

**Ministry of Science and Higher Education of the Republic of Kazakhstan
MAQSUT NARIKBAYEV UNIVERSITY**

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**Determination of Likelihood of Confusion of Trademarks: Comparative
Analysis of Legislation and Judicial Practice**

educational program 7M04210 - «Intellectual Property and Business Law»

Thesis for the academic degree of Master of Law

Astana, 2025

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MASTER'S PROJECT

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Comparative Analysis of Legislation and Judicial Practice"**

**according to the educational program 7M04210 –
«Intellectual Property and Business Law»**

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The calendar plan for the preparation of a master's project

Name of the project stages	Period	A note on the implementation of the project stages			
		Actual completion date	The degree of readiness of the completed stage of the project	Signature of the postgraduate	Signature of the supervisor
Review of literature and practical materials	15.10.2024-31.10.2024	31.10.2024	100%		
Methodology development	01.11.2024-10.11.2024	10.11.2024	100%		
Data Collection And processing	11.11.2024-25.11.2024	25.11.2024	100%		
Analysis and interpretation of the results obtained	26.11.2024-10.12.2024	10.12.2024	100%		
Development of project recommendations	11.12.2024-20.12.2024	20.12.2024	100%		
Preparation of the introduction and conclusion	21.12.2024-31.12.2024	31.12.2024	100%		
Preparation of project: Preparation of the first section of the project	02.01.2025 - 05.02.2025	05.02.2025	100%		
Preparation of the II section of the project	06.02.2025 - 02.03.2025	02.03.2025	100%		
Preparation of the III section of the project	03.03.2025-31.03.2025	31.03.2025	100%		
Receiving feedback from the supervisor	01.04.2025 - 10.04.2025	10.04.2025	100%		
Preparation of a report, visual aids and presentations	11.04.2025 - 22.04.2025	23.04.2025	100%		
Defense of the master's project	26.05.2025-30.05.2025	26-27.05.2025	100%		

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LIST OF ABBREVIATIONS

Appeals board – the Appeals Board of the Ministry of Justice of the Republic of Kazakhstan

CFE – the Center for the Forensic Examination of the Ministry of Justice of the Republic of Kazakhstan

CJEU – Court of Justice of the European Union

EU – European Union

EUIPO – European Union Intellectual Property Office

Methodology of Judicial Expert Evaluation – Judicial Expert Evaluation of Identity or Similarity of Trademarks to the Extent of Confusion

NIIP – National Institute of Intellectual Property of the Republic of Kazakhstan

Paris Convention – Paris Convention for the Protection of Industrial Property

Rules for Conducting Examinations of NIIP – Rules for conducting an examination of applications for selection achievements, objects of industrial property, trademarks, service marks, geographical indications, and appellations of goods origin, on registration of integrated circuits topologies

The Law “On Trademarks” – the Law of the Republic of Kazakhstan “On Trademarks, Service Marks, Geographical Indications and Appellations of Origin”

TRIPS – Agreement on Trade-Related Aspects of Intellectual Property Rights

U.S. – United States of America

WIPO – World Intellectual Property Organization

WTO – World Trade Organization

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INTRODUCTION

In Kazakhstan, the issue of assessing *trademark similarity* is widely recognized as problematic by both the judiciary and leading scholars. As noted in the Supreme Court's Practical Guide on Intellectual Property Disputes,¹ courts often face difficulties due to the absence of a unified and transparent methodology for evaluating likelihood of confusion. This problem is further emphasized by legal scholars such as T.E. Kaudyrov,² who argues that “in practice, the evaluation of similarity heavily depends on the subjective interpretation of the decision-maker, resulting in inconsistent and unpredictable outcomes.”

Against this background, the issue of defining and systematically assessing confusing similarity between trademarks becomes a critical challenge for the Kazakhstani legal system, requiring urgent doctrinal and procedural clarification. Moreover, as the number of registered trademarks increases and competition in international markets escalates, the challenge of assessing the degree of similarity between trademarks and the likelihood of consumer confusion becomes increasingly pertinent. This issue is also pertinent in the Republic of Kazakhstan.

According to the official website of the National Institute of Intellectual Property of the Republic of Kazakhstan (*hereinafter* - “NIIP”), 100 000 trademarks were registered in Kazakhstan,³ information about 100 000th registration was entered into the State Register of Trademarks. In general, NIIP notes a large increase in applications for registration of trademarks in the first half of 2024 with an increase of 34%,⁴ one of the catalysts for this may be the growing interest of the population of Kazakhstan, namely business representatives, in obtaining protection for intellectual property.

In the context of trademarks, the relevance and interest are not only in the protection of trademarks, but also in the current system of trademark defense. It is necessary to clarify the point that in the framework of intellectual property, protection implies *obtaining protection documents* for intellectual property objects, for example, obtaining a certificate or a patent, while defense involves *active enforcement measures* to protect one's infringed rights.

Undoubtedly, the issue of trademark protection is a highly sensitive

¹ Supreme Court of the Republic of Kazakhstan, Practical Guide on Intellectual Property Disputes: Judicial Library Series (2011) 61

² Kaudyrov T.E. Civil protection of industrial property objects: Monograph. – Almaty: Zheti Zhargy, 2001. – 448 p. P. 14.

³ Qazpatent, ‘Qazpatent has registered the 100-thousandth trademark’ (Qazpatent, 7 April 2025) <https://qazpatent.kz/en/media/6556/qazpatent-has-registered-100-000th-trademark> Accessed on 7 April 2025.

⁴ Qazpatent, ‘The number of applications to Qazpatent increased by 34% in the first half of the year’ (Qazpatent, 19 July 2024) <https://qazpatent.kz/en/media/6434/number-applications-qazpatent-increased-34-first-half-year> accessed 5 April 2025.

issue for the business community, as is the resulting issue of identification of their goods and/or services. As mentioned earlier, the issue of the likelihood of confusion between trademarks and their perception by consumers is a pressing problem. Particularly for Kazakhstan, this problem is complicated by different approaches to the definition of similarity and, in general, the concept of confusing similarity.

Currently, a distinct ecosystem can be identified in the assessment of trademark similarity. This ecosystem includes: the presumed trademark owner; the NIIP acting as the expert organization responsible for examining intellectual property objects (in this case, trademarks); the consumer, as the ultimate recipient of trademark information through market engagement and the purchase of goods and/or services; a second trademark holder or an applicant who has submitted a similar trademark for registration; the Appeals Board of the Ministry of Justice (*hereinafter* – “*Appeals Board*”), which functions as a pre-trial dispute resolution body; the Courts of the Republic of Kazakhstan, which serve as the judicial authority and offer a mechanism for the recognition and protection of rights; the Center for the Forensic Examination (*hereinafter* – “*CFE*”), which conducts forensic examinations; and, importantly, independent experts (patent attorneys), who may provide their own independent opinions on trademark similarity in the context of judicial proceedings.

Within this ecosystem, several key actors can be identified, namely the NIIP, the CFE, and independent experts. The primary focus of this study is the examination of how trademark similarity - specifically, *likelihood of confusion* - is assessed globally, alongside an analysis of the current practices in the Republic of Kazakhstan. The Kazakhstani practice reveals a certain degree of inconsistency, reflected in the differing approaches to assessment. In particular, representatives of the NIIP rely on the Rules for conducting an examination of applications for selection achievements, objects of industrial property, trademarks, service marks, geographical indications, and appellations of goods origin, on registration of integrated circuits topologies (*hereinafter* - “*Rules for Conducting Examinations of NIIP*”),⁵ which emphasize the “overall impression” of trademarks. In contrast, experts from the CFE apply their own methodology,⁶ which is based on a more ‘mathematical’ approach. As a result, the conclusions drawn by the NIIP and the CFE often conflict, prompting the courts to involve independent experts (patent attorneys) to provide an impartial opinion in the event of a dispute.

Thus, this study, titled “**Determination of Likelihood of Confusion of Trademarks: Comparative Analysis of Legislation and Judicial Practice**,” explores how different legal systems approach the assessment

⁵ Rules for Conducting Examinations on Industrial Property by the NIIP.

⁶ Forensic Expert Methodology for “Establishing Identity and Likelihood of Confusion of Trademarks” by the CFE.

of trademark similarity. It draws on international legal instruments, regional frameworks, and national judicial practice in the Republic of Kazakhstan to provide a comprehensive understanding of the key legal criteria, consumer perception factors, and judicial standards that influence the outcome of trademark disputes.

Relevance of the Research

The growing globalization of markets and the rapid increase in cross-border commerce underscore the importance of clearly defining and determining the likelihood of confusion in trademark law. In both academic and practical contexts, safeguarding brand identity against infringement has become a pressing issue, as confusion over similar marks can erode consumer trust and undermine fair competition. Moreover, legal systems around the world employ different standards and methodologies to assess confusion, leading to jurisdiction-specific interpretations. By analyzing these diverse approaches, this study provides valuable insights into the strengths and potential shortcomings of various legal frameworks, ultimately helping policymakers, businesses, and scholars refine and harmonize trademark protection strategies in Kazakhstan.

Research Objectives and Questions

This thesis aims to investigate the likelihood of confusion in trademark law, focusing on legislative criteria, judicial practices, and administrative procedures. In particular, the research objectives include:

1. Identifying the legal principles and factors that influence the likelihood of confusion across multiple jurisdictions.
2. Examining how different courts and administrative bodies apply these principles through comparative analysis, highlighting both shared and unique features.
3. Proposing evidence-based recommendations and frameworks for more consistent, transparent, and effective trademark protection.

Building on these objectives, the main research question guiding this study is: ***How do different legal systems determine the likelihood of confusion in trademark disputes, and what are the key similarities and differences in legislative approaches and judicial practices?***

To support this overarching question, the following sub-questions are considered:

• *RQ1: What is the core legal criteria used to determine trademark confusion in various jurisdictions?*

• *RQ2: How do courts and administrative bodies interpret and apply these criteria in practice?*

• *RQ3: In what ways can international and regional regulations (such as TRIPS, the Madrid System, and the EU Trademark Law) influence*

national approaches to trademark confusion?

Methodology and Research Approach

To address the research question and objectives, this thesis employs a comparative legal analysis, integrating qualitative insights where applicable. The primary methodological steps include:

1. Literature Review and Legal Framework Analysis: Examining international treaties (TRIPS), regional instruments (EU Trademark Law), and national laws (with a focus on Kazakhstan).

2. Case Law Examination: Reviewing landmark judicial decisions and administrative rulings to identify patterns, differences, and recurring themes in how likelihood of confusion is determined.

3. Comparative Synthesis: Evaluating the collected data to highlight convergences and divergences in legislative and judicial approaches, culminating in recommendations for more unified and efficient trademark protection.

This approach ensures a holistic understanding of how trademark confusion is defined, interpreted, and enforced across different legal systems.

The novelty of this thesis lies in its detailed comparative perspective on trademark confusion, which brings together disparate legal sources and case studies under a unified analytical framework. While many studies focus on individual jurisdictions or specific legal instruments, this research goes further by juxtaposing continental law with common law, elucidating both shared principles and distinctive national peculiarities.

From a practical standpoint, the findings aim to guide legal practitioners, brand owners, and policymakers in navigating cross-border trademark disputes more effectively. By pinpointing key areas of divergence - such as evidentiary standards, the weight of consumer perception, and the role of administrative bodies - this thesis offers concrete recommendations for harmonizing approaches, thereby reducing legal uncertainty and enhancing brand protection globally.

