

THE SCOPE OF TRADE MARK AS A SUBJECTIVE RIGHT IN THE EUROPEAN UNION LAW

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Abstract

In this paper, we analyze the appropriate regulatory framework of the European Union which is related to the issue of the scope of trade mark, i.e. its application in practice, through appropriate judgements of the Court of Justice of the European Union. More particularly, the focus of the analysis is on the factors on the basis of which the scope of trade mark as a subjective right is determined, i.e. the limits of protection acquired by the concrete trade mark. In that sense, this paper will aim to provide a detailed view of, primarily, the concept of likelihood of confusion which represents the key element for determining the scope of trade mark as a subjective right, through the view of the individual elements from which it consists, i.e. on the basis of which the existence of the mentioned likelihood is determined in each concrete case.

Key words: the scope of trade mark, the concept of likelihood of confusion, the similarity of goods and services, the similarity of signs, the global appreciation of the likelihood of confusion.

ОБИМ СУБЈЕКТИВНОГ ПРАВА НА ЖИГ У ПРАВУ ЕВРОПСКЕ УНИЈЕ

Апстракт

У овом раду анализира се одговарајућа регулатива Европске уније која се односи на питање обима жига, односно њена примена у пракси, и то кроз одговарајуће пресуде Суда правде Европске уније. Детаљније речено, анализирају се чиниоци на основу којих се одређује обим жига као субјективног права, односно границе заштите која се стиче конкретним жигом. У том смислу, у овом раду ће се извршити детаљан приказ, пре свега, концепта вероватноће забуне, који представља кључни елемент за утврђивање обима жига као субјективног права, и то кроз приказ појединачних елемената из којих се она састоји, односно на основу којих се утврђује постојање поменуте вероватноће у сваком конкретном случају.

Кључне речи: обим жига, концепт вероватноће забуне, сличност роба и услуга, сличност ознака, процена постојања вероватноће забуне на општи начин.

INTRODUCTORY REMARKS

Contemporary market is characterized by an extremely high number of mutually similar goods and services which practically make up a vast mass for the average consumer. For the consumer to be able to spot certain goods, i.e. service in such mass, it is necessary to make them different, primarily from competing goods and services. Goods or services can be made different from others in several ways, whereby signs protected by trade mark represent one of the most efficient means in achieving the mentioned aim. In order to make their goods or services different, and therefore recognizable to consumers, and thus to win the market competition, undertakings give great importance to signs protected by trade mark.

Signs protected by trade mark represent special phenomenon of the contemporary market, primarily because of the contradiction created by them. It consists in that that the consumers, very often, choose products led by the criterion of recognizability of the sign, instead by the criterion of quality or the criterion of price. Because of that, undertakings have for their aim, *inter alia*, making the sign recognizable on the market, in order to obtain as large number of consumers as possible.

In this regard, the question of possibility of registering similar signs for marking identical or similar goods or services on the market arises, as well as the question of legal consequences for tolerating such a state in the course of trade. In that sense, starting from the significance of signs protected by the trade mark in the course of trade, precise defining of the limits of legal protection acquired by the trade mark, i.e. determining the scope of trade mark as a subjective right, represents one of the most important questions in Trade Mark Law, with the aim of adequate protection of the rights and interests of trade mark proprietors and consumers, and the aim of ensuring legal certainty.

LEGAL FRAMEWORK FOR DETERMINING THE SCOPE OF TRADE MARK

The legal basis for the protection of the rights of the trade mark proprietor, which, *inter alia*, determines the scope of protection that can be acquired by trade mark as a subjective right is article 10 of the Directive EU 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (hereinafter referred to as: the Directive). Namely, Article 10 paragraph 1. and 2. of the Directive stipulates the following:

- „1. The registration of a trade mark shall confer on the proprietor exclusive rights therein.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the

proprietor of that registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered;

(b) the sign is identical with, or similar to, the trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”

Thus, article 10 paragraph 2. point (b) of the Directive defines the scope of protection that trade mark provides to its proprietor. In that sense, other parties must not use the sign protected by a trade mark for the purpose of marking the goods and services which are similar with those which the sign refers to (Varga, 2014, p. 254). In addition to that, other parties must not even use the sign which is similar to the sign of the trade mark proprietor for the purpose of marking identical or similar goods and services, if there exists a likelihood of confusion on the part of the relevant public regarding the origin of goods or services marked by the trade mark (Varga, 2014, p. 255).

