

Study Guidelines

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2024 – Study Question

Conflicts between composite trademarks including non-distinctive elements

Introduction

- 1) A composite trade mark refers to a trade mark which is a combination of various types of constituent elements, such as words, numbers, devices, colours, sound, video, etc., or a trade mark, though consisting of a same type of elements, elements of which include both distinctive and non-distinctive elements.
- 2) Non-distinctive elements of a trade mark could include generic names, shapes of the designated goods themselves or their containers, terms descriptive of the characteristics of the designated goods/services (such as quality, quantity, value, purpose, provenance, etc.), terms/images commonly used in the trade for those goods/services, and so on.
- 3) Exclusive rights should not be given to a trade mark applicant or user over non-distinctive elements themselves, unless they have acquired distinctiveness through use, but it does not necessarily have to mean that the non-distinctive part of a trade mark is entirely without influence on the scope of protection. A trade mark may be perceived differently with or without the non-distinctive part. For example, a non-distinctive element might denote a sub-brand, such as adding the word “Cherry” close to “Coca-Cola”, but with



"Coca-cola" still being the stronger, dominant element and "Cherry" being partly descriptive of the taste of the product:



- 4) In contrast, the mark "AIPPI" has approximately the same degree of distinctiveness as the blue AIPPI logo, and neither element is significantly subservient to the other:



- 5) When conflicts occur between two trade marks when one or both are composite marks including non-distinctive elements, the conflicts may be between the distinctive parts of the marks, the non-distinctive parts of the marks, or the distinctive part of one mark and the non-distinctive part of the other. It will be important to consider, when assessing similarity and confusion, whether the non-distinctive element may have any significance, and if so, what is that impact.
- 6) There may be some commonalities in practice regarding the function or the role of a non-distinctive element in trade marks when evaluating conflicts between them, but courts, tribunals and IP offices in different jurisdictions may have considered a range of various factors when judging similarity and likelihood of confusion between trade marks including non-distinctive elements and, even in a same jurisdiction, different factors may have been considered in different proceedings or on different occasions.

- 7) This Study Question will examine what factors should or should not be considered by courts or tribunals or IP offices in assessing similarity and likelihood of confusion between marks when one or both are composite trade marks including non-distinctive elements and what functions are performed by non-distinctive elements in those assessments. The intention of the comprehensive comparative review is to provide a suitable framework for consideration, when comparing marks at least one of which is a composite trade mark that includes non-distinctive elements.

Why AIPPI considers this an important area of study

- 8) The issue of conflicts between trade marks is a key issue in both trade mark prosecution and enforcement. Whether two trade marks are similar to each other is an essential factor to consider in deciding whether the later trade mark can be registered or whether trade mark infringement can be established.
- 9) The assessment of similarity between composite trade marks is often difficult and controversial and it can be even more challenging if non-distinctive elements are involved. In some jurisdictions, the non-distinctive elements may be of no or little significance to the assessment, while in others, they may be given more weight. Non-distinctive elements may also be introduced and removed more frequently than the more permanent distinctive elements that represent the “core” trade mark.
- 10) Though the trade mark right holder should not enjoy exclusive rights in relation to a mere non-distinctive element, it is a question what role such an element, when included in a composite trade mark, should play when assessing similarity/confusion. It is important to establish what principles should be adopted or what factors should be considered in resolving conflicts between trade marks including non-distinctive elements and it would be helpful if the law and practice in this respect could be harmonised across different jurisdictions to some extent. Harmonisation would provide legal certainty for businesses that use marks in more than one jurisdiction.

Scope of this Study Question

- 11) This Study Question will focus on the assessment of whether two trade marks are confusingly similar at least one of which is a composite mark consisting of a non-distinctive element. It will look into the questions and issues arising when assessing similarity of such trade marks in both right-acquiring (prosecution) proceedings and trade mark enforcement proceedings.
- 12) The following issues are not within the scope of this Study Question:

- criteria for evaluating whether a trade mark or a constituent element of a trade mark is distinctive or the degree of distinctiveness;
- criteria for evaluating similarity between a sign in actual use and the registered trade mark in the course of non-use cancellation proceedings;
- criteria for assessing whether a trade mark is likely to deceive or cause confusion, other than by reason of being identical or similar to another trade mark where both trade marks are composite marks; and
- grounds for trade mark infringement other than trade mark similarity and confusion, such as dilution and parasitism.

Previous work of AIPPI

13) AIPPI has studied and explored some relevant issues in the past Resolutions and other occasions.

