



OPPOSITION No B 1 944 381

Polska Wytwórnia Papierów Wartościowych S.A., ul. Romana Sanguszki 1, 00-222 Warsaw, Poland (opponent), represented by **Lds Łazewski Depo & Partners**, ul. Okopowa 58/72, 01-042 Warsaw, Poland (professional representative)

a g a i n s t

Prim'vision, 905 rue Albert Einstein, Agora, 06905 Sophia Antipolis, France (holder).

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

DECISION:

1. Opposition No B 1 944 381 is upheld for all the contested services.
2. International registration No 1 077 127 is entirely refused protection in respect of the European Union.
3. The holder bears the costs, fixed at EUR 650.

REASONS:

The opponent filed an opposition against all the services of international registration designating the European Union No 1 077 127. The opposition is based on, inter alia, Community trade mark registration No 8 579 773. 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.

The opposition is based on more than one earlier trade mark. For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier Community trade mark registration No 8 579 773.

a) The goods and services

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

- Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for the conducting, switching, converting, storage, regulating and controlling of electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.*
- Class 35: *Advertising; business management; business administration; office functions.*
- Class 38: *Telecommunications.*
- Class 42: *Scientific and technological services and research and design services relating thereto; industrial analysis and research services; design and development of computer hardware and software.*
- Class 45: *Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.*

The contested services are the following:

- Class 35: *Advertising; business management; business administration; office functions; direct mail advertising; arranging newspaper subscriptions for others; business management and organization consultancy; book-keeping; document reproduction; employment agencies; computerized file management; organization of exhibitions for commercial or advertising purposes; online advertising on a computer network; rental of advertising time on communication media; publication of publicity texts; rental of advertising space; dissemination of advertising matter; public relations.*
- Class 38: *Telecommunications; information about telecommunication; communications via computer terminals or via fiber-optic networks; radio or telephone communications; mobile radio telephone services; providing user access to a global computer network; electronic bulletin board services (telecommunications services); providing telecommunications connections to a global computer network; news agencies; rental of telecommunication equipment; radio or television broadcasts; teleconferencing services; electronic messaging; rental of access time to global computer networks.*
- Class 42: *Evaluations, estimates and research in the scientific and technological fields provided by engineers; design and development of computers and software; research and development for others; technical project studies; architecture; design of interior decor; development (design), installation, maintenance, updating or rental of software; computer programming; consultancy in the field of computer hardware; data conversion of computer programs and data [not physical conversion]; conversion of data or documents from physical to electronic media;*

graphic arts designing; styling (industrial design); authenticating works of art.

Contested services in Class 35

The contested *Advertising; business management; business administration; office functions* are included in the list of services in Class 35 of the earlier mark. The services are identical.

The contested *direct mail advertising; online advertising on a computer network; publication of publicity texts; dissemination of advertising matter; rental of advertising time on communication media; rental of advertising space; public relations* are included in the broad category of the opponent's *Advertising* in Class 35. Therefore, these services are considered identical.

The contested *business management and organization consultancy* are included in the broad category of the opponent's *business management* in Class 35. Therefore, these services are considered identical.

The contested *employment agencies; organization of exhibitions for commercial or advertising purposes* are included in the broad category of the opponent's *business administration* in Class 35. Therefore, these services are considered identical.

The contested *arranging newspaper subscriptions for others; book-keeping; document reproduction; computerized file management* are included in the broad category of the opponent's *office functions* in Class 35. Therefore, these services are considered identical.

Contested services in Class 38

All the contested services in this class are included in the broad category of the opponent's *Telecommunications*. Therefore, these services are considered identical.

Contested services in Class 42


The contested *Evaluations, estimates and research in the scientific and technological fields provided by engineers; research and development for others; technical project studies; architecture; design of interior decor; graphic arts designing; styling (industrial design); conversion of data or documents from physical to electronic media; data conversion of computer programs and data [not physical conversion]; authenticating works of art* are included in the broad category of the opponent's *Scientific and technological services and research and design services relating thereto* in Class 42. Therefore, these services are considered identical.

The contested *design and development of computers and software; development (design), computer programming* are included in the broad category of the opponent's *design and development of computer hardware and software* in Class 42. Therefore, these services are considered identical.

The contested *installation, maintenance, updating or rental of software; consultancy in the field of computer hardware* have the same nature and purpose, and a strong, complementary link to the opponent's *design and development of computer hardware*

and software in Class 42. Furthermore, they can coincide in producers, distribution channels and consumers. These services are similar.

b) The signs

	Smart Ad
Earlier trade mark	Contested sign

The relevant territory is the European Union.

