



OPPOSITION No B 2 062 035

xx-well.com GmbH, Ehrenbergstrasse 19, 10245 Berlin, Germany (opponent), represented by **White & Case LLP**, Jungfernstieg 51, 20354 Hamburg, Germany (professional representative)

a g a i n s t

Beijing Kxwell Technology Co.Ltd, Zhucheng Building, Tower B, 308A Zhongguancun South Street, Haidian District, Beijing, the People's Republic of China (applicant), represented by **Polopatent**, Dr. Fleming 16, 28036 Madrid, Spain (professional representative).

On 06/05/2013 the Opposition Division takes the following

DECISION:

1. Opposition No B 2 062 035 is partially upheld, namely for the following contested goods:

Class 9: Computer peripheral devices; Computer software, recorded; Software (Computer -), recorded; Microprocessors; Computer programs [downloadable software]; Radios; Intercommunication apparatus; Optical communication instrument; Network Communication Equipment; Receivers (Audio- and video); Television camera; Audiovisual teaching apparatus; all of the mentioned goods exclude those related to nutritional and fitness programs.

2. Community trade mark application No 10 891 554 is rejected for all the above goods. It may proceed for the remaining goods, namely:

Class 9: Electro-dynamic apparatus for the remote control of signals; Monitoring apparatus, electric; Cases especially made for photographic apparatus and instruments; Stands for photographic apparatus; Tripods for cameras; Remote control apparatus; Electric installations for the remote control of industrial operations; Regulating apparatus, electric; all of the mentioned goods exclude those related to nutritional and fitness programs.

3. Each party bears its own costs.

REASONS:

The opponent filed an opposition against all the goods of Community trade mark application No 10 891 554. The opposition is based on German trade mark registration No 302 010 018 644. 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 goods and 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 goods and services on which the opposition is based are the following:

Class 3: Soaps; perfumery, essential oils, cosmetics, hair tonics; dentifrices.

Class 9: Electronic publications (downloadable), also provided on the internet or for retrieval on mobile devices; electronic newsletters; electronic recipes, nutrition and fitness programs (recorder and/or downloadable); sound carriers, digital image carriers as well as digital data memories, in particular CDs, CD-ROMs, MP3 and DVDs; software, computer programs as well as computer operating programs (each recorded and/or downloadable).

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; stationery; plastic materials for packaging (not included in other classes); instructional and teaching material (except apparatus).

Class 35: Advertising, rental of advertising space, also on the Internet and other media; collecting, compiling, updating and maintenance of data in computer databases, in particular in the field of nutrition, health and body related data, organisation of trade fairs for commercial or advertising purposes; retail services, in particular online and catalogue mail order services, in the fields of groceries, diet products, fitness and sports articles, books and guidebooks, body and beauty care.

Class 38: Providing of platforms or portals on the internet; providing of access to information, computer programs and databases in data networks like the Internet, including input, search and navigation functions; providing of access to chat lines, chat rooms and forums on the Internet or other data networks; electronic mail; all the aforementioned services in particular relating to the topics nutrition, health and fitness; telecommunications.

Class 41: Education, providing of training; entertainment, sporting and cultural activities; coaching and educational consultancy, in particular in the field of nutrition, fitness, health and overcoming of addictions; operating of health clubs, nutrition clubs, fitness clubs and non smoking clubs (entertainment); services of fitness studios; services of a publishing house (except printing); publishing and providing of electronic publications (not downloadable) as well as of electronic recipes, nutrition and fitness programs on the Internet (not downloadable).

Class 44: Consultancy regarding nutrition, diet, health and beauty; consultancy for overcoming of addictions, in particular for smokers; conducting of therapies,

therapeutic support, services of a psychologist; all the aforementioned services in particular also on the internet and via telephone; teledoctor services; medical services; hygienic and beauty care for human beings.

The contested goods are the following:

Class 9: Computer peripheral devices; Computer software, recorded; Software (Computer -), recorded; Microprocessors; Computer programs [downloadable software]; Radios; Intercommunication apparatus; Electro-dynamic apparatus for the remote control of signals; Optical communication instrument; Network Communication Equipment; Monitoring apparatus, electric; Receivers (Audio- and video-); Television camera; Cases especially made for photographic apparatus and instruments; Stands for photographic apparatus; Tripods for cameras; Audiovisual teaching apparatus; Remote control apparatus; Electric installations for the remote control of industrial operations; Regulating apparatus, electric; all of the mentioned goods exclude those related to nutritional and fitness programs.

The contested *Computer software, recorded; Software (Computer -), recorded; Computer programs [downloadable software];* all of the mentioned goods exclude those related to nutritional and fitness programs are included in opponent's software, computer programs as well as computer operating programs (each recorded and/or downloadable). Therefore, these goods are identical.

The contested *Computer peripheral devices; all of the mentioned goods exclude those related to nutritional and fitness programs* are similar to the opponent's software. *Computer peripheral devices* are any devices that can be attached to a host computer behind the chipset, whose primary function is dependent upon the host, and which can, therefore, be considered as expanding the host's capabilities (some of the more common peripheral devices are printers, scanners, disk drives, tape drives, microphones, speakers and cameras). *Software* is composed of programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation. They are all related to the field of IT and are used in combination. Furthermore, they also share the same end users and distribution channels, and may have the same commercial origin.