With regard to the aforementioned, it can be concluded that in the Trade Mark Law the subject matter of protection is the link between certain goods or services and certain sign, and not the sign as such (Marković, 2011, p. 43). In other words, a trade mark consists of a sign and a list of goods or services (Bošković, 1998, p. 1088).

Thus, the notion of similar goods, or services determines the ultimate range of protection acquired by a trade mark (Vlašćević, 2012, p. 719). That means that a trade mark can be used freely for the purpose of marking the goods or services which are not similar with the ones specified in the application for trade mark registration (Vlašćević, 2011). In that case, the trade mark infringement cannot be discussed (Vlašćević, 1995, p. 560).

On the other hand, as it follows from article 10 paragraph 2. point (c) of the Directive, the mentioned rule does not apply to the trade marks with a reputation which enjoy broader protection than the one previously defined. However, the legal protection of the trade marks with a reputation is not the subject of this paper, therefore it will not be discussed in more detail.

*THE CONCEPT OF “LIKELIHOOD OF CONFUSION”
AS THE MOST IMPORTANT ELEMENT FOR DETERMINING
THE SCOPE OF TRADE MARK*

The concept of *likelihood of confusion* represents, not only the key link in determining the scope of trade mark as a subjective right, but at the same time in the protection of the rights of the trade mark proprietor. Namely, proceeding from the fact that the origin function is the basic trade mark function (Baumbach, Hefermehl, 1979, p. 66-69), it is clear that the *prevention of likelihood of confusion* regarding the origin of goods or services marked by the trade mark, is of essential importance in achieving the basic role of the trade mark.

Having regard to the fact that the existence of *likelihood of confusion* is a factual issue which has to be resolved in each specific case, the most expedient is to start from the practice of the Court of Justice of the European Union, for the purpose of defining the mentioned concept. Thus, in the *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc., formerly Pathe Communications Corporation* judgement, the mentioned court defines *likelihood of confusion* as the risk that the public might believe that the goods or services in question come from the same undertaking or, from economically-linked undertakings (Judgement of the Court of Justice of the European Union in Case C-39/97, 1998, para. 29). The first case is about *likelihood of direct confusion*, and the second case is about *likelihood of indirect confusion* (Judgement of the Court of Justice of the European Union in Case C-251/95, 1997, para. 16).

When discussing *the assessment of existence of likelihood of confusion*, the Court of Justice of the European Union states that the existence of mentioned confusion must be assessed globally by reference to the perception which the relevant public has of the signs and of the goods or services in question, taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (Judgment of the General Court in Case T-390/15, 2016, para. 35). In accordance with the mentioned, a lesser degree of similarity between goods or services in question may be offset by a greater degree of similarity between the signs, and *vice versa* (Judgement of the Court of Justice of the European Union in Case C-39/97, 1998, para. 17).

Thus, *the existence of likelihood of confusion* presupposes both that the sign applied for registration and the earlier sign are identical or similar, and that the goods or services covered in the application for registration are identical or similar to those in respect of which the earlier mark is registered (Judgment of the General Court in Case T-390/15, 2016, para. 36). Those conditions are cumulative (Judgment of the General Court in Case T-390/15, 2016, para. 36), which means that both of them must be fulfilled in order for a likelihood of confusion to exist.

When assessing *the existence of likelihood of confusion* in each concrete case, the Court of Justice of the European Union first determines the circle of persons which constitute the relevant public, considering the type of goods or services in question, then it determines the similarity of the goods and services, and in the end, the similarity of concrete signs. The mentioned order, in terms of giving the rationale for each individual element, will be used in this paper.

