

EU Trade Mark Regulation (EUTMR)

Hildebrandt / Sosnitza

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to be understood as the geographical origin, but rather exclusively the operational origin in the sense of the organisational and control unit behind the trade mark.⁷⁵

The likelihood of confusion must be **appreciated globally**, taking into account all 37 factors relevant to the circumstances of the case.⁷⁶ Mandatory cumulative requirements are the identity or similarity of the signs and the identity or similarity of the products.⁷⁷ Thus, if the signs in question are not similar – for example “Miele” and “AEG” – a likelihood of confusion is ruled out from the outset, without it being necessary to examine the similarity of the products.⁷⁸ The same applies if the signs are similar but not the labelled products – such as oil tankers and seeds.⁷⁹

In addition to similarity of signs and products, the **distinctiveness**⁸⁰ of the earlier 38 trade mark, ie its inherent distinctiveness⁸¹ as well as any reputation acquired through use,⁸² is the third significant factor in assessing the likelihood of confusion.⁸³ A high degree of distinctiveness extends the scope of protection of a trade mark.⁸⁴ However, a certain distinctiveness is not a mandatory requirement.⁸⁵

⁷⁵ CJEU 29 September 1998 – C-39/97 mn. 29 f. – Canon, with reference to CJEU 11 November 1997 – C-251/95 mn. 16–18 – Sabèl; also CJEU 22 June 1999 – C-342/97 mn. 16–18 – Lloyd Schuhfabrik Meyer; 6 October 2005 – C-120/04 mn. 26 – Medion; 26 April 2007 – C-412/05 P mn. 55 – Alcon; 12 June 2007 – C-334/05 P mn. 33 – HABM/Shaker; 20 September 2007 – C-193/06 P mn. 32 – Nestlé/HABM; 24 June 2010 – C-51/09 P mn. 31 – Barbara Becker; 25 March 2010 – C-278/08 mn. 38 – BergSpechte; 8 July 2010 – C-558/08 mn. 51 – Portakabin; 16 September 2010 – C-559/08 P mn. 74 – Rajani; 7 May 2015 – C-343/14 P mn. 31 – Adler Modemärkte; 3 June 2015 – C-142/14 P mn. 102 – Sunrider; 19 November 2015 – C-190/15 P mn. 38 – Fetim; GC 23 October 2002 – T-104/01 mn. 25 – Miss Fifties/Fifties; see EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.8.

⁷⁶ Constant case law, eg: CJEU 11 November 1997 – C-251/95 mn. 22 – Sabèl; 29 September 1998 – C-39/97 mn. 15 and 16 and 24 – Canon; 22 June 1999 – C-342/97 mn. 18 – Lloyd Schuhfabrik Meyer; 22 June 2000 – C-425/98 mn. 40 – Marca/Adidas; 28 April 2004 – C-3/03 P mn. 28 – Matratzen Concord; 6 October 2005 – C-120/04 mn. 27 – Medion; 12 January 2006 – C-361/04 P mn. 18 – Picasso; 23 March 2006 – C-206/04 P mn. 18 – Muelhens; 27 April 2006 – C-235/05 P mn. 34 – L’Oréal; 12 June 2007 – C-334/05 P mn. 34 – HABM/Shaker; 24 June 2010 – C-51/09 P mn. 32 – Barbara Becker; 2 September 2010 – C-254/09 P mn. 44 – Calvin Klein; 18 July 2013 – C-252/12 mn. 34 – Specsavers; 20 July 2017 – C-93/16 mn. 40 – Ornu Co-operative; also GC 23 October 2002 – T-104/01 mn. 26 – Miss Fifties/Fifties; BGH GRUR 2000, 506 (508) – ATTACHÉ/TISSERAND.