The issue of trademark similarity and the associated likelihood of consumer confusion has been widely discussed in international legal scholarship. While various jurisdictions adopt different frameworks for analysis, the underlying challenge remains the same: how to balance effective trademark protection with fair competition and legal predictability. This literature review examines key doctrinal contributions and institutional perspectives relevant to the subject of this dissertation.

Literature review

Graeme Dinwoodie and Mark Janis, in their seminal work *Trademarks and Unfair Competition: Law and Policy* (2021), argue that

the absence of a harmonized standard for determining trademark similarity creates legal uncertainty, especially in transnational contexts. They emphasize that the evaluation of similarity is inherently contextual and must account for both legal and market realities. According to the authors, the flexibility of international agreements such as TRIPS, while intended to respect national sovereignty, often leads to divergent judicial interpretations that undermine predictability and coherence in trademark enforcement. This observation is particularly relevant to the Kazakhstani context, where courts and institutions apply different methodologies without a clear unifying standard.

Barton Beebe's empirical work, including "An Empirical Study of the Multifactor Tests for Trademark Infringement" (2006), explores the inconsistencies in the application of multifactor confusion tests in U.S. courts. Beebe finds that despite formal structures, outcomes often depend on judicial discretion rather than uniform standards. This insight resonates with the Kazakhstani experience, where experts and judges similarly exercise broad interpretive freedom in assessing likelihood of confusion, sometimes reaching contradictory outcomes on nearly identical factual grounds.

In her article "The Fairy Tale of the Average Consumer" (2020), Lotte Anemaet critically examines the notion of the "average consumer" as applied in EU trademark law. She argues that the figure of the average consumer is often constructed more as a legal fiction than a behavioral reality, serving to justify expansive trademark protection. This critique is especially pertinent for Kazakhstan, where the legal system borrows elements of EU practice, including references to consumer perception, without a precise definition or empirical foundation for such concepts.

The analysis of judicial and administrative inconsistencies in Kazakhstan is further developed in the monograph by ZH Baimoldina and TE Kaudyrov, *Pravo intellektualnoy sobstvennosti Respubliki Kazakhstan* (2013). Kaudyrov notes that the assessment of trademark similarity in Kazakhstan is largely subjective, with outcomes frequently depending on the personal interpretation of decision-makers. The absence of a legally binding methodology has led to a lack of coherence across NIIP, forensic experts, and the judiciary, a concern that this dissertation directly addresses through comparative legal analysis and reform-oriented recommendations.

On the institutional level, the role of international legal instruments such as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the Paris Convention for the Protection of Industrial Property is pivotal. While TRIPS establishes a presumption of confusion in cases involving identical signs and goods (Art. 16.1), it does not define how similarity should be assessed. Similarly, the Paris Convention (Art. 6bis) obliges member states to prohibit the use of confusingly similar

marks but refrains from setting evaluative criteria. As Dinwoodie and Janis point out, this regulatory silence grants flexibility but risks fragmentation.

The Kazakhstani doctoral dissertation by A.N. Seitova, *Legal Regulation of the Protection and Enforcement of Trademarks in the Republic of Kazakhstan* (2024), supports the notion that institutional divergence is a key barrier to consistent enforcement. Seitova observes that NIIP decisions are frequently challenged in court, with forensic experts applying alternate frameworks that occasionally contradict the original examination. Her findings substantiate the central argument of this dissertation regarding the need for unified national standards.

Finally, practical perspectives are also informed by EUIPO's internal training materials, such as Virginia Melgar's 2023 presentation "Assessing Likelihood of Confusion: Methodology." These resources demonstrate the EU's preference for a holistic "global appreciation" approach, integrating visual, phonetic, and conceptual analysis. Although Kazakhstan formally references similar principles, their fragmented application underscores the importance of not only adopting but consistently implementing doctrinal standards.

In summary, the existing literature highlights a global and domestic consensus on the necessity of structured, transparent, and context-sensitive evaluation of trademark similarity. The absence of unified criteria in Kazakhstan mirrors broader international trends, yet demands local solutions. This dissertation contributes to the ongoing scholarly discourse by identifying gaps in national methodology and proposing targeted reforms aligned with comparative best practices. Moreover, recent empirical scholarship has further highlighted the challenges associated with the practical application of trademark confusion tests. Lim's 2024 study reveals that judicial outcomes often diverge even within single jurisdictions due to inconsistent weighting of confusion factors, underscoring the necessity for clearer interpretive standards in trademark law.⁷

Theses Submitted to Defense

The absence of a unified methodology for assessing trademark similarity in Kazakhstan leads to legal uncertainty. At present, the Republic of Kazakhstan lacks a single normative instrument that sets binding criteria for determining the likelihood of confusion between trademarks in judicial practice. Inconsistencies between the conclusions of NIIP examiners, forensic experts from the Center for Forensic Examination (CFE), opinions of independent patent attorneys, and judicial decisions undermine the effectiveness of trademark protection and reduce predictability in legal outcomes.

⁷ D Lim, 'Trademark confusion revealed: An empirical analysis' (2024) 114 Trademark Reporter 799.

A comparative analysis of the EU and US legal systems enables the development of a balanced model for evaluating trademark similarity. The European Union applies the “global appreciation” approach established by the Court of Justice of the European Union (CJEU), while the United States follows the multifactor Polaroid test. Both frameworks emphasize consumer perception and consider a range of contextual factors including visual, phonetic, and conceptual similarity, product proximity, and actual confusion. This comparative perspective highlights the advantages of transparency, consistency, and evidentiary rigor in confusion assessments.

It is proposed to initiate the development and adoption of a Normative Resolution by the Supreme Court of the Republic of Kazakhstan. The objective of such a resolution would be to establish a unified judicial standard for determining the likelihood of confusion between trademarks. The resolution should:

- **Introduce a clear list of key factors**, analogous to the Polaroid factors (e.g. strength of the mark, similarity of the signs, relatedness of goods or services, evidence of confusion, intent of the junior user, etc.);
- **Define consumer perception as the central criterion** in the assessment process;
- Clarify the interplay between expert opinion and judicial discretion, ensuring courts **may consider expert input without being bound by it**;

Implementing this proposal would strengthen the institutional capacity of Kazakhstan’s judiciary in the field of intellectual property. The adoption of a Supreme Court resolution would reduce methodological fragmentation between administrative bodies and courts, reaffirm the judiciary’s independent role in evaluating trademark similarity, and improve trust in Kazakhstan’s trademark enforcement system. In the long term, this would also lay the foundation for the development of specialized judicial practice in IP, aligning Kazakhstan with international standards promoted by WIPO.

CHAPTER 1: THEORETICAL AND LEGAL FOUNDATIONS OF TRADEMARK SIMILARITY

1.1 The Concept and Legal Nature of Trademarks Similarity

“The difference between the almost right word and the right word is really a large matter – it’s the difference between the lightning bug and the lightning.”

- Mark Twain⁸

The concept of trademark similarity is fundamental within the broader framework of intellectual property law. It serves as a key mechanism for ensuring both consumer protection and the preservation of trademark owners’ exclusive rights. When trademarks are perceived as similar, the risk of consumer confusion significantly increases, potentially leading to reputational harm and market distortion. This issue has become more prominent due to inconsistencies in legal standards across jurisdictions, often resulting in ambiguous and conflicting judicial rulings.

The term ‘Similarity’ is reflected in the Oxford Dictionary as the *“state of being similar to somebody or something but not exactly the same.”*⁹ In the context of trademark law, this concept takes on a more nuanced meaning. It does not merely refer to surface-level resemblance but rather to the degree to which one trademark evokes the same overall impression as another in the minds of consumers. This impression can be shaped by visual, phonetic, and conceptual elements - all assessed in light of the specific goods or services associated with the marks. This tripartite distinction is not explicitly found in the Paris Convention for the Protection of Industrial Property (*hereinafter* – “*Paris Convention*”), but Paris Convention refers broadly to the need to prevent confusion between marks with well-known trademarks.¹⁰ As a result, the task of defining and applying specific criteria - such as visual, phonetic, and conceptual comparison - is left to the discretion of national legislations and judicial practice within each jurisdiction. Recent judicial research proposes that clearer standards for deciding trademark confusion claims, especially those emphasizing the consumer’s actual experience in the marketplace, could significantly reduce fragmentation.¹¹

Legal systems around the world interpret trademark similarity

⁸ Mark Twain, ‘The difference between the almost right word and the right word is really a large matter...’ (Goodreads, undated) <https://www.goodreads.com/quotes/4957-the-difference-between-the-almost-right-word-and-the-right> accessed 2 April 2025.

⁹ ‘Similarity’ Oxford Learner’s Dictionaries <https://www.oxfordlearnersdictionaries.com/definition/english/similarity> accessed 2 April 2025.

¹⁰ Paris Convention for the Protection of Industrial Property (adopted 20 March 1883, last revised at Stockholm 14 July 1967) art 6bis(1) <https://www.wipo.int/wipolex/en/text/288514> accessed 2 April 2025.

¹¹ A Holtzman, ‘A Proposal on Deciding Trademark Infringement Claims to Limit Confusion for Consumers’ (2025) 24(2) UIC Review of Intellectual Property Law 124.

through different lenses, often combining statutory language with judicial interpretation. While some jurisdictions adopt formal comparison criteria, others emphasize the perception of an *average consumer* operating under typical market conditions. Regardless of the approach, the determination of similarity remains a foundational element in assessing the likelihood of confusion - a standard that is central to both the registration process and infringement litigation. Dinwoodie states that similarity is not merely a descriptive or aesthetic notion but a legally operative fact, forming the basis for legal determinations such as refusal, invalidation, or liability for infringement. In his view, similarity should be analyzed not in isolation but as a triggering condition for broader legal consequences within trademark protection regimes.¹²

Trademark similarity, though doctrinally a conceptual matter, acquires legal substance when it forms the factual basis for a legal conclusion - such as refusal of registration, invalidation of a mark, or establishment of infringement. Therefore, similarity functions as a constitutive legal fact within the logic of trademark protection.

The challenges arising from the absence of clear and standardized criteria for assessing trademark similarity are not unique to Kazakhstan. Comparative study of Baiocchi, introducing an analysis of the Brazilian legal framework, demonstrate that even jurisdictions with robust trademark protection mechanisms encounter difficulties when judicial and administrative bodies lack uniform methodologies.¹³

Summarizing all the above, it becomes evident that the concept of trademark similarity serves as a foundational pillar of trademark law, directly influencing the legal assessment of consumer confusion and the scope of trademark protection. While the notion of similarity is universally acknowledged, its practical interpretation varies across jurisdictions due to the absence of a harmonized international methodology. The reliance on visual, phonetic, and conceptual elements has become a widely accepted tripartite model, though its application is often shaped by national legislative and judicial discretion. The lack of precise definitional guidance in international instruments such as the Paris Convention reinforces the significance of domestic legal doctrine and institutional practice. Accordingly, understanding trademark similarity as a legal concept requires both doctrinal clarity and contextual sensitivity to consumer perception and market realities. Further empirical research also suggests that the predictability of judicial decisions could be enhanced by

¹² Graeme B Dinwoodie and Mark D Janis, *Trademarks and Unfair Competition: Law and Policy* (5th edn, Aspen Publishers 2021) 215–217.