The Relevant Public

As it has already been said, in order for the trade mark infringement to exist, it is necessary that the likelihood of confusion regarding the origin of goods or services marked by the trade mark exists on the part of *the relevant public*. When discussing the question from whom the relevant public comprises, the Court of Justice of the European Union states that the formulation of article 10 paragraph 2. point (b) of the Directive¹ „...there exists a likelihood of confusion on the part of the public...” shows that the perception of signs in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion (Judgement of the Court of Justice of the European Union in Case C-251/95, 1997, para. 23). It can be concluded, from the mentioned, that the Court under relevant public implies *average consumer of the concrete type of goods or services*. Therefore, *the relevant public* is determined separately in each concrete case, starting from the type of goods or services in question (Jurkiewicz, 2011).

Thus, for example, in *Perfetti Van Melle Benelux BV v European Union Intellectual Property Office* case, the Court of Justice of the European Union started from the fact that the goods in question, confectionery products and cereal chips to be precise, represent food products, i.e. everyday consumer goods, and therefore *the relevant public* consists of end consumers (Judgment of the General Court in Case T-390/15, 2016, para. 39).

In relation to determining the relevant public, the Court of Justice of the European Union also states that *the average consumer* is deemed to be reasonably well-informed and reasonably observant and circumspect (Judgement of the Court of Justice of the European Union in Case C-342/97, 1999, para. 26). Namely, the Court has defined *the average consumer* in the

¹ Accurately speaking, the mentioned judgement, like other judgements mentioned in this paper which are delivered before the Directive EU 2015/2436 has entered into force, takes article 5 paragraph 1. point (b) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks for the legal basis of the likelihood of confusion. However, because the mentioned article has been incorporated as article 10 paragraph 2. point (b) into the Directive EU 2015/2436 in essentially unmodified form, for the convenience of the reader, in this paper we will cite only article 10 paragraph 2. point (b) of the Directive EU 2015/2436.

mentioned manner, starting from the fact that he only rarely has the chance to make a direct comparison of the different marks, but must place his trust in the imperfect picture of them that he has kept in his mind, and that *the average consumer's level of attention* is likely to vary according to the category of goods or services in question (Judgement of the Court of Justice of the European Union in Case C-342/97, 1999, para. 26).

In relation with the foregoing, it should be emphasized that the Court of Justice of the European Union took the position that *average consumer's level of attention* can be average, higher or lower, depending on the type of goods or services.

In this regard, *the average level of attention* usually exists when it comes to goods such as beverages and foodstuff, which are abundantly displayed on shelves in food retailers, shopping centers, restaurants, and bars (Maeyaert, Muyldermans, 2013). A somewhat *lower degree of attention* exists when it comes to mass consumer goods with a low monetary value, which are often purchased impulsively (Maeyaert et al., 2013). Finally, a *higher degree of attention* exists when it comes to goods or services which are durable, have high value, which are intended for more exceptional use, or goods for which the relevant public is made up of specialists in the sector (Maeyaert et al., 2013).

Thus, for example, in *Perfetti Van Melle* case the Court has determined that *the average consumer's level of attention* will be relatively low, starting from the fact that products in question mostly represent inexpensive everyday consumer goods (Judgment of the General Court in Case T-390/15, 2016, para. 39, 77).

The Similarity of Goods and Services

After it has been determined who *the average consumer* is in the concrete case, we proceed to the question whether that *average consumer* considers that goods or services marked by the signs are similar or not. Namely, article 10 paragraph 2. point (b) of the Directive provides that the likelihood of confusion presupposes that the goods and services marked by the trade mark and the sign are identical or similar, because of which in every concrete case it is necessary to determine the existence of identity or similarity. This point of view is also confirmed by the Court of Justice of the European Union by stating that: “even where a sign is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered” (Judgement of the Court of Justice of the European Union in Case C-39/97, 1998, para. 22).

