



OPPOSITION No B 2 039 942

Graph-X, besloten vennootschap met beperkte aansprakelijkheid, Frankrijklei 112, 2000 Antwerpen, Belgium (opponent), represented by **Bureau M.F.J. Bockstael Nv**, Arenbergstraat 13, 2000 Antwerpen, Belgium (professional representative)

a g a i n s t

Mia Spółka z o.o., ul. Kwiatowa 3, 30-437 Kraków, Poland (applicant), represented by **Ryszard Hubisz**, Osiedle Stalowe 6/20, 31-920 Kraków, Poland (professional representative).

On 17/05/2013 the Opposition Division takes the following

DECISION:

1. Opposition No B 2 039 942 is upheld for all the contested services, namely

Class 35: Advertising, public relations, marketing involving arranging the sale of goods, and marking them, multimedia agencies in the field of company and goods advertising, design and organisation of advertising; Business consultancy, market analysis.

2. Community trade mark application No 10 686 962 is rejected for all the contested services. It may proceed for the remaining goods and services.
3. The applicant bears the costs, fixed at EUR 650.

REASONS:

The opponent filed an opposition against some of the services of Community trade mark application No 10 686 962 namely against some of the services in Class 35. The opposition is based on Community trade mark registration No 6 870 406. The opponent invoked Article 8(1)(b) CTMR.

LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services 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 and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

a) The services

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

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

Class 35: Marketing of goods and/or services for others; advertising; arranging of advertising services; dissemination of advertising matter; commercial information; market canvassing, research and analysis.

The contested services are the following:

Class 35: Advertising, public relations, marketing involving arranging the sale of goods, and marking them, multimedia agencies in the field of company and goods advertising, design and organisation of advertising; Business consultancy, market analysis.

The contested *advertising* is identically present in both specifications, therefore this is identical.

The applicant's *market analysis* is identically included in the opponent's *market canvassing, research and analysis*; these services are identical.

Marketing is the process of communicating the value of a product or service to customers, for the purpose of selling the product or service. It is a critical business function for attracting customers and involves a marketing plan for a product through continued advertising, promotions, public relations and sales.

Advertising services consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing the client's position in the market and acquiring competitive advantage through publicity. In order to fulfil this target, many different means and products might be used. These services are provided by specialised companies which study their client's needs and provide all the necessary information and advice for the marketing of their products and services, and create a personalised strategy regarding the advertising of their goods and services through newspapers, websites, videos, the internet, etc.

To the extent that marketing coincides and includes advertising these services are deemed identical.


The opponent's *Marketing of goods and/or services for others* is a broad specification that includes the applicant's *marketing involving arranging the sale of goods, and marking them, multimedia agencies in the field of company and goods advertising, design and organisation of advertising*. Therefore these services are deemed identical.

The contested *public relations* are the on-going activities to ensure the overall company has a strong public image. Public relations are primary activities included in marketing and promotions, conducted through the media, that is, newspapers, television, magazines, etc. Therefore they are included in the array of the opponent's marketing services and therefore are deemed identical.

The contested *business consultancy* refers to both the industry, and the practice of, helping organizations improve their performance, primarily through the thorough analysis of existing business problems and development of plans for improvement. Companies hire the services of management consultants who identify the problems, and make recommendations for more effective or efficient ways of performing business tasks. They involve activities such as business research and appraisals, cost price analysis and organisation consultancy. These services also include any 'consultancy', 'advisory' and 'assistance' activity that may be useful in the 'management of a business, such as how to efficiently allocate financial and human resources; how to improve productivity; how to increase market share; how to deal with competitors; how to reduce tax bills; how to develop new products; how to communicate with the public; how to do marketing; how to research consumer trends; how to launch new products; how to create a corporate identity; etc.