¹³ Enzo Baiocchi, 'The Protection of Highly Renowned Trademarks in Brazil' (2014) WIPO Academy, Chapter 3.

triangulating different methods, including linguistic analysis and consumer surveys.¹⁴

1.2 The Role of Consumer Perception in Trademark Confusion

Returning to the main function of a “trademark”, a trademark – is a designation used to identify goods and/or services from one manufacturer from another. Thus, a trademark serves as a “lightning house” for consumers, which should help them to choose a certain product among many similar ones, so consumer perception is extremely important. Dinwoodie emphasizes that the legal significance of similarity arises from its potential to disrupt consumer expectations and marketplace transparency, and that similarity becomes problematic not because of mere similarity but because it may interfere with the proper functioning of the trademark as an original identifier.¹⁵

In the *Gut Springenheide v Oberkreisdirektor (C-210/96)* case of the Court of Justice of the European Union (*hereinafter* – “CJEU”), an “average consumer” was recognized as a person who is sufficiently well informed, observant and prudent enough, without ordering an expert opinion or ordering a consumer survey.¹⁶ Thus, the concept of the “average consumer” provides courts and administrative bodies with a standardized benchmark for assessing whether a given sign is likely to cause confusion. It is essential for ensuring consistency in legal evaluations, protecting consumers from misleading indications, and preserving fair competition among trademark holders. This standard, while a bit abstract, helps to account for different levels of attention in various market sectors.

However, the assumption that an “average consumer” exists and behaves predictably has been critically examined in recent scholarship. Anemaet argues that this image is in many ways a legal fiction, strategically shaped to justify expansive trademark protection, especially in cases involving cultural or non-traditional marks.¹⁷ According to her, empirical consumer surveys often serve to amplify trademark owners’ market power, especially when such owners invest heavily in marketing that molds consumer perception over time.

In the United States, the likelihood of confusion is assessed through a *multifactorial framework* established in *Polaroid Corp. v. Polarad Elecs.*

¹⁴ E DeRosia, J Egbert and T Lee, ‘Triangulating the Likelihood of Confusion: Linguistics and Consumer Surveys’ (2024) 50(1) *BYU Law Review* 1.

¹⁵ Graeme B Dinwoodie and Mark D Janis, *Trademarks and Unfair Competition: Law and Policy* (5th edn, Aspen Publishers 2021) 221

¹⁶ Case C-210/96 *Gut Springenheide GmbH and Rudolf Tusky v Oberkreisdirektor des Kreises Steinfurt – Amt für Lebensmittelüberwachung* [1998] *ECR I-04657*, para 31 <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex:61996CJ0210> accessed 4 April 2025.

¹⁷ Lotte Anemaet, ‘The Fairy Tale of the Average Consumer’ (2020) 69(10) *GRUR International* 1008.

Corp., 287 F.2d 492 (2d Cir. 1961) case, which considers, among other factors, the strength of the mark, the proximity of the goods, and evidence of actual confusion.¹⁸ Consumer perception is an integral part of this analysis, particularly in evaluating how a typical buyer would respond in a marketplace setting.

Yet recent experimental studies suggest that existing survey methodologies fail to capture a crucial element: consumer uncertainty. Beebe, Sprigman and others demonstrate that most consumer surveys in trademark litigation do not assess the strength of the belief held by respondents, instead, they force binary answers - whether a person is confused or not - while ignoring how confidently that belief is held.¹⁹ This omission is problematic, as belief strength significantly influences consumer behavior and purchasing decisions.

As the authors show through controlled experiments with Teflon, Eveready, and Squirt survey formats, many consumers hold beliefs with low certainty, yet courts may treat those beliefs as fully formed and decisive. The scholars argue that survey evidence lacking belief strength should not be sufficient to meet the plaintiff's burden of proof, and that courts should tailor remedies based on how strongly mistaken beliefs are held.²⁰

Thus, consumer perception in trademark law is not a static legal standard but a complex intersection of behavioral economics, normative policy, and empirical evidence. It is vital that courts and administrative bodies move beyond abstract models of the average consumer and begin to integrate more nuanced, evidence-based tools to assess confusion. As Beebe et al. note, *"the consumer is the measure of all things in trademark law,"* but this measure must reflect the real contours of human psychology, not merely its legal projections.²¹

Taking into account the analysis conducted above, it can be concluded that the evaluation of trademark confusion cannot be meaningfully conducted without considering consumer perception, which serves as a critical benchmark in both administrative and judicial determinations. As affirmed by the CJEU in *Gut Springenheide*, and consistently applied in U.S. case law such as *Polaroid v. Polarad*, the notion of an "average consumer" allows for a structured and objective

¹⁸ *Polaroid Corp v Polarad Electronics Corp* 287 F.2d 492 (2d Cir 1961) <https://www.wipo.int/wipolex/en/text/581585 accessed 4 April 2025>.

¹⁹ Barton Beebe and others, 'Consumer Uncertainty in Trademark Law: An Experimental Investigation' (2023) 72 Emory Law Journal 489, 495–496.

²⁰ *ibid* 538–546 (Barton Beebe and others, 'Consumer Uncertainty in Trademark Law: An Experimental Investigation' (2023) 72 Emory Law Journal 489, 495–496)

²¹ Barton Beebe, 'Search and Persuasion in Trademark Law' (2005) 103 Michigan Law Review 2020, 2025. <https://repository.law.umich.edu/mlr/vol103/iss8/2/>

framework to assess the likelihood of confusion in various market contexts. Although inherently abstract, this standard ensures that courts account for varying degrees of attentiveness depending on the nature of goods or services. Ultimately, the integration of consumer perception and psychological aspect into legal analysis contributes to the fairness, consistency, and functionality of trademark law, aligning legal protection with real-world consumer behavior.

1.3 International Legal Framework (TRIPS, Paris Convention)

The globalization of trade has underscored the necessity of a coherent international framework for trademark protection, particularly in preventing consumer confusion and safeguarding the distinctiveness of commercial signs. The international legal regulation of trademark similarity is primarily grounded in two instruments: the Agreement on Trade-Related Aspects of Intellectual Property Rights (*hereinafter* – “TRIPS”) and the Paris Convention. Although both treaties provide for the protection of trademark rights and emphasize the prevention of consumer confusion, they notably refrain from prescribing any specific methodology for assessing similarity or likelihood of confusion.

Article 16.1 of TRIPS, administered by the World Trade Organization (*hereinafter* – “WTO”), grants trademark holders the exclusive right to prevent third parties from using identical or similar signs for identical or similar goods or services, if such use would result in a likelihood of confusion. It explicitly states:

“In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.”²²

This provision highlights the centrality of consumer perception in trademark law but stops short of detailing the parameters for assessing visual, phonetic, or conceptual similarity. Furthermore, Article 16.3 of TRIPS extends protection to well-known trademarks, including for dissimilar goods or services, if the use of a mark suggests a connection that could damage the legitimate interests of the right holder. This underscores the growing importance of reputation in contemporary trademark enforcement.

Scholars such as Dinwoodie and Janis argue that, while TRIPS sets minimum standards for member states, it also grants significant discretion in implementation. In their view, this flexibility, though designed to accommodate national legal diversity, may ultimately lead to doctrinal fragmentation and unpredictability in cross-border enforcement.²³

²² Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) (15 April 1994) art 16 https://www.wto.org/english/docs_e/legal_e/27-trips_04_e.htm accessed 4 April 2025.

²³ Graeme B Dinwoodie and Mark D Janis, *Trademarks and Unfair Competition: Law and Policy* (5th edn, Aspen Publishers 2021) 215–216.

Similarly, Article 6bis of the Paris Convention obliges member states to refuse or cancel the registration of a trademark that constitutes a reproduction, imitation, or translation of a well-known mark, if such use is likely to cause confusion. The provision states:

“The countries of the Union undertake... to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation... liable to create confusion.”²⁴

However, like TRIPS, the Paris Convention does not offer a detailed framework for evaluating trademark similarity or determining when confusion is likely. Instead, it delegates this task to domestic administrative and judicial bodies, resulting in divergent national practices.

The Convention Establishing the World Intellectual Property Organization (*hereinafter* - “WIPO”) further supports international cooperation in IP law by promoting the harmonization of national legislation and facilitating the development of multilateral agreements.²⁵ Nevertheless, WIPO’s role remains largely promotional and consultative, without binding enforcement authority over member states. As a result, true methodological harmonization remains aspirational rather than realized.

This discretion afforded to national authorities has led to varied approaches. For example, the European Union (*hereinafter* - “EU”) applies the global appreciation test, which considers visual, phonetic, and conceptual aspects of marks as perceived by the average consumer. In contrast, the United States (*hereinafter* - “U.S.”) utilizes a multifactor test, developed in *Polaroid Corp v Polarad Electronics*, which takes into account the strength of the mark, proximity of the goods, channels of trade, and evidence of actual confusion.²⁶

Legal scholars, including Beebe, have expressed concern that such variations in national doctrine undermine predictability and consistency in international trademark enforcement. He notes that while treaties like TRIPS and the Paris Convention provide shared goals, the lack of unified criteria contributes to uncertainty, especially for multinational businesses navigating multiple legal systems.²⁷

In conclusion, TRIPS and the Paris Convention reflect a clear international commitment to protecting trademark distinctiveness and preventing consumer confusion. However, their deliberate silence on methodological specifics allows member states to develop divergent standards based on domestic traditions and policy goals. While such

²⁴ Paris Convention for the Protection of Industrial Property (1883, last revised 1967) art 6bis <https://www.wipo.int/wipolex/en/text/288514> accessed 2 April 2025.

²⁵ Convention Establishing the World Intellectual Property Organization (Stockholm, 1967, amended 1979) art 4, in MIPLC Statute Book 2020, 5.

²⁶ *Polaroid Corp v Polarad Electronics Corp* 287 F.2d 492 (2d Cir 1961).

²⁷ Barton Beebe, ‘Search and Persuasion in Trademark Law’ (2005) 103 Michigan Law Review 2020, 2025. <https://repository.law.umich.edu/mlr/vol103/iss8/2/>

flexibility may respect legal sovereignty, it risks undermining the uniformity and reliability of trademark protection in an increasingly interconnected global market.

In light of the foregoing, it is clear that while the TRIPS and the Paris Convention lay down fundamental principles for trademark protection, they stop short of providing a unified methodological framework for assessing similarity and likelihood of confusion. This gap necessitates the development of supplementary guidelines or best practices to enhance predictability and fairness in global trademark law. Such measures would aid in harmonizing national approaches, thereby strengthening the international trademark protection system.

The conceptual and legal underpinnings of trademark similarity constitute the cornerstone for assessing the likelihood of confusion, which in turn plays a pivotal role in both the registration and enforcement of trademark rights. The notion of similarity, though deceptively simple in its linguistic sense, acquires a multifaceted and legally significant dimension within trademark law, encompassing visual, phonetic, and conceptual components. These dimensions are evaluated through the lens of consumer perception an interpretive standard that seeks to reflect real market behavior and cognitive responses.

As established in the jurisprudence of the CJEU and reaffirmed by numerous national legal systems, the “average consumer” standard is instrumental in operationalizing this evaluation. The recognition of the average consumer as reasonably well-informed and observant allows for a structured approach that tempers subjectivity, though it does not eliminate it entirely. In the United States, a more empirical and context-sensitive methodology has emerged, with judicial discretion and multifactorial analysis providing flexibility at the expense of uniformity.

On the international level, instruments such as the TRIPS Agreement and the Paris Convention offer foundational norms but stop short of prescribing specific evaluation methodologies. Article 16(1) of TRIPS, for example, implies the importance of consumer confusion and presumes its existence in cases of identity, but it leaves substantial interpretive discretion to national authorities.

