

# Recent Swedish case law on likelihood of confusion assessment for descriptive trademarks



## **Introduction**

The question of whether there exists likelihood of confusion between two trademarks may arise in several situations – for example, in the case of trademark registrations or oppositions to trademarks, or in the use of trademarks when marketing and selling goods and services.

It may seem commercially attractive to companies to register a trademark that contains descriptive elements, as the targeted consumers will quickly grasp the kind of goods or services sold under the trademark. However, the more descriptive the trademark, the narrower the scope of protection afforded.

To demonstrate the Swedish patent and market courts' assessment of trademarks with descriptive elements (eg, a word trademark compared with another word trademark, a figurative trademark with another figurative trademark or a word trademark compared with a figurative trademark), this article compiles illustrative and relevant examples from Swedish registration and infringement case law from recent years. A recently decided case from the Patent and Market Court concerning likelihood of confusion between a company name and a trademark is also included.

## **Key takeaways**

The case law clearly shows that, as a main rule, the scope of protection awarded by the Swedish patent and market courts to trademarks containing descriptive elements – such as KRISPROLLS for biscuits and WART for wart removal products – is very narrow when it comes to assessing the likelihood of confusion. Thus, the owner of the trademark KRISPROLLS had to accept that its competitor used an essentially similar mark (CRISP ROLLS) for identical goods and the proprietor of the WARTNER trademark could not prevent registration of the WARTNIX trademark for wart removal products. Only when a trademark with descriptive elements has obtained enhanced distinctiveness may the trademark owner have success in preventing others from using similar mark – see in this respect the cases concerning the trademarks THE BODY SHOP and the OATLY, as well as the recently decided case between Aktiebolaget Trav och Galopp and Svenska Spel Sport & Casino.


As the scope of protection varies with the trademark's characteristics, brand owners are advised to be strategic in the creation of new trademarks. In summary, to obtain a trademark with a wide scope of protection it is necessary to avoid descriptive elements, even though such elements will seem attractive to companies from a consumer communication perspective.


# Case law

Earlier trademark	Conflicting trademark/mark	Good or services covered by the earlier trademark and the conflicting	Similarity between the trade-marks/other relevant factors
WARTNER	WARTNIX	<p>The earlier trademark covered "pharmaceutical preparations". The conflicting trademark covered "medical preparations and substances".</p> <p>The Patent and Market Court of Appeal (PMCA) held that some of the products were identical.</p>	<p>The PMCA held that the prefix "WART" in both marks was descriptive for the treatment of warts.</p> <p><b>The PMCA held that there was no likelihood of confusion.</b></p>
LegalZoom	LEGALROOM	<p>Both trademarks covered "legal services".</p> <p>The PMCA held that the services were identical.</p>	<p>The PMCA held that the terms "Legal" and "LEGAL" were commonly used to describe legal services and could therefore not be considered as an indication of origin for legal services.</p> <p>Although the terms "LEGAL" and "Legal" were descriptive, they could not be neglected in the overall assessment.</p> <p>The elements "Room" and "Zoom" constituted the distinctive and dominant components of the marks. There was a clear conceptual and phonetic difference between them.</p> <p>The marks as a whole gave rise to different associations.</p> <p><b>The PMCA held that there was no likelihood of confusion.</b></p>

<p>KRISPROLLS</p>	<p>CRISP ROLLS</p>	<p>Both trademarks covered "biscuits, rusks".</p> <p>The PMCA held that the goods were identical.</p>	<p>The PMCA held that KRISPROLLS had weak original distinctiveness for biscuits and thus a limited scope of protection. The trademark owner had failed to demonstrate enhanced distinctiveness by use.</p> <p>KRISPROLLS and CRISP ROLLS were basically phonetically identical.</p> <p>A visual difference was created by the difference in the initial letter ("K" versus "C") and the space in between "CRISP" and "ROLLS".</p> <p><b>The PMCA held that there was no likelihood of confusion.</b></p>
		<p>Both marks covered "security services".</p> <p>The Patent and Market Court (PMC) held that the services were identical.</p>	<p>The PMC held that the words "SAFE4U" and "SAFE" took up a prominent position in the respective marks.</p> <p>There was a visual similarity between the marks: both marks featured a blue background and a gold/yellow border and contained the word "SAFE".</p> <p>However, the marks contained various differences, such as the words "SECURITY OF SWEDEN" compared with the word "BEVAKNING". Also, the word "SAFE" was descriptive in relation to the services to which the marks apply.</p> <p><b>The PMC held that there was no likelihood of confusion.</b></p>



<p>OATLY</p>		<p>The earlier mark covered "flour and nutritional preparations made from cereals". The conflicting trademark covered "cereal cakes, including oatcakes for human consumption".</p> <p>The PMCA held that there was a similarity between the goods covered.</p>	<p>The PMCA held that OATLY enjoyed normal inherent distinctiveness in relation to the registered goods. However, the trademark had been used to such an extent that it enjoyed an enhanced distinctiveness in relation to flour and cereals in class 30.</p> <p>The words "Oatly" and "Oatie" began with "OAT" but were separated by the endings "-ly" "-ie". Both marks consisted of five letters. There was some visual and phonetic similarity between them.</p> <p>There was a conceptual similarity between the trademarks – without being descriptive – they both recalled oat products.</p> <p><b>The PMCA held that there was a likelihood of confusion.</b></p>
<p>THE BODY SHOP</p>	<p>THEFACESHOP</p>	<p>The earlier mark covered "cosmetic products, retail services for cosmetics". The conflicting trademark covered "cosmetic products, retail services for cosmetic products".</p> <p>The PMC held that the trademarks covered identical, or at least very similar, goods and services.</p>	<p>The PMC held that the inherent distinctiveness of THE BODY SHOP trademark in relation to the goods and services in question was low. However, THE BODY SHOP enjoyed an enhanced distinctiveness in relation to cosmetics and hair and body care products in class 3 as well as for the retail sale of such products in class 35. Therefore, it had obtained a normal degree of distinctiveness.</p> <p>The common elements consisted of the words "THE" and "SHOP" while the elements "FACE" and "BODY" differed. However, the individual elements should not be assessed on their own; the marks should be compared in their entirety.</p> <p>There was some visual and phonetic similarity between the brands of goods. There was also some conceptual similarity between the marks as the words "FACE" and "BODY" were both associated with the human body.</p> <p><b>The PMC held that there was a likelihood of confusion.</b></p>

<p>Aktiebolaget Trav och Galopp</p>		<p>The earlier company name covered, among other things, the service "to provide games for money, to promote the sport of trotting and galloping". The conflicting trademark covered, among other things, "lottery tickets (printed), betting activities and the organization of lotteries, etc".</p> <p>The PMC held that, in principle, there was similarity between the goods and services offered by Aktiebolaget Trav och Galopp and the goods registered under the trademark.</p>	<p>The PMC held that Trav and Galopp enjoyed low inherent distinctiveness. However, the company name had obtained a normal degree of distinctiveness through use since 1973 and through intense market exposure.</p> <p>The word elements of the trademark were, in principle, identical to the relevant part of the company name. The word elements were phonetically identical. The trademark contained additional figurative elements. The flag functioned almost as a background; the other symbol had strong distinctiveness but formed a slightly smaller part of the trademark and was positioned at some distance from the word elements. Although the symbol was prominent, the word elements formed the dominant part of the brand.</p> <p><b>The PMC held that there was a likelihood of confusion.</b></p>
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