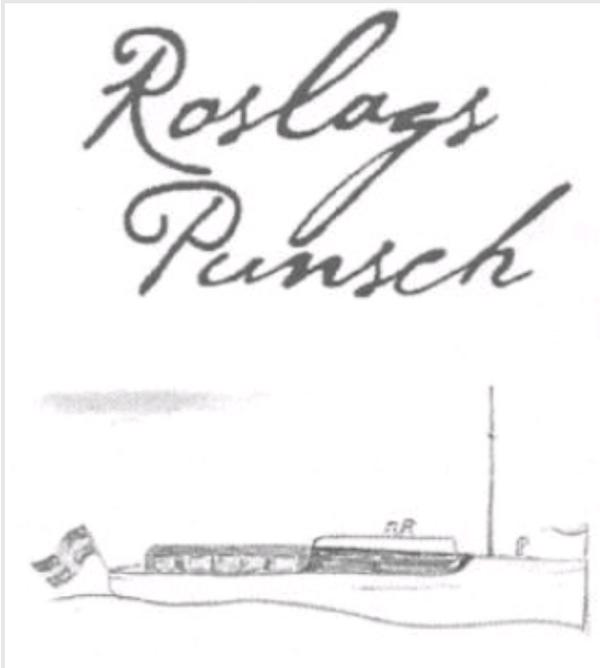


Court of Justice EU, 12 June 2019, Patent-och registreringsverket v Hansson



## TRADEMARK LAW

Member States are free to provide for waivers of rights under national law

- in so far as they do not impair the effectiveness of the Trade Mark Directive and, in particular the protection against trade marks that are liable to create a likelihood of confusion

37. In those circumstances, it must be stated, as the Advocate General observes in points 22 and 24 of his Opinion, that the Member States in principle remain free to lay down provisions in their national law allowing disclaimers to be recorded at the time of registration of signs as trade marks, whether those disclaimers are entered voluntarily by the applicant or at the request of the national authority with competence for registration, provided that the disclaimers do not impair the effectiveness of the provisions of Directive 2008/95, in particular the protection given to proprietors of earlier trade marks against the registration of trade marks liable to create a likelihood of confusion on the part of consumers or end users.

**Article 4(1)(b) Trade mark Directive 2008 precludes national legislation providing for a waiver of rights**

- whose effect would be to exclude an element of a complex trade mark from the global analysis of the relevant factors for showing the existence of a likelihood of confusion within the meaning of that provision,
- that attributes in advance and permanently, limited importance to such an element in that analysis

46. In the light of those principles and of all the case-law referred to in paragraphs 40 to 45 above, it must be

concluded, in the first place, that a disclaimer provided for by national law whose effect was to exclude an element of a complex trade mark, mentioned in the disclaimer, from the analysis of the relevant factors for establishing the existence of a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 because that element is descriptive or not distinctive would not be compatible with the requirements of that provision.

47. Such an exclusion could lead to an incorrect assessment both of the similarity between the signs at issue and of the distinctiveness of the earlier trade mark, which would lead to a distorted global assessment of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95, all the more so as those factors are interdependent, as stated in paragraph 43 above, that interdependence being directed, as the Advocate General observes in point 41 of his Opinion, to bringing the assessment of the likelihood of confusion into line as far as possible with the actual perception of the relevant public.

[...]

52. It must be stated, in the second place, that, for reasons analogous to those set out in paragraphs 48 to 51 above, a disclaimer provided for in national law whose effect were to attribute, in advance and permanently, a lack of distinctiveness to the element of a complex trade mark mentioned by it, so that the element has only limited importance in the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95, would also be incompatible with the requirements of that provision.

[...]

57. In the third place, the interpretation set out in paragraphs 46 and 52 above cannot be called into question by the fact that the element mentioned in the disclaimer at issue in the main proceedings is, under national law and because of its descriptive character, excluded from the protection granted to a registered trade mark, so that taking it into account in the analysis of the relevant factors for finding a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 would allow it to enjoy a protection which it cannot have in the system of that directive.

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**Court of Justice EU, 12 June 2019,**

(E. Regan, C. Lycourgos, E. Juhász, M. Ilešič (rapporteur), I. Jarukaitis)

JUDGMENT OF THE COURT (Fifth Chamber)

12 June 2019<sup>(1)</sup>

(Reference for a preliminary ruling — Trade marks — Directive 2008/95/EC — Article 4(1)(b) — Likelihood of confusion — Overall impression — Earlier trade mark registered with a disclaimer — Effects of such a disclaimer on the extent of protection of the earlier trade mark)

In Case C-705/17,

<sup>1</sup> Language of the case: Swedish

REQUEST for a preliminary ruling under Article 267 TFEU from the Svea hovrätt, Patent- och marknadsöverdomstolen (Svea Court of Appeal, Patents and Market Court of Appeal, Stockholm, Sweden), made by decision of 20 November 2017, received at the Court on 15 December 2017, in the proceedings

Patent- och registreringsverket

v

Mats Hansson,

THE COURT (Fifth Chamber),

composed of E. Regan, President of the Chamber, C. Lycourgos, E. Juhász, M. Ilešič (Rapporteur) and I. Jarukaitis, Judges,

Advocate General: G. Pitruzzella,

Registrar: C. Strömholm, Administrator,

after considering the observations submitted on behalf of:

– Patent- och registreringsverket, by K. Isaksson, M. Nowicka and M. Ahlgren, acting as Agents,

– the European Commission, by K. Simonsson, É. Gippini Fournier, E. Ljung Rasmussen and G. Tolstoy, acting as Agents,

having regard to the written procedure and further to the hearing on 13 December 2018,

after hearing [the Opinion of the Advocate General](#) at the sitting on 6 March 2019,

gives the following

#### Judgment

1. This request for a preliminary ruling concerns the interpretation of Article 4(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

2. The request has been made in proceedings between the Patent- och registreringsverket (Patent and Registration Office, Sweden, ‘the PRV’) and Mr Mats Hansson, a Swedish national, concerning the refusal to register the word sign ‘ROSLAGSÖL’ as a national trade mark.

#### Legal context

##### EU law

3. Recitals 4, 6, 8, 10 and 11 of Directive 2008/95 state: ‘(4) It does not appear to be necessary to undertake full-scale approximation of the trade mark laws of the Member States. It will be sufficient if approximation is limited to those national provisions of law which most directly affect the functioning of the internal market.

...

(6) Member States should also remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration. They can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both. ...

...

(8) Attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark be, in general, identical in all Member States. ...

...

(10) It is fundamental, in order to facilitate the free movement of goods and services, to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States. This should not, however, prevent the Member States from granting at their option extensive protection to those trade marks which have a reputation.

(11) The protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in the case of similarity between the mark and the sign and the goods or services. It is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion. The likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection. The ways in which likelihood of confusion may be established, and in particular the onus of proof, should be a matter for national procedural rules which should not be prejudiced by this Directive.’

4. In accordance with Article 3(1)(c) of Directive 2008/95:

‘1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

...

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services’.

5. Article 4(1)(b) of that directive provides:

‘1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

...

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark.’

6. Article 5(1)(b) of the directive reads as follows:

‘1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

...

*(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, 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.'*

7. Article 6(1)(b) of the directive provides:

*'1. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:*

...

*(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services'.*

8. Directive 2008/95 was repealed with effect from 15 January 2019 by 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 (OJ 2015 L 336, p. 1), which entered into force on 12 January 2016. In view of the date of the application for registration at issue in the main proceedings, the present reference for a preliminary ruling must however be examined by reference to the provisions of Directive 2008/95.

9. Article 37(2) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark (OJ 2009 L 78, p. 1), which replaced the identically worded Article 38(2) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), provided: *'Where the trade mark contains an element which is not distinctive, and where the inclusion of that element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, the [European Union Intellectual Property Office (EUIPO)] may request, as a condition for registration of said trade mark, that the applicant state that he disclaims any exclusive right to such element. Any disclaimer shall be published together with the application or the registration of the [European Union] trade mark, as the case may be.'*

10. Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Regulation No 40/94, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21), repealed Article 37(2) of Regulation No 207/2009.

#### **Swedish law**

11. In accordance with Paragraph 6 of Chapter 1 of the Varumärkslagen (2010:1877) (Law No 1877 of 2010 on trade marks, 'the Law of 2010'), the exclusive right to a trade mark is acquired by registration.

12. Point 2 of the first subparagraph of Paragraph 10 of Chapter 1 of the Law of 2010 provides that the exclusive right to a registered trade mark means that no

one other than the proprietor may, without his consent, use in the course of trade any sign where, because of its identity with or similarity to the trade mark and because of the identity or similarity of the goods covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, including the risk of an impression that there is an association between the user of the sign and the proprietor of the trade mark.