The contested *Microprocessors; all of the mentioned goods exclude those related to nutritional and fitness programs* are used to control the logic of computers as well as almost all digital devices. They are similar to the opponent's software as they can coincide in producer, end user and distribution channels. Furthermore, they are complementary.

The contested *Radios; Intercommunication apparatus; Optical communication instrument; Network Communication Equipment; Television camera; Audiovisual teaching apparatus; Receivers (Audio- and video-);* all of the mentioned goods exclude those related to nutritional and fitness programs are apparatus for recording, transmission or reproduction of sound or images used to communicate audio or video information over a distance via radio waves, optical signals, etc. or along a transmission line. The opponent's *telecommunications* services allow people to communicate with one another by remote means. There is a link between these goods in Class 9 and the services in Class 38 (telecommunication services). These goods and services are similar because they are complementary and even though their nature is different, their purposes and distribution channels are the same.

The remaining contested goods are dissimilar to the opponent's goods in Class 9. The contested *Cases especially made for photographic apparatus and instruments; Stands for photographic apparatus; Tripods for cameras; all of the mentioned goods exclude those related to nutritional and fitness programs* are accessories for photographic apparatus and instruments. The contested *Regulating apparatus, electric; all of the mentioned goods exclude those related to nutritional and fitness programs* are apparatus and instruments for regulating and/or controlling electricity. The contested *Electro-dynamic apparatus for the remote control of signals; Electric installations for the remote control of industrial operations; all of the mentioned goods exclude those related to nutritional and fitness programs* are highly specific apparatus and installations used for the remote control of signals and industrial operations. The contested *Remote control apparatus; Monitoring apparatus, electric; all of the mentioned goods exclude those related to nutritional and fitness programs* are apparatus used specifically for controlling and monitoring the goods. These goods differ in their nature, purpose and method of use from the opponent's goods in Class 9, which cover electronic publications, sound and data image carriers and software. Furthermore, these sets of goods target different consumers and are offered through different distribution channels. They do not have the same producers and are neither in competition, nor complementary.

Likewise, these remaining contested goods are dissimilar to any of the opponent's goods and services in Classes 3 (covering cosmetics, soaps, perfumery, etc.), 16 (covering paper, printed matter, stationery, etc.), 35 (advertising and retail services in connection with groceries, books and dietary goods), 38 (telecommunications), 41 (education, entertainment, and sporting, cultural and publication services) and 44 (consultancy, health and beauty, and medical services). The remaining contested goods are clearly different in their nature and purpose from any of the opponent's goods and services. They also differ in their producers and distribution channels. These sets of goods and services are neither in competition nor complementary.

b) The signs

xx-well	KXWELL
Earlier trade mark	Contested sign

The relevant territory is Germany.

Visually, the earlier mark consists of the hyphenated element 'xx-well'. It is a word mark. Therefore, the word, per se, is protected and not its written form, which means that differences in the use of lower or upper case letters are immaterial. The contested sign is a figurative mark composed of the element 'KXWELL', written in upper case letters in a rather standard computer-like font. The signs coincide in five letters out of six, namely in the sequence of letters 'XWELL', and differ in their initial letters, 'X' versus 'K'. The signs also differ in the hyphen in the earlier sign, appearing between the second and the third letters. Therefore, the signs are visually similar to the extent that they coincide in the abovementioned aspects.

Aurally, the earlier sign is pronounced as /x-x-well/ and the contested sign as /k-x-well/. Therefore, the pronunciation of the signs coincides in the second and third syllables and differs in the initial syllable, pronounced as 'iks' versus 'ka'. The marks are,

therefore, aurally similar to the extent that they coincide in the abovementioned aspects.

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 visual and aural 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 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 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 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 goods found to be identical and similar are directed both at the public at large and at more specialised consumers in the IT field. The attention of the relevant public will vary from average to high.

f) Global assessment, other arguments and conclusion

The trade marks were found to be visually and phonetically similar to the extent that they coincide in the letters 'XWELL'. It is true that the signs differ in their initial letters, 'X' versus 'K', and in the hyphen of the earlier trade mark, which create certain differences between the signs. However, in the case at issue, the coincidences in the signs prevail over the differences. Although the phonetic effect of the different initial letters, 'X' versus 'K', in the signs is detectable, these letters are not very different from a visual perspective. In addition, the letters in the signs are not represented in a graphically noticeable way that would enable them to be easily distinguished, and the

signs are of the same length. Furthermore, the signs do not have any concept for the German consumer.

Having regard to all the above factors, the Opposition Division considers that the similarities between the marks are sufficient to trigger likelihood of confusion on the part of the public. It is likely that the relevant public, on being exposed to the use of both signs in relation to identical and similar goods and having an imperfect recollection of the earlier mark, might think that the goods on which the later mark appears are produced/provided by the same undertaking as the goods and services sold or offered under the mark of which the consumer has only an imperfect recollection.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public and therefore the opposition is partially well founded on the basis of the opponent's German trade mark registration.

It follows from the above that the contested trade mark must be rejected for the goods found to be identical or similar to the goods and services of the earlier trade mark. The opposition is not successful insofar as the remaining dissimilar goods are concerned.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party. According to Article 85(2) CTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Opposition Division shall decide a different apportionment of costs.

Since the opposition is successful only for part of the contested goods, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



The Opposition Division

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Liliya YORDANOVA

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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.