When assessing the mentioned similarity by *the average consumer*, belonging of goods and services to a certain class, in accordance with the Nice Agreement Concerning the International Classification of Goods and

Services for the Purposes of the Registration of Marks,² cannot serve as a decisive criterion for determining the similarity of concrete goods and services. Namely, the classification of goods and services in accordance with the mentioned agreement, serves exclusively for administrative purposes, because of which goods and services may not be regarded as being similar on the grounds that they appear in the same class, as well as the goods and services may not be regarded as being dissimilar on the grounds that they appear in different classes (Commission regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark, article 1, title I, rule 2, point (4)). Thus, for example, in *Perfetti Van Melle* case the Court has found that products in question belong to the class 30 of the mentioned Agreement, whereby it took the fact of belonging to the mentioned class only as one of the criteria for determining the similarity of the concrete products (Judgment of the General Court in Case T-390/15, 2016, para. 3, 6, 7, 42, 46).

Also, when assessing the similarity of goods or services, it is not enough to take the position that they are either similar or dissimilar, but the degree of similarity, which can be high, normal i.e. certain, or weak i.e. low, must be determined (Maeyaert et al., 2013). In this regard, one should bear in mind the rule that the similarities between the goods or services outweigh the differences (Judgment of the General Court in Case T-161/10, 2011, para. 25).

Finally, when assessing the similarity of the goods or services, all the relevant factors relating to those goods or services themselves should be taken into account (Judgement of the Court of Justice of the European Union in Case C-39/97, 1998, para. 23). These factors include, *inter alia*, their *nature*, their *intended purpose* and their *method of use*, and whether they are *in competition with each other or are complementary* (Judgement of the Court of Justice of the European Union in Case C-39/97, 1998, para. 23).

Factors for assessment of the existence of similarity of goods and services. When discussing the mentioned factors, one should bear in mind primarily that the Court of Justice of the European Union, when stating these factors, uses the expression *inter alia*, which means that, depending on the circumstances of the concrete case, other factors can be of influence on the assessment of existence of similarity of goods and services (Jurkiewicz, 2011). Thus, for example, in *Perfetti Van Melle* case the Court also took into account the *distribution channels* for the mentioned products and the possibility that they can be *produced by the same undertakings* (Judgment of the General Court in Case T-390/15, 2016, para. 41, 52, 53).

² Namely, it is a system that is introduced by the World Intellectual Property Organization (WIPO), which divides all goods and services capable for registering into 45 classes (Ashmead, 2007, p. 82). Cited according to: Jurkiewicz, 2011.

On the other hand, the mentioned Court delivered a large number of judgments on determining the existence of similarity of goods and services, at the same time giving the interpretation of the mentioned factors. In that sense, factors for assessment of the existence of the similarity of goods and services will be shown through, already mentioned, judgement *Perfetti Van Melle* in which the court has determined the similarity of confectionery products and cereal chips (Judgment of the General Court in Case T-390/15, 2016), and which is largely based on the earlier practice of the Court of Justice of the European Union.

Thus, when discussing *the nature* of mentioned products, the Court first stated that cereal chips can be both sweet and salty and therefore that sugar can be a common ingredient of the mentioned chips and confectionery products (Judgment of the General Court in Case T-390/15, 2016, para. 46, 48). However, as the Court further states, the other ingredients of the two types of products must be taken into consideration, having regard to the fact that one part of the confectionery products from class 30, like chocolate, can be made from the same ingredients and, therefore, be *the same in nature* as sweet cereal chips, while that is not the case concerning other part of the products, like candies and chewing gums (Judgment of the General Court in Case T-390/15, 2016, para. 48). Then, when it comes to the *intended purpose* and the *method of use*, the Court first stated that mentioned products have *the same purpose*, considering that they are consumed occasionally as snacks between main meals and satisfy a certain urge or craving for food with a certain taste (Judgment of the General Court in Case T-390/15, 2016, para. 42). However, starting from *the nature* of the mentioned products, the Court has determined that they have *the same purpose* in so far as they are intended to serve as sweet snacks, whereas in the reverse situation that is not the case (Judgment of the General Court in Case T-390/15, 2016, para. 51). Thereafter, the Court took the position that mentioned products *can be produced by the same undertakings*, in particular if the cereal chips in question are sweet, and that they share *the same distribution channels*, regardless of the taste of the mentioned chips (Judgment of the General Court in Case T-390/15, 2016, para. 42, 52, 53). Finally, when discussing the question whether the products are *in competition with each other* or *are complementary*, the Court took the view that competition can exist only when it comes to sweet cereal chips, whereas in the other case the products are complementary (Judgment of the General Court in Case T-390/15, 2016, para. 54).