13. Paragraph 5 of Chapter 2 of the Law of 2010 provides that one of the general conditions of registration laid down by that chapter is that the trade mark must be distinctive for the goods or services which it covers.

14. Under point 2 of the first subparagraph of Paragraph 8 of Chapter 2 of the Law of 2010, a trade mark is not to be registered if it is similar to an earlier trade mark and the goods or services designated by the two marks are identical or similar, where there exists a likelihood of confusion, including the likelihood of an impression that there is an association between the user of the trade mark and the proprietor of the registered trade mark.

15. The first subparagraph of Paragraph 12 of Chapter 2 of the Law of 2010 provides that, if a trade mark contains an element which cannot be registered by itself and there is a clear risk that registration may give rise to uncertainty as to the scope of the exclusive right, that element may be excluded from protection at the time of registration, by a disclaimer.

16. The second subparagraph of Paragraph 12 provides that, if that element subsequently satisfies the conditions for registration, the element or the entire trade mark may be registered on a fresh application without such a disclaimer.

The dispute in the main proceedings and the questions referred for a preliminary ruling

17. In 2007 the Swedish company Norrtelje Brenneri Aktiebolag registered, for alcoholic drinks in Class 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, as a national trade mark the following word and figurative sign ('the earlier trade mark'):



Fig. 1.

18. That registration was accompanied by a disclaimer stating that 'registration does not give an exclusive right over the word RoslagsPunsch'. The disclaimer was required by the PRV as a condition of registration of the earlier trade mark, in so far as the term 'Roslags' refers to a region of Sweden and the term 'Punsch' describes one of the goods covered by the registration.

19. By document of 16 December 2015, Mr Hansson applied to the PRV for registration of the word sign 'ROSLAGSÖL' as a national trade mark for goods in Class 32 of the Nice Agreement, in particular non-alcoholic beverages and beers.

20. By decision of 14 July 2016, the PRV rejected the application for registration because of the likelihood of confusion between the sign and the earlier trade mark. The PRV found that the signs at issue started with the descriptive term 'Roslags'. The fact that they also included other words or figurative elements did not reduce the similarity, since the word 'Roslags' was a dominant element of both signs. Moreover, the signs referred to identical or similar products which could be distributed by the same sales networks and could address the same customers.

21. Mr Hansson brought an action before the Patent- och marknadsdomstolen (Patents and Market Court, Sweden) against that decision, arguing that there was no likelihood of confusion between the signs in question. As regards the effect of the disclaimer relating to the earlier trade mark on the outcome of the action, the PRV argued before that court that an element of a trade mark which has been excluded from protection by means of a disclaimer must in principle be regarded as not distinctive. In the present case, registration of the earlier trade mark had been granted with such a disclaimer because the trade mark included a term that was descriptive of a geographical region, 'Roslags'.

22. The practice of the PRV concerning the non-distinctive character of geographical names had developed in the meantime, in particular with the aim of putting into practice the conclusions in paragraphs 31 and 32 of the judgment of 4 May 1999, [Windsurfing Chiemsee](#) (C-108/97 and C-109/97, EU:C:1999:230). The term 'Roslags' was now capable of registration in itself as a trade mark and was distinctive for the goods at issue in the present case, so that it could even dominate the overall impression given by the earlier trade mark. It thus followed from a global assessment of the signs at issue that because of the common element 'Roslags' the relevant public could have the impression that the goods referred to by those signs had the same commercial origin.

23. The Patent- och marknadsdomstolen (Patents and Market Court), contrary to the position put forward by the PRV, allowed Mr Hansson's application and approved the registration of his sign as a trade mark, finding that there was no likelihood of confusion. The court also stated that, despite the disclaimer, the terms to which it related had to be taken into account in the assessment of that likelihood, in so far as they could have an effect on the overall impression created by the earlier trade mark, and hence on the extent of protection of that mark. According to the court, the purpose of the disclaimer was to make it clear that the exclusive right deriving from registration of the earlier trade mark did not relate to the terms referred to as such.

24. The PRV appealed against the judgment of the court of first instance to the Svea hovrätt, Patent- och marknadsöverdomstolen (Svea Court of Appeal, Patents and Market Court of Appeal, Stockholm, Sweden).

25. That court explains that in its view Directive 2008/95 and the associated case-law confirm that the substantive rules on the protection of a national trade mark are in principle fully harmonised at the level of EU law, while the procedural rules are within the competence of the Member States. It therefore asks whether a national rule allowing a disclaimer to be made may be categorised as a procedural rule, even though it has the effect of changing the criteria on which is based the global assessment to be carried out in order to examine the likelihood of confusion within the meaning of Article 4(1)(b) of that directive.

26. That court is uncertain whether that provision, having regard in particular to the settled case-law of the Court according to which the assessment of the likelihood of confusion must be based on an overall impression and the perceptions of consumers play a dominant part in the global assessment of that likelihood, may be interpreted as meaning that a disclaimer can affect that assessment because an element of the earlier trade mark was, at the time of registration, expressly excluded from protection by means of that disclaimer, so that that element must be given less importance in the analysis of the overall impression than it would have had in the absence of the disclaimer.

27. If Directive 2008/95 were to preclude such an approach, the question would then arise of whether it allows a disclaimer to have the effect that the element to which it relates is considered not to have been the subject of the registration of the earlier trade mark, and therefore not to enjoy the protection of that mark, so that it can be excluded from the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of that directive. That approach, according to the referring court, would appear to have been followed by EUIPO in the application of Article 37(2) of Regulation No 207/2009.

28. That court observes, moreover, that the case-law of the national courts is not uniform concerning the effect of a disclaimer, as provided for in national law, on the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95.

29. In those circumstances, the Svea hovrätt, Patent- och marknadsöverdomstolen (Svea Court of Appeal, Patents and Market Court of Appeal, Stockholm), decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

‘(1) Must Article 4(1)(b) of [Directive 2008/95] be interpreted as meaning that the global assessment of all relevant factors which is to be made in an assessment of the likelihood of confusion may be affected by the fact that an element of the trade mark has expressly been excluded from protection on registration, that is to say, that a so-called disclaimer has been entered on registration?’

(2) If the answer to the first question is in the affirmative, can the disclaimer in such a case affect the global assessment in such a way that the competent authority has regard to the element in question but gives it a more limited importance so that it is not regarded as being distinctive, even if the element would de facto be distinctive and prominent in the earlier trade mark?’

(3) If the answer to the first question is in the affirmative and the answer to the second question in the negative, can the disclaimer even so affect the global assessment in any other way?’

#### **Consideration of the questions referred**

30. By its questions, which should be considered together, the referring court asks in substance whether Article 4(1)(b) of Directive 2008/95 must be interpreted as precluding national legislation making provision for a disclaimer whose effect would be to exclude an element of a complex trade mark, referred to in that disclaimer, from the analysis of the relevant factors for showing the existence of a likelihood of confusion within the meaning of that provision, or to attribute to such an element, in advance and permanently, limited importance in that analysis.

31. As a preliminary point, it should be recalled that the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, to

that effect, judgments of 16 September 2004, [SAT.1 v OHIM](#), C-329/02 P, EU:C:2004:532, paragraph 23, and of 8 June 2017, [W. F. Gözze Frottierweberei and Gözze](#), C-689/15, EU:C:2017:434, paragraph 41).

32. Directive 2008/95, which applies, in accordance with Article 1, in particular to trade marks for goods or services which are the subject of registration or of an application in a Member State for registration, approximates, as stated in recitals 4, 6, 8 and 10, those national provisions of law which most directly affect the functioning of the internal market. According to those recitals, it is fundamental, for that purpose, to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States and that the conditions for obtaining a registered trade mark are, in general, identical in all Member States, while leaving the Member States free to fix the procedural provisions concerning inter alia the registration of those trade marks.

33. In this respect, Article 5(1)(b) of Regulation No 2008/95 states that the registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent inter alia from using in the course of trade any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, 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.

34. Article 4(1)(b) of Directive 2008/95 provides for its part that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

35. Those provisions thus aim to protect the individual interests of proprietors of earlier trade marks, and guarantee the trade mark as an indication of origin if there is a likelihood of confusion (see, to that effect, judgment of 6 October 2005, [Medion](#), C-120/04, EU:C:2005:594, paragraphs 24 and 26, and of 22 October 2015, [BGW](#), C-20/14, EU:C:2015:714, paragraph 26).

36. Neither those provisions nor any other provisions of Directive 2008/95 contain an obligation for Member States to introduce, or a prohibition on their introducing, provisions in their national law under which the registration of a sign as a trade mark may be accompanied by a disclaimer. Nor do those provisions specify the effects of such a disclaimer on the examination of the likelihood of confusion within the meaning of that directive.