Likewise, Article 6bis of the Paris Convention protects well-known marks but does not articulate a detailed framework for the assessment of similarity. This normative openness allows legal systems to tailor the concept of similarity to their own doctrinal traditions, but it also introduces risks of inconsistency.

Critically, the chapter has demonstrated that the absence of universally binding criteria results in a spectrum of interpretive and procedural divergence. While this may reflect the pluralistic nature of international IP law, it complicates efforts toward global harmonization and creates significant uncertainty for rightsholders operating across multiple

jurisdictions. Recent judicial research proposes that clearer standards for deciding trademark confusion claims, especially those emphasizing the consumer's actual experience in the marketplace, could significantly reduce fragmentation.²⁸

Accordingly, the legal and theoretical reflections presented in this chapter establish a foundation for the subsequent analysis of Kazakhstan's national framework. In particular, they underscore the importance of aligning domestic practice with international norms while also tailoring doctrinal tools to local enforcement realities. As will be further explored in Chapter 2, the fragmentation observed at the global level is mirrored in Kazakhstan's dual institutional approach, reinforcing the urgency of systematic reform and the adoption of coherent, consumer-focused methodologies.

²⁸ A Holtzman, 'A Proposal on Deciding Trademark Infringement Claims to Limit Confusion for Consumers' (2025) 24(2) UIC Review of Intellectual Property Law 124.

CHAPTER 2: THE LEGAL REGULATION AND PRACTICAL ASSESMENT OF TRADEMARK SIMILARITY IN KAZAKHSTAN

2.1 Legal Provisions Governing Similarity of Trademarks in Kazakhstan

The legal regulation of trademark similarity in Kazakhstan is embedded within a broader national effort to modernize the intellectual property framework and align it with international standards. Baimoldina and Kaudyrov in the Textbook on Intellectual Property Law note that since the early 2000s, intellectual property protection has been identified as a national strategic priority, repeatedly emphasized in presidential addresses and national development programs.²⁹

The legal foundation for regulating the similarity of trademarks is rooted in the Civil Code of the Republic of Kazakhstan, the Law of the Republic of Kazakhstan “On Trademarks, Service Marks, Geographical Indications and Appellations of Origin” (*hereinafter* - “the Law “On Trademarks”) and supported by by-laws and procedural acts governing registration and examination. The Civil Code defines exclusive rights and the conditions under which such rights may be infringed, implicitly recognizing confusion as a form of violation of trademark rights.³⁰ The specialized trademark law further clarifies this issue. Article 6 of the Law “On Trademarks” establishes that legal protection shall not be granted to a trademark if it is *confusingly similar* to an earlier registered mark in relation to identical or similar goods or services.³¹

Although the statutory wording provides a general basis, the criteria for evaluating similarity - visual, phonetic, and conceptual — are not codified in primary legislation. These elements are instead operationalized through regulations of the NIIP, particularly the *Rules for Conducting Trademark Examination*.

Further detail is provided in the *Methodology for Judicial Expert Evaluation of Identity or Similarity of Trademarks to the Extent of Confusion* (*hereinafter* - “*Methodology for Judicial Expert Evaluation*”), developed by the Center for Forensic Expertise under the Ministry of Justice. This Methodology for Judicial Expert Evaluation instructs experts to assess visual, phonetic, and semantic similarity, the strength and distinctiveness of the earlier mark, and market context including the type of consumer and the degree of attention.

However, significant inconsistencies persist between the practices of NIIP, courts, and expert evaluations. NIIP’s examination procedure

²⁹ ZH Baimoldina and TE Kaudyrov (eds), *Pravo intellektualnoy sobstvennosti Respubliki Kazakhstan* (Institute of Legislation of the Republic of Kazakhstan 2013).

³⁰ Civil Code of the Republic of Kazakhstan (Part 1) art 1026.

³¹ Law of the Republic of Kazakhstan No. 456-І of 26 July 1999, art 6.

follows a checklist-style analysis of trademark components, while forensic evaluations are based on detailed qualitative assessments. The lack of a single binding methodology leads to divergent conclusions, particularly when courts are not legally bound to follow either NIIP findings or expert opinions.

The Supreme Court of Kazakhstan has not yet issued a normative resolution clarifying how the likelihood of confusion or similarity should be assessed, and current judicial practice reflects considerable variation.³² The automatic distribution of cases under the TØRELİK information system³³ further exacerbates the issue, as IP disputes are not necessarily assigned to specialized judges.

From an international law perspective, Kazakhstan is a party to the TRIPS, which sets general standards for the protection of trademarks, including the obligation to refuse or cancel registration in case of confusing similarity.³⁴ Moreover, the country ratified the *Agreement on Unified Principles for the Protection of IP Rights* in 2011³⁵ committing to regional harmonization. Nonetheless, the domestic application of these principles remains underdeveloped.

Thus, while Kazakhstan's legal framework formally addresses the issue of trademark similarity, in practice it suffers from fragmentation and uncertainty. The absence of a unified, binding methodology - either by law or judicial resolution - creates unpredictability for applicants and trademark owners, limiting the effectiveness of IP protection. A potential remedy lies in the development of a national standard or a Supreme Court resolution that could provide consistency and guidance in the evaluation of similarity.

Based on the discussion presented, it appears that the current legal and procedural regime for determining trademark similarity in Kazakhstan reveals a significant gap between formal legislative provisions and practical enforcement mechanisms. While the foundational framework, as outlined in the Civil Code and the Law “On Trademarks,” provides a basic prohibition against the registration of confusingly similar signs, the absence of codified evaluative criteria and a harmonized methodology has resulted in interpretive fragmentation across administrative and judicial bodies.

The dual-track system involving NIIP and the CFE further complicates legal certainty. Whereas NIIP applies a checklist-style

³² Recommendations of the Supreme Court of Kazakhstan on the Consideration of IP Disputes, 2020.

³³ ‘Informatsionnye tekhnologii, vnedrennye v sudebnuyu sistemu’ (Infozakon.kz, 6 February 2024) <https://infozakon.kz/sud/20731-informatsionnye-tehnologii-vnedrennye-v-sudebnuyu-sistemu.html> accessed 10 March 2025.

³⁴ Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) (15 April 1994) art 16 https://www.wto.org/english/docs_e/legal_e/27-trips_04_e.htm accessed 4 April 2025.

³⁵ Law of the Republic of Kazakhstan No 448-IV of 30 June 2011 ‘On Ratification of the Agreement on Unified Principles of Regulation in the Sphere of Intellectual Property Rights Protection’ <https://adilet.zan.kz/rus/docs/Z1100000448> accessed 4 April 2025.

examination based on internal rules, CFE operates under a more contextual methodology that integrates consumer perception and market dynamics. However, without a binding legal hierarchy or unifying standard, the divergence between these institutions produces inconsistent and sometimes contradictory outcomes. This is particularly problematic in litigation, where courts remain free to assign differing weights to NIIP and CFE conclusions, often without reference to a single authoritative test.

To address these deficiencies, it is recommended that Kazakhstan adopt a unified national methodology, either through a judicial resolution or legislative reform, which clearly outlines the evaluative criteria for determining trademark similarity. Such a standard should synthesize the formal criteria used by NIIP with the context-sensitive approach developed by CFE, while aligning with international best practices that emphasize consumer perception and market realities. Establishing this coherence is essential to fostering legal certainty, ensuring fair competition, and enhancing the overall credibility of Kazakhstan's intellectual property system

2.2 Institutional Roles: NIIP and the Center for Forensic Expertise

In the Republic of Kazakhstan, NIIP plays a central role in the administration of industrial property rights. As the designated authority for examining trademark applications, NIIP is responsible for conducting both preliminary and substantive examinations of national and international trademarks, issuing protective documents or refusals accordingly, as defined in the *Rules for Conducting the Examination of Applications for Registration of Trademarks*.

For national trademarks, NIIP conducts a two-stage examination: a preliminary examination within one month from the filing date and a substantive examination within seven months. In response to applicant demands for efficiency, an accelerated examination procedure was introduced in 2024, reducing the total timeline to three months. NIIP also functions as the competent authority for international trademark registration under the Madrid System, facilitating centralized applications to over 130 jurisdictions through the WIPO.³⁶

Despite these administrative capacities, NIIP's methodology remains largely formalistic, focusing on visual, phonetic, and semantic comparisons, without deeper consideration of market conditions or consumer perception. Its decisions, although authoritative at the registration stage, are not binding in judicial proceedings. As noted by

³⁶ World Intellectual Property Organization (WIPO), *Madrid System*. Available at: <https://www.wipo.int/en/web/madrid-system> (Accessed: 3 April 2025).

Kaudyrov, this approach fosters formalistic and often superficial analysis, which does not always reflect the actual risk of confusion in the marketplace.³⁷

This methodological divergence has resulted in substantive inconsistencies in legal practice. For example, in the 2024 Doctoral dissertation of Ms. Seitova notes that trademarks approved and registered by NIIP were later challenged in court, with forensic experts concluding that the marks were confusingly similar.³⁸ Conversely, trademarks denied by NIIP have sometimes been upheld by court-appointed experts as dissimilar. This inconsistency in reasoning has led to unpredictability in outcomes even in cases with nearly identical factual matrices.

A particularly illustrative case is discussed in the Practical Guide on Intellectual Property Disputes issued by the Supreme Court of Kazakhstan, where a dispute arose between the trademarks “NEXT” and “NESTEA.” In this case, the court of first instance limited its assessment solely to visual differences between the signs, neglecting phonetic and conceptual analysis altogether. The appellate court subsequently overturned this decision, emphasizing the necessity of applying a comprehensive and multi-faceted approach to trademark comparison in accordance with established principles of likelihood of confusion.³⁹

Legal scholars and honored experts in intellectual property system of Kazakhstan such as Kaudyrov emphasize that the criteria for determining similarity remain inherently subjective in practice, and the absence of a uniform methodology leaves excessive discretion to both administrative bodies and forensic experts. According to Kaudyrov, “in reality, the evaluation of similarity heavily depends on the personal interpretation of the decision-maker, which creates inconsistency and undermines legal predictability.”⁴⁰

Further complexity arises from the uneven qualifications of forensic experts involved in IP disputes. As noted in the Supreme Court’s 2020 practical guide, regional disparities in expert competence contribute to variability in judicial reasoning and assessment of expert opinions.⁴¹

³⁷ Supreme Court of the Republic of Kazakhstan, Practical Guide on Intellectual Property Disputes: Judicial Library Series (2011) 59

³⁸ A.N. Seitova, *Legal Regulation of the Protection and Enforcement of Trademarks in the Republic of Kazakhstan: Issues of Theory and Practice* (PhD dissertation, Adilet Higher School of Law, Caspian Public University 2024) https://farabi.university/storage/files/18795923396656b5c876eee085186100_%D0%94%D0%B8%D1%81%D1%81%D0%B5%D1%80%D1%82%D0%B0%D1%86%D0%B8%D1%8F%20%D0%A1%D0%B5%D0%B8%D1%82%D0%BE%D0%B2%D0%B0%20%D0%90%D0%9D.pdf. (accessed on March 23, 2025)

³⁹ Supreme Court of the Republic of Kazakhstan, Practical Guide on Intellectual Property Disputes: Judicial Library Series (2011) 61

⁴⁰ Kaudyrov T. E. Civil protection of industrial property objects: Monograph. – Almaty: Zheti Zhargy, 2001. – 448 p. P. 14.

