

OPPOSITION No B 2 767 732

Gap (ITM) Inc., 2 Folsom Street, 94105 San Francisco, United States of America (opponent), represented by **NautaDutilh**, Chaussée de la Hulpe, 120, 1000 Bruxelles, Belgium (professional representative)

a g a i n s t

STMicroelectronics International N.V., Schiphol Boulevard 265, 1118 BH Schiphol, Netherlands (applicant), represented by **Casalonga Alicante, S.L.**, Avenida Maisonave, 41-6C, 03003 Alicante, Spain (professional representative).

On 31/05/2018, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 767 732 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

Preliminary Remark

As from 01/10/2017, Regulation (EC) No 207/2009 and Regulation (EC) No 2868/95 have been repealed and replaced by Regulation (EU) 2017/1001 (codification), Delegated Regulation (EU) 2017/1430 and Implementing Regulation (EU) 2017/1431, subject to certain transitional provisions. Further, as from 14/05/2018, Delegated Regulation (EU) 2017/1430 and Implementing Regulation (EU) 2017/1431 have been codified and repealed by Delegated Regulation (EU) 2018/625 and Implementing Regulation (EU) 2018/626. All the references in this decision to the EUTMR, EUTMDR and EUTMIR should be understood as references to the Regulations currently in force, except where expressly indicated otherwise.

REASONS

The opponent filed an opposition against all the goods of European Union trade mark application No 15 620 081 for the word mark 'gapDRIVE', namely against all the goods in Class 9. The opposition is based on European Union trade mark registrations No 10 658 102, No 8 784 027 and No 4 550 778, all for the word mark 'GAP'. The opponent invoked Article 8(1)(b) EUTMR.

PROOF OF USE

In accordance with Article 47(2) and (3) EUTMR, if the applicant so requests, the opponent must furnish proof that, during the five-year period preceding the date of filing or, where applicable, the date of priority of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the opponent cites as justification for its opposition, or that there are proper reasons for non-use. The earlier

mark is subject to the use obligation if, at that date, it has been registered for at least five years.

The same provision states that, in the absence of such proof, the opposition will be rejected.

The applicant requested that the opponent submit proof of use of two of the trade marks on which the opposition is based, namely European Union trade marks No 8 784 027 and No 4 550 778, both for the word mark 'GAP'.

The request was submitted in due time and is admissible given that the earlier trade marks were registered more than five years prior to the relevant date mentioned above.

The date of priority of the contested application is 05/07/2016. The opponent was therefore required to prove that the trade marks on which the opposition is based were put to genuine use in the European Union from 05/07/2011 to 04/07/2016 inclusive.

Furthermore, the evidence must show use of the trade marks for some of the goods and services on which the opposition is based, namely the following goods:

EUTM No 4 550 778:

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling 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; magnetic encoded cards and cards containing an integrated circuit chip, namely, smart cards containing programming used to purchase merchandise and services.*

EUTM No 8 784 027:

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling 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.*

The Opposition Division notes that the applicant's request for proof of use did not cover all goods and services covered by the two EUTMs and invoked by the opponent as basis of the opposition but was limited to the goods for which the marks were registered in Class 9. Consequently and despite the request in the Office's letter of 06/06/2017, the opponent was not required to submit proof of use with regard to the goods and services covered by EUTM No 8 784 027 in Classes 14 and 35.

The Opposition Division finds it necessary to clarify that the opponent submitted on 22/09/2016 declarations pursuant to Article 33(8) EUTMR (former Article 28(8)

EUTMR, in force before 01/10/2017) indicating that its intention on the date of filing of the earlier marks had been to seek protection in respect of goods in Class 9 beyond those covered by the literal meaning of the heading of that class, namely *containers for contact lenses; electronic publications, downloadable; eyeglass cases; eyeglass chains; eyeglass cords; eyeglass frames; hair-curlers, electrically heated; magnets; magnets (decorative -); make-up removing appliances, electric; mouse pads; spectacle cases; spectacle frames* (the opponent's declaration also covered following goods in Class 14: *cases for watches [presentation]; cases for clock- and watchmaking; key rings [trinkets or fobs]; watch bands; watch cases; watch chains; watch glasses*).

However, the effects of amending the list of goods and services of EUTMs further to declarations under Article 33(8) EUTMR are laid down in Article 33(9) EUTMR (former Article 28(8) EUTMR and Article 28(9) EUTMR, in force before 01/10/2017). Accordingly amending the list of goods and services of the earlier EU trade mark will not give the proprietor the right to prevent third parties from using any of the added goods or services, on the understanding that the use commenced before the register was amended and did not infringe the proprietor's rights on the basis of the literal meaning of the goods and services in the register at that time.