⁷⁷ Constant case law, eg: CJEU 12 October 2004 – C-106/03 P mn. 51 – SAINT-HUBERT 41/HUBERT; 6 October 2005 – C-120/04 mn. 25 – Medion; 13 September 2007 – C-234/06 P mn. 48 – Il Ponte Finanziaria; 18 December 2008 – C-16/06 P mn. 44 – René; 7 May 2009 – C-398/07 P mn. 34 – Waterford Wedgwood; 4 March 2010 – C-193/09 P mn. 43 – Kaul; 3 June 2015 – C-142/14 P mn. 108 – Sunrider; previously already GC 12 December 2002 – T-110/01 mn. 65 – SAINT-HUBERT 41/HUBERT; 14 October 2003 – T-292/01 mn. 56 – PASH/BASS; 22 October 2003 – T-311/01 mn. 59 ff. – ASTERIX/Starix; BGH GRUR 1999, 245 – LIBERO; GRUR 2002, 340 – Fabergé; GRUR 2003, 428 (431) – BIG BERTHA.

⁷⁸ See CJEU 4 March 2010 – C-193/09 P mn. 44 – Kaul; 2 September 2010 – C-254/09 P mn. 53 – Calvin Klein; 27 October 2010 – C-342/09 P mn. 25 – Victor Guedes; 14 March 2011 – C-370/10 P mn. 51 – Ravensburger; 24 March 2011 – C-552/09 P mn. 65 f. – FERRERO; 23 January 2014 – C-558/12 P mn. 42 – HABM/riha WeserGold Getränke.

⁷⁹ See CJEU 7 May 2009 – C-398/07 P mn. 35 – Waterford Wedgwood.

⁸⁰ On distinctiveness see → mn. 210 ff.

⁸¹ On the concept of distinctive character see → § 4 mn. 52–162.

⁸² On obtaining distinctive character through use → § 4 mn. 145–162.

⁸³ Thus already the 16th recital of the TMD; constant case law, eg: CJEU 29 September 1998 – C-39/97 mn. 19 – Canon; 22 June 1999 – C-342/97 mn. 21 – Lloyd Schuhfabrik Meyer; 22 June 2000 – C-425/98 mn. 40 f. – Marca/Adidas; 12 January 2006 – C-361/04 P mn. 18 – Picasso; 15 March 2007 – C-171/06 P mn. 31 – T. I. M.E. ART; 11 September 2007 – C-225/06 P mn. 16 – AVEE; 17 April 2008 – C-108/07 P mn. 32 f. – Ferrero; 18 December 2008 – C-16/06 P mn. 64 – René; 18 July 2013 – C-252/12 mn. 36 – Specsavers; 17 February 2016 – C-396/15 P mn. 74 – Shoe Branding Europe.

⁸⁴ CJEU 17 April 2008 – C-108/07 P mn. 32 with further references – Ferrero; 18 July 2013 – C-252/12 mn. 36 – Specsavers; 17 February 2016 – C-396/15 P mn. 74 – Shoe Branding Europe.

⁸⁵ GC 1 March 2005 – T-185/03 mn. 60 – ANTONIO FUSCO/ENZO FUSCO; 15 March 2006 – T-35/04 mn. 70 – FERRERO/FERRÓ, confirmed by CJEU 11 September 2007 – C-225/06 P – AVEE.

- 39 The likelihood of confusion must **actually be established** and may not be presumed on the basis of certain circumstantial evidence.⁸⁶ However, it should also be noted in this respect that it is a case of endangering: It is sufficient that there is a likelihood of confusion without actually having to prove a concrete confusion.⁸⁷

2. Types of likelihood of confusion

- 40 Likelihood of confusion is assumed in two situations:
- The public **directly confuses** the two trade marks, thus mistaking one for the other.
 - Or the public is able to distinguish the trade marks but assumes that the goods or services in question come from the same undertaking or from economically-linked undertakings.⁸⁸
- 41 For the second group of cases, the CJEU adopted the term “likelihood of association” used in Art. 8(1)(b), although it is actually rather a **“likelihood of a presumption of economic association”**. The background to this acrobatics of terminology is that the CJEU did not want to include the “likelihood of association”, ie the mere association⁸⁹ of two trade marks.⁹⁰ This would unduly extend the scope of protection of trade marks and make it unnecessarily difficult for new trade marks to enter the market in a densely populated trade mark environment in a large market such as the EU.
- 42 The protection against the presumption of an economic connection is justified. Trade mark law essentially protects the company’s function of origin. It is not the local origin that is protected, but the possibility of a company to control the **use of a sign and thus the marked products**. Such control may exist, for example, in the case of companies belonging to the same group of companies, or in the case of licensing, sales promotion and distribution agreements, as well as in any situation where the public believes that the use of the trade mark implies the consent of the trade mark proprietor.⁹¹ If the public therefore assumes such a constellation on the basis of certain similarities between the trade marks, the proprietor of the earlier trade mark must solely be granted the possibility of control.