⁴¹ Supreme Court of the Republic of Kazakhstan and ABA ROLI, Manual on Drafting Judicial Decisions in IP Disputes (2020)

The trademark expert's community of Kazakhstan, including such well-known specialists in Kazakhstan as Abitbekova, has raised concerns over the dual-track methodology employed by NIIP and the CFE. At the joint event of WIPO and Ministry of Justice of the Republic of Kazakhstan on November 3, 2023 regarding questions of likelihood of confusion on trademarks and judicial review, Ms. Abitbekova highlighted that NIIP and CFE apply divergent analytical criteria: while NIIP emphasizes the 'overall impression' of the sign, CFE experts assess 'dominant elements' and often exclude holistic analysis, resulting in contradictory expert reports in the same case.⁴²

Given the above, it is recommended that Kazakhstan adopt a unified national methodology for determining trademark similarity. Such a framework should incorporate international best practices, clarify the relationship between administrative and forensic assessments, and be reinforced by a normative resolution from the Supreme Court of Kazakhstan. This would enhance legal certainty, foster consistency, and strengthen the credibility of Kazakhstan's intellectual property regime.

Accordingly, the foregoing examination indicates that the current bifurcation in Kazakhstan's trademark similarity assessment - split between the formal administrative procedure of NIIP and the more contextual analysis employed by the CFE - demonstrates a critical structural deficiency in the national system of IP protection. While each institution contributes distinct strengths, the absence of an integrated or hierarchical methodology has resulted in inconsistent legal outcomes, judicial unpredictability, and diminished trust in expert evaluations. Observations from case law and expert commentary consistently point to systemic fragmentation, with divergent interpretations even in factually similar disputes. Without a binding resolution from the Supreme Court or legislative clarification of methodological standards, these discrepancies are likely to persist. A harmonized national framework that draws from both administrative efficiency and forensic depth, aligned with international best practices, would not only improve the quality of trademark adjudication but also serve the broader goal of enhancing legal certainty and protecting market participants in Kazakhstan's evolving intellectual property landscape.

2.3 Divergence of Methodologies: NIIP, Courts and Experts

In the broader context of Kazakhstan's effort to modernize its intellectual property system and harmonize national practices with international standards, the judicial assessment of trademark similarity occupies a particularly critical space. While legislative instruments and administrative regulations provide a formal framework for evaluating the

⁴² Abitbekova A.S., Presentation on Trademark Disputes: Issues of Methodology (2023) presented at the Joint event in Astana, 2023.

likelihood of confusion between trademarks, judicial decisions remain the most visible reflection of how these standards are interpreted and applied in practice.

The absence of a binding methodology or interpretive resolution from the Supreme Court of the Republic of Kazakhstan has led to noticeable fragmentation between administrative bodies such as the NIIP and expert institutions CFE. This has given rise to divergent approaches, particularly in cases where courts are asked to assess or overturn administrative decisions relating to the registration or opposition of trademarks.

Within this evolving legal landscape, several landmark cases demonstrate both the strengths and gaps of the national trademark system. These cases highlight the Kazakh judiciary's gradual shift away from formalistic assessment and toward more consumer-centric and contextual evaluations of trademark similarity. Notably, courts have begun to prioritize dominant element analysis, phonetic proximity, semantic overlap, and average consumer perception reflecting broader trends in international trademark jurisprudence.

This section of the dissertation critically examines two illustrative decisions: HUGO BOSS AG v Babyboss, and Shchedroe Leto v Shchedroe Pole, both of which offer valuable insights into how Kazakhstani courts and administrative bodies interpret and apply the concept of trademark similarity. These cases were selected for analysis due to their doctrinal richness, relevance to international standards, and capacity to reflect both progress and persisting inconsistencies within Kazakhstan's legal framework.

Through detailed examination of judicial reasoning, procedural history, and expert opinions presented in these cases, this section aims to identify prevailing doctrinal tendencies and evaluate the practical implementation of the "overall impression" methodology in Kazakhstan. The analysis also draws connections to international case law and scholarly perspectives, demonstrating how domestic practice aligns or diverge from global approaches such as the European Union's "global appreciation" standard and the United States' multifactorial test under the Polaroid doctrine.

HUGO BOSS v Babyboss

BOSS
HUGO BOSS

v.



The case *HUGO BOSS AG v Ministry of Justice of the Republic of Kazakhstan and Durymbetova F.Zh.*⁴³ concerns the dispute over the registration of the trademark “Babyboss,” which the applicant sought to register under Certificate No. 70545 for goods in Class 25 of the Nice Classification. The German company HUGO BOSS AG filed an opposition against the decision of the Appeal Board of the Ministry of Justice of the Republic of Kazakhstan, which had previously dismissed HUGO BOSS’s objection to the trademark application.

In the Astana City Court’s decision dated 5 February 2024 (Civil Case No. 2-12352/2023), the court upheld the position of the plaintiff, HUGO BOSS AG, and annulled the earlier decision of the Appeal Board, stating that the mark “Babyboss” is indeed confusingly similar to the well-known mark “BOSS” owned by the German company.

The court emphasized the importance of visual and phonetic similarities. As stated in the judgment:

“The word element ‘boss’ is the dominant and distinctive part of the disputed mark, and despite the addition of the prefix ‘baby’, the core element remains recognizable and likely to create confusion in the perception of consumers, especially when used in relation to the same class of goods (clothing)” (p. 5, Court Decision).

The court also referred to the notion of semantic proximity between the two marks, concluding that the overall impression of the word “Babyboss” is closely associated with “BOSS,” thereby infringing upon the exclusive rights of the senior mark holder. Conversely, the position of NIIP was based on the argument that “Babyboss” constitutes a single, indivisible word, and thus cannot be separated into two distinct elements, “BABY” and “BOSS.”

Importantly, the court rejected the argument made by the Appeal Board that the addition of “baby” sufficiently distinguishes the marks. Instead, the court noted:

“Consumers tend to focus on the element that is most distinctive and familiar. The presence of ‘boss’ in both marks contributes to a high likelihood of confusion, particularly for consumers who are not engaging in detailed analysis during the purchasing process” (p. 6, Court Decision).

The judgment reflects a shift from a formalistic assessment to one grounded in consumer perception and the holistic impression of the trademark. This aligns with foreign approaches such as the EU’s *global appreciation* standard and the U.S. *Polaroid* multifactor test.

⁴³ RESOLUTION of the Judicial Collegium for Administrative Cases of Astana City No. 7199-24-00-4a/1421 dated December 26, 2024.

From an analytical standpoint, this case illustrates several critical issues in Kazakhstan's trademark dispute resolution practice:

1. **Recognition of Dominant Elements:** The court correctly identified that the component “boss” dominates the visual and phonetic identity of both marks, overriding any differentiating prefix.
2. **Consumer Perception Focus:** The court placed appropriate weight on how the average consumer would perceive the mark in practice, moving away from a purely mechanical comparison of word elements.
3. **Deviation from Administrative Assessment:** Notably, the court's conclusion contradicted the findings of the Appeal Board, highlighting the lack of a unified methodology and reinforcing the broader theme of institutional fragmentation, as discussed in Chapter 3.2 of this dissertation.

This decision sets an important precedent in favor of a *consumer-centric* and *contextual* approach in trademark confusion cases. It underscores the necessity for the Supreme Court of Kazakhstan to issue a normative resolution establishing a unified methodology for assessing similarity, particularly to bridge gaps between administrative and judicial interpretations.

The *HUGO BOSS v Babyboss* case provides a vivid example of the importance of dominant element analysis and reinforces the relevance of international doctrinal approaches in Kazakhstani judicial practice. It highlights both the strengths and current gaps in the domestic system, particularly the absence of binding interpretive guidance and the inconsistent application of trademark confusion criteria.

***Shchedroe Leto v Shchedroe Pole* (In Eng. *Generous Summer v Generous Field*)**



The trademark dispute between *Shchedroe Leto* (“Generous Summer”) and *Shchedroe Pole* (“Generous Field”) presents a compelling example of Kazakhstan’s evolving standards in the assessment of likelihood of confusion, particularly in relation to composite marks containing partially overlapping descriptive components.⁴⁴

The trademark *Shchedroe Pole* was registered to LLP “GLOBAL RETAIL” under Certificate No. 89037, dated 23 January 2024, for

⁴⁴ Case No. 7194-21-3-1-1/1592 dated February 17, 2025 Astana

margarine and related products in Class 29. The registration was challenged by JSC “Zhirovoy Kombinat” - the rights holder of the earlier mark *Shchedroe Leto*, alleging confusing similarity.

The opposition was reviewed by NIIP which rejected the claims on the basis that the marks do not meet the legal threshold for confusion. The NIIP referred to the official Rules for Conducting the Examination of NIIP.

From a visual and phonetic perspective, both marks consist of two words and share the initial adjective “*Shchedroe*” (“Generous”). However, the second elements - “*Leto*” (“Summer”) and “*Pole*” (“Field”) - differ semantically and phonetically. As stated in the NIIP’s expert response (Expert conclusion of NIIP), this divergence results in distinct overall impressions, and thus, the marks are not confusingly similar.

This conclusion was supported by an independent trademark assessment issued by “ASTANAPATENT,” which further emphasized the semantic distinction between a season and a geographical/landscape feature. While both terms carry positive connotations in a food-related context, they evoke different associations for the average Kazakhstani consumer - one being temporal (*Leto*, or summer), the other spatial (*Pole*, or field).

Phonetically, although the rhythm of the phrases is comparable, the ending syllables (-*leto* vs. -*pole*) diverge in vowel articulation and stress patterns, reducing the risk of oral confusion. The conclusion also notes that both *Leto* and *Pole* are commonly used descriptive terms, weakening their distinctiveness as independent identifiers.

Importantly, the NIIP reaffirmed its commitment to the “overall impression” methodology - a non-numerical, holistic assessment model which avoids applying any fixed percentage of similarity. This methodology contrasts sharply with the forensic standard used by the CFE, which calculated similarity in percentage terms.

The *Shchedroe Leto v Shchedroe Pole* case aligns with principles expressed in EUIPO doctrine regarding shared weak or descriptive elements. An interesting observation is that according to the EUIPO’s publication *Overlap in a Weak or Non-Distinctive Element*,⁴⁵ when the dominant or distinctive elements differ significantly, even shared descriptive words do not automatically render marks confusingly similar.

Examination system, as applied by NIIP, similarly emphasizes that the presence of a common but descriptive element (*Shchedroe*) does not suffice to generate confusion in the absence of other aligning dominant components. This interpretation is doctrinally consistent with decisions by

⁴⁵ EUIPO, ‘Overlap in a Weak or Non-Distinctive Element’ (2023), p. 4

the CJEU, such as *Lloyd Schuhfabrik Meyer v Klijsen Handel* (C-342/97),⁴⁶ and with the United States' emphasis on consumer sophistication and context under the *Polaroid* framework.

However, the case also underlines a structural challenge in Kazakhstan's trademark system: the lack of a binding national methodology that could unify the practices of administrative bodies like NIIP with judicial expertise from the CFE. Without such guidance, courts and experts may continue to diverge in their reasoning, even when examining marks with similar factual contexts.

This case illustrates the practical application of Kazakhstan's "overall impression" methodology in determining trademark similarity. By refusing to view shared descriptive terms as sufficient grounds for opposition, and emphasizing semantic divergence and consumer perception, the NIIP has followed a path consistent with international trademark standards.

Nonetheless, the need remains for greater methodological harmonization across institutions, particularly between administrative and forensic bodies. The findings in *Shchedroe Leto v Shchedroe Pole* support the continued development of a unified national approach - an objective directly aligned with the goals of Kazakhstan's IP modernization strategy.

