

June 13 2022

# Likelihood of confusion despite low degree of distinctiveness

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#### Introduction

In this case,<sup>(1)</sup> an application to register the trademark TANDLÄKARGRUPPEN ODENPLAN was refused due to the earlier registered company name Tandläkarhuset Odenplan AB, notwithstanding the low degree of distinctiveness in the trademark elements of both marks ("*tandläkar-*" means "dentist" and "Odenplan" is the location of both businesses).

The Patent and Market Court (PMC) emphasised that it is not possible to draw a general conclusion that descriptive elements of signs should be excluded from an assessment of similarity. Since the signs at issue consisted of partly identical words in an identical order, the PMC concluded that a likelihood of confusion existed between the signs.

This outcome differs from several recent Swedish court judgments in which the courts (namely, the PMC and the Patent and Market Court of Appeal (PMCA)) had concluded that no likelihood of confusion existed due to the presence of descriptive elements.<sup>(2)</sup>

#### Facts

In July 2020, a company applied to register the word mark TANDLÄKARGRUPPEN ODENPLAN for various dental services in class 44.

The company Tandläkarhuset Odenplan AB filed an opposition based on its earlier registered company name, also covering dental services. The Swedish Patent and Registration Office (PRV) found that the company name Tandläkarhuset Odenplan AB enjoyed a normal degree of inherent distinctiveness. In its assessment of the likelihood of confusion, the PRV found that the services were identical and that the marks were conceptually similar to a high degree. The PRV therefore concluded that there was a likelihood of confusion between the signs at issue.

The decision was appealed to the PMC.

#### Decision

The PMC initially confirmed that the relative grounds for refusal of trademarks apply to company names as well – that is, a Swedish company name registration could prevent a similar sign from being registered as a trademark and vice versa (cross-protection).

The PMC then referred to European Court of Justice case law, which states that a global appreciation of the visual, aural or conceptual similarity of the signs in question must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components. Further, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

The PMC also stated that whether the descriptive elements of a sign are to be excluded from the assessment of similarity must be determined on a case-by-case basis.

Moving on to the comparison of the signs, the PMC held that the earlier sign, Tandläkarhuset Odenplan AB, is a combination of the Swedish words "*tandläkare*" ("dentist") and "*hus*" ("house"). The word "Odenplan" is a geographical place in Stockholm. These words could not be neglected regardless of whether they are descriptive. The term AB, short for "*Aktiebolag*" ("joint stock company"), could, however, be neglected.

Contrary to the PRV's assessment, the PMC held that Tandläkarhuset Odenplan AB enjoyed less than a normal degree of distinctiveness, taking into account the descriptive elements in the company name.

The contested trademark, TANDLÄKARGRUPPEN ODENPLAN, also consisted of the terms "*tandläkare*" and "Odenplan" and constituted a normal structure of words in Swedish. The words "*tandläkar-*" and "Odenplan" could not be neglected.

Furthermore, the PMC found the similarity between the signs to be enhanced because:

- they shared identical words;
- the order in which the words were presented was the same; and
- the construction of the signs was the same.

With regard to the comparison of services, the PMC held that the services were identical.

Taking all of the above into consideration, the PMC concluded that there existed a likelihood of confusion between the company name and the trademark.

#### Comment

The decision essentially confirms that a likelihood of confusion is at hand when the signs are identical and/or highly similar (eg, the words are in same order). Of course, the outcome depends on the specific circumstances of each case.

This decision may appear reasonable considering the similarities between the trademarks. The company name Tandläkarhuset Odenplan

AB and the trademark TANDLÄKARGRUPPEN ODENPLAN shared two words and were presented in the same order. Taking into account the PMC's reasoning, the outcome probably would have been different if the contested trademark had included, for example, a different geographical place (eg, TANDLÄKARGRUPPEN KARLAPLAN).

On the other hand, it may be questioned whether this type of highly descriptive sign should really be eligible for protection.

In a recent Swedish judgement,<sup>(3)</sup> the PMCA reached a different conclusion than in the case at issue, finding that there was no likelihood of confusion between CURA OF SWEDEN and CARE OF SWEDEN. In that case, the PMCA found that "cura" and "care" were the most distinctive elements in each sign. Although only one letter was different between the trademarks, they were not considered confusingly similar. It should also be mentioned that the goods covered by the trademarks in that case were considered highly similar, which differs from the case at issue, in which the services were identical. With the *Cura* case in mind, it can be concluded that there is a very fine line when determining the likelihood of confusion of trademarks that enjoy a low degree of distinctiveness.

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#### **Endnotes**

(1) PMÄ 16679-21.

(2) See, for example, *Cura of Sweden v Care of Sweden*, *SVENSKA POOLFABRIKEN* (device mark) v *SVENSKA POOLFABRIKEN*, *LEGALROOM v LegalZoom* and *Ebox v eboks* (both device marks).

(3) PMT 669-21.