3. Subjective concept of likelihood of confusion

- 43 The concept of likelihood of confusion is complex. It can hardly be decided or predicted with any degree of precision. The practice of adjudication reveals considerable deviations. Findings from psychological decision theory and from recent brain research suggest that quite different aspects could play a role than the elements of the offence established by the CJEU. In particular, it is now recognised that **decision-makers unconsciously simplify complex issues**. The simplified questions that run will perhaps be “Would I confuse the trade marks if I were not quite so clever?” or “Does the trade mark proprietor really mind the conflicting sign?” or – even simpler and probably

⁸⁶ CJEU 22 June 2000 – C-425/98 mn. 34 – Marca/Adidas; BGH GRUR 2002, 544 (547) – BANK 24.

⁸⁷ GC 15 January 2003 – T-99/01 mn. 48 – Mystery/Mixery; 6 October 2004 – T-117/03 bis T-119/03 and T-171/03 mn. 52 – NL.

⁸⁸ EUIPO Guidelines Part C Section 2 Chapter 1 no. 3.1.

⁸⁹ This approach originated in the constant case law of the Benelux countries and was applied, inter alia, to unknown trade marks.

⁹⁰ CJEU 11 November 1997 – C-251/95 mn. 18 ff. and 26 – Sabèl; 22 June 1999 – C-342/97 mn. 17 – Lloyd Schuhfabrik Meyer; 22 June 2000 – C-425/98 mn. 34 – Marca/Adidas; 22 March 2012 – C-354/11 P mn. 79 – Emram; 17 September 2015 – C-548/14 P mn. 44 – Arnoldo Mondadori Editore; also GC 16 May 2007 – T-158/05 mn. 84 – TREK/ALLTREK; BGH 11 April 2013 – I ZR 214/11 mn. 45 – VOLKSWAGEN/VolksInspektion.

⁹¹ CJEU 22 June 1994 – C-9/93 mn. 37 – Ideal Standard.

closest to the unconscious processes – “Do I think it is right for the trade mark proprietor to seek injunctive relief?”

In summary, the decision is made in two steps: The actual decision is not made consciously. And the complexity of the question being asked is reduced. Against this background, the following points are discussed, which may be decisive for the assessment of the likelihood of confusion beyond the official **criteria** of the CJEU:

- Does the decision-maker know the attack mark? If so, the decision-maker will tend to grant it a reputation or at least a large scope of protection.
- Does the decision-maker like the offensive mark? Then he will be more inclined to ban third party marks from the environment.
- Does he like the attacker? Then he will be more likely to affirm the attacker’s need for protection.
- Is the violator sympathetic? In this case, the infringer must be protected from being overburdened with too extensive claims.
- Was the infringer acting in good faith at the time of the commencement of use?⁹² If the infringer did not know or even could not have known of the counter-sign, then he has fallen into the mills of justice through no fault of his own and is to be treated leniently.
- Who is the decision-maker? If the decision-maker belongs to the targeted public, he is all the more likely to base his decision on his own understanding of the facts.
- Does the decision-maker have expertise? Experienced decision-makers regularly have more courage for extreme decisions.
- How high is the decision density, ie approximately how many decisions does the decision-maker make annually? Those who decide many cases regularly make decisions with greater consistency.
- Has real damage been done? Real damage – unlike fictitious damage – must be compensated.
- Who loses more? Every good judgement tries to keep the overall social damage as low as possible.
- Is the product concerned likeable? Likeable products are more likely to encourage the decision-maker to attempt rescue.
- Is the infringer dependent on the trademark or is it just nice to have? If the infringer can easily do without the trade mark, the injunctive relief is less consequential and therefore easier to obtain.
- Is there sympathy with the pleadings? Pleasant, easy to read, brief pleadings will encourage the reader to follow the contents of the pleadings.

