

Being the Later Mark or the Earlier Mark does Play a Role

Background Cases

The European Court of Justice (ECJ) has stated, in two joined cases Strigl (C-90/11) and Securvita (C-91/11), that a mark consisting of an acronym which is not descriptive in itself, but created by and combined with a descriptive word combination, is not distinctive overall because of its 'ancillary position'.

How these findings with respect to grounds of refusal affect the global assessment of the likelihood of confusion was one of the key issues of the so called BGW preliminary ruling of the ECJ of October 22, 2015 (C-20/14).

In a nutshell, the ECJ was asked by the Bundespatentgericht (German Federal Patent Court) whether an acronym can, in principal, still dominate the overall impression of a mark, which consists of an acronym and its descriptive word combination, when conducting the assessment of the likelihood of confusion.

In this case the ECJ pointed out that due to the different legal contexts the findings of the application procedure cannot automatically be applied to the proceedings for the assessment of the likelihood of confusion.

Therefore, in particular the distinctive and dominant elements still have to be borne in mind as well as the case-law resulting from the Medion judgment (C-120/04). Also, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.

DSA versus



In a recent judgement of July 9, 2015, Case I ZB 16/14, the Bundesgerichtshof (German Federal Court of Justice) came to the conclusion that, exceptionally in this case in which the earlier mark BSA (word mark) does not consist of a word combination followed by its abbreviation (acronym) like the later mark DSA, this later mark can still be dominated by the acronym DSA.

This was justified by the Court because of the graphic accentuation of the acronym DSA within the mark DSA, even when the acronym itself is not distinctive because of its 'ancillary position' according to the Strigl and Securvita cases and the general rule is observed that non-distinctive elements cannot justify a likelihood of confusion.

This also applies when the average consumer will even perceive the descriptive character of the acronym.

The Court came to the conclusion that this exception has to be made. Otherwise a later mark would have been privileged inappropriately when it would be sufficient to simply add a non-distinctive element to the letter sequence, for example, by adding the descriptive word combination "DEUTSCHE SPORTMANAGEMENTAKADEMIE" to DSA.

However, on the other hand, the Court made explicitly clear that such an exception can only be made when a later mark is concerned, as, when an earlier mark is concerned, such non-distinctive elements like an acronym in an 'ancillary position' still cannot justify a likelihood of confusion.



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Conclusion

Therefore, being the later mark or the earlier mark consisting of an acronym which was created by and combined with a descriptive word combination does play a decisive role for the global assessment of the likelihood of confusion.



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