an EUTM “HYLO-VISION” registered, among others, for medical preparations, filed an opposition against the EUTM application “HYDROVISION” (figurative) of Olimp Laboratories sp. z o.o, designating, among others, pharmaceutical products, including those for eye diseases.

HYLO-VISION

vs

Hydrovision

The Opposition Division found a likelihood of confusion and the Board of Appeal (BOA) confirmed. The BOA considered that that the element ‘vision’ in the marks at issue and the element ‘hydro’ in the mark applied for had a weak distinctive character in relation to the goods in question, while the element ‘hylo’ of the

earlier mark was distinctive in relation to those goods; then it held that the two signs as a whole were visually similar to an average degree, phonetically highly similar and that, conceptually, either they were partially similar or the conceptual comparison was neutral.

Olimp Laboratories' application to the GC was unsuccessful. The GC agreed with the BOA that the element 'vision', common to the marks at issue, had a weak distinctive character; it also agreed that the prefix 'hydro' had a weak distinctive character as it would be perceived by the relevant public as referring to water and, as such, to characteristics of the goods in question, namely providing moisture for the eyes. Finally, the GC held that HYLO was distinctive.

Consequently, the GC found that the signs in question differed conceptually as a result of the presence of the prefixes 'hylo' and 'hydro', although they were, for the part of the relevant public which understands the term 'vision', conceptually similar in part. The applicant argued and the GC agreed that, in principle, consumers tend to focus more on the first element of a mark. Nonetheless, in an overall assessment, the GC found that the visual and aural similarity of the signs was very high, not least because of the identical endings 'vision'. This, in conjunction with the identity between the goods, would lead to a likelihood of confusion. The differences between the initial elements 'hylo' and 'hydro' were not capable of avoiding confusion.

This line of reasoning, however, appears somewhat inconsistent with the CJEU case law.

Taken on their own, it is highly debatable whether HYLO and HYDRO would ever be considered confusingly similar (even visually) only on account of the initial "HY" and the final "O". This is mainly because the conceptual meaning of HYDRO is clear and specific (to use the CJEU words) so that it can be grasped immediately by the relevant public, and thus the conceptual difference between HYDRO and HYLO "may counteract the visual and phonetic similarities between them" (see last C-449/18 P and C-474/18 P – MESSI, at § 85), even assuming these visual and phonetic similarities existed in the first place. However, the addition of a term like VISION, that the same GC acknowledges to be weak and descriptive, changes the equation and the overall assessment on confusion.

Although this not the first time where EU courts find a likelihood of confusion on account of weak elements (here commented "*EU: Pharmaceutical and cosmetic trademarks - confusion on account of weak elements*"), this decision is remarkable because the earlier mark was composed by an assumedly distinctive component (HYLO) and generally speaking, when marks share an element with a low (or no) degree of distinctiveness, the assessment of likelihood of confusion should focus on the impact of the non-coinciding components on the overall impression of the marks (cf. Common Practice CP5). So while it is true that in the overall assessment the marks must be considered as a "whole", disregarding only negligible elements, this case would seem to indicate that for signs which happen to share the same length and pattern, the "value" of common non-distinctive/weak/descriptive components is greater than that of the distinctive elements. That, is not entirely convincing, although it is not new in Luxembourg's wisdom.