All these factors are likely – sometimes to a greater or lesser extent – to take precedence over the normative elements of the likelihood of confusion. Ultimately, we are therefore likely to be dealing with a “**subjective concept of likelihood of confusion**”. In practice, they are often more suitable for determining the scope of protection of a trade mark than the “official” constituent elements or the “official” examination procedure.⁹³

4. Order of examination of the EUIPO

The CJEU has derived certain points of examination and a **certain order of examination** for the examination of the likelihood of confusion from the case law of

⁹² See the results obtained during numerous interviews of judges at *Visser*, *Beslissen in IE-zaken*, *Nederlands Juristenblad* 2008, 1924 f.

⁹³ See *Hildebrandt* § 12 mn. 13.

the CJEU. The Office consistently adheres to this order. The national courts of the Member States generally take the same criteria into account, but often in a different order. This alone occasionally leads to different results.

- 46 The EUIPO assesses the likelihood of confusion taking into account several factors in the following steps:
- Comparison of goods and services
 - Relevant public – degree of attention
 - Comparison of the signs
 - Distinctiveness of the earlier trade mark
 - Other factors
 - Comprehensive assessment of likelihood of confusion.⁹⁴
- The following commentary is based on this order.

5. Comparison of goods and services

- 47 a) **Overview.** The first **indispensable**⁹⁵ **prerequisite** for the likelihood of confusion – besides the identity or similarity of the signs – is the identity⁹⁶ or similarity of the goods and services (product similarity).
- 48 Since the Canon decision of the CJEU, **all significant factors** identifying the relationship between the products must be taken into account when assessing the similarity of the products concerned. These factors include in particular
- their Art,
 - purpose and
 - use, and
 - their distinctiveness as competing or complementary goods or services.⁹⁷
- 49 The use of the word “in particular” indicates that the **list is only exemplary** and not exhaustive. Other criteria – not mentioned in the Canon decision, but generally accepted – are
- the question of coinciding or diverging distribution channels of the products in question, and
 - the usual origin of the products.⁹⁸
 - In addition, as always when examining the likelihood of confusion, the relevant public must of course be taken into account.
- 50 The **EUIPO Guidelines**⁹⁹ translate the Canon factors into specific questions:
- How are the goods/services used?
 - What is their purpose?
 - How likely are they to have the same manufacturer?
 - Are they commonly found in the same retail outlets, department stores or super-market section?

⁹⁴ EUIPO Guidelines Part C Section 2 Chapter 1 no. 4.2.

⁹⁵ On this subject → mn. 37.

⁹⁶ On this subject → mn. 23 ff.

⁹⁷ CJEU 29 September 1998 – C-39/97 mn. 23 – Canon; 11 May 2006 – C-416/04 P mn. 85 – The Sunrider; 9 March 2007 – C-196/06 P mn. 28 – Alecansan/HABM; 26 April 2007 – C-412/05 P mn. 72 – Alcon; 18 December 2008 – C-16/06 P mn. 65 – René; 3 June 2009 – C-394/08 P mn. 60 – Zipcar; 3 June 2015 – C-142/14 P mn. 118 – Sunrider; 21 January 2016 – C-50/15 P mn. 21 – Hesse; 14 April 2016 – C-480/15 P mn. 69 – KS Sports IPCo; 20 September 2017 – C-673/15 P bis C-676/15 P mn. 48 – The Tea Board; also GC 23 October 2002 – T-104/01 mn. 31 – Miss Fifties/Fifties; BGH GRUR 1999, 496 – TIFFANY; EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.1.1.

⁹⁸ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.1.1.

⁹⁹ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.1.2.