Zhana Gradus v Gradus°



v,



The divergence in trademark similarity assessment in Kazakhstan is further illustrated by the case involving the signs *Zhana Gradus* and *Gradus°*. In this matter, the applicant - IE "Germes" - filed for the registration of a combined trademark "Zhana Gradus" under application No. 83694, covering goods and services in Classes 32, 33, and 35 of the Nice Classification. The application was initially refused on the basis of likelihood of confusion with earlier marks, including the national registration No. 64442 for "Gradus°", held by IE "Lumax" in respect of Class 43 (food and beverage services).

A forensic expert examination, conducted in accordance with the 2010 Methodology of the CFE, concluded that the signs were 92.83%

⁴⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [1999] ECR I-3819 (CJEU)

similar across phonetic, semantic, and visual dimensions.⁴⁷ According to the methodology, such a level of similarity indicates a likelihood of confusion. The dominant element “Gradus” appeared in both signs and was found to carry identical meaning - referring to units of temperature or alcohol content. The word “Zhana” (meaning “new”) was perceived as a descriptive prefix and did not eliminate the core semantic and phonetic identity formed by “Gradus.”

In contrast, the administrative body (NIIP) reached the opposite conclusion, affirming that the overall impression of the two signs differed due to variations in color scheme, composition, and stylization. NIIP emphasized that the applicant's sign included one letter rendered graphically, used a different font, and was placed on a contrasting background, which significantly altered its perception by consumers.⁴⁸ Relying on Rule 31 of the Trademark Examination Rules, NIIP held that these differences prevented the formation of a similar overall impression.

This case exemplifies the ongoing methodological conflict between the quantitative expert-based approach – which relies on mechanical percentage thresholds – and the qualitative administrative model, which favors a consumer-oriented and context-sensitive assessment. While the expert report found the signs confusingly similar based on cumulative similarity indicators, NIIP's analysis, grounded in market perception and visual differentiation, led to a finding of dissimilarity.

The *Zhana Gradus* case underscores the absence of a harmonized framework for trademark similarity in Kazakhstan. It demonstrates the need for a unified national methodology that would reconcile the procedural rigor of expert analysis with the flexible, perception-based examination adopted by NIIP. Without such alignment, courts will continue to navigate inconsistencies between institutional conclusions, leading to unpredictability and reduced legal certainty for trademark holders.

Espumisan v Esmizan-ODS

ЭСПУМИЗАН

ЭСМИЗАН-ODS

v.

Case concerns a trademark dispute between *Berlin-Chemie AG*, the owner of the well-known pharmaceutical mark *Espumisan*, and *VISTA*

⁴⁷ CONCLUSION OF SPECIALISTS No. 54/2023 dated July 31, 2023 Chistousova Olga Sergeevna and Syrymbetova Akmaral Bakytzhanovna Almaty

⁴⁸ Response of the NIIP to the administrative claim to cancel the decision of the appeal board

PHYTOLAB Inc. (Canada),⁴⁹ regarding the registration of the combined trademark Esmizan-ODS under Certificate No. 73404 in Class 5 of the Nice Classification. Berlin-Chemie opposed the registration before the Appeal Board of the Ministry of Justice of Kazakhstan, arguing that the marks were confusingly similar. The Appeal Board, however, rejected the opposition on 24 April 2023 (Decision No. 20/2023), triggering administrative litigation.

The case subsequently proceeded through all three levels of judicial review, reflecting Kazakhstan's multi-instance system. Initially, the Specialized Interdistrict Administrative Court of Astana ruled in favor of Berlin-Chemie AG, holding that Esmizan-ODS was confusingly similar to Espumisan, particularly due to phonetic and visual resemblance and the descriptive nature of the element "ODS", which merely referred to the pharmaceutical form "orally disintegrating strips."

However, the Appellate Court overturned the decision, following the results of a comprehensive forensic examination conducted by the East Kazakhstan Branch of the Center for Forensic Expertise (CFE). According to expert conclusion No. B-70 (dated 19 February 2024) and the follow-up report No. 559 (dated 20 March 2025), the signs Esmizan-ODS and Espumisan were not confusingly similar, and the goods were not homogeneous, except for products containing the active ingredient simethicone.

The experts emphasized:

- The lack of semantic or graphic similarity between the signs;
- The distinct pronunciation and structure of the marks;
- The difference in pharmaceutical form and method of application (Esmizan-ODS is an orally dissolving film, while Espumisan is a tablet);
- The target audience's heightened level of attention, typical for pharmaceutical purchases in pharmacies.

Moreover, the element "ODS" was found to be dominant, occupying over 20% of the visual space of the sign, and graphically separated from the core word. Experts also stated that the comparative analysis performed by Berlin-Chemie relied on linguistic conclusions provided by non-certified experts, which were disregarded by the appellate court due to procedural non-compliance.

The Supreme Court of Kazakhstan eventually annulled the initial appellate ruling, citing insufficient clarity in the expert conclusion, and remanded the case for a new hearing. However, the second appellate decision reaffirmed the original position, again rejecting Berlin-Chemie's claim. It concluded that the likelihood of confusion was absent, particularly

⁴⁹ Decision of the Specialized Interdistrict Administrative Court of Astana No. 7194-23-00-4/2402 dated October 5, 2023

when judged from the standpoint of the average consumer with a high degree of attentiveness in the pharmaceutical sector.

The four analyzed cases - *HUGO BOSS v Babyboss*, *Shchedroe Leto v Shchedroe Pole*, *Zhana Gradus v Gradus*°, and *Espumisan v Esmizan-ODS* - collectively reveal the inconsistent and fragmented nature of Kazakhstan's trademark similarity assessment system. Each case highlights different doctrinal tendencies and institutional approaches, ranging from formalist analysis to consumer-focused contextual evaluation.

In *HUGO BOSS v Babyboss*, the court adopted a progressive methodology grounded in dominant element analysis and consumer perception, departing from the administrative body's conclusion. In *Shchedroe Leto v Shchedroe Pole*, NIIP applied the "overall impression" standard in line with EU practice, emphasizing semantic distinctions and descriptive weakness. Conversely, *Zhana Gradus v Gradus*° demonstrated the disconnect between the quantitative, percentage-based forensic evaluation and NIIP's qualitative assessment, exposing structural contradictions. Lastly, *Espumisan v Esmizan-ODS* illustrated how courts increasingly rely on state-certified expert testimony and market context - especially in sectors like pharmaceuticals - while dismissing linguistically sound but procedurally informal evidence.

Collectively, these cases illustrate that courts, NIIP, and forensic experts apply divergent standards without reference to a unifying interpretive framework. This divergence results in legal uncertainty, unpredictability in outcomes, and reduced public confidence in the effectiveness of trademark protection. The inconsistency is exacerbated in factually similar cases, where conflicting conclusions emerge due to the absence of hierarchical or harmonized guidelines.

The findings reinforce the urgent need for Kazakhstan to adopt a unified national methodology that defines the legal criteria for trademark similarity, aligns administrative and judicial reasoning, and integrates both formal components and consumer perception. This should be supported by a binding Supreme Court resolution and institutional capacity-building among experts and judges.

Case	Approach by NIIP	Approach by CFE / Forensic Experts	Approach by Courts	Key Observations
HUGO BOSS v Babyboss	Formal checklist, no sufficient differentiation recognized (Appeals Board dismissed claim, Court later reversed).	Not explicitly detailed; court emphasized dominance of 'boss'.	Focused on dominant element ('boss') and consumer perception; found likelihood of confusion.	Court shifted from formalism to consumer-centric dominant element analysis.
Shchedroe Leto v Shchedroe Pole	Overall impression; semantic difference recognized between 'Summer' and 'Field'; no confusion found.	No separate forensic expertise mentioned; NIIP's decision primary.	Supported NIIP's decision, emphasizing semantic divergence and overall impression.	Semantic divergence given critical importance; descriptive elements evaluated carefully.
Zhana Gradus v Gradus°	Found overall visual differences (composition, stylization) to outweigh similarities; no confusion.	92.83% similarity by percentage calculation; strong emphasis on phonetic and semantic identity ('Gradus').	Divergence between expert report (confusion) and administrative findings; courts inclined to accept NIIP's market-based view.	Strong divergence between quantitative (CFE) and qualitative (NIIP) approaches; unresolved conflict.
Espumisan v Esmizan-ODS	Initial administrative decision: similarity rejected; based on semantic and phonetic differences, and consumer attentiveness in pharmaceuticals.	Expert conclusion found no confusion, emphasizing differences in form, pronunciation, and consumer attentiveness.	Initially recognized confusion but appellate court overturned based on expert report citing no confusion due to pharmaceutical context.	Sector-specific consumer attention (pharma products) influenced confusion analysis.

Table 1. Comparative analysis of cases in Kazakhstan

The analysis reveals that Kazakhstan currently lacks a unified and transparent approach to assessing the likelihood of confusion between trademarks. Although the legal framework formally addresses trademark protection, practical application remains fragmented.

- The NIIP applies a formalized checklist methodology based on internal rules and the “overall impression” standard, while forensic experts rely on a percentage-based technical analysis developed under the 2010 Methodology.
- Courts often fluctuate between these different approaches, exercising wide discretion depending on the circumstances of each case, leading to inconsistency and unpredictability in judicial outcomes.
- This divergence creates *significant legal uncertainty* and a lack of procedural transparency for applicants and trademark holders, undermining confidence in the trademark protection system and weakening the principle of legal predictability.
- It is therefore reasonable and timely to propose the adoption of a normative resolution by the Supreme Court of the Republic of Kazakhstan, which would establish a clear judicial standard for assessing trademark similarity. Such a normative act would harmonize the methodologies used by administrative authorities, forensic experts, and courts, while affirming the judiciary’s independent role in evaluating cases based on legal judgment rather than technical expertise alone.
- Strengthening cooperation with the WIPO, particularly through participation in judicial trainings and workshops on IP adjudication, would also enhance judicial expertise and capacity in Kazakhstan.⁵⁰
- In the long term, Kazakhstan should consider establishing a specialized judicial panel or chamber for intellectual property cases, similar to the model implemented in the Republic of Belarus,⁵¹ to address the increasing complexity and number of IP disputes.

Overall, Chapter 2 demonstrates the urgent need for convergence of institutional methodologies, reinforcement of judicial interpretive authority, and the development of specialized structures to ensure a consistent, predictable, and effective system for resolving trademark similarity disputes in Kazakhstan.

⁵⁰ WIPO, ‘WIPO Judicial Institute’ (World Intellectual Property Organization) https://www.wipo.int/about-wipo/en/activities_by_unit/index.jsp?id=1022 accessed 10 April 2025.

⁵¹ National Center of Intellectual Property (NCIP), ‘Judicial Panel on Intellectual Property Cases of the Supreme Court of the Republic of Belarus’ (NCIP) <https://ncip.by/sistema-is/infrastruktura/sudebnaya-kollegiya-po-dela-m-intellektualnoy-sobstvennosti-verkhovnogo-suda-respubliki-belarus/> accessed 10 April 2025.