37. In those circumstances, it must be stated, as the Advocate General observes in points 22 and 24 of his Opinion, that the Member States in principle remain free to lay down provisions in their national law

allowing disclaimers to be recorded at the time of registration of signs as trade marks, whether those disclaimers are entered voluntarily by the applicant or at the request of the national authority with competence for registration, provided that the disclaimers do not impair the effectiveness of the provisions of Directive 2008/95, in particular the protection given to proprietors of earlier trade marks against the registration of trade marks liable to create a likelihood of confusion on the part of consumers or end users.

38. In addition, such disclaimers must not have the effect of calling in question the objectives pursued by Directive 2008/95, referred to in recitals 8 and 10 of the directive, namely to ensure that the conditions for obtaining a registered trade mark are, in general, identical in all Member States, and to guarantee equal protection of trade marks under the legal systems of all the Member States (see, by analogy, judgments of 26 April 2007, Boehringer Ingelheim and Others, C-348/04, EU:C:2007:249, paragraphs 58 and 59; of 19 June 2014, Oberbank and Others, C-217/13 and C-218/13, EU:C:2014:2012, paragraphs 66 and 67; and of 22 September 2011, Budějovický Budvar, C-482/09, EU:C:2011:605, paragraphs 30 and 32).

39. In the present case, the referring court sets out three possible effects of a disclaimer, as provided for by national law, on the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95. According to that court, a first interpretation of national law would be that the element of a complex mark that is the subject of such a disclaimer is excluded from the analysis of the likelihood of confusion. A second interpretation of that law would be that such an element is indeed taken into account in that analysis, but its importance for that purpose must be limited, even if it is in reality the distinctive and dominant element of the trade mark. A third interpretation would, in substance, be that in the analysis of the likelihood of confusion account must be taken of such an element in a manner consistent with the principles applicable to that analysis identified in the settled case-law of the Court.

40. On this point, it must be recalled that the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 (see, to that effect, judgments of 29 September 1998, Canon, C-39/97, EU:C:1998:442, paragraph 29, and of 8 May 2014, Bimbo v OHIM, C-591/12 P, EU:C:2014:305, paragraph 19 and the case-law cited).

41. According to settled case-law of the Court, the existence of a likelihood of confusion depends on numerous elements, in particular the recognition of the trade mark on the market, the association which can be made with the used or registered sign, and the degree of similarity between the trade mark and the sign and between the goods or services identified. The likelihood of confusion must therefore be appreciated

globally, taking into account all the relevant factors of the particular case (see, to that effect, judgments of 29 September 1998, Canon, C-39/97, EU:C:1998:442, paragraph 16; of 22 June 1999, Lloyd Schuhfabrik Meyer, C-342/97, EU:C:1999:323, paragraph 18; and of 10 April 2008, adidas and adidas Benelux, C-102/07, EU:C:2008:217, paragraph 29).

42. Those factors also include the distinctiveness of the earlier trade mark, which determines the extent of protection. The Court has previously stated that the more distinctive the earlier mark, the greater the likelihood of confusion will be (see, to that effect, judgment of 8 November 2016, BSH v EUIPO, C-43/15 P, EU:C:2016:837, paragraph 62 and the case-law cited).

43. A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, in particular a similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the trade marks, and vice versa. The interdependence of these factors is expressly mentioned in recital 11 of Directive 2008/95, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion (see, to that effect, judgments of 29 September 1998, Canon, C-39/97, EU:C:1998:442, paragraph 17, and of 22 June 1999, Lloyd Schuhfabrik Meyer, C-342/97, EU:C:1999:323, paragraph 19).

44. Similarly, according to the Court's case-law, the fact that a trade mark is of weak distinctiveness does not exclude a likelihood of confusion, in particular where the signs and the goods or services covered are similar (see, to that effect, judgment of 8 November 2016, BSH v EUIPO, C-43/15 P, EU:C:2016:837, paragraph 63 and the case-law cited).

45. That global assessment must, as regards the visual, phonetic or conceptual similarity of the trade marks at issue, be based on the overall impression created by them. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, judgments of 11 November 1997, SABEL, C-251/95, EU:C:1997:528, paragraph 23; of 22 June 1999, Lloyd Schuhfabrik Meyer, C-342/97, EU:C:1999:323, paragraph 25; and of 22 October 2015, BGW, C-20/14, EU:C:2015:714, paragraph 35).

46. In the light of those principles and of all the case-law referred to in paragraphs 40 to 45 above, it must be concluded, in the first place, that a disclaimer provided for by national law whose effect was to exclude an element of a complex trade mark, mentioned in the disclaimer, from the analysis of the relevant factors for establishing the existence of a likelihood of confusion within the meaning of Article 4(1)(b) of Directive

2008/95 because that element is descriptive or not distinctive would not be compatible with the requirements of that provision.

47. Such an exclusion could lead to an incorrect assessment both of the similarity between the signs at issue and of the distinctiveness of the earlier trade mark, which would lead to a distorted global assessment of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95, all the more so as those factors are interdependent, as stated in paragraph 43 above, that interdependence being directed, as the Advocate General observes in point 41 of his Opinion, to bringing the assessment of the likelihood of confusion into line as far as possible with the actual perception of the relevant public.

48. As regards, first, the assessment of the similarity between the signs at issue, it should be recalled that it cannot be confined to taking one sole component of a complex trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, taking account in particular of their distinctive and dominant elements (see, to that effect, judgment of 22 October 2015, [BGW](#), C-20/14, EU:C:2015:714, paragraph 36 and the case-law cited).

49. It is therefore necessary in each individual case to analyse the components of a sign and their relative weight in the perception of the public, in order to determine in the light of the particular circumstances of the case the overall impression made on the public by the signs at issue (see, to that effect, judgment of 8 May 2014, [Bimbo v OHIM](#), C-591/12 P, EU:C:2014:305, paragraphs 34 and 36). It cannot therefore be considered in advance and in general that the descriptive elements of signs at issue must be excluded from the assessment of their similarity (see, in that respect, order of 7 May 2015, *Adler Modemärkte v OHIM*, C-343/14 P, not published, EU:C:2015:310, paragraph 38).

50. As regards, second, the distinctiveness of the earlier trade mark, it follows from the Court's case-law that the determination of distinctiveness depends on the inherent characteristics of the trade mark, including the presence or absence of elements that are descriptive of the goods or services for which it has been registered as a mark (see, to that effect, judgment of 22 June 1999, [Lloyd Schuhfabrik Meyer](#), C-342/97, EU:C:1999:323, paragraphs 20, 22 and 23 and the case-law cited).

51. As the Advocate General observes in point 43 of his Opinion, the power of a trade mark to identify the goods or services for which it has been registered as a mark as coming from a particular undertaking must be assessed in relation to the sign as a whole, and hence in the light of all its components, so that the exclusion of one of the elements of the earlier trade mark from the analysis of the distinctiveness of that mark may have an effect on the extent of protection of that mark.

52. It must be stated, in the second place, that, for reasons analogous to those set out in paragraphs 48 to 51 above, a disclaimer provided for in national law

whose effect were to attribute, in advance and permanently, a lack of distinctiveness to the element of a complex trade mark mentioned by it, so that the element has only limited importance in the analysis of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95, would also be incompatible with the requirements of that provision.

53. In this respect, it must be observed, first, that the descriptive, non-distinctive or weakly distinctive elements of a complex trade mark, whether or not mentioned in a disclaimer such as that at issue in the main proceedings, generally have less weight in the analysis of the similarity between the signs than the elements of greater distinctiveness, which are also more able to dominate the overall impression created by the mark (see, in that respect, judgment of 11 November 1997, [SABEL](#), C-251/95, EU:C:1997:528, paragraph 23, and order of 27 April 2006, *L'Oréal v OHIM*, C-235/05 P, not published, EU:C:2006:271, paragraph 43).

54. However, the Court has held that the individual assessment of each sign for the purpose of determining the overall impression produced by it, as required by the Court's settled case-law, must be made in the light of the particular circumstances of the case and cannot be regarded as being subject to general presumptions (see, to that effect, judgment of 8 May 2014, [Bimbo v OHIM](#), C-591/12 P, EU:C:2014:305, paragraph 36).

55. Second, where the earlier trade mark and the sign whose registration is sought coincide in an element that is weakly distinctive or descriptive with regard to the goods or services at issue, the global assessment of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 will admittedly not often lead to a finding that that likelihood exists. However, it follows from the Court's case-law that a finding that a likelihood of confusion exists cannot, because of the interdependence of the relevant factors, be ruled out in advance and in any event (see, in that respect, order of 29 November 2012, *Hrbek v OHIM*, C-42/12 P, not published, EU:C:2012:765, paragraph 63, and judgment of 8 November 2016, *BSH v EUIPO*, C-43/15 P, EU:C:2016:837, paragraphs 48 and 61 to 64).

56. It follows from the above that the attribution to an element of a complex trade mark, mentioned in a disclaimer, of non-distinctiveness and hence of limited weight in the global assessment of the likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 could indeed correspond in some situations to the relevant public's perception of the signs at issue. However, it cannot be considered that that will necessarily be so in every case, so that a disclaimer having that effect could lead to the registration of signs liable to produce a likelihood of confusion on the part of the public within the meaning of that provision.

57. In the third place, the interpretation set out in paragraphs 46 and 52 above cannot be called into question by the fact that the element mentioned in the disclaimer at issue in the main proceedings is, under

national law and because of its descriptive character, excluded from the protection granted to a registered trade mark, so that taking it into account in the analysis of the relevant factors for finding a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 2008/95 would allow it to enjoy a protection which it cannot have in the system of that directive.

58. A finding of a likelihood of confusion leads solely to the protection of a certain combination of elements without, however, a descriptive element which forms part of that combination being protected as such (see, by analogy, orders of 15 January 2010, *Messer Group v Air Products and Chemicals*, C-579/08 P, not published, EU:C:2010:18, paragraph 73, and of 30 January 2014, *Industrias Alen v The Clorox Company*, C-422/12 P, EU:C:2014:57, paragraph 45). Consequently, the proprietor of a complex trade mark cannot in any event claim an exclusive right solely in one element of the trade mark, whether or not it is referred to in a disclaimer provided for by national law.

59. Moreover, as the Advocate General observes in points 26 and 50 of his Opinion, Directive 2008/95 provides sufficient guarantees to ensure that signs consisting exclusively of signs or indications that are descriptive of categories of goods or services for which registration is sought are, pursuant to Article 3(1)(c), not registered or are declared invalid, and may thus be freely used by other economic operators.

60. In addition, it follows from Article 6(1)(b) of that directive that, where a sign is validly registered as a trade mark, the exclusive right conferred by the mark does not allow its proprietor to prohibit a third party from using in the course of trade descriptive indications for the goods and services concerned, subject to compliance with certain conditions (see, in that respect, judgments of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraphs 25 and 28; of 10 April 2008, *adidas and adidas Benelux*, C-102/07, EU:C:2008:217, paragraphs 46 and 47; and of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU:C:2011:139, paragraphs 59 to 62).

61. Furthermore, it must be observed that that interpretation is in line with the objectives of Directive 2008/95 referred to in paragraph 32 above, in so far as it aims to ensure that a registered national trade mark is protected against a likelihood of confusion in accordance with the same criteria and thus in a uniform manner in all the Member States, having regard in particular to the fact that numerous Member States do not provide for the possibility of registering signs as trade marks with such disclaimers and that the conditions of recording those disclaimers and the effects of the disclaimers may vary between the legal systems of the Member States.

62. It follows from all the above considerations that Article 4(1)(b) of Directive 2008/95 must be interpreted as precluding national legislation making provision for a disclaimer whose effect would be to exclude an element of a complex trade mark, referred

to in that disclaimer, from the global analysis of the relevant factors for showing the existence of a likelihood of confusion within the meaning of that provision, or to attribute to such an element, in advance and permanently, limited importance in that analysis.

#### Costs

63. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the referring court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Fifth Chamber) hereby rules:

Article 4(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as precluding national legislation making provision for a disclaimer whose effect would be to exclude an element of a complex trade mark, referred to in that disclaimer, from the global analysis of the relevant factors for showing the existence of a likelihood of confusion within the meaning of that provision, or to attribute to such an element, in advance and permanently, limited importance in that analysis.

[Signatures]

## OPINION OF ADVOCATE GENERAL PITRUZZELLA

delivered on 6 March 2019 (1)

Case C-705/17

Patent- och registreringsverket

v

Mats Hansson

(Request for a preliminary ruling

from the Svea hovrätt (Svea Court of Appeal, Stockholm, Sweden))

(Reference for a preliminary ruling — Trade marks — Directive 2008/95/EC — Grounds for refusal or invalidity — Conflicts with earlier rights — Earlier mark containing a geographical name — Name excluded from protection by a disclaimer — Global assessment)

1. In certain legal systems, the registration of a trade mark may be accompanied by a note or remark recording a statement of waiver, a so-called ‘disclaimer’, if the application concerns a complex or composite sign that contains one or more descriptive or general words relating to the product(s) or service(s) covered by the application. Depending on the system of rules that applies, the disclaimer may be offered by the applicant voluntarily or may be required by the competent office as a condition of registration, and its purpose is to make it clear that the descriptive, non-distinctive word or words within the sign applied for will not be covered by exclusive rights and will thus remain available for general use. (2) The proprietor of the mark will not, therefore, be entitled to prohibit

other undertakings from using the word or words in question.

2. Swedish law permits the use of such disclaimers. In the request for a preliminary ruling which is the subject of this Opinion, the Svea hovrätt, Patent- och marknadsöverdomstolen (Svea Court of Appeal, Patents and Market Court of Appeal, Stockholm, Sweden) has asked the Court of Justice whether, and if so under what conditions, in the event that there is a conflict between a sign for which registration as a trade mark is sought and an earlier mark, the fact that an element of the earlier mark is covered by a disclaimer affects the assessment of the likelihood of confusion that must be carried out for the purposes of Article 4(1)(b) of Directive 2008/95/EC. (3)

3. That question arose in a dispute concerning the rejection by the Patent- och registreringsverket (the Swedish Patent Registration Office, 'the PRV') of an application made by Mr Mats Hansson for registration of a national word mark.

#### Legal framework

##### EU law

4. Pursuant to Article 4(1)(b) of Directive 2008/95:

*'1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:*

...

*(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark.'* (4)

5. Pursuant to Article 5(1)(b) of Directive 2008/95:

*'The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:*

...

*(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, 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.'* (5)

##### National law

6. Point 2 of the first paragraph of Article 10 of Chapter 1 of the varumärkslagen (2010:1877) (Law No 1877 of 2010 on trade marks, 'the VML'), (6) which transposed into Swedish law Article 5(1)(b) of Directive 2008/95, defines the content of the exclusive right conferred on the proprietor of a registered trade mark to prohibit the use by unauthorised third parties of signs that would give rise to a likelihood of confusion or association with the registered trade mark.

7. In accordance with Article 5 of Chapter 2 of the VML, which transposed into Swedish law Article 3(1)(b) of Directive 2008/95, in order to be registered, a trade mark must have distinctive character in relation

to the goods or services for which registration is sought.

8. In accordance with the first paragraph of Article 12 in Chapter 2 of the VML, if a trade mark contains an element which cannot be registered by itself and there is a clear risk that registration of the mark may give rise to uncertainty as to the scope of the exclusive right conferred on the proprietor, that element may be expressly excluded from protection at the time of registration. The second paragraph of Article 12 provides that, if that element subsequently satisfies the requirements for registration, that element or the trade mark in its entirety may be registered, following a fresh application, without the exclusion provided for in the first paragraph.

#### The main proceedings and the questions referred for a preliminary ruling

9. On 16 December 2015, Mats Hansson, the respondent in the main proceedings, lodged with the PRV, the appellant in the main proceedings, an application for registration of the word ROSLAGSÖL as a national word mark for goods in Class 32 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended ('the Nice Agreement'), and, in particular, for non-alcoholic beverages and beers ('the mark applied for').

10. By decision of 14 July 2016, the PRV refused the application for registration because of the likelihood of confusion between the mark applied for and the earlier figurative mark ROSLAGS PUNSCH ('the earlier mark'), which is shown below:

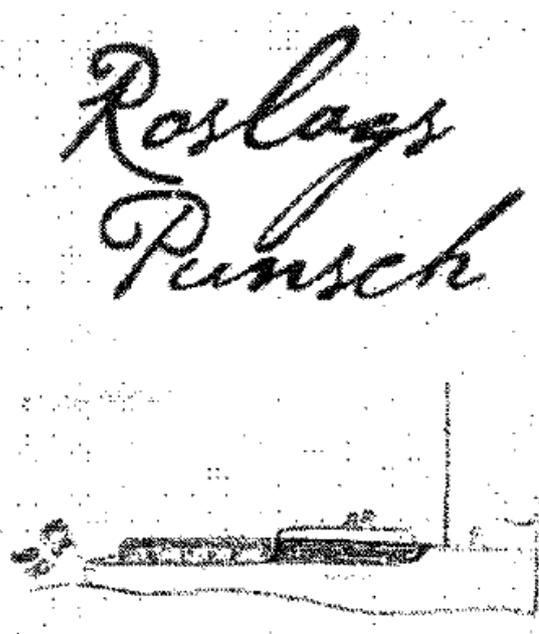


Fig. 1.

The earlier mark had been registered for alcoholic beverages in Class 33 of the Nice Agreement and has been held since 2007 by the company Norrtelje

Brenneri Aktiebolag. (7) The registration of the earlier mark was accompanied by the following remark: 'Registration does not give an exclusive right over the word "Roslagspunsch"'.  
(8)

11. Roslagen is the name of a geographical region on Sweden's eastern seaboard.

12. In reaching its conclusion that there was a likelihood of confusion, the PRV took account of the fact that the marks at issue both began with the descriptive term 'Roslags', which was dominant in both signs, and that the two marks were to be used for identical or similar goods that were likely to be distributed via similar channels and sold to the same customers.

13. Mr Hansson brought an action against the PRV's decision of 14 July 2016 before the Patent- och marknadsdomstolen (Patents and Market Court, Sweden), arguing that there was no similarity between the mark applied for, which was a word mark, and the earlier mark, which was a figurative mark, and that the word 'Roslagen' was commonly used in the distinctive signs used by firms in the region to which the word referred. In the course of the proceedings before the Patent- och marknadsdomstolen (Patents and Market Court), the parties expressed their positions on the effect of the disclaimer which accompanied the registration of the earlier mark. The PRV submitted that, as a rule, the elements of a mark that are excluded from protection because of a disclaimer are regarded as lacking in distinctive character and cannot therefore be taken into consideration in the assessment of the likelihood of confusion. The PRV nevertheless stated that its practice with regard to the registration of geographical names had changed over time and that, in accordance with the rules currently followed, the word 'Roslags', appearing in the earlier mark, must be taken into consideration, notwithstanding the disclaimer, in assessing whether there was a ground for refusal arising from a likelihood of confusion with the earlier mark.  
(8)

14. The Patent- och marknadsdomstolen (Patents and Market Court) upheld Mr Hansson's action. It found, in essence, that, notwithstanding the disclaimer, the words 'Roslags' and 'Punsch' did have to be taken into consideration in the assessment of the likelihood of confusion between the marks at issue, because of their effect on the overall impression given by the earlier mark. However, according to that court, the figurative elements of the earlier mark and the fact that the verbal element of the earlier mark comprised two separate words were sufficient to render the two marks visually different. It also took the view that the difference between the verbal element 'punsch' in the earlier mark and the letters 'öl' at the end of the word that constituted the mark applied for, meant that there was little aural similarity between the two marks. Finding also that there was only a low degree of similarity between the goods in question, the Patent- och marknadsdomstolen (Patents and Market Court) concluded that there was no likelihood of confusion.

15. The PRV brought an appeal against the judgment at first instance before the referring court.

16. The referring court observes that, although provisions of substantive law on the protection of trade marks are fully harmonised by Directive 2008/95, procedural rules remain, in principle, within the competence of the Member States. It questions whether a national provision which permits the lodging of a disclaimer at the time of registration of a mark may be regarded as a procedural rule where it has the effect of altering the criteria by reference to which the assessment of the overall impression given by a mark is carried out in the context of the assessment of the likelihood of confusion pursuant to Article 4(1)(b) of Directive 2008/95.

17. The referring court also queries whether such a provision precludes the elements of a mark covered by a disclaimer from being excluded from the assessment of the likelihood of confusion, or their being ascribed lesser importance, in the context of that assessment, than they would have been given in the absence of the disclaimer.

18. In this connection, the referring court points out that, in a judgment of 1991, (9) the Högsta förvaltningsdomstolen (Supreme Administrative Court, Sweden, formerly known as Regeringsrätten), which was at that time the highest Swedish court for trade mark matters, held that the elements of a registered trade mark covered by a disclaimer had to be taken into consideration in determining the overall impression given by the mark for the purposes of the assessment of the likelihood of confusion with a later mark. However, in more recent judgments, given by courts other than the court of last instance, the elements covered by a disclaimer have been regarded as having no distinctive character and consequently as having less weight in the assessment of the overall impression given by a trade mark. (10)

19. It was in that context that, by decision of 20 November 2017, the Svea hovrätt (Svea Court of Appeal, Stockholm) stayed the proceedings before it and referred the following questions to the Court for a preliminary ruling:

'Must Article 4(1)(b) of ... Directive [2008/95] be interpreted as meaning that the global assessment of all relevant factors which is to be made in an assessment of the likelihood of confusion may be affected by the fact that an element of a trade mark has expressly been excluded from protection on registration, that is to say, that a so-called disclaimer has been entered on registration?

If the answer to the first question is in the affirmative, can the disclaimer in such a case affect the global assessment in such a way that the competent authority has regard to the element in question but gives it a more limited importance so that it is not regarded as being distinctive, even if the element is de facto distinctive and prominent in the earlier trade mark?

If the answer to the first question is in the affirmative and the answer to the second question in the negative,

can the disclaimer even so affect the global assessment in some other way?’

Procedure before the Court of Justice

20. The PRV, Mr Hansson and the European Commission have submitted written observations to the Court, in accordance with Article 23 of the Statute of the Court of Justice of the European Union. Those parties attended the hearing on 13 December 2018.

#### Analysis

21. By the three questions which it has referred for a preliminary ruling, which it is appropriate to deal with together, the Svea hovrätt (Svea Court of Appeal, Stockholm) essentially asks whether an element of an earlier mark that is covered by a disclaimer can affect the assessment of the likelihood of confusion, within the meaning of Article 4(1)(b) of Directive 2008/95, and if so how.

22. Although they are not expressly contemplated by Directive 2008/95, disclaimers, for which provision is made in only a very few Member States, (11) cannot be regarded as in themselves inconsistent with that directive. (12) As stated in recital 4 thereof, Directive 2008/95 does not pursue the objective of full-scale approximation of the trade mark laws of the Member States, but instead seeks to harmonise only those national provisions of law which most directly affect the functioning of the internal market, (13) such as those governing the conditions for obtaining and continuing to hold registered trade marks, (14) leaving the Member States ‘free’ to fix the provisions of procedure, (15) including those relating to the registration of trade marks. (16)

23. The system of regulation of the EU trade mark, in parallel with harmonised national systems, (17) has, for over 20 years, permitted the registration of signs containing elements which are not distinctive, provided that the applicant lodges, at the request, initially, of the Office for Harmonisation in the Internal Market (OHIM) and, subsequently, of the European Union Intellectual Property Office (EUIPO), a statement disclaiming any exclusive right over such elements. (18)

24. The consistency with Directive 2008/95 of the use of disclaimers is nevertheless conditional on compliance with the provisions of that directive.

25. For example, a disclaimer cannot be used in order to obtain registration of a mark comprising only descriptive or non-distinctive elements, (19) which would be in breach of Article 3(1)(b) and (c) of Directive 2008/95. More generally, given that the function of disclaimers is to enable the registration of marks which are registrable as a whole but which contain within them elements that, taken in isolation, are not registrable, it would be contrary both to that function and to the provisions of Directive 2008/95 if a disclaimer could be used to overcome absolute impediments to registration of a mark. Equally, a disclaimer cannot be allowed if it relates to the distinctive elements of the mark applied for. Such a disclaimer would not only contravene the rules of Directive 2008/95 which lay down the requirements for

obtaining a mark, but would also unduly restrict the scope of the protection afforded to the mark, which the directive intended to be unitary in character. (20)

26. In short, the idea of a disclaimer is not in itself incompatible with Directive 2008/95, provided that its function is confined to making explicitly clear, in the interests of greater transparency and legal certainty, the limits of the protection afforded to the registered mark (as regards certain of its elements), resulting from the application of the provisions concerning the absolute impediments to registration laid down in Directive 2008/95. I would point out in this connection that paragraph 1(b) of Article 6 of the directive, which is headed ‘Limitation of the effects of a trade mark’, provides that a trade mark does not entitle its proprietor to prohibit third parties from using, in the course of trade, ‘indications (21) concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services’, (22) thus emphasising, in general terms, that such indications — which are not in themselves registrable as trade marks — (23) remain available for use even if they are elements of a composite or complex sign that has been registered as a mark. (24)

27. While the registration of a trade mark accompanied by a disclaimer may, within the limits I have described, be regarded as being in line with Directive 2008/95, and now Directive 2015/2436, it is necessary to consider, as the referring court asks the Court of Justice to do, what consequences flow from such a waiver in the event that a conflict arises between such a trade mark and a later sign.

28. The protection afforded to a trade mark entails, in accordance with Article 5(1)(b) of Directive 2008/95, the right for the proprietor of the mark to prevent third parties not having his consent from using in the course of trade ‘any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, 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’. By the same token, Article 4(1)(b) of the directive provides that a trade mark may not be registered or, if registered, is liable to be declared invalid where there exists the same likelihood of confusion with an earlier mark.