The examination as to the similarity of the products shall, in principle, be based on the **registered list**.¹⁰⁰ If the language versions of the list of goods of an EU trade mark differ, the wording in the language of the Office in which the EU trade mark application was filed is decisive. If the application was filed in a language which is not an official language, the wording in the second language indicated by the applicant is authentic (Art. 147(3)).¹⁰¹ Only if the use of the opposing mark has to be proven, partial non-use, if any, has to be taken into account.¹⁰² Specific marketing concepts or marketing restrictions of the specific trade mark proprietors are irrelevant as long as the restrictions are not expressed in the list.¹⁰³

However, especially in the case of **broad generic terms** in the list of goods and services,¹⁰⁴ the GC does not want to let insignificant differences between the respective products suffice. Thus, the “organisation of sporting competitions” is not similar to various goods and services related to motor vehicles, despite the fact that the sporting competitions may be car races.¹⁰⁵ Nor is the fact that manufacturers of vehicles may occasionally also produce prams sufficient to establish similarity between the products.¹⁰⁶

Often, before the examination of product similarity, it must first be clarified what is actually meant by the **phrases in the list of goods and services**. In this respect, dictionaries are helpful. However, dictionary entries must be examined against the background of the reality in trade and, above all, taking into account the systematics of the Nice Classification.¹⁰⁷ In this respect, the EUIPO Guidelines¹⁰⁸ provide the illustrative example of “ice” and “ices”. The terms appear identical at first glance. Only the analysis of the Nice Classification shows that “cooling ice” is meant in one case and “ice cream” in the other. Otherwise, the coexistence of both terms in the classification would be meaningless.

However, the **Nice Classification should not be overrated**. The classification plays no direct role in the question of product similarity, but serves exclusively administrative purposes. Products cannot therefore be considered similar or dissimilar merely on the basis of their class (Art. 9(2) TLT; Art. 39(7) TMD; Art. 33(7)).¹⁰⁹

b) Nature of the goods or services. The CJEU has not yet elaborated on the concept of the “scope of the goods or services”. The EUIPO Guidelines¹¹⁰ **define** the term as the

¹⁰⁰ For instance GC 7 September 2006 – T-133/05 mn. 30 f. – PAM-PAM/PAM-PIM’S BABY-PROP; also GC 8 September 2008 – T-373/06 mn. 36 – EPIGRAN/Epican Forte; 8 September 2008 – T-374/06 mn. 36 – EPIGRAN/Epican, both confirmed in the result by CJEU 4 December 2009 – C-488/08 P and C-489/08 P – Rath.

¹⁰¹ Also *Pohlmann* § 10 mn. 45.

¹⁰² See on this subject → Art. 47 mn. 132.

¹⁰³ GC 25 November 2003 – T-286/02 mn. 29 ff. – MOU/KIAP MOU; 30 June 2004 – T-317/01 mn. 58 – EURODATA TV/M+M EURODATA; 13 April 2005 – T-286/03 mn. 33 – WILKINSON SWORD XTREME III/RIGHT GUARD XTREME SPORT; 24 November 2005 – T-346/04 mn. 35 – Arthur/ARTHUR ET FELICIE; also BGH 2 February 2012 – I ZR 50/11 mn. 24 – Bogner B/Barbie B; 17 November 2014 – I ZR 114/13 mn. 21 – PINAR; to the indication “intended for export only” in the list of goods: BGHZ 34, 1 – Chérie.

¹⁰⁴ On the broadness of the term “affairs”, for example in “real estate affairs”: GC 17 September 2008 – T-10/07 mn. 41 – FVD/FVB.

¹⁰⁵ GC 15 March 2006 – T-31/04 mn. 33 ff. – EUROMASTER.

¹⁰⁶ GC 28 October 2015 – T-576/13 mn. 43 – Verus.

¹⁰⁷ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.1.2.

¹⁰⁸ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.1.2.