As regards *advertising services* the purpose is 'to reinforce the [business] position in the market' and the purpose of business management services is to help a business in 'acquiring, developing and expanding market share'. There is not a clear-cut difference between 'reinforcing a business position in the market' and 'helping a business to develop and expand market share'. A professional who offers advice regarding how to efficiently run a business may reasonably include advertising strategies in that advice because there is little doubt that advertising plays an essential role in business management. Furthermore, business consultants may offer advertising (and marketing) consultancy as a part of their services and therefore the relevant public may believe that these two services have the same professional origin. Consequently, considering the above these services are similar to a low degree (see decision R 2163/2010-1 'INNOGAME / INNOGAMES', para. 13-17).

b) The signs

MIA	
Earlier trade mark	Contested sign

The relevant territory is the European Union.

The earlier mark 'MIA' is a word mark; therefore it is the word as such that is protected and not its written form.

The contested sign is made up of the stylised capital letters 'MIA' with the last letter 'A' depicted in quite a fanciful manner and red and black colours as seen above.

Visually, in spite of their difference in stylisation the signs coincide in their three letters 'MIA'. On the other hand, they differ in the style and colours of the contested mark.

Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory the pronunciation of the marks coincides in the sound of all three letters 'MIA', and therefore the marks are aurally identical.

Conceptually, the word 'MIA' is the female gender for *an, one* in Greek, (<http://www.wordreference.com/gren/%CE%BC%CE%B9%CE%B1>) and the signs will be clearly understood with an identical concept the Greek public.

In Italian and Spanish 'MIA' defines the possessive pronoun *my* (<http://www.wordreference.com/iten/mia>) and both signs will be identically perceived by the Italian-speaking public.

Moreover 'MIA' will be perceived as a female name in several countries of the relevant territory among others in the UK, Portugal, France, and Germany; therefore the signs are conceptually identical for the relevant part of the aforesaid public.

In the territories where the word 'MIA' has no meaning, neither of the two signs has a meaning. Therefore, they have no concept in common.

Taking into account the abovementioned visual, aural and, where applicable, conceptual coincidences, it is considered that the signs under comparison are highly similar.

c) Distinctive and dominant elements of the signs

In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

The marks under comparison have no elements which could be considered clearly more distinctive or dominant (visually eye-catching) than other elements.

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 marks are particularly distinctive by virtue of intensive use or reputation.

Consequently, the assessment of the distinctiveness of the earlier marks will rest on their distinctiveness *per se*. In the present case, the earlier trade mark as a whole has no meaning in relation to any of the goods and services at hand from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier marks must be seen as normal.

e) Relevant public – level 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 level of attention is likely to vary according to the category of goods or services in question.

In the present case, the services found to be identical and similar are directed at the public at large.

f) Global assessment, other arguments and conclusion

As already seen the figurative features of the contested sign are merely the calligraphic script of the word 'MIA' and the colour of the last letter 'A'. These, however, are very basic decorative components that do not alter the way the word element 'MIA' is perceived. It should be taken into account that as the earlier mark 'MIA' is a plain word mark it can be depicted in various letter types.

Further to the analysis previously done, the conflicting signs are visually very similar, aurally identical and for a part of the relevant public, among others, Greek, Italian, Spanish, English, French, Portuguese they are conceptually identical.

In view of the striking similarity between the marks and the identity and similarity (low degree) between the services, consumers may either confuse the signs or merely perceive the contested sign as relating to an economically linked undertaking or indeed as denoting a different line of the services at issue.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public for the services found identical and similar even to a low degree. This is so given that a global assessment of the likelihood of confusion implies some interdependence between the relevant factors and that a lesser degree of similarity between the goods may be offset by a greater degree of similarities between the marks and vice versa (judgment of 29/09/1998, C-39/97 'Canon', paragraph 17), it is considered that in the present case the similarities between the signs are sufficient to overcome the low degree of similarity between the goods at hand.

Therefore the opposition is partly well founded on the basis of the opponent's Community trade mark registration.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

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

According to Rule 94(3), (6) and (7)(d)(i) CTMIR, the costs to be paid to the opponent are the opposition fee and the costs of representation which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Lucinda CARNEY

Elisavet PAPATHANASIOU

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According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.