14) AIPPI Resolution Q127 (1995, Montréal) on “*Evaluation of confusion in trademark law*” concluded that:

“Comparison of the overall impressions created by the respective marks will normally be decisive. In determining overall impression, the marks are not to be dissected into their constituent elements and compared detail by detail because that is not the way marks are perceived or recalled by the relevant public.

In some cases, however, where non-distinctive elements contribute to the overall impressions of the respective marks, it may be necessary to consider the constituent elements of the marks. In such cases, the likelihood of confusion is doubtful unless both marks have a distinctive element or elements which is or are similar.”

15) AIPPI Resolution Q195 (2007, Singapore) on “*Limitations of Trademark Rights*” resolved that the exclusive rights of a trade mark owner over a trade mark comprising or consisting of non-distinctive elements should be subject to conditions:

“Limitation of the exclusive rights of the trademark owner should be allowed, under the specific conditions indicated hereinafter, for the use of a sign corresponding totally or partially to another’s trademark in the course of trade in order to indicate kind, quality, intended purpose, value, geographical origin, time of production/rendering or other characteristics of the goods or the services of a third party, as well as to indicate

compatibility of the third party's goods or services with those of the trademark owner."

- 16) Other AIPPI resolutions such as Q273 (2020, online) on "*Descriptive use as a defence in trade mark proceedings*", Q155 (2001, Melbourne) on "*Conflicts between Trademarks and Company and Business Names*", Q104 (1992, Tokyo) on "*Trademarks: Conflicts with prior rights*" also touched on trade mark issues but did not directly address the subject-matter of these Guidelines.
- 17) At AIPPI's San Francisco Congress held in 2022, a panel session was featured on composite trade marks, with the session title of "*How different is different?*" The panel with members from Canada, China, Poland, and the US shared their practices and experiences in similarity determinations between composite trade marks including those with non-distinctive elements.

Discussion

- 18) Conflicts between two trade marks where one or both are marks containing non-distinctive elements present unique challenges. Courts, tribunals and IP offices may consider various factors, such as the dominant element of the composite trade mark, the similarity of goods or services, perception by the relevant consumer and so on, when judging trade mark similarity and likely confusion. It seems to be a general principle adopted in jurisdictions that a global comparison of the conflicting marks must be carried out but it may be arguable as to what weight should be given to each constituent element, especially whether any weight should be given to a non-distinctive element. In some jurisdictions, the non-distinctive elements may have no significance, while in others, they would be given a certain weight as well. Whilst every determination is highly sensitive to the specific facts of the case, some common issues may emerge.
- 19) An "Anti-Dissection Rule" and a "Rule of Dominant Feature" are two main and widely used principles when determining similarity between two trade marks. The "**Anti-Dissection Rule**" means that two marks should be compared as an indivisible whole visually, phonetically and structurally while the "**Rule of Dominant Feature**" is based on the dominant feature of a trade mark being more decisive in the comparison with the consequence that using (or reproduce in the context of an application) one or more dominant elements of another mark without using (or reproducing) the entire mark may still lead to finding that the marks are similar to each other.

- 20) In Canada, the Canadian Trademark Examination Manual states “*Where the trademark being considered is a composite mark, it is the totality of the trademark which must be considered.*”
- 21) In India, the Anti-Dissection Rule and the Rule of Dominant Feature are both applicable. The Delhi High Court in *South India Beverages Ltd. v. General Mills Marketing Inc.* [2015 (61) PTC] made it clear that “*the principle of ‘anti dissection’ and identification of ‘dominant mark’ are not antithetical to one another and... the said principles rather compliment each other...*”.
- 22) In a recent trade mark infringement case in India¹, the judge ruled that the plaintiff’s “d mart” mark and the defendant’s “D Mart” sign:



were not deceptively similar by comparing them as a whole. The judge stated that it is well-settled law that a composite trademark is not to be dissected to determine whether there is any deceptive similarity with the impugned trademark and a comparison has to be by taking the rival marks as a whole. In relation to the “dominant feature” in a composite mark, the judge held that the letter “d” itself cannot be given protection and the word “mart” means “market” in the English language so the plaintiff only has a registration for the “d mart” composite mark and cannot enjoy exclusive right over the separate word elements in “d mart”.