¹⁰⁹ GC 30 June 2004 – T-317/01 mn. 64 – EURODATA TV/M+M EURODATA; 13 December 2004 – T-8/03 mn. 40 – EMIDIO TUCCI/EMILIO PUCCI; 16 May 2007 – T-158/05 mn. 61 – TREK/ALLTREK; 4 June 2014 – T-161/12 mn. 35 – FreeLounge/free LA LIBERTÉ N’ A PAS DER PRIX.

¹¹⁰ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.1.

essential qualities or characteristics by which that good or service is recognised. The nature often corresponds to a particular type or variety of product or service, or to a particular category to which that product belongs. Ultimately, the question is “What is it?”

- 56 Often, determining the scope of the goods or services will involve finding out which **generic term** the product falls under. For example, a cap is a head covering. Products that fall under a common heading are not automatically similar; for example, fresh fruit and coffee are dissimilar, although both can be grouped together as foodstuffs.¹¹¹ Only in the case of a rather narrow generic term can it be presumed that the products are similar; this applies, for example, to cheese and condensed milk, which are both dairy products,¹¹² or to transport services by taxi or bus.¹¹³
- 57 In determining the nature of a good, the **materials** of which the product is made – such as in the previous example of dairy products – may also play a role.¹¹⁴ But even identical materials are not a compelling indication because, for example, completely different products can be manufactured from plastic.¹¹⁵
- 58 Furthermore, in determining the nature of a good or service, **the way in which it functions** may be relevant. For example, motor vehicles and pedal boats are both vehicles, but differ in the way they operate with respect to their propulsion. On the other hand, a similar mode of operation does not automatically lead to products being similar any more than a different mode of operation would automatically lead to dissimilarity.¹¹⁶ Industrial lighting devices and Christmas tree lights, for example, are fundamentally based on the same technology, but are nonetheless dissimilar.¹¹⁷
- 59 Finally, in determining the art of a commodity, its **state of aggregation** can play a role, but is less informative. For example, unlike solid foods, beverages are always liquid; yet dissimilar beverages exist, such as milk and whiskey, but so do similar liquid and solid foods, such as different types of yoghurt.¹¹⁸
- 60 **Goods on the one hand and services on the other** are always dissimilar in nature. This is because goods are of a material nature and are regularly marketed by means of transfer of ownership, whereas services are provided as intangible services.¹¹⁹ However, they may exceptionally be similar on the basis of criteria other than their nature.¹²⁰
- 61 c) **Intended use.** The EUIPO¹²¹ defines intended use as the reason for which something is made or created or for which it exists. In the context of product comparison, the intended use of the products must be taken into account and not every other conceivable use. The intended use is often not obvious at first sight; for example, vinegar is a “condiment” rather than a “foodstuff for human consumption”.¹²² On the other hand, an example of similarity due to coinciding intended use are creams for skin protection on the one hand and food supplements on the other hand, which may have the same medicinal effect.¹²³ Motorbikes and bicycles and their accessories are also slightly similar.¹²⁴

¹¹¹ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.1.1.

¹¹² See GC 4 November 2003 – T-85/02 mn. 33 – Castillo.

¹¹³ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.1.3.

¹¹⁴ See GC 4 November 2003 – T-85/02 mn. 33 – Castillo.

¹¹⁵ See EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.1.2.

¹¹⁶ See EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.1.2, with further examples.

¹¹⁷ GC 19 March 2019 – T-133/18 mn. 39 ff. – Lumix/Lumiqs.

¹¹⁸ See EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.1.2.

¹¹⁹ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.1.4.

¹²⁰ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.3.3.

¹²¹ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.2, with examples.

¹²² EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.2.

¹²³ GC 28 May 2020 – T-724/18 mn. 58 ff. – AUREA/AUREA BIOLABS.