The Similarity of Signs

If it has been determined that a certain degree of similarity between goods or services exists, we proceed to determination of existence of the similarity of signs. In that sense, the global appreciation of *the likelihood of confusion* implies, when it comes to the assessment of similarity of signs in question, taking into account visual, phonetic or conceptual similarity of the

signs, whereby the mentioned similarity must be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant components (Judgment of the General Court in Case T-390/15, 2016, para. 58). Namely, the mentioned method of assessment is necessary, bearing in mind that *the average consumer* normally perceives a sign as a whole, and does not proceed to analyse its various details (Judgment of the General Court in Case T-390/15, 2016, para. 58).

When discussing the visual, phonetic or conceptual similarity of the signs, it is enough that similarity on the basis of just one of the mentioned aspects exists, in order to talk about the similarity of signs, i.e. it is not necessary that similarity of signs exists in respect to all three aspects cumulatively. The mentioned ascertainment is confirmed by the Court of Justice of the European Union when stressing that two signs are similar when, from the point of view of *the relevant public*, they are at least partially identical with regard to one or more relevant aspects, concretely the visual, phonetic or conceptual aspect (Judgement of the Court of Justice of the European Union in Case C-286/02, 2003, para. 38).

Also, starting from the fact that, as already mentioned, *the average consumer* only rarely has the chance to make a direct comparison of the different marks, and must place his trust in the imperfect picture of them that he has kept in his mind (Judgement of the Court of Justice of the European Union in Case C-342/97, 1999, para. 26), when assessing the similarity, the rule that the higher attention is paid to those elements of sign which are similar than to those which are different is applied (Miladinović, 2009, p. 96).

Visual, phonetic and conceptual similarity of signs. Starting from the fact that the mentioned aspects of similarity of signs are general notions, they can best be understood through practical examples. In that sense, as in assessment of similarity of goods and services, we will use judgement in case *Perfetti Van Melle* in which the Court has determined the similarity of sign *3D^S* and sign *3D* (Judgment of the General Court in Case T-390/15, 2016). Thus, the Court took the position that, from visual perspective, both mentioned signs contain the element *3D*, which is also their dominant element (Judgment of the General Court in Case T-390/15, 2016, para. 60). In addition to that, the Court has determined that the element 's' is much smaller than the mentioned common element and that it occupies an ancillary role in relation to that element, because of which *the degree of visual similarity of signs is higher than average* (Judgment of the General Court in Case T-390/15, 2016, para. 60, 64). Thereafter, the Court has found that there exists *a high degree of phonetic similarity of signs*, having regard to the fact that, starting from the rules of pronunciation, only slight differences appear at the end of the signs (Judgment of the General Court in Case T-390/15, 2016, para. 60). Finally, when discussing the conceptual similarity of signs, the Court took the view that element *3D* means three-

dimensional, the quality of being three-dimensional, whether or not accompanied by the ancillary element 's (Judgment of the General Court in Case T-390/15, 2016, para. 60, 68).

Distinctiveness of the Earlier Protected Sign

After it has been determined that between signs in question a certain degree of similarity does exist, we proceed to the determination of the existence of possible distinctiveness of the earlier protected sign. That also means that, if between concrete signs similarity does not exist, there is no need for determining the degree of distinctiveness of the earlier protected sign (Judgement of the Court of Justice of the European Union in Case C-57/08 P, 2008, para. 56). The distinctiveness represents the capacity of the sign to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (Judgement of the Court of Justice of the European Union in Case C-342/97, 1999, para. 22).

The need for determining the degree of distinctiveness was defined by the Court of Justice of the European Union when stated that: “the more distinctive the earlier protected sign, the greater will be *the likelihood of confusion*” (Judgement of the Court of Justice of the European Union in Case C-251/95, 1997, para. 24). The mentioned relation of the distinctiveness of a sign and *the likelihood of confusion* has for a consequence the fact that signs with a high degree of distinctiveness, either per se or because of the reputation they possess on the market, enjoy broader protection than signs with a less distinctive character (Judgement of the Court of Justice of the European Union in Case C-39/97, 1998, para. 18).