For reasons of procedural economy, the Opposition Division will focus the comparison of the signs on the Estonian-speaking part of the relevant public.

The earlier mark is a figurative mark containing word elements, and is red and yellow in colour. The contested mark is a word mark. In the case of word marks, the word as such is protected and not its written form.

Visually, the signs are similar to the extent that they coincide in the element SMART and the grapheme A that follows, while taking into account that there are differences in stylisation. The marks differ in the ending of their second word elements, APP/AD, in the remaining word elements of the earlier mark and in the slight stylisation and colour of the earlier mark that are not present in the contested mark.

Aurally, the pronunciation of the marks coincides in the sound of the letter sequences SMART A__, present identically in both signs, and to that extent the marks are aurally similar. Furthermore, the letter sequences APP and AD (pronounced ADD) present significant similarities.

The pronunciation differs in the in the sound of the letters PP/DD, and in the remaining graphemes of the earlier mark which have no respective counterpart in the contested mark.

Conceptually, neither of the two signs has a meaning for the public in the relevant territory. Therefore, they have no concept in common.

Taking into account the abovementioned coincidences, it is considered that the signs under comparison are 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 earlier mark has no elements which are considered to be clearly more distinctive than any other elements.

The element SMART APP, of the earlier mark, by virtue of its central position and size, overshadows the other verbal elements of the mark. This element is the visually dominant element of the earlier mark.

The contested sign has no element 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 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 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 mark 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, and at business customers with specific professional knowledge or expertise.

f) Global assessment, other arguments and conclusion

The services are partially identical and partially similar. The marks have been found to contain visual and aural similarities.

It is considered that when a sign consists of both word and figurative components, as is the case with the earlier mark, the word components of the sign usually have a stronger impact on the consumer than the figurative components. This is because the public will most readily refer to a sign by its verbal component than by describing the elements of stylisation.

Although the signs differ slightly in respect of the stylisation of the word elements in the earlier mark, considering the typeface and colours used, it must be noted that there is a significant visual similarity between the grapheme sequence SMART A __, and also in the structure of the word elements, with the different parts of conjoined elements beginning with an upper case or larger letter. Furthermore, the beginning of the signs is aurally identical. The ending of the word elements of the signs, APP and AD, contains significant similarities in pronunciation. The remaining word elements in the earlier mark are written in a much smaller typeface and placed in a secondary

position at the bottom of the earlier mark. As regards the figurative elements included in the earlier sign, they consist of simply a stylisation of letters. These circumstances contribute to the overall similarity between the marks.

Moreover, both words (of the trade marks in question) are distinctive, *per se*, in relation to the services they cover.

Considering all the relevant facts, there is a risk that the visual and aural dissimilarities are unlikely to be remembered, especially as the consumer only rarely has a chance to make a direct comparison between the signs and must place his trust in an imperfect recollection of the marks (see judgment of 22/06/1999, case C-342/97, 'Lloyd Schuhfabrik').

Based on the principle of imperfect recollection, it is considered that the established similarities between the signs are sufficient to cause, at least part, of the public to believe that the conflicting services, which are identical and similar, come from the same or from economically linked undertakings. The relevant public is, therefore, likely to mistake one mark for the other.

It is a result of the unitary character of the Community trade mark, laid down in Article 1(2) CTMR, that an earlier Community trade mark has identical protection in all Member States. Earlier Community trade marks may therefore be relied upon to challenge any subsequent application for a trade mark which would prejudice their protection, even if this is only in relation to the perception of consumers in part of the European Community. It follows that the principle laid down in Article 7(2) CTMR, which provides that it is sufficient that an absolute ground for refusal exists in only part of the Community for a trade mark application to be refused, applies, by analogy, to a relative ground for refusal under Article 8(1)(b) CTMR.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public.

Therefore, the opposition is well founded on the basis of the opponent's Community trade mark registration No 8 579 773. It follows that the contested International registration must be refused protection entirely, in respect of the European Union.

As the earlier right CTM No 8 579 773 leads to the success of the opposition and to the rejection of the contested trade mark for all the services against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent (see judgment of 16/09/2004, T-342/02, 'Moser Grupo Media').

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 holder 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) CTMR, 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

Vít MAHELKA

Erkki MÜNTER

Alistair BUGEJA

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.