

OPPOSITION No B 3 098 185

W + R GmbH, Carl-Zeiss-Str. 5, 72555 Metzingen, Germany (opponent), represented by **Kohler Schmid Möbus Patentanwälte Partg mbB**, Kaiserstr. 85, 72764 Reutlingen, Germany (professional representative)

a g a i n s t



Moda Effe S.r.l., Via Strasburgo, 5/7/9, 76121 Barletta (BT), Italy (applicant), represented by **Dimitri Russo S.r.l.**, Via G. Bozzi, 47A, 70121 Bari, Italy (professional representative).

On 04/01/2021, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 098 185 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS

The opponent filed an opposition against some of the goods of European Union trade mark application No 18 098 766 for the figurative mark , namely against all the goods in Class 25. The opposition is based on European Union trade mark registration No 16 477 572 for the figurative mark . The opponent invoked Article 8(1)(b) EUTMR.

LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods

The goods on which the opposition is based are the following:

Class 25: *Gloves [clothing]; sports gloves; clothing, in particular sportswear and outerclothing.*

Class 28: *Sports gloves, included in class 28.*

Following the limitation submitted on 14/01/2020, the contested goods are the following:

Class 25: *Clothing; tee-shirts; hosiery; tops [clothing]; shorts; sweaters; cardigans; sweaters; sweat shirts; shirts; casual shirts; trousers; skirts; denim jeans; topcoats; gowns; jackets [clothing]; heavy jackets; coats; mackintoshes; pelerines; waist belts; shawls; sashes for wear; neckties; swimming costumes; underwear; headgear; hats; footwear; none of the aforementioned goods relating to music merchandising.*

Some of the contested goods are identical to goods on which the opposition is based. For reasons of procedural economy, the Opposition Division will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed as if all the contested goods were identical to those of the earlier mark in Class 25, which is the best light in which the opponent's case can be considered.

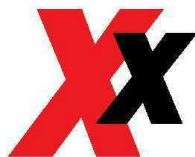
b) Relevant public — degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods in question.

In the present case, the goods assumed to be identical are directed at the public at large.

The degree of attention is average.

c) The signs



Earlier trade mark



Contested sign

The relevant territory is the European Union.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The comparison between signs consisting of two letters not recognisable as a word follows the same rules as that for word signs comprising a word, a name or an invented term (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 47-48).

Both signs are figurative marks consisting of two letters 'XX', albeit with very different stylisations. The combination of the letters 'XX' will not be associated with any clear,

specific or unambiguous meaning by the relevant public, aside from being letters of the Latin alphabet. Therefore, the signs are not descriptive, allusive or otherwise weak in relation to the relevant goods and they have an average degree of distinctiveness.

The earlier mark's first letter 'X' is depicted in red and is considerably bigger than the second one. The second letter 'X' is written in black and has a higher position than the first one. In addition, both letters are written in italics and overlap slightly. Whereas the contested sign's letters 'XX' are depicted in a bold, black, stylised typeface. They are written on one line and the bottom parts of the letters contain white stripes. The signs differ in their colours (red-and-black versus black-and-white) and the size of the letters 'X'. In addition, the earlier mark is written in italics and its letters overlap slightly, while the contested sign's letters are straight and contain white stripes in the bottom parts. This gives the impression that they are vanishing towards the bottom in the contested sign. Therefore, the considerable differences in the depictions of the letters 'XX' create quite a distinct overall impression.

The length of the signs may influence the effect of the differences between them. The shorter a sign, the more easily the public is able to perceive all of its single elements. Therefore, in short signs, small differences may frequently lead to a different overall impression (06/07/2004, T-117/02, Chufafit, EU:T:2004:208, § 48; 20/04/2005, T-273/02, Calpico, EU:T:2005:134, § 39). In contrast, the public is less aware of differences between long signs. The fact that the verbal components have a stronger impact on consumers does not mean that the stylisation of the signs, particularly in short signs consisting of just two letters, such as in this case, will not attract the consumers' attention. The signs' stylisations are visually significant and memorable. Although the verbal element is the one by which consumers will refer to the sign, they will not overlook or ignore the figurative elements, especially as they have a strong impact on the overall visual impression created by the signs. Therefore, these figurative aspects of the signs will also catch the consumers' attention and will be decisive in the case in question.

Neither of the signs has any element that could be considered clearly more dominant than other elements.

Visually, the signs coincide in their stylised letters 'XX'. However, they differ in the particular stylisations of these letters, which produce striking differences.

The letters 'XX' in the contested sign are depicted in black-and-white, are written in a slightly more decorative manner and stylised in a different way, as described in detail above, which will not be overlooked by the public. By contrast, the earlier mark is depicted in red-and-black and its stylisation is manifestly different, with the letters at different levels, having different sizes and overlapping. Therefore, compared in detail or as a whole, the signs show substantial differences, which are striking and evident even at a first glance. Although a certain degree of visual similarity between the signs cannot be denied, it is only low.