The Concept of “Likelihood of Association”

When discussing the concept of *likelihood of confusion* mention should be made to the concept of *likelihood of association*, i.e. clarification should be made to the relation between these two concepts. Namely, as it was previously mentioned, article 10 paragraph 2. point (b) of the Directive stipulates, *inter alia*, that *the likelihood of confusion* includes *the likelihood of association*. The likelihood of association was defined by the Court of Justice of the European Union as a situation where the public considers the sign to be similar to the trade mark, because of which the perception of the sign calls to mind the memory of the trade mark, although the two are not confused by the public (Judgement of the Court of Justice of the European Union in Case C-251/95, 1997, para. 16). However, the Court took the position that from the wording of the mentioned article of the Directive, which stipulates that *the likelihood of confusion* includes *the likelihood of association*, follows that the concept of likelihood of association is not an alternative to that of likelihood of confusion, but serves to define its scope

(Judgement of the Court of Justice of the European Union in Case C-251/95, 1997, para. 18). In that sense, *the concept of likelihood of association* represents just one of the factors which should be taken into account when assessing whether there exists *the likelihood of confusion* in the concrete case.

The Global Appreciation of “the Likelihood of Confusion”

As already stated, the existence of the likelihood of confusion is appreciated globally, taking into account all the above-mentioned factors, as well as their interdependence. In this regard, the mentioned global appreciation can best be shown on a practical example, therefore, we will again use the *Perfetti Van Melle* case, in a manner in which we will show all the above-mentioned factors in one place, as well as the assessment which the Court has given after determining their existence.

Thus, in the mentioned case, the Court, starting from the fact that confectionery products and cereal chips represent food products, i.e. everyday consumer goods, has found that *the relevant public*, i.e. *the average consumers of the concrete type of goods or services*, consists of end consumers of the mentioned products (Judgment of the General Court in Case T-390/15, 2016, para. 39, 77). Then, the Court has determined the level of attention of *the relevant public*, by taking a position that the mentioned *average consumers* will evince *relatively low degree of attention* when selecting the mentioned products, having regard to the fact that the mentioned products are mostly inexpensive items (Judgment of the General Court in Case T-390/15, 2016, para. 39).

Thereafter, the Court drew the conclusion on the *degree of similarity* of products. Namely, the Court has determined that confectionery products and sweet cereal chips show *significant similarities* in sense that they have the same *intended purpose* and *method of use*, the same *distribution channels*, then that they *can be manufactured by the same undertakings* and are *in competition with each other* (Judgment of the General Court in Case T-390/15, 2016, para. 56). The mentioned conclusion of the Court refers to the situation where the mentioned products, besides sugar, have other common ingredients, and therefore have *the same nature*. However, as the Court further states, even in a situation where the mentioned products *do not have the same nature*, there exists *an average degree of similarity* of products (Judgment of the General Court in Case T-390/15, 2016, para. 56). On the other hand, concerning confectionery products and salty cereal chips, having regard to their overall differences, i.e. their different *intended purpose* and *method of use*, their *different manufacture* and the fact that they are *not in competition*, but having regard to the fact that they have *the same distribution channels*, the Court took the position that there exists *a low degree of similarity* (Judgment of the General Court in Case T-390/15, 2016, para. 56). With regard to all of the foregoing, the Court took the view that confectionery products and cereal chips, taken as a whole, show a

degree of similarity which is *slightly lower than the average degree of similarity* (Judgment of the General Court in Case T-390/15, 2016, para. 57). In this place it is significant to point out that the Court has found, in second and in third situation, that *the similarity* of products exist, although the similarity in regard to all the factors which relate to the mentioned products is not determined. Namely, the Court has taken this position when making the global appreciation of the similarity, and bearing in mind the rule that the similarities between the goods or services outweigh the differences (Judgment of the General Court in Case T-161/10, 2011, para. 25).

When discussing *the similarity of signs* the Court took the view that the signs in question (3D^s and 3D) show *a high degree of phonetic and conceptual similarity*, while the *degree of visual similarity* of signs is *higher than average*. In this regard, the Court further stated that certain visual differences which exist between the signs in question (element 's) are not such as to have an influence on the mentioned degree of similarity of signs which comes from the common element 3D, and especially starting from the fact that the average consumer only rarely has the chance to make a direct comparison of the different signs, but must place his trust in the imperfect picture of them that he has kept in his mind (Judgment of the General Court in Case T-390/15, 2016, para. 66). In addition to that, the Court stated that since the consumers generally pay greater attention to the beginning of a sign than to the end, the relevant public will pay less attention to the disputed element 's (Judgment of the General Court in Case T-390/15, 2016, para. 70). With regard to the aforementioned, the Court drew the conclusion that mentioned signs, taken as a whole, show *a high degree of similarity* (Judgment of the General Court in Case T-390/15, 2016, para. 69).

When discussing *the distinctiveness* of the signs, the Court has dismissed the claim of the applicant for trade mark registration that the element 3D is descriptive of a characteristic of the products for which the earlier sign is registered, i.e. that it describes cereal chips as products in a three-dimensional shape, but instead it has determined that in the concrete case there exists *an average degree of distinctiveness* (Judgment of the General Court in Case T-390/15, 2016, para. 19, 75).

After determining the existence of the mentioned factors, the Court went on to the global appreciation of the *likelihood of confusion*, i.e. to the determination of interdependence of the factors, whereby it paid special attention to the interdependence of the degree of similarity of signs and the degree of similarity of marked products. In accordance with the mentioned, the Court has taken into account that a lesser degree of similarity between goods or services in question may be offset by a greater degree of similarity between the signs, and *vice versa* (Judgment of the General Court in Case T-390/15, 2016, para. 71).

Finally, when discussing the *Perfetti Van Melle* case, it remained to the Court to solve the problem of influence which the mentioned *level*

of distinctiveness of the earlier protected sign can have on the global appreciation of the likelihood of confusion. In that sense, the Court first stated that although the distinctive character or the earlier protected sign must be taken into account when assessing the likelihood of confusion, it is only one of the elements entering into that assessment (Judgment of the General Court in Case T-390/15, 2016, para. 76). Thereafter, the Court took the position that even in a case involving an earlier protected sign of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (Judgment of the General Court in Case T-390/15, 2016, para. 76).

Having regard to the mentioned, the Court took the view that starting from the fact that the earlier protected sign possesses *an average degree of distinctiveness* and that the products in question, taken as a whole, show a degree of similarity which is *slightly lower than the average degree of similarity*, but also from the fact that, on the other hand, the mentioned signs show *a high degree of similarity* and that the *relevant public* will evince *relatively low degree of attention* when selecting the mentioned products, in the concrete case there exists a *likelihood of confusion* (Judgment of the General Court in Case T-390/15, 2016, para. 72, 77).

CONCLUSION

The scope of trade mark as a subjective right, i.e. the limits of protection acquired by the trade mark, are determined depending on the circumstances of each concrete case. In other words, each sign protected by the trade mark enjoys a different scope of protection, which means that it is a factual issue, to which the answer cannot be given in advance. In that sense, solutions stipulated by the Directive which are related to the mentioned problem, represent only a starting point for determining the scope of trade mark as a subjective right, i.e. the framework in which the practice may operate. The mentioned solution is conditioned by, on one hand, the inability of the legislator to follow the everyday movement of commercial life, and on the other hand, by the fact that determining the existence of *the likelihood of confusion* depends largely on the subjective elements which are not suitable for precise defining with relevant legal norms.

Namely, when determining the scope of protection, we start from the concept of *likelihood of confusion*, whereby the mentioned concept is not defined by the Directive, but the Directive only gives its frameworks, which are identity, i.e. similarity of goods and services on the one hand, and identity, i.e. similarity of signs on the other. Starting from the mentioned frameworks, the practice has determined the elements on the basis of which the existence of the mentioned similarities is determined, and therefore the existence of *the likelihood of confusion*. However, the mentioned elements

cannot be treated as rules on the basis of which we could in advance give an answer on the existence of *the likelihood of confusion*, i.e. on the basis of which we could in advance determine the scope of protection acquired by the concrete trade mark. Such conclusion is conditioned by the fact that the assessment of mentioned similarities is made by *the average consumer*, which implies individual approach in each concrete case.

