

AIPPI 2024 – STUDY QUESTION - FINLAND

Conflicts between composite trade marks including non-distinctive elements

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.**

Group's Comments: It has been stated in EU case law that non-distinctive elements are not generally regarded by the public as being dominant elements in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them. (see, for example, Case T 563/08, CM Capital Markets Holding SA). Similar interpretations have been adopted in Finnish case law.

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.**

Group's Comments: Based on EU case law, where a trade mark is composed of verbal and figurative elements, the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark (see Case T 312/03, Wassen International v. SMHV – Stroschein Gesundheitskost).

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 nondistinctive 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.**

Group's Comments: Phonetical and semantic similarity of the trade marks may also be considered.

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:

- 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.**

Group's Comments:

- 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.**

Group's Comments: Phonetical and semantic similarity of the trade marks may also be considered.

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.
- b) Yes, it is very straightforward.
- c) It depends on the non-distinctive element.
- d) Other, please clarify.**

Group's Comments: It depends, in the case of similarity with an earlier mark (B), on the degree of similarity of the marks. We assume that the absence of the word 'protected' does not affect the outcome (whereas in Scenario 3 it has been included), since otherwise the earlier mark would not enjoy protection and the answer would be b).

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.**

Group's Comments: The trade mark (A) has left out the non-distinctive elements of the earlier mark (B) and consists i.e. is identical with the distinctive elements of the earlier mark (B). We assume that the absence of the word 'protected' does not affect the outcome (whereas in Scenario 4 it has been included), since otherwise the earlier mark would not enjoy protection and the answer would be b).

- 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.
- b) Yes, it is very straightforward.
- c) It depends on the nature of all marks/signs.
- d) Other, please clarify.**

Group's Comments: It depends, in the case of similarity with a protected earlier mark (B), on the degree of similarity of the marks.

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.
- b) Yes, it is very straightforward.
- c) It depends on the nature of all marks/signs.
- d) **Other, please clarify.**

Group's Comments: It depends, in the case of similarity with a protected earlier mark (B), on the degree of similarity of the marks.

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.
- b) Yes, the case law would support a finding of similarity.
- c) It depends on the nature of the marks.
- d) **Other, please clarify.**

Group's Comments: It depends on the degree of similarity of the different distinctive elements. By the word 'different', we assume that there is some difference between the distinctive elements, but this does not necessarily mean that the distinctive elements are dissimilar.

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**

Group's Comments: It depends on the degree of similarity of the different distinctive elements. By the word 'different', we assume that there is some difference between the distinctive elements, but this does not necessarily mean that the distinctive elements are dissimilar.

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.

Group's Comments: Our Group considers that our Group's current law and practice relating to these matters is mainly adequate. However, the conditions when the "Rule of Dominant Feature" or "Anti-Dissection Rule" rules are applied could be specified, as sometimes composite marks consisting of weakly distinctive and non-distinctive elements may be offered too large of a protection.

In order for the situation to be specified, clarifying case law would be needed from both Finnish and EU level. However, currently, only a small percentage of disputes end up in court.

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.

Group's Comments: It is highly unpreferable that each combination of distinctive and non-distinctive elements should be registered. A requirement for registration would increase the costs of the rightsholder and would eventually make the rightsholder unable to take action against the use of a particular unregistered combination of distinctive and non-distinctive elements. Permitting the "disassembly" of registered marks into elements is therefore the preferable alternative.

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.

Group's Comments: No, there are no other policy considerations and/or proposals for improvement that our Group would like to suggest.

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.

Group's Comments: Yes.

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).

Group's Comments: This could be justified, where the non-distinctive element is dominant in terms of e.g., position or size, which makes it have a specific impression on consumers and makes it remembered by the consumers.

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.

Group's Comments: It should be possible, for example, when a trade mark contains a word element of which position or size makes a specific impression on consumers and is remembered by the consumers, even though the word element itself is non-distinctive.

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.

Group's Comments: In general, word elements should have more impact on the evaluation than the figurative elements, but this depends on the case while, for example, the position of the element and other such factors should have impact on the evaluation.

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 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.

- 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.**

Group's Comments: In case of an established trade 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.**

Group's Comments: In objection proceedings, whether the earlier trade mark is part of a broader series of trade marks that share the same elements as the earlier trade mark could also be taken into account.

- 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.**

Comments: Phonetical and semantic similarity of the trade marks should also be considered.

20) In the assessment of trade mark 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.**

Group's Comments: In case of an established trade 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.**

Group's Comments: For example, if the suspected infringer has acted similarly in the past, previous similarities in earlier infringement cases with respect to the same mark could be taken into account.

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.**

Group's Comments: Phonetical and semantic similarity of the trade marks should also be considered.

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.**

Group's Comments: Such an exceptional case could arise e.g., if the distinctive elements of trade mark A were similar only to a low degree to the earlier trade mark B or if the non-distinctive element of trade mark A were to constitute its dominant 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 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) 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.**

Group's Comments: Such an exceptional case could arise e.g., if the distinctive elements of trade mark A were similar only to a low degree to the earlier trade mark B or if the non-distinctive element of trade mark A were to constitute its dominant element.

- 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.**
- 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.
- 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.**

Group's Comments: It should depend on the degree of similarity of the different distinctive elements. The assessment should concentrate on the comparison between the distinctive elements, and the non-distinctive elements should have a minor or non-existent impact. By the word 'different', we assume that there is some difference between the distinctive elements, but this does not necessarily mean that the distinctive elements are dissimilar.

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.**

Group's Comments: It should depend on the degree of similarity of the different distinctive elements. The assessment should concentrate on the comparison between the distinctive elements, and the non-distinctive elements should have a minor or non-existent impact. By the word 'different', we assume that there is some difference between the distinctive elements, but this does not necessarily mean that the distinctive elements are dissimilar.

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

Group's Comments: Our Group does not have any additional issues that we would like to raise.

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

Group's Comments: