



European Communities Trade Mark Association

Survey on a Likelihood of confusion of TMs consisting of a person's name

A Survey conducted by ECTA Harmonization Committee

June 2009

Introduction:

The purpose of this survey is to establish how TMs consisting of names of persons are observed in the individual Member States and which positions the national jurisprudence adopts on the question of a likelihood of confusion between TMs consisting of or including names of persons.

Background of this questionnaire is the following legal situation:

The assessment of the likelihood of confusion between two trademarks comprising first names and family names give rise to substantial divergences within the European Area. Nor is it evident that the OHIM follows any clear-cut practice. In case R 3077/2002, decision of 23-10-2002 "PAUL GREEN" vs. "MARY GREEN" the opposition division of OHIM assumed a risk of confusion. On the contrary, in case R 221/2001-4, decision of 04-09-2002 "TONELLI" vs. "LAURA TORELLI" the fourth board of appeal denied a risk of confusion. The Court of First Instance affirms a likelihood of confusion in the case of identical surnames, even if the two trademarks for comparison have different first name components (see case T-185/03 (No. 51 ff.), decision of 01-03-2005 "ANTONIO FUSCO" vs. "ENZO FUSCO" and case T-212/07 (No. 37), decision of 02-12-2008 "Barbara Becker" vs. "BECKER"), unless it concerns very common names (see case T-169/03, decision of 01-03-2005 "SISSI ROSSI" vs. "MISS ROSSI"). In contrast, 9 European Member States including Germany look at the name in its entirety i.e. the overall impression derived from the first and the family name.

However, the CFI (see "ANTONIO FUSCO" vs. "ENZO FUSCO", loc cit No. 52) has, to date, emphasized that the "perception of signs made up of personal names may vary from country to country" and stated "in determining whether, in a particular country, the relevant public generally attributes greater distinctiveness to the surname than the forename, the case law of that country, although not binding on the Community Courts, may provide useful guidelines". If so, it might be doubted that the ECJ will be in a position to harmonize the so far widespread case law - although such harmonization would be most desirable.

In order to give a first overview of the topic, the survey starts with reflecting the various questions and a short summary of the answers thereto. Thereafter follow detailed answers for the Member States in alphabetic order.

There are contributions from nearly all Member States of the European Union except for Lithuania and Slovakia which are currently not represented in the Harmonization Committee.

The Harmonization Committee hopes that this survey serves all colleagues in need of information on how to assess a likelihood of confusion between trademarks consisting of a person's name in the different Member States of the European Union.



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Many thanks to everyone who participated in this survey.

Dr. Alexandra von Bismarck

Field Fisher Waterhouse Deutschland LLP



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Questions and Summary:

1 Which are the fundamental criteria on which an assessment of a likelihood of confusion between TMs consisting of a person's name is based?

In numerous countries the fundamental criteria for establishing a risk of confusion between trademarks consisting of a person's names are in principal the same as for other trademarks. The national Intellectual Property Office will consider if the trademarks are identical or similar visually, aurally or conceptually. This applies to Benelux, Bulgaria, the Czech Republic, Finland, France, Germany, Hungary, Ireland, Italy, Latvia, Portugal, Rumania, Slovenia, Spain, Sweden and the United Kingdom.

However, some countries make exceptions in specific cases:

In numerous countries the reputation of the earlier mark will be considered for example in Portugal, Finland, France, Sweden and the United Kingdom.

Some countries have special criteria for trademarks consisting of a person's name, for example differentiate between names that are very common and frequent and those, which are not very common and therefore more distinctive. This applies for example to Austria and Poland.

Other countries consider if the trademark contains the name of a family business (for example Spain).

Countries like for example Austria and Poland affirm a likelihood of confusion in case of identical or highly similar surnames, countries like for example Estonia, Cyprus and Greece deny a likelihood of confusion if the conflicting trademarks consist of the same surname but differ by the first name.

In Malta names are in general non-registrable as a trademark except such name has a reputation with respect to the goods and services of interest.

For details please see below.

2 Is the situation according to the national jurisdiction such that the overall impression of a sign comprising a first name and a family name is normally characterized by the family name, i.e. does the family name constitute the dominant and individualizing element of a person's name (as in case T-185/03 "ANTONIO FUSCO" vs. "ENZO FUSCO")?

The situation in the different Member States is not at all harmonized. In 10 Member States covered by the survey the family name constitutes the dominant and individualising element of a person's name, in 10 Member States it does not.

In Estonia, the Czech Republic, Hungary and Malta substantial case law does not exist yet.



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In France, in principal the family name is considered the most important part of the sign. However, it will depend on the notoriety of the name of the later trademark whether the courts will retain a likelihood of confusion.

For details please see below.

3 If the answer to question 2 is “No”, is it a recognized principle of national practice that the inland consumer's attention is normally geared to the sign comprising a first name and a family name in its entirety, to whose individualization the first name essentially contributes?

Almost all countries, who answered with “No” on the second question, confirmed that the comparison of conflicting trademarks has to be made on the basis of the entirety of the elements contained in each trademark including the first name. France and Austria have a special approach.

For detail please see below.

4 Is the addition of initials in one of the marks, to indicate a first name, sufficient to exclude a risk of confusion if the marks are otherwise identical?

In nearly all countries the addition of initials in one of the marks is not sufficient enough to exclude a risk of confusion. However, in Austria the addition of initials can exclude a risk of confusion if the initials are added to a person’s name which consists of a very common and frequent first and surname.

For details please see below

5 Are there any further national particularities with regard to assessing a risk of confusion between TMs consisting of a person’s name?

Most countries did not mention any further national particularities.

In Poland, basic national particularities with regard to assessing a risk of confusion between TMs consisting of a person’s name are listed under Articles 131, 135 and 156 of the Law on Industrial Property.

Once a family name is very common and, thus, not very distinctive in Slovenia, the first name then plays a dominant role within trademarks consisting of a first name and a family name.

In Greece, first names as such are in general non-registrable, except from cases, in which they have been recognised through intensive use in commerce.

The Czech IPO observes identity of the applied trademarks consisting of a person’s name and the applicant’s name. The applicant thus has to prove that he has the right to register the name. Otherwise, the office will refuse to protect his trademark. Furthermore, the



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proprietor of a trademark is not entitled to prohibit third persons from using their name and surname.

For details please see below.

Detailed Answers to Question 1

1 Which are the fundamental criteria on which an assessment of a likelihood of confusion between TMs consisting of a person's name is based?

- Austria** At first one must differentiate between names that are very common and frequent (e.g. in Austria: Huber, Mair, Schmidt, Bauer, Schneider Hofmann, ecolex, 1990, 160 - *Hofmann; Hohenecker/Friedl.*) and those, which are not very common and therefore more distinctive. In the case of a common and therefore rather weak sign, slight deviations may already exclude likelihood of confusion. In the Austrian case OGH 4 Ob 43/92 Harald Schmidt/ Harald A. Schmidt the Supreme Court decided that the initial of the second name A. is sufficient to exclude danger of confusion. On the other hand, the Supreme Court considered a high risk of confusion between the trademarks DANZER and EDITH DANZER OGH 4 Ob 31/97f, based on the argument that the name DANZER is not very common and therefore rather distinctive. Consequently, even the additional first name in the sign EDITH DANZER is not sufficient to exclude risk of confusion.
Jurisdiction:
Danger of confusion:
OGH 24.02.1998, 4 Ob 368/97i, Hörmann/ Hörmann; OGH 20.06.2006, 4 Ob 67/2006s, Engelbert and/or Perlinger/ Engelbert and/or Perlinger; OGH 18.05.1999, 4 Ob 108/99g -Sacher/ Helmut Sachers; OGH 11.02.1997, 4 Ob 31/97f Danzer/ Edith Danzer; OGH 23.05.2000, 4 Ob 139/00w (Fa.) Hofbauer/ Michael Hofbauer
- Benelux** The criteria when making an assessment as to the likelihood of confusion between TMs consisting of a person's name do not differ from the criteria otherwise used when assessing the likelihood of confusion between trademarks. A first name can in general be accepted as a valid trademark and enjoys a "normal" protection in court proceedings. Jurisdiction: COMPTE JOSEPH vs JOSEPH GUY (BIE 1986, p. 14): both trademarks were registered and being used for cognac. The name JOSEPH was considered the dominant and individualizing element in both trademarks. The younger trademark COMPTE JOSEPH could therefore lead to (association) confusion on the part of the public as to the origin of the cognac in the Benelux.
- Bulgaria** The same as for all other trademarks – the overall impression.
- Cyprus** Firstly, the Registrar examines whether the TMS consisting of a person's name are visually the same and if their pronunciation is the same. Furthermore, when the Registrar faces a Situation where two TMS consists of the same surname but different first name, both TMS will be approved.



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However, when two TMS consists of exactly the same name and surname, the person who files the application first has priority and therefore the person who files second, will be instructed by the Registrar to change its trademark so as not to be identical with the first TM.

- Czech Republic** The Czech IPO uses no special methodology for TMs consisting of a person's name. Usual criteria for likelihood of confusion are used. The Office examines identity with the applicant's name and judges the distinctiveness of the trade mark.
- Denmark** In accordance with established Danish practice, a trademark consisting of a family name is confusingly similar to another trademark consisting of a first name + the identical or quasi-identical family name, e.g. BRUBAKER = HENRY BRUBAKER (appeal board decision) whereas a trademark consisting of a first name is not confusingly similar to trademark consisting of a first name + family name, i.e. MARY ≠ MARY QUANT.
 Trademarks consisting of full names (first names + family names) must be very similar to establish a likelihood of confusion, e.g. GIANFERRE FASHION = GIANFRANCO FERRE but ANNE SHANTEL ≠ CHANTELLE (supreme court decision from 2003) Trademarks consisting of first names are confusingly similar if they are of the same sex and very similar, e.g. HANNE = HANNA.
 Trademarks consisting of two first names for two different sexes are confusingly similar if they have the same origin and are similar, e.g. ALEXANDER = ALEXANDRA but COLUMBINE ≠ COLUMBUS (appeal board decision).
 In a recent (2008) decision, Supreme Court stated that Louise Lego is allowed to use GALLERI LEGO for her art gallery and sale of posters and post cards, LEGO as a meta tag on her website, and L.Lego as a signature on art pieces irrespective of LEGO being a well known trademark (toys) since LOUISE LEGO had used her own name in accordance with good marketing practices and neither the use of the service mark GALLERI LEGO nor use of the meta tag LEGO were considered to take unfair advantage of or to be detrimental to the well known trademark LEGO.
- Estonia** There are yet no standard fundamental criteria of the issue. In general, it may be stated that there is no substantial case law yet regarding the current specific issue. The cases involved so far and decided, for instance, by the Industrial Property Board of Appeal (BoA) have involved the matters where opposing trademarks have included the person's name vs. trademark (name). E.g. HUGO BOSS / BOSS vs. Bossini in class 25 (BoA decision No. 486-0 of June 11. 2002), SERGIO ROSS1 vs. ROSS in class 25 (BoA decision No. 672-o of November 11, 2003). Polo (fig.) vs. MARCOPOLO < fig.) in class 34 (BoA decision No. 644-0 of May 30. 2008).
 Also the BoA has passed the decision No. 447-0 of December 4, 2002 in case regarding die Opposition of GALLUP (Hg) vs. A. GALLUP in classes 16 and 35, and the decision No. 448-o of December 4, 2002 in case GALLUP (fig.) vs. GEORGE GALLUP in classes 16 and 35. In the former decision the BoA



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found the trademarks GALLUP (fig.) and A. GALLUP being associative due to the reason that the first letter of the first name is not enough providing to the marks a different character. In the latter case, the BoA dismissed the opposition finding the marks GALLUP (fig.) and GEORGE GALLUP not being similar and associative due to the reason that an average consumer perceives the mark GEORGE GALLUP as the name of a person, and visually, phonetically, semantically the marks differ in the first part (GEORGE), which is essential from the distinguishable aspect of marks. Nevertheless, the latter decision was appealed with the court, at which the BoA decision did not come into effect. No court decision has come into effect in this case yet, therefore, no court decisions have been made available to the public currently.

Based on these decisions it may be concluded that at least the BoA's position has generally been, dealing with the opposing marks consisting of the person's name vs. trademark (name) with a (closely) coinciding family name, that these opposing marks have been regarded different. The cases are not directly gained with the current issue, but indirectly could provide some guidance, since in these cases the opposing marks comprised the identical/similar element to the family name and the BoA did not find the trademarks being similar to the person's name as a whole.

Of course, the mentioned decisions of BoA have been passed mainly before the accession of the Republic of Estonia to EU and may differ in the further cases. Also in accordance with the case law of ECJ, our trademark practice refers that in each case the circumstances and facts of the case shall be assessed separately, while the previous decisions are irrelevant, and as such, in every new case the outcome of the matter may differ compared to these mentioned cases.

Finland The cases relating to trademarks involving a family name are decided on a case by case basis. Therefore, it is difficult to establish a general rule from the existing cases. The Finnish Trademarks Act includes the Section 3 according to which the name of another may not be included in a trademark. In addition, according to Section 14 para 1 item 4 if the trademark is composed of or contains anything likely to give the impression of being the name or likeness of another person, unless such name or likeness plainly relates to a person long dead, such name may not be included in a trademark. Person's names that have a secondary meaning like "Karhu" (Bear), Koivu (Birch) etc. may be accepted unless there are other similar prior rights. If a foreign name is perceived a person's name it may not be included in a trademark, either.

The overall impression of the marks will be decisive but also individual elements of the names will be taken into account. Some person's names may be more distinctive and provide thus a stronger basis for the protection. Considering possibility of likelihood of confusion of a trademark consisting of a person's name may be based on an assumption whether the name may be perceived a person's name.



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France The known decisions on TM's consisting of a person's name concern almost always living persons and not fanciful or invented names. In numerous cases the prior TM - which mostly consists of either a family name or a family name and a first name - is rather well known and the later TM is filed by a living person bearing an identical name. Consequently the court decisions on likelihood of confusion are very often influenced by the notoriety of one name or the other. It is therefore very difficult to establish a general rule from those decisions which might vary from case to case.

The fundamental criteria for establishing a risk of confusion between TMs consisting of names are in principal the same as for other TMs: those signs are considered confusing if they are similar in image and/or sound and/or meaning.

Germany As regards trademarks consisting of a person's name the older jurisdiction basically held the overall impression of a trademark in general would be solely engraved from the family name. However, and unlike the ECJ, the German courts in recent decisions developed the principle that the consumer would rather refer to the overall name and its overall impression, meaning the full name (i.e. first and family name). The fundamental criteria for assessing the likelihood of confusion between TMs consisting of a person's name are thus in principle the same as for other TMs. Beside considering if the goods and services covered by the younger mark are identical or similar to those covered by the later mark, the German DPMA will consider if the marks are identical or similar visually, aurally and conceptually.

However, in the context of determining the likelihood of confusion, the distinctiveness of the different parts of a combination mark (consisting of a first and a last name) have to be examined, as a sole part may have gained increased distinctiveness.

Furthermore, the identity of the first name in a mark shall never cause a likelihood of confusion between two marks unless on rare occasions where the first name is used as identification for a particular person or business and known therefore (see BPatG GRUR 1998, 1027 – *Boris/BORIS BECKER*).

United Kingdom The same criteria are used in assessing likelihood of confusion between trade marks consisting of names as are used in assessing likelihood of confusion between other marks. The UK Intellectual Property Office will consider if the goods and services covered by the earlier mark are identical or similar to those covered by the later mark. They will also consider if the marks are identical or similar conceptually, visually and aurally. They will also apply the interdependency rule and consider the reputation of the earlier mark. It can be difficult to establish a reputation in a common surname.

Greece Each person has the right to use his name as a trademark. According to Article 5 Law 2239/1994 the same name may be used for registration of a later trademark, when this consists of the name of another person, provided



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that a distinctive characteristic will be added in order to be distinguished clearly from the previous one.

According to case-law, if the previous trademark is well known, then the added characteristic must be intensively distinctive in order to avoid the threat of confusion.

- Hungary In theory, the visual, aural and conceptional similarity shall be assessed, as in any other case. Unfortunately, we are not aware of court decisions dealing with exactly this issue.
- Ireland
- (1) The general principles set down in Case C-251/95 Sabél v Puma should be taken into account when assessing the likelihood of confusion between two marks consisting of a person's name. The general principle of this case is to assess the overall impression given by the marks. Thus, one must consider the mark visually, phonetically and conceptually. The following should also be considered: - Recognition of the trade mark on the market.
 - (2) Association that can be made with the used or registered sign.
 - (3) The degree of similarity between the trade mark and the sign with the goods and services covered by the marks. According to the Nichols Case (C-404/02), the assessment of the distinctiveness of a surname must be carried out according to the specific circumstances of the case. In addition, the court stated that the following should be considered when assessing the likelihood of confusion of a trade mark consisting of a person's name:
 - (4) A predetermined number of persons with the same name.
 - (5) The number of undertakings providing products or services of the type covered by the application.
 - (6) The prevalence or otherwise of the use of surnames in the relevant trade. It is general principle that a stricter approach, than that applied to any other mark, should not be applied when assessing likelihood of confusion for a surname or common name.
- Italy The fundamental criteria for establishing a risk of confusion between TMs consisting of names are in principal the same as for other TMs: those signs are considered confusing if they are similar in image and/or sound and/or meaning.
- Latvia According to the Law on Trademarks and Geographical Indications, there are no specific criteria provided for assessment of a likelihood of confusion between trademarks consisting of a person's name. The approach with regard to designations incorporating personal names when evaluating a likelihood of confusion between such a category of trademarks is the same as in respect of the word trademarks. In compliance with applicable legislation, the trademarks consisting of names and/or surnames are word trademarks. A trademark consisting of a person's name is distinctive if it is capable of distinguishing the goods and services of one undertaking from those of other undertakings. Accordingly, the relevant approach is applied when evaluating confusing similarity between the trademarks incorporating the personal names.



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- Lithuania No answers could have been provided as there is currently not any Committee Member from this country.
- Malta In principle, the Comptroller will probably not register a name unless it is clear that such name has a reputation with respect to the goods/services of interest, which makes it difficult for a name to be registered when the mark is new (in which case evidence of use as a *de minimis* is required). Subsequently, for another name to be accepted in the same class, the Comptroller would probably require a Letter of Consent from the proprietor of the earlier mark.
- Poland The criteria are based on a view of how a person's name is generally perceived, namely whether it is regarded as famous, common or uncommon. In general, rights of protection shall not be granted for signs, the use of which infringes third parties' personal rights. Also, according to the Polish Law on Industrial Property, a trademark owner cannot prohibit third parties from using, in the course of trade, their names or addresses. Polish courts have already dealt with the issue of trademarks consisting of a person's name, and there are some decisions that set forth useful standards for handling future cases: The Supreme Administrative Court, decision of 20 September 2006, case No. II GSK 115/06, decided that a person's name may constitute a trademark which is capable of distinguishing the goods or services of different producers. However, in this case the registration of a person's name KOZLOWSKI as a trademark would not help consumers to distinguish between different producers and their products or services that are offered under the subject name, as different members of the KOZLOWSKI family used this sign/name for different products. According to the decision of The District Administrative Court in Warsaw of 6 April 2004, (case No. 6 II SA 3954/02), personal signature is personal intangible property protected by the Civil Code. A contract that is not questioned by a third party allows its parties to use Salvadore Dali's name, surname and signature as trademark and trade name. The contract serves as consent to use such personal intangible property and has economic value, and the entitled person has the right to apply for trademark registration, or to file the request for cancellation of a trademark owned by others which was registered as a sign consisting of the name, surname or signature of Salvadore Dali.
- Portugal The fundamental criteria for assessing the risk of confusion between TMs consisting of a person's name are the same as for other TMs. There must be a similarity (graphical, aural, figurative, or other similarity) between the signs under comparison and between the goods and/or services to which the marks



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refer to. Here too, if one of the marks (names) is well-known in Portugal this will certainly be an additional element to consider.

If the above question refers to the assessment between a trademark sign and an existing individual name what is necessary to analyse is whether the mark contains a "name, picture, expressions or figurative signs that concern a certain individual person without his/her authorization". If the person is deceased the competent persons for the authorization are the heirs or the persons' relatives (until the 4th degree). In this case however, the trademark registration must be refused if the mark is considered offensive or disrespectful to the person in question, even where an authorization is obtained from said heirs or relatives.

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| Romania | There is no fundamental criteria. The similarity is invoked, if the name, surname or just a word contained in the trademark is identical and/or similar. |
| Slovakia | No answers have been provided as there is currently not any Committee Member from this country. |
| Slovenia | Main criterium for the assessment of a likelihood of confusion between TMs consisting of a person's name is that the public(consumers) would be mislead into assuming that the goods under such marks derive from the same source and that these goods are produced by the same producer. |
| Spain | The jurisprudence of the Spanish Supreme Court concerning the risk of confusion between trademarks which contain a person's name is not unitary. Our analysis of several judgments from the 1970ies to recent years leads to the conclusion, actually declared by the Courts, that there are no specific criteria for this category of trademarks. Said judgments are rather based on general principles such as the "global view of all circumstances involved". Decisive factors are the same as in other judgments on trademarks, especially how well known a prior trademark in the business sector and / or the geographical origin of the correspondent goods is. |

- (1) First, there is a group of judgments concerned with the Situation of a family business which splits, e.g. after the death of the Company's founder. In these cases, it happens that each of the brothers or sisters who establish their own Company is trying to register a trademark consisting of the family name (which normally had already been registered as a trademark by the deceased founder) and the first name of the respective brother or sister.
- (a) The majority of the judgments dealing with this kind of Situation deny a likelihood of confusion between the new trademarks and the prior trademark, as well as a likelihood of confusion between the new trademarks themselves each of which contains the same family name. In this context, we refer to the judgments of the Spanish Supreme Court dated March 13th 1978, March 10^h 1980 and July 5th 1993, amongst others. The latter is concerned with the case of a hairdresser business owned by two brothers who acted under the common trademark "Bellido"



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equivalent to one of the two common family names (remember that in Spain everybody has two family names equivalent to one's father's and mother's family name!). One of the brothers set up his own business under the new trademark "Mariano Garcia Bellido", being "Mariano" his first name and "Garcia" the second common family name. The Supreme Court did not see any incompatibility between the new trademark and the prior one which only consisted of one family name. According to the Court's opinion, the addition of the first name and the other family name eliminated any risk of confusion. The Supreme Court applied the same criterion in a case in which both trademarks only consisted of one family name "Loscertales" and one brother prefixed his first name applying for a new trademark "Simon Loscertales": Compatibility was affirmed (judgment dated March 10th 1980).

- (b) On the other hand, compatibility is denied if the prior trademark is well known nationwide or in a whole region of Spain. Thus, the Supreme Court rejected the application for a trademark which contained the family name "Codorniu", as the latter had already been a famous mark for a "Champagne" (cava) produced in Catalonia (judgment dated December 13th 1963). In the same way, the recordal of a trademark called "Torres Valls" for wines consisting of the two family names "Torres" and "Valls" was denied due to the existence of the prior mark "Torres" which only contains one family name but which is a very well known denomination for a wine distributed in whole Spain (judgment dated June 6th 2001).
- (2) Aside from the enumerated cases of Splitting family businesses, the general criteria initially mentioned apply. The judicature of the Supreme Court underlines the decisiveness of the general impression created by a mark composed of several elements. This impression is normally influenced by how well the prior trademark or a involved family name in a determined region or in the business sector concerned are known. Thus, the Supreme Court rejected an application for the trademark "Bodegas Vazquez Gavino" for wines in view of the prior mark "Gavino" granted also for wines which were cultivated in the same region of origin (Andalusia). The Court gave the following reasons for its decision (dated March 31st 1989):
- (a) The common element "Gavino" is a quite well known trademark for a wine cultivated in that region and is equivalent to the surname of a famous family of winegrowers who owns this prior trademark.
- (b) The prefixed element "Vazquez" is a very common family name nationwide having a weak differentiating capability.
- (c) The prefix "bodega" refers to winegrowing activity, the same business sector the prior mark had been granted for.

In the same line, the Spanish Trademark Office rejected the recordal of the trademark "Vinagarcia" in class 33 due to the Opposition of the prior mark "Don Garcia" granted also for wines, since "Vina" only refers to winegrowing activity



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and thus does not add an element with differentiating capability to the common element which consists of the family name "Garcia". Said decision of the Trademark Office is dated September 24th 2003.

Lastly, a likelihood of confusion is affirmed with respect to trademarks consisting of the same family name and different first names if the first names are very common in Spain, such as "Juan", "Jose" etc. . The Supreme Court's decision dated March 27th 1991 assumed incompatibility of the mark "Oliver Massaguer" with relation to the prior mark "Juan Juan Massaguer", both in class 25, arguing that the respective first names "Oliver" and "Juan" have almost no differentiating capability. A similar decision was issued by the Spanish Trademark Office on December 12th 2002 which rejected the trademark "Mauro Estevez" on the basis of the prior mark "Estevez" in the same class (33), pointing to the weak differentiating capability of the first name "Mauro" prefixed in the posterior application.

Sweden That the trademark is meant to be interpreted as someone's family name. The mark does not have to be identical with the family name.

Detailed Answers to Question 2

2 Is the situation according to the national jurisdiction such that the overall impression of a sign comprising a first name and a family name is normally characterized by the family name, i.e. does the family name constitute the dominant and individualizing element of a person's name (as in case T-185/03 "ANTONIO FUSCO" vs. "ENZO FUSCO")?

a) Yes: Are there any court decisions known to you?

b) No: Are there any court decisions known to you?

Austria No, the overall impression is relevant.

Benelux Yes, when assessing the likelihood of confusion between TMs consisting of a person's name, the court will more often than not see the family name as the dominant and individualizing element of the TMs.

Jurisdiction:

Use of the name ASSCHER (BIE 1982, p. 159): the use of the trade name PAUL H. ASSCHER (owned by Diamond Center B.V.) can lead to confusion with and/or dilution of the trademarks ASSCHER and ASSCHER'S DIAMANT.

Bulgaria No information for such cases and court decisions.

Cyprus Yes, but there are no court decisions.

Czech Republic There are no court decisions.



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- Denmark Yes, but the family name/surnames must be identical or quasi-identical, and the overall impression of the marks will be taken into account when the likelihood of confusion is assessed, cf. GIANFERRE FASHION = GIANFRANCE FERRE (appeal board decision).
Jurisdiction:
Supreme Court decision regarding ANNE SHANTEL ≠ CHANTELLE
- Estonia Since there is no substantial case law yet, no particular comment is available.
- Finland Both alternatives are applicable:
Yes. Jurisdiction:
KKO 1990:53 PALMROTH (the Supreme Court)
The trademark Pertti Palmroth was protected against the shoe manufacturer's son Juhani Palmroth Jr (trademark in this form). It was stated that the family name PALMROTH was such a dominating element that the protection should be given to Pertti Palmroth. In addition, it was stated that the father had used his trademark in different variations including the dominant name PALMROTH. The different first names and the sign "Jr" could not remove the risk of confusing similarity. For the background information we may state that PERTTI PALMROTH is truly one of most renowned trademarks in the footwear branch in Finland.