- 23) The above case seems to suggest that in India, the non-distinctive element may not be taken into account when determining the similarity between two trade marks. However, it is also possible that due to the facts of the case being very specific, no new principles of law emerge from the decision.
- 24) Courts in the EU have adopted the principle that the similarity of the marks must normally be assessed by reference to the overall impression created by the marks, bearing in mind their distinctive and dominant components, but also when all other components of a complex mark are negligible, it is permissible to make the comparison solely on the basis of the dominant elements. However,

¹ Dolphin Mart Private Limited vs. Avenue Supermarts Limited and Anr. (CS(COMM) 177/2017)(decision date: August 21, 2023)

it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark.

- 25) Some EU decisions² concluded that a descriptive element of mark is unlikely to dominate the mark. In Germany, similarly, there was a long-established rule that non-distinctive elements have in most cases no substantial relevance. The public is expected to perceive such elements merely as additional (or informative), so that these elements fade into the background during the assessment³.
- 26) However, in some other EU and German national cases⁴, different conclusions were reached. For instance, in the EU “Solid Floor” opposition case⁵, the judge stated that *“In any event, the fact that the word element ‘solid floor’ of the earlier mark is only of weak distinctive character does not necessarily imply that that element cannot constitute a dominant element provided that, because, in particular, of its position in the sign or its size, it is capable of making an impression on consumers and of being remembered by them. In the present case, the word element ‘solid floor’ constitutes the dominant element”*. The German Supreme Court (BGH), in its decision for case ZB 34/17⁶, also noted that, in a case where a prior trade mark has been included in a more complex sign, it is not precluded that the corresponding element can dominate the overall impression of the complex sign even if said corresponding element is perceived as being descriptive/non-distinctive. In this regard, the BGH referred to specific circumstances, such as when the corresponding (and non-distinctive) element is emphasised due to its position and/or size, etc.
- 27) In China, the *Trademark Examination Guidelines* and the courts’ decisions establish that not only the overall impression but also the dominant part should be considered when judging the similarity of composite trade marks. According to the *Trademark Examination Guidelines*, if a later trade mark is composed of the dominant part of an earlier trade mark and a non-distinctive element, the two trade marks shall be considered as similar trade marks, such as

PARKER'S CELLAR Parkers

² See joined Cases T-117/03 to T-119/03 and T-171/03

³ BGH (German Supreme Court), decision of 19.07.2007, case I ZR 93/04 para. 49 – Windsor Estate

⁴ Which would still be relevant from an EU perspective, as the German decisions in question post-date the Trade Mark Directive.

⁵ T-395/12, in this case the goods in question are floor-related goods, such as floor panels, floor tiles, slate flooring, stone flooring and etc.

⁶ BGH (German Supreme Court), decision of 14.02.2019, case I ZB 34/17 para. 41 – KNEIPP

in class 33. The two trade marks should not be determined to be similar marks if the similar elements between them are of no or very weak distinctiveness, for example:

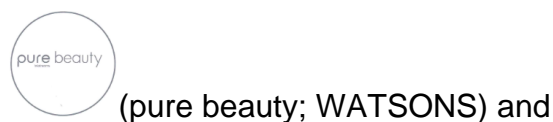
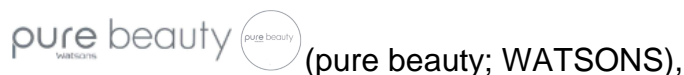


which share similar device elements but are not similar to each other as the devices/graphical signs in these two marks are commonly used insignia with a correspondingly weak distinctiveness.

- 28) However, in a review of refusal decision⁷ made by the China National Intellectual Property Administration (CNIPA), it was determined that the refused trade mark:



Is similar to earlier marks:



since they share the English phrase “pure beauty”. These trade marks are all in class 3 and “pure beauty” hardly has distinctiveness in class 3, especially in relation to cosmetic goods. CNIPA did not give less weight to the weak distinctive part though the Chinese character part in the refused trade mark is more dominant in size and position.

- 29) In a French case⁸ with somewhat similar facts:

⁷ Review of TM refusal of Chinese TM application No. 31213489 (TRAB [2019] No. 0000284813)

⁸ Cour d'appel de Paris, Pôle 5, 29 janvier 2016, n° 2015/02883

CARTER-CASH v. CAR&CASH.com

it was held that any likelihood of confusion should be excluded, notably, since the common term "CASH" in both marks has a weaker distinctive character.

- 30) The inclusion of non-distinctive elements may bring higher levels of uncertainty to the assessment of similarity regardless of whether of the overall impression or dominant feature test are used. There may be differences between jurisdictions in practice. Clarity and harmonisation in this regard may be desired and benefit the right holder and the public.