29. The likelihood of confusion thus constitutes the ‘specific condition for [the] protection’ afforded to registered trade marks by Directive 2008/95, in particular, against the use by third parties of non-identical signs. (25) The Court has defined that condition as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings. (26)

30. As indicated in recital 11 of Directive 2008/95, (27) a number of factors come into play in the assessment of the likelihood of confusion, in particular, the recognition of the trade mark on the market, the

association which can be made with the used or registered sign, the degree of similarity between the conflicting signs and between the goods or services which they designate. The likelihood of confusion must therefore be assessed globally, with account being taken of all the relevant factors of the case at hand. (28) 31. In particular, in order to assess the degree of similarity between conflicting signs, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to assess the importance to be attached to those various factors, taking account of the category of goods or services in question and the circumstances in which they are marketed. (29) The visual, aural or conceptual similarity of the signs in question must be the subject of a global assessment in which the perception of the signs by the average consumer of the goods or services in question plays a decisive role. (30) It has been clarified in the case-law that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. (31) The global assessment of the visual, aural or conceptual similarity of the conflicting signs must therefore be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant components. (32) The Court has also clarified that assessing the similarity between two signs means more than taking just one component of a composite sign and comparing it with another sign, and that the comparison must be made by examining each of the signs in question as a whole. (33) The Court has stated that, in principle, even an element that has only weak distinctive character may dominate the overall impression of a composite mark if, in particular, because of its position in the sign or its size, 'it may make an impression on consumers and be remembered by them'. (34) Lastly, the Court has clarified that the appraisal of the similarity between signs must not be carried out in the abstract, but must take specific account of the manner in which the consumer comes into contact with the mark, having regard in particular to the fact that 'the average consumer only rarely has the chance to make a direct comparison between ... different marks but must place his trust in the imperfect picture of them that he has kept in his mind'. (35) 32. From the principles which I have set out above flow two fundamental points of guidance for answering the questions which have been raised in the present reference for a preliminary ruling. 33. In the first place, as we have seen, the similarity between conflicting signs must be assessed by reference to the public's perception. That rule, the criteria for the application of which the Court of Justice and the General Court have progressively defined in the case-law, has its origin in the function which EU law ascribes to trade marks. In Directive 2008/95 (and now in Directive 2015/2436), as in the regulation on the European Union trade mark, (36) a trade mark is protected first and foremost because of its distinguishing function, (37) that is, as a sign which identifies the commercial origin of the goods or

services which it designates. The likelihood of confusion, as a pre-condition for protection of a trade mark, is a test designed to ensure that that function may operate without interference among those to whom the mark is addressed, that is to say, the consumers of the goods or services which the mark designates.

34. If the assessment of the similarity between conflicting signs, in the context of an assessment of the likelihood of confusion, were to be carried out only after excluding from consideration one of the components of the earlier sign, the image of the sign with which the public comes into contact would thereby be distorted and it would therefore be more difficult to form a conclusion in strict alignment with the perception of the relevant consumer in the particular case at hand, which is, however, required by the case-law I have cited. (38)

35. In the second place, in accordance with the case-law of the Court of Justice and the General Court, the rule relating to perception that is of pre-eminent importance is that the mark must be perceived as a whole. Admittedly, the various components of a mark must be analysed individually, in order to determine the relative importance of each of them within the mark and the relationships between them. However, the purpose of that analysis is to determine, through a synthesis of those factors, the overall impression conveyed by the sign as a whole that is likely to be remembered by the relevant public. Two consequences flow from that.

36. First, if the similarity between conflicting signs, on which the existence of a likelihood of confusion depends, (39) must be assessed by reference to the overall impression conveyed by the signs to the average consumer of the goods or services in question, it follows that the proprietor of a complex mark may not, irrespective of the existence of a disclaimer, claim exclusive rights over only one part of the mark. The protection afforded by Article 5(1)(b) of Directive 2008/95 operates against the use of signs which might be confused with a trade mark considered as a whole, not as regards its individual elements. This further relegates the function of disclaimers to that of a simple means of clarifying the limits of the protection which the mark enjoys.

37. Secondly, the fact that it is necessary to reconstruct the overall impression created by a mark militates in favour of the view that the existence of a disclaimer will have no effect on the manner in which the comparison of conflicting marks must be carried out. Indeed, to exclude from consideration the element covered by a disclaimer would both alter the actual determination, on the basis of the public's perception, of the overall impression created and render it necessary to 'dissect' the various components of the mark, which would be not only an artificial exercise but one that could prove difficult in practice. (40)

38. In conclusion, given that the rules relating to perception must be observed in the assessment of the similarity between conflicting signs and the fact that that assessment must be strictly objective, I think the

existence of a disclaimer covering just one element of a mark for which protection is sought should not alter the parameters of that assessment: it should result in neither the exclusion of that element from consideration, nor the attribution to that element of a value within the sign or a distinctive character other than that which it actually has. The determination, through a synthesis of all the factors, of the overall impression conveyed by the mark as a whole must, even in such a case, be arrived at solely by reference to the perception of the relevant public.

39. As I have mentioned, similarity between conflicting signs is only one of the factors on which a likelihood of confusion depends.

40. Whether or not a likelihood of confusion as to origin exists must be determined in the context of a final assessment in which all the factors relevant to the circumstances of the case are taken into account and weighed. (41)

41. Even in the context of such an assessment, the perception of the public plays a central role. (42) As the Court of Justice has repeatedly held, ‘a global assessment of the likelihood of confusion implies some interdependence between the relevant factors’. (43) Establishing the relationships between those various factors and balancing them, in particular the similarity between the marks and the similarity between the goods or services which they designate, must be done from the perspective of the relevant public. The existence of interdependence between the various factors that come into play has been recognised by the Court precisely so that the assessment of the likelihood of confusion will be, as far as possible, in line with actual public perception.

42. Among the factors that must be taken into consideration in the assessment of the likelihood of confusion, the Court of Justice has also included the distinctive character, original or acquired, of the mark for which protection is sought. (44)

43. The greater or lesser identifying power of a mark must also be assessed from the perspective of the relevant public and in the light of all the circumstances of the case (45) and, again, account must be taken of all the components of the mark. To expunge from that assessment one of the elements of a complex mark, or to ascribe to it a weight other than that which it actually has, could affect the global assessment of the identifying power of the mark. That identifying power depends of how capable the sign is of conveying a message which the public will associate with the goods of services covered. While that message will be conveyed principally by the more distinctive and dominant elements of the mark, it is with reference to the sign viewed as a whole, and therefore in the light of all of its components, that it is necessary to evaluate its capacity to identify the origin of the goods or services.

44. I should also point out that, in the assessment of the likelihood of confusion, the identifying power of the mark for which protection is sought must be appraised as at a relevant time after the date of application for registration. (46)

45. Indeed, it cannot be ruled out that an element of a complex mark which, at the time when the mark was registered, was devoid of distinctive character, being merely descriptive, will have become distinctive with the passage of time, for example, as a result of the use that has been made of the mark, and especially where the importance within the mark of the element in question is not merely negligible or even dominates the overall impression which the mark conveys to the relevant public.

46. The facts of the case in the main proceedings provide a clear illustration of this. It became clear at the hearing (47) that, between the time of registration of the earlier mark and the assessment of the likelihood of confusion between that mark and the mark applied for, the PRV had changed its practice with regard to the registration of indications of geographical origin, bringing it into line with the criteria — more consistent with the rules relating to perception (48) — laid down by the Court in its judgment of 4 May 1999, *Windsurfing Chiemsee* (C-108/97 and C-109/97, EU:C:1999:230), with the result that, under its new practice, it no longer regarded the element of the earlier mark covered by the disclaimer as being devoid of distinctive character.

47. To exclude from the assessment of the degree of distinctiveness of a mark which must be carried out when assessing the likelihood of confusion pertaining to one of its elements for the sole reason that, in the examination that was carried out at the time of registration, that element was regarded as devoid of distinctive character, thus necessitating the use of a disclaimer, would mean that no account could be taken of how the perception of the mark might have changed between the time when it was registered and the time when the assessment of the likelihood of confusion is carried out, or indeed of any other factor arising subsequently to registration that could influence that assessment.

48. That would not only stand in the way of determining the identifying power of the mark in current, effective and specific terms, as is required for the purposes of examining of the likelihood of confusion, but could also, given the interdependence of the various factors that enter into consideration, (49) result in an incorrect appraisal of the likelihood of confusion.