No. It would be possible to decide upon this basis, as well, although there are no prior cases known.
- France Both alternatives are applicable:
Yes. Jurisdiction:
Court of Appeal (CA) Paris October 20, 2000: JEAN-FRANCOIS RECH similar to GEORGES RECH
Supreme Court (CC) November 24- 1987: JEAN-LUC MALBRANQUE similar to MALBRANQUE

No. Jurisdiction:
CA Versailles December 21. 2004: TINO ROSSI not similar to SERGIO ROSSI
CA Paris December 15, 2000: EDDIE BARCLAY not similar to BARCLAY
- Germany No. Jurisdiction:
BGH GRUR 1999, 241, 244 – Lions; BGH GRUR 2000, 233, 234 f. – RAUSCH/ELFI RAUCH; BGH GRUR, 1031, 1032 – Carl Link; BPatGE 47, 198 – Ella May; BPatG PAVIS PROMA 27 (pat) 173/03 – leni baldessari/BALDESSARINI; BGH GRUR 2005, 513, 514 -MEY/Ella May.
- United Kingdom No. Jurisdiction:
McQUEEN/ALEXANDER McQUEEN (0-120-04) and PUCCI/EMILIO PUCCI (0-168-07)
- Greece Yes. However, if the family name has a common distinctive power, then the addition of the different first name in a trademark consisted of the same family name can be considered enough to avoid the likelihood of confusion.



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- Hungary /.
Ireland No. Full names and surnames with initials will be treated in the same way as a person's name. Like all trade marks, the overall impression the marks make will be taken into consideration when assessing likelihood of confusion.
Italy Yes. The majority of the Italian decisions states that the surname is the dominant part of the sign and it should be considered when comparing trade marks constituted of name + surname.
Jurisdiction:
Court of First Instance of Genoa, January 15, 1992: the trade mark "GIGI BULGARY", applied for products of class 25 (clothing) is confusingly similar to the prior registered trade mark "BULGARI" (Decision published in GADI, 3035).
Court Appeal of Milan, June 2, 1998: the trade mark "A.V. BY VERSACE" applied by Mr. Alfredo Versace for products of classes 3, 18, 24 and 25 is confusingly similar to the prior registered trade marks "VERSACE" and "GIANNI VERSACE" (Decision published in GADI 3924).
Court of First Instance of Bologna, order of October 26, 2004 stated that the patronymic trademark assumes is itself "strong" feature and its "heart" must be found in the surname, whereas the first name only assumes a subordinate and accessory role (Order partially published in "Italian IP Courts Case Law Report. 2004, 195).
Court of Appeal of Milan, July 6, 2004: the trade mark ANTONELLA PRADA applied by Antonella Prada d.i. is confusingly similar to "PRADA" (Decision published in Dir. Industriale , 2005, 454).
Supreme Court February 28, 2006: the sign "CENTRO MODA CANALI" used also as company name in the filed of clothing is confusingly similar to "CANALI", used and registered by Canali SpA for products of class 25 , clothing (Decision published in Foro It. 2006, 10, 1, 2794)
Latvia No, the family name does not constitute the dominant element of a person's name. Neither do the first names. A common and overall impression, visual perception as well as analysis of phonetic structure are taken into consideration when evaluating distinctiveness of the designations and comparing them between each other.
Lithuania No answers could have been provided as there is currently not any Committee Member from this country.
Malta No. Since the Trademarks Act 2000 came into effect, we are not aware of any court decisions.
Poland No. According to the decision of the Polish Supreme Administrative Court of 20 September 2007, (case No. II GSK 121/07), the assessment of likelihood of consumers' confusion should be based on the average consumer's attention at the moment of making a selection of different goods or services which belong to the same category, for which a trademark was registered.
However, according to the decision of the District Administrative Court in



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Warsaw of 31 August 2006 (case No. VI SA/Wa 1012/06), the existence of an earlier trademark registration GOTTIE was an obstacle for registration of a trademark GOTTIE FREDERIQUE GOTTIE, which was destined for similar products. Neck ties (products from class 25 of the Nice Classification) are goods of the same kind as clothes (clothing).

- Portugal Yes. The critical point is whether the name identifies a certain individual person. While the overall impression of the sign should always be assessed it is likely that the family name (if any) will generally be more distinctive, that is to say more characteristic of an individual person. Court decisions with statements on this specific topic: Lisbon Court of Appeal, 15/12/1994: XUXA/XUXA rejects an appeal filed on behalf of the Brazilian actress XUXA against the granting of the trademark registration XUXA in class 25 because the name was not sufficiently well-known in Portugal as an individual name of the actress. Supreme Court of Justice 3/04/2001: BOBBY JONES/BOBBY JONES confirms refusal of the registration of the mark BOBBY JONES for restaurant services due to the unauthorized use of the individual name of the famous golf player.
- Romania Yes, but we are not aware about Court Decisions. However, a distinction is made between the fanciful names and the real names, since in case of fanciful names the examination is not taking into consideration only the "idea" of names but even common nouns or fanciful trademarks (ex: ELIZABETH SWAN/SWANN; JACK POLO/POLO; DANIEL BEBETO/BEBETOM)
- Slovakia No answers could have been provided as there is currently not any committee Member from this country.
- Slovenia Yes, the family name is dominant and individualizing element of a person's name. However, the practice on this issue is rather poor. There are some SIPO's Decisions on this issue, however, no significant Court decisions.
- Spain No. Reference is made to the Spanish reply to the first question where the correspondent judgments of the Spanish Supreme Court were quoted. The family name prevails if the first name is very common and thus has a weak differentiating capability. The family name contained in a prior trademark is also a decisive factor if it is well known in a certain region or business sector.
- Sweden Yes, the family name is the dominant element. If a family name also is a first name, e.g. "Stevens", and 50 percent or more are carrying the name as a first name, it is not considered to be a hindrance. Also, if a family name has a well known meaning other than as a family name, e.g. Gran (which means spruce) is might be registered unless it is meant to be interpreted as someone's family name. It would be possible to register GRAN with a picture of a spruce, but not GRAN'S LAW FIRM for example. See case 00-450 STONES SPORT.