¹²⁴ GC 14 May 2019 – T-12/18 mn. 27 ff. – TRIUMPF/Triumph.

d) Method of use. The criterion of “method of use” essentially corresponds to “intended use”. In addition, however, it also covers the type of use of the products in question and is thus somewhat broader. However, this is hardly likely to establish product similarity on its own. In this respect, the EUIPO Guidelines¹²⁵ give the illustrative example of chewing gum and chewing tobacco, which are used in the same way, but are decidedly dissimilar.

e) Complementarity. With the criterion of complementarity in the sense of a functional addition, the CJEU has **considerably expanded the concept of product similarity**. The criterion of functional complementarity is an independent group of cases on which similarity can be based.¹²⁶ Nevertheless, it should not be overrated.¹²⁷ Complementarity regularly only leads to similarity if other factors are also present.¹²⁸ For example, teaching materials and courses¹²⁹ or the services of an architect and construction¹³⁰ are similar because they are each not only complementary but are also directed at the same public and often come from the same supplier.

Products are complementary if there is a **close relationship** between them in the sense that one is **indispensable or at least important** for the use of the other in such a way as to give consumers the impression that the production of those goods or the supply of those services is carried out by the same undertaking.¹³¹ Ultimately, then, it is again a question of public assuming a uniform place of origin in any case. This is likely to be the case in the relationship between network hardware and software.¹³² “Beverages” and “Business management in the beverage sector”, on the other hand, are not similar.¹³³

Products intended for **different publics** cannot automatically be complementary.¹³⁴ Complementarity is precisely about the fact that the same public uses the products together.¹³⁵

For complementarity, it is **not sufficient** if products are **used together** intentionally or for convenience without being truly interdependent.¹³⁶ For example, the mere fact that a product can be used as a part, accessory or component of another product is not sufficient to prove that the end products containing such components are similar. The nature, intended use and customers of the products may be different.¹³⁷ For example, wine on the one hand and wine glasses on the other are not similar, even though wine and glasses are occasionally sold together in gift packs, because the public does not

¹²⁵ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.3.

¹²⁶ CJEU 21 January 2016 – C-50/15 P mn. 23 – Hesse.

¹²⁷ See CJEU 7 May 2009 – C-398/07 P mn. 45 – Waterford Wedgwood; also BGH 6 November 2013 – I ZB 63/12 mn. 16 – DESPERADOS/DESPERADO.

¹²⁸ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.4.

¹²⁹ GC T-388/00 of 23/10/2002 – ELS.

¹³⁰ GC 9 April 2014 – T-144/12 mn. 65 ff. – Comsa/COMSA S.A.

¹³¹ GC 11 May 2011 – T-74/10 mn. 40 – Flaco; 21 November 2012 – T-558/11 mn. 25 – Artis; 4 February 2013 – T-504/11 mn. 44 – Dignitude; EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.4.

¹³² Other opinion: GC 26 March 2020 – T-312/19 mn. 28 ff. – CHAMELEON/CHAMELEON.

¹³³ GC 12 March 2020 – T-296/19 mn. 38 ff. – Sumol/SUMO11.

¹³⁴ See GC 11 May 2011 – T-74/10 mn. 40 – Flaco; 22 June 2011 – T-76/09 mn. 30 – Farma Mundi Farmaceuticos Mundi; EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.3.1.

¹³⁵ GC 22 June 2011 – T-76/09 mn. 30 – Farma Mundi Farmaceuticos Mundi; 12 July 2012 – T-361/11 mn. 48 – Dolphin.

¹³⁶ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.4.1 and 3.2.4.2, with further examples.

¹³⁷ GC 27 October 2005 – T-336/03 mn. 61 – OBELIX/MOBILIX, confirmed in the result by CJEU 18 December 2008 – C-16/06 P – René; however, different with regard to computer elements GC 15 November 2007 – T-38/04 mn. 32 – SUN/SUNPLUS, confirmed in the result by CJEU 26 March 2009 – C-21/08 P – Sunplus Technology.

inevitably assume that the two goods come from the same manufacturer.¹³⁸ Similarly, dietary herbal supplements are not essential or important for the use of beer or soft drinks and thus not similar.¹³⁹ After all, there are beers to which coffee or tea is added; but that does not make the products similar.¹⁴⁰