49. I therefore think — in line with my conclusion regarding the assessment of the similarity between conflicting signs — that the existence of a disclaimer covering one of the elements of the mark for which protection is sought should affect neither the determination of the degree of distinctiveness of the mark nor the final assessment of the likelihood of confusion in which the various factors which enter into consideration are assessed and weighed, one against the other.

50. More generally, the existence of a disclaimer, such as that at issue in the case in the main proceedings, should not, in my view, alter the rules for the assessment of the likelihood of confusion, which have

been harmonised at EU level. In particular, the mere fact that a component of a complex mark for which protection is sought is covered by a disclaimer does not justify the automatic exclusion of that component from the assessment or any failure to give consideration to the perception of the public in the assessment of the role which that component plays in the determination of the overall impression created by the mark or of the mark's distinctive character. In my view, the requirement that elements such as those at issue remain free for use can in no way justify any alteration of those rules, which could lead to the registration of signs capable of creating a likelihood of confusion. The interest which economic operators have in being free to use indications or signs which describe the goods or services they market is sufficiently well protected, first of all, by the provisions of Directive 2008/95 on the absolute impediments to registration and by the provisions which limit the effects of trade marks, which I have mentioned, (50) secondly, by the fact that the rights conferred by Article 5(1)(b) of Directive 2008/95 do not permit the proprietor of a complex mark to seek protection of just one of the components of that mark and, lastly, by the rules which govern the assessment of the likelihood of confusion, in accordance with which the likelihood of confusion must be determined having regard, in particular, to the distinctive and dominant components of the conflicting signs and the distinctive character of the mark for which protection is sought.

### Conclusion

51. On the basis of all the foregoing considerations, I propose that the Court should answer the questions referred by the Svea hovrätt (Svea Court of Appeal, Stockholm, Sweden) as follows:

*Article 4(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the existence of a waiver, or disclaimer, such as that at issue in the case in the main proceedings, relating to one of the elements which comprise an earlier mark, has no bearing on the assessment of the likelihood of confusion between that earlier mark and a later sign for which registration as a trade mark is sought.*

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1 Original language: Italian.

2 See, to that effect, judgments of 7 September 2016, *Beiersdorf v EUIPO (Q10)* (T-4/15, not published, EU:T:2016:447, paragraph 18), and of 19 November 2009, *Agencja Wydawnicza Technopol v OHIM (100 and 300)* (T-425/07 and T-426/07, EU:T:2009:454, paragraph 19).

3 Directive of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Codified version) (OJ 2008 L 299, p. 25). With effect from 15 January 2019, Directive 2008/95 was repealed and replaced by 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 (OJ 2015 L 336, p. 1), which

entered into force after the material time in the main proceedings.

4 Article 5(1)(b) of Directive 2015/2436 is drafted in practically identical terms.

5 See Article 10(2)(b) of Directive 2015/2436.

6 An unofficial translation in English of the VML may be found on the website of the World Intellectual Property Organisation at the following address: <https://wipo.int/en/text/290530>.

7 It is apparent from the order for reference that, in Swedish law, an assessment of the likelihood of confusion with earlier marks is carried out ex officio when an application for registration is examined.

8 At the hearing, in response to a question put by the Court, the PRV clarified this change in practice, mentioned in the order for reference, explaining that, while in the past a disclaimer had invariably been required as a condition of registration of signs containing elements relating to a geographical name, from 2012 onwards, it had applied the criterion mentioned in paragraph 31 of the judgment of 4 May 1999, *Windsurfing Chiemsee (C-108/97 and C-109/97, EU:C:1999:230)*, and had begun distinguishing between cases in which the geographical name was associated with the category of goods in question and cases in which no such association could be identified. In the first kind of case, registration is currently refused and in the second it is granted without a disclaimer being required.

9 RÅ 1991, ref. 10, MTV Music Television.

10 The referring court cites, by way of example, the judgment of the Patentbesvärätten (Patent Court) of 3 October 2011, in Case No 10-136, BIOGEN.

11 Other than Sweden, only Ireland and Latvia. In the United Kingdom, the trade mark registration office abolished disclaimers a number of years ago: see Max Planck Institute for Intellectual Property and Competition Law, Study on the overall functioning of the European Trade Mark System, 2013, available at: <https://publications.europa.eu/en/publication-detail/-/publication/5f878564-9b8d-4624-ba68-72531215967e>, p. 74, point 2.40.

12 See, to that effect, Opinion of Advocate General Ruiz-Jarabo Colomer in *Koninklijke KPN Nederland (C-363/99, EU:C:2002:65, point 45)*. In the judgment that was delivered in that case, the Court held that the effects of registration could not be restricted, albeit without expressly adopting a position on whether or not waivers are permissible (see judgment of 12 February 2004, *Koninklijke KPN Nederland (C-363/99, EU:C:2004:86, paragraphs 114 and 115)*).

13 Directive 2015/2436 goes beyond the limited scope of approximation achieved by Directive 2008/95, extending it to other aspects of substantive and procedural law (see, in particular, recitals 8 and 9).

14 See recital 8 of Directive 2008/95. See, to the same effect, recital 12 of Directive 2015/2436.

15 As mentioned, Directive 2015/2436 brings about fuller harmonisation, also aligning, as indicated in recital 9, 'the principal procedural rules in the area of trade mark registration', albeit without going further than outlining the general principles and leaving the Member States free to establish more specific rules.

16 According to recital 6 of Directive 2008/95, the Member States 'can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both. Member States should remain free to

determine the effects of revocation or invalidity of trade marks’.

17 See recital 2 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1) and recital 3 of Directive 2015/2436, which states that ‘the coexistence and balance of trade mark systems at national and Union level in fact constitutes a cornerstone of the Union’s approach to intellectual property protection’.

18 See Article 38(2) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) and Article 37(2) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1). The latter provision remained in force until it was repealed, with effect from 23 March 2016, by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Regulation No 40/94, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21): see Article 1(35)(a), and, as regards the date of application, see the first and second paragraphs of Article 4.

19 See, to that effect, with reference to Article 37(2) of Regulation No 207/2009, judgment of 7 September 2016, Q10 (T-4/15, not published, EU:T:2016:447, paragraph 18). In that judgment, the General Court held that the disclaimer offered by the applicant could not be accepted, since it related to the word element of a composite mark in which the figurative elements comprised the colour yellow and a particular stylisation of the word element ‘Q10’. The General Court’s finding that the word element covered by the disclaimer was dominant and that the figurative elements were merely decorative led it to hold that, if the disclaimer were to be accepted, no distinctive element would remain within the sign capable of benefiting from the exclusive right conferred by Article 9 of Regulation No 207/2009.

20 See recital 10 of Directive 2008/95, which states that, ‘in order to facilitate the free movement of goods and services’, it is essential that ‘registered trade marks [should] enjoy the same protection under the legal systems of all the Member States’. See, to the same effect, recital 10 of Directive 2015/2436, which states that ‘it is essential to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States’.

21 Article 14(1)(b) of Directive 2015/2436 adds a reference to descriptive ‘signs’, in addition to the descriptive ‘indications’ previously mentioned in Article 6(1)(b) of Directive 2008/95.

22 The second subparagraph of Article 6(1) of Directive 2008/95 provides that such use must be ‘in accordance with honest practices in industrial or commercial matters’. On the interpretation of that condition, with reference to the corresponding provision of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), which preceded Directive 2008/95, see the judgment of 7 January 2004, Gerolsteiner Brunnen (C-100/02, EU:C:2004:11, paragraph 25), according to which ‘the mere fact that there exists a likelihood of aural confusion’ between an indication of geographical origin, even if used as a trade mark, and an earlier word mark is in itself insufficient to support the conclusion that use of that indication is not in accordance with honest practices.

23 The same wording is used in Article 3(1)(c) of Directive 2008/95 (and now Article 4(1)(c) of Directive 2015/2436), even though the two provisions are entirely independent, as

the Court observed in its judgments of 4 May 1999, Windsurfing Chiemsee (C-108/97 and C-109/97, EU:C:1999:230, paragraph 28), and of 10 March 2011, Agencja Wydawnicza Technopol v OHIM (C-51/10 P, EU:C:2011:139, paragraphs 59 to 62).

24 See, with reference to Article 6(1)(b) of Directive 89/104, judgment of 4 May 1999, Windsurfing Chiemsee (C-108/97 and C-109/97, EU:C:1999:230, paragraph 28). The Court has clarified that ‘by a limitation of the effects of the rights derived from Article 5 of Directive 89/104 by the proprietor of a trade mark, Article 6 of that directive seeks to reconcile the fundamental interests of trade-mark protection with those of free movement of goods and freedom to provide services in the common market in such a way that trade mark rights are able to fulfil their essential role in the system of undistorted competition which the Treaty seeks to establish and maintain’: see judgments of 23 February 1999, BMW (C-63/97, EU:C:1999:82, paragraph 62), and of 7 January 2004, Gerolsteiner Brunnen (C-100/02, EU:C:2004:11, paragraph 16).