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Detailed Answers to Question 3

3 If the answer to question 2 is “No”, is it a recognized principle of national practice that the inland consumer's attention is normally geared to the sign comprising a first name and a family name in its entirety, to whose individualization the first name essentially contributes?

a) Yes: Are there any court decisions known to you?

b) No: Are there any exceptions to this principle?

Austria	No.
Benelux	./.
Bulgaria	./.
Cyprus	./.
Czech Republic	./.
Denmark	./.
Estonia	Although there is no substantial case law, the argument could be, based on the different earlier cases, that the inland Estonian consumer's attention is normally geared to the sign in its entirety. Indeed, in each case the facts and circumstances of the case play role, but the general position is that the consumer would perceive the mark in its entirety.
Finland	No.
France	Neither nor. In principle the family name is considered the most important part of the sign. Therefore there is no likelihood of confusion, when only first names are identical. However, it will depend on the notoriety of the name of the later TM, whether the courts will retain a likelihood of confusion. Example: Tino Rossi and Eddie Barclay were well-known persons; therefore no likelihood of confusion with SERGIO ROSSI resp. BARCLAY. But nobody knows Jean-Francois Rech; therefore likelihood of confusion with GEORGES RECH.
Germany	Yes. Jurisdiction: BGH GRUR 1999, 241, 244 – Lions; BGH GRUR 2000, 233, 234 f. – RAUSCH/ELFI RAUCH; BGH GRUR, 1031, 1032 – Carl Link.
United Kingdom	Yes, see answer to Question 2 b.
Greece	./.



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Hungary	./.
Ireland	No cases exist which in particular deal with this matter. When examining the likelihood of confusion one will consider the overall impression of the marks, and the extent of a particular name on the target mark.
Italy	./.
Latvia	Yes. The designations are perceived in their entirety without separating a family name from the first name, i.e. without dividing the whole designation into separate elements. The consumers normally perceive the marks as a whole based on the overall impression made by the marks.
Lithuania	No answers as there is currently not any Committee Member from this country.
Malta	./.
Poland	Yes, but court decisions are not known.
Portugal	./.
Romania	./.
Slovakia	No answers could have been provided as there is currently not any Committee Member from this country.
Slovenia	./.
Spain	Yes. The general criterion is the one explained in the judgment dated July 5 th 1993 which has been quoted in our reply to Question 1: "... the comparison has to be made on the basis of the entirety of the elements contained in each trademark ..., without fragmenting its phonetic unity, so that the total structure prevails over its partial components,...".
Sweden	./.

Detailed Answers to Question 4

4 Is the addition of initials in one of the marks, to indicate a first name, sufficient to exclude a risk of confusion if the marks are otherwise identical?

a) Yes: Are there any court decisions known to you?

b) No: Are there any court decisions known to you?

Austria	Yes, but this is only true in the case of a name, which is very common and frequent. "Harald and Schmidt" for example are both very common names in
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German. Therefore the addition of the initial A. after the first name ("Harald A. Schmidt") is sufficient to exclude any risk of confusion. (In the Austrian case OGH 4 Ob 43/92 Harald Schmidt/ Harald A. Schmidt) the Supreme Court decided that the initial of the second name A. is sufficient to exclude danger of confusion. On the other hand, the Supreme Court considered a high risk of confusion between the trademarks DANZER and EDITH DANZER 4 Ob 31/97f, based on the argument that the name DANZER is not very common and therefore rather distinctive. Consequently, even the additional first name in the sign EDITH DANZER is not sufficient to exclude risk of confusion. However, this is not the case for names which enjoy a higher degree of distinctiveness. (OGH 20.06.2006, 4 Ob 67/2006s, Engelbert and/or Perlinger/Engelbert and/or Perlinger).

Benelux	No. The addition of initials on one of the marks to indicate a first name may not be sufficient to exclude a risk of confusion if the marks are otherwise identical (or resembling).
Bulgaria	No.
Cyprus	Yes, but there are no court decisions.
Czech Republic	No. Usual criteria for likelihood of confusion are used.
Denmark	No.
Estonia	Since there is no relevant case law yet, no particular comment is available. But considering the mentioned BoA's decision in case GALLUP (fig.) vs. A. GALLUP where the BoA found the trademarks being associative, it may be stated that the addition of initial in one of the marks is not sufficient to exclude a risk of confusion.
Finland	No.
France	No. Court decisions are not known. However, it is rather unlikely that the addition of an initial would be sufficient.
Germany	The addition of the initials to a mark has not been challenged in court as of yet. The ruling BPatG PAVIS PROMA 24 W(pat) 2/02 – L. Gallino/GALILEO has dealt with the issue but did not answer the question. However, it is likely that the courts would not hold the addition of initials sufficient to exclude the likelihood of confusion between two marks consisting of person's names. This, however, may be seen different where the names in conflict are very common.
United Kingdom	Yes. This depends on the global assessment of the likelihood of confusion.
Greece	No. Jurisdiction: i.e. LEVI'S v. J. LEVI'S FASHION LEVI'S v. JO LEVIS FASHION LOUMIDIS v. S. LOUMIDIS.
Hungary	./.