CHAPTER 3: COMPARATIVE ANALYSIS OF TRADEMARK CONFUSION ASSESMENT: INTERNATIONAL PERSPECTIVES

3.1 The European Union: The Global Appreciation Standard and the Role of Consumer

The legal framework governing the assessment of trademark confusion in the European Union is firmly grounded in a holistic approach known as the “global appreciation” test. Scholars have also argued that despite the holistic approach, the European methodology sometimes struggles with the operationalization of abstract consumer standards, particularly when empirical data is absent.⁵²

“Global appreciation” test was authoritatively articulated by the CJEU in *Sabel BV v Puma AG* (C-251/95), where the Court emphasized that the likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case, in particular, the interdependence between the similarity of the marks and that of the goods or services.⁵³ This approach is also codified in Regulation (EU) 2017/1001 on the European Union Trade Mark,⁵⁴ which lays down substantive rules for the refusal of trademark registration due to likelihood of confusion (Art. 8) and cancellation procedures (Art. 60). The accompanying Implementing Regulation (2017/1431)⁵⁵ and Delegated Regulation (2017/1430)⁵⁶ specify the procedural and technical criteria applied by the EUIPO in assessing the similarity of signs and goods or services.

The criteria applied in this context include the visual, phonetic, and conceptual similarities between the marks, the distinctiveness and reputation of the earlier mark, the nature of the goods or services, and the relevant public's level of attention. The role of the average consumer is central to this assessment. As established in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* (C-342/97), the average consumer is deemed to be reasonably well-informed, observant, and circumspect,

⁵² JB Swann, 'A History of the Evolution of Likelihood of Confusion Methodologies' (2023) 113 Trademark Reporter 723.

⁵³ *Sabel BV v Puma AG* [1997] ECR I-6191 (CJEU)

⁵⁴ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark [2017] OJ L154/1; Commission Implementing Regulation (EU) 2017/1431 of 18 May 2017 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 [2017] OJ L205/39; Commission Delegated Regulation (EU) 2017/1430 of 8 May 2017 supplementing Regulation (EU) 2017/1001 [2017] OJ L205/1.

⁵⁵ Commission Implementing Regulation (EU) 2017/1431 of 7 June 2017 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 207/2009 on the European Union trade mark [2017] OJ L205/39.

⁵⁶ Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96 [2017] OJ L205/1.

although the level of attention may vary depending on the product category.⁵⁷

The European Union Intellectual Property Office (*hereinafter* – “EUIPO”) further clarified the methodology in its Guidelines and case law presentations. According to Virginia Melgar, a senior examiner at EUIPO, the global appreciation involves assessing *whether the overall impression of the conflicting signs in the mind of the relevant public is sufficiently similar to give rise to confusion*. Importantly, this impression must be derived without dissection, as consumers generally perceive marks as a whole rather than by analyzing their individual components.⁵⁸

A key consideration in EUIPO practice is the notion of the ‘dominant element’ within composite marks. Where a non-distinctive or weak element is shared by both marks, the likelihood of confusion may be lower, provided that other components of the signs are sufficiently dissimilar. As noted in the EUIPO publication *Overlap in a Weak or Non-Distinctive Element*, marks sharing a common descriptive term or a weakly distinctive word may still be considered dissimilar overall if their distinctive and dominant elements differ substantially.⁵⁹

Despite the structured approach, challenges persist in ensuring consistency across cases. Critics have noted that the weighting of factors often lacks transparency, and even within EUIPO or the General Court, there have been instances of divergent outcomes in cases involving similar factual matrices. For example, the cases *Bainbridge* and *Picasso v Picasso* demonstrate the tension between visual similarity and conceptual dissimilarity and their respective roles in offsetting one another.⁶⁰

These doctrinal nuances underline the importance of maintaining a balance between formal legal criteria and consumer-centric analysis. EU case law consistently reflects a commitment to protecting both the public from confusion and the integrity of trademark rights, while also acknowledging that the threshold for confusion may vary depending on the distinctiveness and market exposure of the earlier mark.

Reflecting on the points discussed, it follows that the EU’s approach to determining trademark similarity is characterised by a structured yet flexible methodology rooted in the global appreciation standard. This framework incorporates visual, phonetic, and conceptual analysis, evaluated through the perspective of the average consumer. While

⁵⁷ Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999] ECR I-3819 (CJEU)

⁵⁸ Virginia Melgar, ‘Assessing likelihood of confusion: methodology’, presented at the Joint event in Astana, 2023.

⁵⁹ EUIPO, ‘Overlap in a Weak or Non-Distinctive Element’ (2023), p. 3

⁶⁰ T-185/02 *Bainbridge* [2004] ECR II-1733; Case C-361/04 P *Picasso v OHIM* [2006] ECR I-643

comprehensive, the absence of a clearly defined system for weighting individual factors, such as the dominance or distinctiveness of elements, introduces interpretive variability.

Doctrinal consistency is reinforced through EUIPO guidelines and CJEU jurisprudence, yet challenges remain in maintaining uniform application across similar factual scenarios. Divergent rulings - such as those found in the *Bainbridge* and *Picasso* cases - illustrate the inherent tensions between legal formalism and market realities, especially when balancing conceptual dissimilarity against visual similarity. Scholars have also argued that despite the holistic approach, the European methodology sometimes struggles with the operationalization of abstract consumer standards, particularly when empirical data is absent.⁶¹

In comparative legal analysis, the EU model stands as a mature example of balancing formal legal principles with behavioral economics. Its emphasis on holistic evaluation and consumer perception offers a relevant benchmark for jurisdictions seeking to improve their trademark assessment practices. For countries such as Kazakhstan, where fragmented methodologies persist and no unified standard governs similarity assessment, the European experience underscores the value of interpretive cohesion, judicial consistency, and consumer-centered analysis. Rafael García-Pérez observes, the continuous evolution and expansion of trade mark protection within the European Union has increased legal uncertainty, primarily due to the lack of conceptual precision and the proliferation of unwritten conditions introduced by CJEU jurisprudence.⁶² This illustrates the importance of ensuring methodological clarity and doctrinal consistency from the early stages of IP system development in emerging jurisdictions like Kazakhstan.

3.2 The United States: Multifactorial Judicial Analysis and Evidentiary Practice

The legal doctrine of likelihood of confusion in the United States is grounded in §32(1) of the *Lanham Act*, which prohibits the use of any mark that is “likely to cause confusion” with a previously registered mark. However, the Act does not articulate a precise methodology for assessing confusion, and courts have instead developed a multifactorial analytical framework, primarily through judicial precedent.⁶³

The most widely cited test originates from the Second Circuit’s decision in *Polaroid Corp v Polarad Electronics Corp*, where the court identified eight non-exhaustive factors to be considered: (1) the strength

⁶¹ JB Swann, ‘A History of the Evolution of Likelihood of Confusion Methodologies’ (2023) 113 Trademark Reporter 723.

⁶² Rafael García, ‘Assessing Trademark Similarity: Judicial Practice and Doctrinal Challenges’ (2023) 49(2) Journal of Intellectual Property Law 215.

⁶³ Lanham Act, 15 USC § 1114(1)

of the prior mark; (2) the degree of similarity between the marks; (3) the proximity of the products; (4) the likelihood that the prior user will bridge the gap; (5) actual confusion; (6) the defendant's good or bad faith; (7) the quality of the defendant's product; and (8) the sophistication of buyers.⁶⁴ In the MIPLC Statute Book,⁶⁵ factors were described as follows:

1. **The first factor**, the strength of the prior mark, assesses both its inherent distinctiveness (i.e., whether it is arbitrary, suggestive, descriptive, or generic) and its commercial strength based on market recognition. Strong marks - arbitrary or fanciful ones - receive broader protection, whereas descriptive or weak marks require proof of secondary meaning.

2. **The second factor**, the degree of similarity between the marks, evaluates the overall impression conveyed by the marks in terms of their visual appearance, sound, and conceptual meaning. Courts emphasize that marks should be assessed holistically rather than dissected into separate elements.

3. **The third factor**, the proximity of the products, examines whether the goods or services are related enough that consumers might assume a common source. The closer the competitive distance, the higher the likelihood of confusion.

4. **The fourth factor**, the likelihood that the senior user will bridge the gap, considers the possibility that the trademark owner might expand into the junior user's product market. If expansion seems probable, confusion becomes more likely.

5. **The fifth factor**, actual confusion, involves evidence that consumers have already been misled. Although not a prerequisite for a finding of infringement, actual confusion serves as compelling proof.

6. **The sixth factor**, the defendant's good or bad faith, analyzes whether the junior user intentionally adopted the mark to capitalize on the goodwill of the senior mark. Bad faith can heavily influence the finding of likelihood of confusion.

7. **The seventh factor**, the quality of the defendant's product, considers whether the junior user's product is inferior, thereby potentially harming the reputation of the senior mark through negative consumer associations.

8. **The eighth factor**, the sophistication of buyers, assesses the degree of care exercised by the relevant consumer group. Purchasers of expensive or highly specialized goods are deemed more discerning, reducing the likelihood of confusion.

Each factor is evaluated in light of the circumstances, with no single element being determinative. The strength of the prior mark refers to its distinctiveness and consumer recognition; the more distinctive the mark,

⁶⁴ *Polaroid Corp v Polarad Electronics Corp* 287 F.2d 492 (2d Cir 1961)

⁶⁵ MIPLC, Legal Materials on Intellectual Property and Competition Law, 2020

the greater its scope of protection. Similarity is assessed across visual, phonetic, and conceptual dimensions. Proximity considers whether the goods or services occupy the same market. Bridging the gap examines whether the senior user is likely to expand into the junior user's market. Evidence of actual consumer confusion, while not required, strongly supports the claim. Good or bad faith involves the junior user's intent in selecting the mark. Product quality relates to potential damage to the senior mark's reputation, and finally, buyer sophistication reflects the expected level of care exercised in purchasing decisions.

Scholars such as Barton Beebe argue that in practice, courts disproportionately emphasize two of these factors - the similarity of the marks and the existence of actual confusion - while others are inconsistently applied.⁶⁶ Beebe's empirical study of over 300 U.S. federal cases demonstrated that these two factors had the highest statistical correlation with findings of liability.⁶⁷

In *AMF Inc v Sleekcraft Boats*, the Ninth Circuit adopted a parallel framework, noting that the relative importance of factors may vary depending on context. The court also highlighted that consumer perception plays a central role, particularly when goods are inexpensive or purchased without extensive consideration.⁶⁸

U.S. courts regularly accept consumer surveys, including confusion and secondary meaning surveys, as evidence. However, the **Federal Judicial Center** has issued guidance cautioning against over-reliance on flawed or poorly designed surveys, recommending rigorous standards of methodology and statistical reliability.⁶⁹

Despite the doctrinal robustness of the multifactorial approach, legal scholars such as Graeme Dinwoodie and Mark Janis argue that excessive judicial discretion and a lack of weighting principles undermine the predictability of outcomes. They observe that decisions are often based on intuitive reasoning rather than systematic application of the factors.⁷⁰

Nevertheless, the United States framework remains one of the most detailed and evidence-driven approaches globally. It offers valuable insights for jurisdictions like Kazakhstan, where statutory criteria are underdeveloped and administrative versus forensic divergence persists.

⁶⁶ Barton Beebe, 'An Empirical Study of the Multifactor Tests for Trademark Infringement' (2006) 94(6) *California Law Review* 1581

⁶⁷ Barton Beebe, 'An Empirical Study of the Multifactor Tests for Trademark Infringement' (2006) 94(6) *California Law Review* 1590

⁶⁸ *AMF Inc v Sleekcraft Boats* 599 F.2d 341 (9th Cir 1979)

⁶⁹ Federal Judicial Center, 'Reference Guide on Survey Research' in *Reference Manual on Scientific Evidence* (3rd edn, 2011)

⁷⁰ Graeme Dinwoodie and Mark Janis, *Trademarks and Unfair Competition: Law and Policy* (4th edn, Aspen Publishers 2014)

The emphasis on consumer psychology, evidentiary rigor, and judicial flexibility contributes to a nuanced but functional system for protecting trademarks from misleading similarity.

