

Family of Marks

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1. Relative Grounds only

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SMARTSURFACE

Cl.9 contact lenses

“ It must be noted at the outset that the concept of a family of marks does not come under absolute grounds for refusal, but only under relative grounds for refusal, with the result that the Board of Appeal had to assess whether the mark applied for was distinctive in the light of its inherent characteristics, without taking into consideration the other allegedly similar marks of which the applicant was the proprietor”

Case T-463/18,

Novartis AG v (EUIPO),



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2. Remember Nestle v Mars UK Ltd

”In the final analysis, the reply to the question raised must be that the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”

Case C-353/03, Société des produits Nestlé SA. v Mars UK Ltd,



3. Definition of a family

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'Bridge', 'Old Bridge', 'The Bridge Basket', 'THE BRIDGE', 'The Bridge', 'FOOTBRIDGE', 'The Bridge Wayfarer' and 'OVER THE BRIDGE', for goods in Cls. 18 and 25 v Bainbridge

“A family or series of trademarks exists when a group of marks shares a common prefix, suffix, or characteristic, creating an association in the public mind that they all originate from the same economic source.”

Case C-234/06 P, Il Ponte Finanziaria SpA

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Torres & various tower devices v Torre Albeniz Case

1. the common element of the earlier word and figurative marks comprised the word 'torres' and/or the representation, in various forms, of a number of towers,
2. The element in the earlier marks, both in word form and figuratively, is the presence of a number of towers which is not a series/family.

T-428/18

Miguel Torres SA v Bodegas Penalba Lopez SL



4. Use of the family members

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- Use of all marks not necessary but a sufficient number
- Only 2 of the marks had been used
- Genuine use must be about scale of frequency of use
- Defensive registrations rejected

Case C-234/06 P, Il Ponte Finanziaria SpA

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PEPEQUILLO v PEPE, PEPE JEANS, etc

In the present case, although the applicant has proved use of the PEPE and PEPE JEANS marks, it has not succeeded in proving, as the Board of Appeal points, use of the other earlier marks belonging to the alleged family of marks, such as PEPE F4, PEPE 2XL and PEPEM9

PJ Hungary Szolgáltató kft (PJ Hungary kft)v Pepekillo, SL, Case T-580/08,



6. Nature of the common element – distinctive/descriptive

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Cl. 5 – pharmaceuticals – hyaluronic acid

any likelihood of association between the mark applied for and the family of marks claimed by the applicant was excluded in the light of the weak distinctive character of the element in common ‘hyal’.

Case T-497/23, Fidia farmaceutici SpA, v Vorwarts Pharma sp. z o.o., est



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Applicant: ROCK & ROCK

Opponent:

MASTERROCK, FIXROCK, FLEXIROCK, COVERROCK & CEILROCK for paints and building materials for Cls. 2 & 19, floor coverings and non-textile wall hangings in Cl. 27.

Common element must be distinctive

Case T-436/12 Deutsche Rockwool Mineralwoll GmbH & Co. OHG v Ceramicas del Foix, SA



7. Link





Arts 8(1(a), & (b) 8(2)(c), 8(5)

The existence of a family may give rise to a link

Case T-518/13, Future Enterprises Pte Ltd v McDonald's International Property Co. Ltd,

8. Likelihood of confusion



“Likelihood of confusion results from mistaken provenance”

Case C-234/06 P, Il Ponte Finanziaria SpA



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UNIWEB v UNIFONDS UNIRAK

- Relevant to the assessment of likelihood of confusion
- Not required to evidentially establish that relevant public perceives the later mark belongs to the family

Case T-303/06 UniCredit SpA v Union Investment Privatfonds GmbH

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10. The characteristics of the later mark



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MC DONALDS, etc v McDREAMS

It is true that the word ‘dreams’ is not the generic name of a foodstuff product or a descriptive characteristic of a foodstuff product. However, the structure of the element ‘mc dreams’ — which is the dominant element in the mark applied for (see paragraph 48 above) — is, at least in part, similar to that of the intervener’s family of marks, since it includes the prefix ‘mc’ followed by a name in English. Thus, that common structure, which itself is not decisive for the purposes of determining the existence of a link between the marks at issue, reinforces the likelihood of such a link in the mind of the relevant public.

Case T-428/18

McDreams Hotel GmbH v McDonald’s International Property Co. Ltd



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SO? SO..? ONE So? CHIC v SO:UNIC

Conflicting goods; Cl.3

“It is then necessary, in order for that likelihood of confusion to exist, that the mark concerned should have characteristics which might suggest that it belongs to the family of marks in question.”

Case C-270/14 P,

Debonair Trading Internacional Lda v OHIM



10. Passing Off

easyJet, easyCar, easyBus, easyEverything (later easyInternetcafé), easyHotel and easyMoney

“This is a point capable of bearing on issues of confusion and links (under infringement) and misrepresentation (under passing off). Where a proprietor establishes that there is a family of marks, and the challenged sign reproduces some of the elements of the “family”, then the possibility of confusion is enhanced.”

Easygroup Ltd v Easy Live (Services) Ltd[2022] EWHC 3327 (Ch)



The passing off claim, which easyGroup had accepted would stand or fall with the s.10(2)(b) claim, therefore also failed. Per HHJ Melissa Clarke

easyGroup Ltd v Cubico (UK) Ltd (t/a “Easy Bathrooms”) [2026] ETMR 36



11. Conclusion

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The effects on the global appreciation test:

(i) The global appreciation test- The similarity of marks;
(ii) The global appreciation test interdependence between the trade marks and between these goods or services';
(iii) The global appreciation test - the recognition of the earlier trade mark on the market, (KitKat), acquired distinctiveness;
(iv) The global appreciation test - imperfect recollection;
(v) The global appreciation test - descriptiveness – acquired distinctiveness (KitKat);
(vi) Abandonment;
(vii) Assignments of part of a family- deception.