- 67 In the case of certain goods, case-law exceptionally considers **aesthetic complementarity** conceivable if the goods are aesthetically coordinated with each other.¹⁴¹ For example, handbags and clothing, while not functionally complementary, are often design-matched. They are similar because they may also be distributed by the same or related manufacturers, bought by the same public and found in the same shops.¹⁴²
- 68 **Raw materials** and the goods manufactured from them are complementary, but this alone does not make them similar;¹⁴³ however, similarity may exist for other reasons.¹⁴⁴ The situation is different for **semi-finished products** and the end products, where a similarity is regularly to be affirmed.¹⁴⁵ Similar are, for example, motor vehicles on the one hand and sports cars in kit form on the other.¹⁴⁶
- 69 **f) Competitive relationship.** According to the EUIPO Guidelines,¹⁴⁷ products are **in competition with each other** if one can replace the other; this is the case, for example, with wallpaper and paint, but also with computers and smartphones.¹⁴⁸ This means that they serve the same or a similar purpose and are offered to the same actual and potential customers. If products are in competition with each other, they are necessarily interchangeable.¹⁴⁹
- 70 **g) Origin and sales channels.** Although the criteria of common origin and common sales channels are not mentioned in the Canon decision,¹⁵⁰ they are regularly **taken into account by the case law.**¹⁵¹ A common distribution channel can be an indication of a common origin from one and the same undertaking.¹⁵²
- 71 In this context, the examination of the “distribution channel” is less concerned with the intermediary trade or the distribution system, but rather with the **place of distribu-**

¹³⁸ GC 12 June 2007 – T-105/05 mn. 31 ff. – Assembled Investments, confirmed in the result by CJEU 7 May 2009 – C-398/07 P – Waterford Wedgwood.

¹³⁹ GC 23 January 2014 – T-221/12 mn. 84 – Sun Fresh.

¹⁴⁰ GC 12 December 2019 – T-648/18 mn. 37 f. – CRISTAL/Crystal.

¹⁴¹ GC 11 July 2007 – T-443/05 mn. 49 f. – Pirañam, carefully GC 1 March 2005 – T-169/03 mn. 62 – Sissi Rossi; 11 July 2007 – T-150/04 mn. 35 ff. – Tosca Blu; 20 October 2011 – T-214/09 mn. 32 ff. – COR II.

¹⁴² GC 11 July 2007 – T-443/05 mn. 49 f. – Pirañam; EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.4.1; see, however, GC 1 March 2005 – T-169/03 mn. 62 ff. – Sissi Rossi.

¹⁴³ On leather and leather goods: GC 25 June 2020 – T-114/19 mn. 47 ff. – b/B; on fabrics and clothing/shoes: GC 15 October 2020 – T-788/19 mn. 44 ff. – ATTACK/Sakkattack.

¹⁴⁴ See GC 9 April 2014 – T-288/12 mn. 39 – Zytel; EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.4.3.

¹⁴⁵ See GC 17 April 2008 – T-389/03 mn. 64 ff. – Pelikan; 10 September 2008 – T-243/06 mn. 35 – PROMA/PROMAT [to furniture and furniture doors]; EUIPO Guidelines Part C Section 2 Chapter 2 no. 4.3.

¹⁴⁶ GC 18 October 2018 – T-109/17 – VIPER/VIPER.

¹⁴⁷ EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.5, with numerous examples.

¹⁴⁸ GC 18 November 2020 – T-21/20 mn. 48 ff. – k7/K7.

¹⁴⁹ GC 4 February 2013 – T-504–11 mn. 42 – Dignitude.

¹⁵⁰ CJEU 29 September 1998 – C-39/97 mn. 23 – Canon.

¹⁵¹ For instance GC 21 April 2005 – T-164/03 mn. 53 – monBébé; also BGH GRUR 1999, 496 (497 f.) – TIFFANY; GRUR 2001, 507 (508) – EVIAN/REVIAN; BGH 30 March 2006 – I ZR 96/03 mn. 13 – TOSCA BLUE; 14 January 2016 – I ZB 56/14 – BioGourmet; EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.6 and 3.2.8.

¹⁵² See EUIPO Guidelines Part C Section 2 Chapter 2 no. 3.2.6.