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- Ireland No, examining likelihood of confusion one will consider the overall impression of the marks, and the extent of a particular name on the target mark.
- Italy No. Jurisdiction:
Court of First Instance of Rome, order of April 30, 2005, stated that the commercial use of family name is lawful within the limits that it does not create likelihood of confusion to the public with another trademark already registered having the same family name as its object, and such likelihood of confusion , in consideration of the strong nature of the trademark having as its object the family name, is not excluded by differences in the graphic aspect or other modifications, but has to be valued considering the commercial and territorial affinities of the performed activity. (Order partially published in "Italian IP Courts Case Law Report. 2005, 179). Court of First Instance of Rome, order of January 12, 2005, stated that denominative trademarks containing the same family name are always subject to likelihood confusion, even where there are distinguishing elements. (Order partially published in "Italian IP Courts Case Law Report. 2005, 159).
- Latvia No. Addition of initials usually does not exclude a risk of confusion, as the trademarks are normally assessed in their entirety considering the overall impression created by the designations.
- Lithuania No answers could have been provided as there is currently not any Committee Member from this country.
- Malta ./.
- Poland No. According to the decision of the District Administrative Court in Warsaw of 20 June 2007 (case No. VI SA/Wa 887/07), Article 135 of the Law of 30 June 2000 – the Law on Industrial Property (Journal of Laws of 2003, No 119, item 1117 with later changes), which provides that "...(g)rant of a right of protection for a trademark in respect of specific goods shall not constitute an autonomous ground for refusal to grant a right of protection for a trademark in respect of the goods identical or similar to those of another undertaking for a sole reason that the trademark contains an identical or similar sign which refers to personal rights, in particular the owner's name," and Article 156.1.1, which provides that "...the right of protection shall not entitle the right holder to prohibit third parties from using, in the course of trade their names or addresses", are not sufficient grounds for an applicant to register a sign which is identical to his competitors' trademark and both signs are intended to mark similar products (even if there is an addition of "Junior" word) if in the case of later registration there will be consumers' confusion as regards the source of goods and the applicant was acting in bad faith.
- Portugal The general rules would certainly apply. I believe it would depend a lot on the specific circumstances of the case have to be taken into account.
- Romania No. There are no court decisions available.



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- Slovakia No answers have been provided as there is currently not any Committee Member from this country.
- Slovenia No. Taking into consideration that the family name is the dominant part of the whole, comprising a first name and a family name, an initialized first name combined with the family name does not exclude the risk of confusion.
- Spain Answer depending on general impression created by the sign (comprising family name, first name and/or any additions) in its entirety, as pointed out in replies to preceding questions. But an initial should normally not be sufficient to change the overall impression.
- Sweden No, because a trademark does not have to refer to a specific person in order to be rejected on this ground. It only needs to be interpreted as a family name, not a specific person's family name.

Detailed Answers to Question 5

5 Are there any further national particularities with regard to assessing a risk of confusion between TMs consisting a person's name?

- Austria No.
- Benelux No.
- Bulgaria No.
- Cyprus No.
- Czech Republic The Czech IPO observes identity of the applied TM consisting a person's name and the applicant's name.

Limitation of the effects of a trade mark: The proprietor of a trade mark is not entitled to prohibit third persons from using their name and surname (Section 10, par. 1 of Trade Mark Act No. 441/2003 Coll.).

- Denmark All particularities are listed above under reply to Question 1.
- Estonia No.
- Finland ./.
- France See preliminary remarks.
- Germany No. See preliminary remarks in Question 1.
- United No.



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Kingdom

Greece It is accepted that the first names solely do not have a distinctive power, except from cases, in which they have been recognised through intense use in commerce.

Hungary We are aware of three cases, not really dealing with the similarity of the signs, however, concerning a possible conflict with the personality rights of third persons:

In the CHAGAL-case, the court refuses the registration of the sign, since it was similar to Mark Chagall's name. Even if only the family name was used, Chagall being a world famous painter, the use of the sign would have violated Chagall's personality rights;

In the GRÓF APPONYI case (where GRÓF is a title prefix, meaning Count), the application was refused, since the Count Apponyis were a well known noble family;

In the CLAUDIA TALK SHOW case (where Claudia Liptai is a well known TV person), the application was rejected, since the public associates the name CLAUDIA with the well known Claudia Liptai.

Ireland No.

Italy ./.

Latvia No.

Lithuania No answers could have been provided as there is currently not any Committee Member from this country.

Malta No.

Poland Basic national particularities with regard to assessing a risk of confusion between TMs consisting a person's name are listed under Articles 131, 135 and 156 of the Law on Industrial Property. Any other particularities are not known to me.

Portugal No.

Romania ./.

Slovakia No answers could have been provided as there is currently not any Committee Member from this country.

Slovenia If a family name is very common, i.e. held by an important number of citizens, such a name would carry less weight when functioning as a trade mark compared to a rare, unusual family name. This should be seen as an exception with respect to our statement under Pt.1, meaning that in a situation where two common family name marks were compared, the first name would then play a dominant role within first + family name marks.



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- Spain See detailed reply to Question 1. The fact that in Spain a person's name consists of two family names reduces the risk of confusion if the opposed trademarks have only one family name in common and diverge in the second family name provided that the latter has enough differentiating capability and the former is not well known.
- Sweden Not other than included in the previous answers.