Aurally, the signs are identical.

Conceptually, neither of the signs has a meaning for the public in the relevant territory. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

d) Distinctiveness of the earlier mark

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the goods in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

Likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case. This appreciation depends on numerous elements and, in particular, on the degree of recognition of the mark on the market, the association that the public might make between the two marks and the degree of similarity between the signs and the goods (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

A likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings.

All the contested goods are assumed to be identical to the opponent's goods and target the general public. The degree of attention is average. The signs are visually similar only to a low degree and aurally identical. The conceptual aspect does not influence the assessment of the similarity of the signs.

As to the overall assessment of likelihood of confusion, the Court made it clear that the fact that two trade marks consisting of the same sequence of letters are found to be identical from an aural and a conceptual point of view is relevant when it comes to assessing the existence of a likelihood of confusion. In such cases, it is only when the later trade mark causes a sufficiently different visual impression that a likelihood of confusion can be safely ruled out (10/05/2011, T-187/10, G, EU:T:2011:202, § 60).

Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 50). Therefore, the noticeable visual differences between the signs caused by their considerably striking stylisations are particularly relevant when assessing the likelihood of confusion between them.

In the assessment of likelihood of confusion between signs comprising the same two letters, it should be borne in mind that the visual comparison is, in principle, decisive because the aural (and, where applicable, conceptual) identity may be overridden by sufficient visual differences between them. A likelihood of confusion can be safely excluded when two conflicting signs, albeit containing or consisting of the same

combination of letters, are stylised in sufficiently different ways, so that their different overall graphical depictions eclipse the common verbal element.

In the present case, the similarities between the signs are limited to the fact that both signs contain two of the letter 'X', which are, however, depicted in a very distinct manner in each sign, as mentioned above. Overall, the signs bear little visual resemblance and their respective differences are sufficiently memorable and eye-catching for consumers to safely distinguish between them. Even assuming that the goods are identical, it is evident that these differences will not go unnoticed by the relevant public.

As explained above, the length of the signs may influence the effect of the differences between them. The shorter a sign, the more easily the public is able to perceive all of its single elements. Therefore, although the signs are aurally identical and the goods are assumed to be identical, this is not sufficient to find a likelihood of confusion since the signs are visually similar only to a low degree and they have no concepts that would help consumers differentiate between them.



The opponent refers to previous decisions of the Office to support its arguments that there is a likelihood of confusion between the signs in dispute, namely joined related cases R 1602/2019-4 and R 1549/2019-4 AX MEN (fig.)/A X (fig.). However, the Office is not bound by its previous decisions, as each case has to be dealt with separately and with regard to its particularities.

This practice has been fully supported by the General Court, which stated that, according to settled case-law, the legality of decisions is to be assessed purely with reference to the EUTMR, and not to the Office's practice in earlier decisions (30/06/2004, T-281/02, Mehr für Ihr Geld, EU:T:2004:198).

Even though previous decisions of the Office are not binding, their reasoning and outcome should still be duly considered when deciding upon a particular case.

The previous joined cases, namely R 1602/2019-4 and R 1549/2019-4 AX MEN (fig.)/A X (fig.) referred to by the opponent, are not relevant to the present proceedings, as the signs are less stylised than in the present case, the letters are depicted in the same colour and positioned on the same level, which is not the case in the present proceedings.

In the Opposition Division's view, the current case bears more resemblance to the case R 1277/2015-2 (02/03/2016, R 1277/2015-2, AM (fig.) / AM (fig.)), where a stylised earlier

mark  was compared with the figurative sign . In that case, the Board found that the marks are visually dissimilar (even though they both contain the letters 'AM'), mainly due to the stylisation of the contested sign and concluded that they are dissimilar overall.

While the Office does have a duty to exercise its powers in accordance with the general principles of European Union law, such as the principle of equal treatment and the principle of sound administration, the way in which these principles are applied must be consistent with respect to legality. It must also be emphasised that each case must be examined on its own individual merits. The outcome of any particular case will depend on specific criteria applicable to the facts of that particular case, including, for example, the parties' assertions, arguments and submissions.

In view of the above, it follows that, even if the previous decision submitted to the Opposition Division is to some extent factually similar to the present case, the outcome may not be the same.

Assessment of the similarity between two signs involves more than taking just one component of a composite trade mark and comparing it with another mark. The general rule should be to compare these signs in their entirety, primarily taking into account the overall impression conveyed. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 35). In this case, the differences between the signs have a sufficiently strong impact to allow the relevant public to distinguish between them.

Considering all the above, there is no likelihood of confusion on the part of the public. Therefore, the opposition must be rejected.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(i) EUTMR, the costs to be paid to the applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

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According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.