



OPPOSITION No B 1 978 108

Friedemann Ehninger, Katharinenstr. 15, 70182 Stuttgart, Germany (opponent),
represented by **Thorsten Meyer**, Pfarrer-Schultes-Weg 14, 89077 Ulm, Germany
(professional representative)

a g a i n s t

MYBODY L.L.C., 2398 E. Camelback Rd., Suite 1020, Phoenix AZ 85016, United
States of America (holder), represented by **A.A. Thornton & Co.**, 235 High Holborn,
London WC1V 7LE, United Kingdom (professional representative).

On 02/05/2013, the Opposition Division takes the following

DECISION:

1. Opposition No B 1 978 108 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against all the goods and services of international
registration designating the European Union No 1 087 105



. The opposition is based on Community trade mark
registration No 8 187 593 for the word mark 'MYBODY'. 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 services on which the opposition is based are the following:

Class 35: Updating and maintenance of data in computer databases; collating of data in computer databases; database management; systematic ordering of data in computer databases; on-line advertising in computer networks; presentation of companies on the Internet and other media; presentation of services on communications media; rental of advertising space on the Internet; arranging of trading and economical contacts, also over the Internet; advertising, for others, in particular on the Internet; market research; market analysis; electronic data storage; electronic data processing consultancy, namely consultancy in connection with computer hardware.

Class 38: Procuring access to databases; providing access to information on the Internet; telecommunications; telecommunications by means of platforms and portals on the Internet; arranging access to databases on the Internet; providing access to online information retrieval.

Class 42: Consultancy relating to computer software and computer networks; technical project management in the field of electronic data processing; rental and maintenance of memory space for website applications, for others (hosting); providing or rental of electronic storage space (webspace) on the Internet; updating of Internet pages and computer databases; consultancy with regard to the design of homepages and Internet pages; provision of search engines for the Internet; designing and creating homepages and Internet pages; rental of web servers; providing of entertainment programs (software) on the Internet; providing an e-commerce and/or information platform on the Internet.

The contested goods and services are the following:

Class 3: Body scrub; cosmetic creams; hair shampoos and conditioners; non-medicated lip protectors; non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels; soaps for body care; anti-wrinkle creams; cloths or tissues impregnated with a skin cleanser; feminine deodorant sprays; feminine deodorant suppositories; feminine hygiene cleansing towelettes; non-medicated anti-aging serum; non-medicated feminine hygiene wash; non-medicated skin creams; skin lightening creams; skin masks; skin moisturizer; sun screen; wrinkle removing skin care preparations.

Class 5: Medicated skin care preparations; medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels; medicinal creams for skin care; non-medicated, therapeutic skin creams for the treatment of acne; nutritional supplements for promoting healthy skin; nutritional supplements in lotion form for skin care; vaginal moisturizers; vaginal preparations, namely, antifungals; vaginal washes; dietary and nutritional supplements; nutraceuticals for use as a dietary supplement; vitamins and vitamin preparations.

Class 35: *On-line retail store services featuring skin care products, perfume, vitamins and nutraceuticals; retail store services featuring skin care products, perfume, vitamins and nutraceuticals.*

Contested goods in Classes 3 and 5

The contested goods consist of cosmetics and toilet preparations in Class 3 and medicated and sanitary preparations, dietary and nutritional supplements in Class 5. On the other hand, the opponent's services are mainly business administration services, advertising, market research, telecommunications services, consultancy, design and development of software, internet pages and computer networks. These services are provided by consultants, advertising agencies, telecommunications agencies and IT consultants and companies. These goods and services in conflict do not have any relevant point of connection, taking into account the abovementioned Canon criteria. They have a different nature (physical goods versus intangible activities) and their purpose and method of use are different. They are also provided or manufactured by different companies and they are neither in competition with each others nor complementary. Obviously, the mere fact that the opponent's goods may appear in advertisements or may be the subject of market analysis and market research is insufficient for finding a similarity since the nature and purpose of these services are fundamentally different from the manufacture of goods. Therefore, it is concluded that the goods and services in conflict are different.

Contested services in Class 35

The contested services are retail services including online retail store services in relation to cosmetics, perfumery, vitamins and nutraceuticals. They consist in bringing together, and offering for sale, a wide variety of different products, thus allowing consumers to conveniently satisfy different shopping needs at one stop. These services are not similar to the opponent's services in Classes 35, 38 and 42, which mainly consist in business administration services, advertising, market research, telecommunications services, consultancy, design and development of software, internet pages and computer networks, and which are rendered by consultants, advertising agencies, telecommunications agencies and IT consultants and companies. The conflicting services have a different nature, purpose and method of use and they are not rendered by the same companies.

The opponent argues that the contested retail services are similar to the advertising services covered by the earlier mark to the extent that retail services include the presentation of goods to customers. The Opposition Division does not share this point of view. Indeed, *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 fulfill 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, web sites, videos, the internet, etc. These services are rendered by advertising agencies to professionals and, although they provide assistance in the sale of goods, their core business is not the selling of goods to the final customers. In the same way, although retail companies usually advertise their goods, they do not provide advertising services to third parties.

Therefore the contested services are considered dissimilar to all the services covered by the earlier mark.

b) Conclusion

Article 8(1)(b) CTMR states that 'the trade mark applied for shall not be registered: if because of its identity with or similarity to the earlier trade mark **and** the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark' (emphasis added).

According to Article 8(1)(b) CTMR, the similarity of the goods or services is a condition for a finding of likelihood of confusion. Since the goods and services are clearly dissimilar, one of the necessary conditions of Article 8(1)(b) CTMR is not fulfilled, and the opposition must be rejected.

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

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



The Opposition Division

Juan-Antonio MORALES
PAREDES

Frédérique SULPICE

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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.