25 See recital 11 of Directive 2008/95 and recital 16 of Directive 2015/2436.

26 See, in particular, judgments of 22 June 1999, Lloyd Schuhfabrik Meyer (C-342/97, EU:C:1999:323, paragraph 17); of 6 October 2005, Medion (C-120/04, EU:C:2005:594, paragraphs 24 and 26); and of 10 April 2008, adidas and adidas Benelux (C-102/07, EU:C:2008:217, paragraph 28).

27 See, to the same effect, recital 16 of Directive 2015/2436

28 See judgments of 11 November 1997, SABEL (C-251/95, EU:C:1997:528, paragraph 22); of 22 June 2000, Marca Mode (C-425/98, EU:C:2000:339, paragraph 40); of 6 October 2005, Medion (C-120/04, EU:C:2005:594, paragraph 27); of 10 April 2008, adidas and adidas Benelux (C-102/07, EU:C:2008:217, paragraph 29); and of 12 June 2007, OHIM v Shaker (C-334/05 P, EU:C:2007:333, paragraph 33).

29 See judgments of 12 June 2007, OHIM v Shaker (C-334/05 P, EU:C:2007:333, paragraph 36), and of 24 March 2011, Ferrero v OHIM (C-552/09 P, EU:C:2011:177, paragraph 85).

30 See judgment of 11 November 1997, SABEL (C-251/95, EU:C:1997:528, paragraph 23).

31 See, in particular, judgments of 11 November 1997, SABEL (C-251/95, EU:C:1997:528, paragraph 23); of 12 June 2007, OHIM v Shaker (C-334/05 P, EU:C:2007:333, paragraph 35); and of 20 September 2007, Nestlé v OHIM (C-193/06 P, not published, EU:C:2007:539, paragraph 34).

32 See, in particular, judgments of 11 November 1997, SABEL (C-251/95, EU:C:1997:528, paragraph 23); of 22 June 1999, Lloyd Schuhfabrik Meyer (C-342/97, EU:C:1999:323 paragraph 25); of 12 June 2007, OHIM v Shaker (C-334/05 P, EU:C:2007:333, paragraph 35); and of 3 September 2009, Aceites del Sur-Coosur v Koipe (C-498/07 P, EU:C:2009:503, paragraph 60).

33 See, in particular, judgments of 12 June 2007, OHIM v Shaker (C-334/05 P, EU:C:2007:333, paragraph 41), and of 3 September 2009, Aceites del Sur-Coosur v Koipe (C-498/07 P, EU:C:2009:503, paragraph 61). On this point, the Court has clarified that, while it is true that the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element:

see, judgments of 12 June 2007, *OHIM v Shaker* (C-334/05 P, EU:C:2007:333, paragraphs 41 and 42), and of 20 September 2007, *Nestlé v OHIM* (C-193/06 P, not published, EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).

34 See, to that effect, judgments of 13 July 2004, *AVEX v OHIM — Ahlers (a)* (T-115/02, EU:T:2004:234, paragraph 20), and of 13 June 2006, *Inex v OHIM — Wiseman (Representation of a cowhide)* (T-153/03, EU:T:2006:157, paragraph 32).

35 See, *inter alia*, judgment of 22 June 1999, *Lloyd Schuhfabrik Meyer* (C-342/97, EU:C:1999:323, paragraph 26).

36 Regulation 2017/1001.

37 See, *inter alia*, judgment of 29 September 1998, *Canon* (C-39/97, EU:C:1998:442, paragraph 28).

38 It is true that the assessment must be based on the distinctive and dominant elements of the conflicting signs, not on their descriptive and non-distinctive elements. However, it is also true that account must be taken of the relationships between the various elements which comprise a sign when endeavouring to reconstruct the overall impression created in the mind of the public.

39 I would observe that, according to the case-law, where there is no similarity between the marks at issue, any likelihood of confusion will automatically be ruled out, without it being necessary to analyse the other factors on which a finding of a likelihood of confusion depends: see, *inter alia*, judgment of 24 March 2011 *Ferrero v OHIM* (C-552/09 P, EU:C:2011:177, paragraph 65).

40 I am mindful here of the circumstances of the case in the main proceedings: the word element alone is covered by the disclaimer, not the particular stylisation of that element.

41 See, *inter alia*, judgment of 22 June 1999, *Lloyd Schuhfabrik Meyer* (C-342/97, EU:C:1999:323, paragraph 18).

42 See, *inter alia*, judgment of 11 November 1997, *SABEL* (C-251/95, EU:C:1997:528, paragraph 23).

43 See judgments of 29 September 1998, *Canon* (C-39/97, EU:C:1998:442, paragraph 17), and of 22 June 1999, *Lloyd Schuhfabrik Meyer* (C-342/97, EU:C:1999:323, paragraph 19).

44 See, *inter alia*, judgments of 11 November 1997, *SABEL* (C-251/95, EU:C:1997:528, paragraphs 22 and 24), and of 22 June 1999, *Lloyd Schuhfabrik Meyer* (C-342/97, EU:C:1999:323, paragraph 20 *et seq.*).

45 In its judgment of 22 June 1999, *Lloyd Schuhfabrik Meyer* (C-342/97, EU:C:1999:323, paragraph 23), the Court clarified that, in determining the distinctive character of a mark, ‘account should be taken, in particular, of [its] inherent characteristics ... including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations’. Similar criteria were listed in the judgment of 4 May 1999, *Windsurfing Chiemsee* (C-108/97 and C-109/97, EU:C:1999:230, paragraph 51), with reference to the acquisition of distinctive character of a geographical name following the use that had been made of it, in accordance with Article 3(3) of Directive 89/104. (On the requirement that the

assessment of the distinctive character of mark must be specific and objective, see also paragraph 52 of the judgment.)

46 In its judgment of 27 April 2006, *Levi Strauss* (C-145/05, EU:C:2006:264, paragraph 20), the Court held, with reference to Article 5(1) of Directive 89/104, that, ‘in order to determine the scope of protection of a trade mark which has been lawfully acquired on the basis of its distinctive character, the national court must take into account the perception of the public concerned at the time when the sign, the use of which infringes that trade mark, began to be used’. If the assessment is carried out, as in the case in the main proceedings, for the purposes of registration of the later sign, the relevant date is the date on which the application for registration of that later sign was lodged.

47 See footnote 8 above.

48 In accordance with the principles laid down by the Court in that judgment, the greater or lesser identifying power of signs which contain indications of geographical origin depends on the association that is created, in the mind of the public, between the reputation or the characteristics of the goods or services designated by the mark and the region which the mark designates, and it must therefore be evaluated with strict reference to the perception of consumers of those goods or services.

49 As a factor in the assessment of the likelihood of confusion, the distinctive character of a mark must be viewed in relation to all the other relevant factors, in order for that assessment to be as objective as possible. Thus, the Court has previously held on a number of occasions that the distinctive character of the mark for which protection is sought is one of the many factors in the global assessment of the existence of a likelihood of confusion (see, in particular, the orders of 29 November 2012, *Hrbek v OHIM*, C-42/12 P, not published, EU:C:2012:765, paragraph 61, and of 2 October 2014, *Przedsiębiorstwo Handlowe Medox Lepiarz v OHIM*, C-91/14 P, not published, EU:C:2014:2261, paragraph 22, and judgment of 8 November 2016, *Bosch und Siemens Hausgeräte v EUIPO*, C-43/15 P, ECLI:EU:C:2016:837, paragraph 61) and that, while it is true that the more distinctive the earlier mark the greater the likelihood of confusion will be, such a likelihood of confusion cannot, in any event, be ruled out where the distinctive character of the earlier mark is weak (see, in particular, order of 19 November 2015, *Fetim v OHIM*, C-190/15 P, not published, EU:C:2015:778, paragraph 40 and the case-law cited, and judgment of 8 November 2016, *Bosch und Siemens Hausgeräte v EUIPO*, C-43/15 P, ECLI:EU:C:2016:837, paragraph 62), in particular, where there is a similarity between the signs and between the goods or services covered (see, in particular, orders of 2 October 2014, *Przedsiębiorstwo Handlowe Medox Lepiarz v OHIM*, C-91/14 P, not published, EU:C:2014:2261, paragraph 24 and the case-law cited, and of 7 May 2015, *Adler Modemärkte v OHIM*, C-343/14 P, not published, EU:C:2015:310, paragraph 59, and judgment of 8 November 2016, *Bosch und Siemens Hausgeräte v EUIPO*, C-43/15 P, ECLI:EU:C:2016:837, paragraph 63).

50 See point 26 of this Opinion.