Thus, the scope of protection which is acquired by the trade mark as a subjective right is determined particularly for each sign protected by the trade mark, starting from the circumstances of the concrete case, on the basis of certain elements whose existence depends on the assessment of *the average consumer*, which includes certain subjective factors in the mentioned assessment, whereby the mentioned assessment must move in the framework established by the Directive.

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- Commission regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark, Official Journal L 303 (1995)
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ОБИМ СУБЈЕКТИВНОГ ПРАВА НА ЖИГ У ПРАВУ ЕВРОПСКЕ УНИЈЕ

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Резиме

Жигом као субјективним правом штите се ознаке које у промету служе за обележавање роба или услуга једног привредног субјекта у циљу разликовања од исте или сличне робе или услуге другог привредног субјекта. Како би наведени циљ био остварен, носилац жига може се супротставити сваком трећем лицу да без његове сагласности користи у привредном промету ознаку која је истоветна са жигом у односу на робу или услуге које су истоветне онима за које је жиг регистрован, као и ознаку која је истоветна, односно слична његовој жигом заштићеној ознаци, и то за обележавање роба или услуга које су истоветне или сличне онима за које је жиг регистрован, уколико постоји вероватноћа да због те истоветности,

односно сличности, настане забуна у релевантном делу јавности у погледу порекла жигом обележених роба или услуга.

Међутим, за разлику од прве ситуације, односно коришћења истоветне ознаке за обележавање истоветних роба или услуга, која је у великој мери једноставна за решавање, један од најсложенијих проблема који се јавља у вези са заштитом права носиоца жига тиче се друге ситуације, односно концепта вероватноће забуне, који уједно представља најважнији елемент за одређивање обима жига као субјективног права.

У вези са наведеним, треба истаћи да појам вероватноће забуне није дефинисан Директивом, већ је пракса, а пре свега Суд правде Европске уније, одредила елементе на основу којих се њено постојање утврђује. Наведени елементи су пре свега, релевантна јавност, сличност роба, односно услуга, и сличност ознака. Како би се утврдио обим заштите који се стиче одређеним жигом, потребно је дефинисати поменуте елементе, зависно од околности сваког конкретног случаја, пратећи критеријуме дефинисања установљене од стране Суда правде Европске уније.

Тако, када је реч о релевантној јавности, основни критеријум њеног дефинисања јесте просечни потрошач конкретне врсте роба или услуга који је разумно добро информисан и обазрив, са разумном моћи запажања, при чему је неопходно утврдити ниво његове пажње зависно од врсте роба или услуга у питању. Затим, када се ради о сличности роба, односно услуга, полази се од њихове природе, намењене сврхе, њиховог начина коришћења, као и од чињенице да ли су међусобно у конкуренцији или су комплементарне. Када је реч о сличности ознака, узима се у обзир визуелна, фонетска или концептуална сличност ознака, при чему наведена сличност мора бити заснована на укупном утиску који ознаке остављају, посебно имајући у виду њихове дистинктивне и доминантне компоненте. На крају, када се утврде поменуте елементи, суд врши процену постојања вероватноће забуне на општи начин, узимајући у обзир све претходно утврђене елементе, као и њихову међусобну зависност.

Дакле, да би жиг остварио своју сврху, односно како би се онемогућила забуна у промету у погледу порекла жигом обележених роба или услуга, неопходно је прецизно одредити његов обим, односно границе заштите коју исти пружа свом носиоцу у погледу конкретне ознаке. На наведени начин обезбеђују се интереси правне сигурности, имајући у виду да се омогућавањем потрошачима да разликују жигом обележену робу или услуге од роба или услуга које имају друго порекло штите како интереси носиоци жига тако и интереси потрошача.