Considering the arguments outlined above, it may be inferred that the United States' multifactorial approach to determining the likelihood of confusion presents a well-developed legal framework that integrates doctrinal clarity with evidentiary flexibility. The judicially constructed test, particularly the Polaroid factors, enables courts to consider a wide array of context-dependent elements, such as mark strength, proximity of goods, and actual consumer confusion, thereby ensuring that the assessment reflects market realities. This holistic model balances legal principles with behavioral insights, particularly through the centrality of consumer perception.

Despite its strengths, the U.S. system is not immune to critique. Scholars have highlighted its tendency toward inconsistent application and excessive judicial discretion, particularly in the absence of a formal weighting system. Nevertheless, the framework's adaptability has allowed it to remain effective across a broad spectrum of trademark disputes. Its structured flexibility, combined with a robust evidentiary foundation - including the strategic use of consumer surveys - positions it as a persuasive model for comparative analysis. Complementary proposals suggest that better structuring of judicial analysis through formalized guidelines could help mitigate judicial discretion and enhance consistency.⁷¹

In the context of jurisdictions like Kazakhstan, the U.S. experience underscores the importance of judicially guided interpretation, procedural standardization, and the integration of consumer psychology into legal reasoning. The American model demonstrates how trademark law can evolve to reflect commercial complexity while preserving fairness and legal certainty in the resolution of disputes.

3.3 Cross-Jurisdictional Comparison: Key Differences and Doctrinal Trends

The comparative legal analysis of trademark confusion doctrines across jurisdictions such as the European Union and the United States reveals marked divergences in both methodological architecture and interpretive orientation.

In the European Union, trademark confusion is assessed through the "global appreciation" approach established in *Sabel BV v Puma AG (Case C-251/95)*, where the CJEU emphasized the need for a holistic evaluation

⁷¹ P Khatri and N Rai, 'Likelihood of Confusion Test in Trademark Infringement' (2023) 17 NJA Law Journal 283.

considering all circumstances, particularly the relationship between the similarity of marks and the goods or services involved.⁷² This standard was further clarified in *Lloyd Schuhfabrik Meyer v Klijsen Handel* (Case C-342/97), where the Court described the average consumer as reasonably attentive, informed, and observant, with the level of attention varying according to the type of product.⁷³ While scholars such as Kur and Senftleben recognize the EU system's efforts to maintain consistency through institutional frameworks like the EUIPO and the CJEU's jurisprudence,⁷⁴ they also note that the absence of explicit factor-weighting introduces an element of unpredictability in the application of the doctrine.

By contrast, U.S. trademark law anchored in §32(1) of the *Lanham Act* - develops through judicial precedent rather than codified methodology. The most influential framework originates from *Polaroid Corp v Polarad Electronics Corp* (287 F.2d 492), where the court introduced an eight-factor test including: the strength of the mark, similarity, proximity of goods, bridging the gap, actual confusion, defendant's intent, product quality, and consumer sophistication.⁷⁵ Scholars such as Barton Beebe criticize this approach for overemphasizing actual confusion and mark similarity at the expense of doctrinal coherence; his empirical study of over 300 federal cases revealed these two factors as determinative in most decisions.⁷⁶

Further divergence emerges in the role of consumer perception. EU courts refer to the *average consumer* standard, emphasizing legal formalism, whereas U.S. courts consider actual marketplace conditions and frequently admit consumer surveys as evidence. The Federal Judicial Center, however, warns against poorly designed surveys and insists on statistical rigor.⁷⁷ This evidentiary flexibility is lauded by some, yet scholars such as Dinwoodie and Janis observe that U.S. judges often apply the factors with excessive discretion, leading to intuitive rather than principled adjudication.⁷⁸

In structural terms, the EU ensures doctrinal stability through central institutions such as the EUIPO and General Court, supported by CJEU oversight. The U.S., by contrast, delegates interpretive authority to federal circuits, resulting in variable regional approaches. While the EU

⁷² *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, para 22

⁷³ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, EU:C:1999:323, para 26

⁷⁴ A. Kur and M. Senftleben, *European Trade Mark Law: A Commentary* (OUP 2017) 246–249.

⁷⁵ *Polaroid Corp v Polarad Electronics Corp*, 287 F.2d 492 (2d Cir. 1961).

⁷⁶ Barton Beebe, 'An Empirical Study of the Multifactor Tests for Trademark Infringement' (2006) 94(6) *Cal L Rev* 1581.

⁷⁷ Federal Judicial Center, *Reference Guide on Survey Research* (3rd edn, 2011) 359–424.

⁷⁸ Graeme B. Dinwoodie and Mark D. Janis, *Trademarks and Unfair Competition: Law and Policy* (5th edn, Aspen Publishers 2021) 215–221.

emphasizes legal certainty and procedural uniformity, the U.S. system permits contextual adaptation and case-by-case balancing.

Criteria	European Union (EU)	United States (US)
Assessment Methodology	Global appreciation - comprehensive evaluation of all relevant factors taken together	Multifactor test (e.g., Polaroid Test) - separate consideration of several independent factors
Core Elements Analyzed	Visual, phonetic, and conceptual similarity between the signs	Strength of the mark, similarity of the marks, proximity of goods/services, likelihood of bridging the gap, evidence of actual confusion, defendant's bad faith, quality of defendant's goods, sophistication of consumers
Role of the Consumer	"Average consumer" - reasonably well-informed, observant, and circumspect	Consumer of the specific product/service category - attentiveness varies depending on the type of goods or services
Use of Dominant Elements	Yes, the dominant and distinctive components of the marks are critically analyzed	Yes, dominant elements are highly relevant when evaluating visual, phonetic, and conceptual similarities
Weighting of Factors	Interdependence between factors: a high degree of similarity can offset a lower degree of distinctiveness and vice versa	No fixed hierarchy of factors; courts exercise discretion to emphasize different factors based on case specifics
Reputation of Senior Mark	Enhances the likelihood of confusion, especially for well-known marks (e.g., under Article 8(5) EUTMR)	Strong and famous marks receive broader protection under multifactor analysis
Requirement of Actual Confusion	Not required; only the likelihood of confusion is necessary	Actual confusion strengthens the claimant's position but is not mandatory
Use of Empirical Evidence	Limited use; consumer surveys and marketing studies are less commonly admitted	Commonly used; consumer surveys are frequently submitted as evidence
Practical Challenges	Lack of strict structure for weighing factors; outcomes may vary significantly	Judicial flexibility can result in inconsistency and unpredictability in decisions

Table 2. Comparative analysis of approaches between EU and U.S.

The European model emphasizes doctrinal consistency through a structured "*global appreciation*" standard, supported by CJEU case law and EUIPO guidelines. However, it is occasionally criticized for excessive

abstraction and the absence of transparent weighting among assessment factors, which can reduce predictability in practice.

The U.S. model offers practical adaptability via a judge-developed multifactor test, allowing significant flexibility in evaluating evidence, including consumer surveys and marketplace realities. Nonetheless, it suffers from inconsistent application across jurisdictions and broad judicial discretion, which can compromise legal certainty.

The contrast between the two systems illustrates a broader tension between formalism and flexibility, centralization and decentralization, and between strict legal doctrine and pragmatic market-oriented reasoning. For Kazakhstan, where fragmented institutional methodologies and the absence of a unified standard currently prevail, the comparative experiences of the EU and the U.S. provide valuable guidance for reform.

The EU's approach offers a *model for centralized interpretive coherence and consumer-centered reasoning*, which could be useful for strengthening judicial consistency and predictability in Kazakhstan.

The U.S.' approach demonstrates *the importance of evidentiary flexibility and procedural adaptability*, particularly in responding to diverse market conditions and consumer behaviors.

A hybrid framework for Kazakhstan, incorporating EU-style doctrinal clarity with U.S.-style evidentiary pragmatism, could greatly enhance the transparency, coherence, and predictability of trademark confusion assessments. Developing a national standard based on this synthesis would not only improve judicial outcomes but also reinforce the broader infrastructure of intellectual property protection in Kazakhstan, aligning it more closely with international best practices. Furthermore, concerns regarding the increasing complexity of confusion tests have been raised by prominent IP law scholars and practitioners. They suggest recalibrating existing multifactor tests to better align them with actual consumer perception patterns observed in contemporary markets.⁷⁹

⁷⁹ A Duff and others, 'Is the Likelihood of Confusion Test Getting out of Hand?' (29th Annual Intellectual Property Law and Policy Conference, Fordham Intellectual Property Law Institute, 21 April 2022).

FINAL REMARKS

Summarising the comprehensive analysis undertaken in this research, it is evident that the issue of determining the likelihood of confusion between trademarks holds critical importance for the development of intellectual property protection in Kazakhstan. The study has demonstrated that, despite having a formally structured legislative framework - including the Civil Code and the Law on Trademarks - the current Kazakhstani system lacks methodological coherence in evaluating trademark similarity.

Institutional divergence between the National Institute of Intellectual Property (NIIP) and the Center for Forensic Expertise (CFE), coupled with the absence of a binding judicial methodology, generates legal uncertainty and inconsistencies in judicial practice. The analysis of selected Kazakhstani cases - such as *HUGO BOSS v Babyboss*, *Shchedroe Leto v Shchedroe Pole*, *Zhana Gradus v Gradus*^o, and *Espumisan v Esmizan-ODS* - clearly reflects that courts and administrative bodies adopt differing approaches to trademark comparison. This fragmentation not only undermines predictability and fairness but also weakens the effective enforcement of trademark rights.

The comparative study of the European Union and the United States highlights that developed jurisdictions provide structured frameworks for trademark confusion analysis. The European Union's "global appreciation" approach and the United States' "multifactor analysis" (notably the Polaroid Factors) emphasize the holistic assessment of consumer perception, market context, and the cumulative effect of multiple elements. These systems achieve a balance between legal certainty and flexibility, offering valuable models for Kazakhstan's legal development.

In light of these findings, this research proposes that Kazakhstan should adopt a unified national methodology for assessing the likelihood of confusion between trademarks. The most appropriate and practical mechanism for this reform would be the adoption of a **Normative Resolution of the Supreme Court of the Republic of Kazakhstan**. This normative resolution should provide clear, structured guidance for courts on how to assess trademark similarity, drawing upon international best practices.

Specifically, the proposed resolution should incorporate a set of factors analogous to the Polaroid Factors, including:

- the strength of the earlier mark;
- the degree of similarity in appearance, sound, and meaning;
- the similarity of the goods or services;
- the likelihood of expansion of the product lines;
- evidence of actual confusion;
- the intent of the alleged infringer;

- the quality of the defendant's goods or services;
- and the degree of consumer care.

The adoption of such a resolution would significantly enhance consistency, transparency, and predictability in the adjudication of trademark disputes. It would foster greater confidence among businesses and investors, strengthen consumer protection, and bring Kazakhstan's intellectual property system closer to international standards.

Looking forward, further research could explore the development of empirical methods – such as consumer surveys and market studies - to support judicial assessments of confusion. Moreover, it would be beneficial to enhance the specialization of judges dealing with intellectual property matters, following best practices observed in other jurisdictions.

In conclusion, the findings of this research emphasize the urgent need for Kazakhstan to modernize its trademark enforcement mechanisms by introducing a clear and unified judicial standard for evaluating likelihood of confusion. The proposed normative resolution by the Supreme Court would represent a vital step toward achieving greater legal certainty, fostering fair competition, and ensuring the effective protection of intellectual property rights in the Republic of Kazakhstan.

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