You are invited to submit a Report addressing the questions below. Please refer to the 'Protocol for the preparation of Reports'.

Questions

I) Current law and practice

Please answer all questions in Part I on the basis of your Group's current law.

- 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.

- 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.
- 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.
 - 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 non-distinctive 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.
 - 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.
 - 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:
- a) The nature of the non-distinctive elements.
 - 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.
 - c) The history and use status of the earlier mark.
 - d) The history and use status of the later mark.
 - e) The industry field of the concerned marks.
 - f) The sophistication of the relevant public.
 - g) The practices and conventions as to the use of the trade mark in the market for the relevant goods or services.
 - h) The relationship between the holders of the two marks.
 - i) The background and history of the earlier mark holder.
 - j) The background and history of the later mark holder.
 - k) The other marks of the earlier mark holder.
 - l) The other marks of the later mark holder.
 - m) The perception of the consumer (as to the non-distinctive element).
 - n) Others, please clarify.

- 7) What factors are considered when judging whether trade marks including non-distinctive 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:
- a) The nature of the non-distinctive elements.
 - 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 .
 - c) The history and use status of the registered/common law mark.
 - d) The history and use status of the suspected infringing mark.
 - e) The industry field of the concerned marks.
 - f) The sophistication of the relevant public.
 - g) The practices and conventions as to the use of the trade mark in the market for the relevant goods or services.
 - h) The relationship between the holders of the two marks.
 - i) The background and history of the holder of the registered/common law mark.
 - j) The background and history of the alleged infringer.
 - k) The other marks of the holder of the registered/common law mark.
 - l) The other marks of the suspected infringer.
 - m) The perception of the consumer (as to the non-distinctive element).
 - n) Others, please clarify.

- 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 jurisdiction⁹?

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:

⁹ In a jurisdiction where absolute ground examination is not conducted in the registration application stage, you may refer to the scenario of an opposition or invalidation.

- a) No, it is definitely not a straightforward registration.
- 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 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.
- 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)¹⁰ 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.
- 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)¹¹ 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.

¹⁰ In those jurisdictions in which having a registration for a trade mark is per se a sufficient and valid defence against infringement claims, please consider that trade mark (A) is not the subject of a registration or application.

¹¹ In those jurisdictions in which having a registration for a trade mark is per se a sufficient and valid defence against infringement claims, please consider that trade mark (A) is not the subject of a registration or application.

- 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 jurisdiction¹²?

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.
- 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.
- 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.

11) As a matter of policy, does your Group believe that it would be better to require

¹² In a jurisdiction where absolute ground examination is not conducted in the registration application stage, you may refer to the scenario of an opposition or invalidation.

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.

- 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.

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.

- 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.
- 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.
 - 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.
 - 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
 - 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 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.
 - 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:
- a) The nature of the non-distinctive elements.
 - 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.
 - c) The history and use status of the earlier mark.
 - d) The history and use status of the later mark.
 - e) The industry field of the concerned marks.
 - f) The sophistication of the relevant public.
 - g) The practices and conventions as to the use of trade marks in the market for the relevant goods or services.
 - h) The relationship between the holders of the two marks.
 - i) The background and history of the earlier mark holder.
 - j) The background and history of the later mark holder.
 - k) The other marks of the earlier mark holder.
 - l) The other marks of the later mark holder.
 - m) The perception of the consumer (as to the non-distinctive element).
 - n) Others, please clarify.
- 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.

- 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.
 - c) The history and use status of the registered/common law mark.
 - d) The history and use status of the suspected infringing mark.
 - e) The industry field of the relevant marks.
 - f) The sophistication of the relevant public.
 - g) The practices and conventions as to the use of trade marks in the market for the relevant goods or services
 - h) The relationship between the holders of the two marks.
 - i) The background and history of the holder of the registered/common law mark.
 - j) The background and history of the suspected infringer.
 - k) The other marks of the holder of the registered/common law mark.
 - l) The other marks of the suspected infringer.
 - m) The perception of the consumer (as to the non-distinctive element).
 - n) Others, please clarify.
- 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.
- 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.
- 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)¹³ 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.
- 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)¹⁴ 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.
- 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.

¹³ In those jurisdictions in which having a registration for a trade mark is per se a sufficient and valid defence against infringement claims, please consider that trade mark (A) is not the subject of a registration or application.

¹⁴ In those jurisdictions in which having a registration for a trade mark is per se a sufficient and valid defence against infringement claims, please consider that trade mark (A) is not the subject of a registration or application.

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