Furthermore, the proprietor will not have the right to oppose to a later trade mark if that later trade mark was in use or had been applied for prior to the register being amended, and that the use in relation to those goods or services did not infringe, or would not have infringed, the proprietor's rights based on the literal meaning of the goods or services recorded in the register at that time.

Consequently, the Opposition Division will proceed the examination of the proof of use and of the present opposition only on the basis of the above indicated goods in Class 9.

According to Article 10(3) EUTMDR (former Rule 22(3) EUTMIR, in force before 01/10/2017), the evidence of use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which the opposition is based.

On 06/06/2017, in accordance with Article 10(2) EUTMDR (former Rule 22(2) EUTMIR, in force before 01/10/2017), the Office gave the opponent until 11/08/2017 to submit evidence of use of the earlier trade marks. On 10/08/2017, within the time limit, the opponent submitted evidence of use.

As the opponent requested to keep certain commercial data contained in the evidence confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data.

The evidence to be taken into account is the following:

- **Exhibits 1a and 1b:** Affidavits of the opponent's President in relation to the use of the earlier marks for sunglasses in the EU attesting that sunglasses have been sold in the EU under the mark 'GAP' since at least 2007 and providing sales figures for the years 2011 – 2017 inclusive;
- **Exhibit 2:** Pictures of the 'GAP' sunglasses, not dated (currently in stores, according to the opponent);
- **Exhibit 3:** Print-outs dated 21/06/2017 and 21/03/2012 from www.gap.eu, where sunglasses are offered for sale;

- **Exhibit 4:** An excerpt of the presentation book for the summer 2012 'GAP' sunglasses collection distributed to 'GAP' retail stores in European countries;
- **Exhibit 5:** An excerpt of the presentation book for the summer 2012 'GAP' sunglasses collection;
- **Exhibit 6:** Sunglasses price stickers for different EU countries (with an indication Summer 2011);
- **Exhibit 7:** A price list including sunglasses (for 1999);
- **Exhibit 8:** Presentation book for the GAP summer sunglasses collection (according to the opponent, for the year 2000, the documents is, however, not dated);
- **Exhibit 9:** Presentation book for the GAPKids summer 2003 sunglasses collection;
- **Exhibit 10:** Press clippings of publications dated or referring to the years 1997 – 2004 mentioning GAP clothing, GAP jackets with interior headphone ports, GAP ski goggles, GAP beachwear, bags, GAP eau de toilette and publications clearly not targeting the EU consumers, for example listing GAP among China Top Brands; several publications from 2009 mentioning a collaboration between GAP and the designer Stella McCartney;
- **Exhibit 11:** Articles published in 2011 in relation to the gap store music playlist and in 2000, 2005 showing that 'GAP' offers customers free music downloads and CDs with music to promote GapKids stores;
- **Exhibits 12a – 12f:** Articles published online in different countries/languages in 2010 in relation to the GAP iPad App;
- **Exhibits 12g – 12h bis:** Articles published online in 2010 and May 2011 in relation to the opponent's app GapStyleMixer;
- **Exhibit 12i:** An article entitled 'PracticalEcommerce: Multichannel Case Study: Gap Inc' dated 21/06/2013;
- **Exhibit 12j:** A publication on GAP Global Buzz published on 18/06/2014, entitled 'Le Record Store' reporting on the launching of a partnership between the opponent and the French music label PIAS by selling discs and jeans;
- **Exhibit 12k:** An article dated in May 2016 reporting on the launching of a new app (GAP+) by the opponent;
- **Exhibit 12l:** An Article entitled 'American Eagle, The Gap, TopShop ranked top mobile fashion retail apps', published on 22/06/2017 on www.retailcustomerexperience.com;
- **Exhibits 12m and 12n:** Articles published in January 2017 in relation to the new pilot app by the opponent called the Dressing Room;
- **Exhibit 13:** A document of unknown source with what seems to be statistical data with regard to the Gap+ Loyalty App;

- **Exhibit 14:** Opponent's internal documents relating to the use of the loyalty cards in the Gap stores, namely Presentation of Gap's gift card packaging and presentation in stores, Gift Card Direction and Holiday Gift Card Directive;
- **Exhibit 15:** Article (published in 2012) about GAP's partnership with keyboard manufacturer Yamaha aimed to encourage people to play piano;
- **Exhibit 16:** TENET 2015 Top 100 Most Powerful brands wherein GAP is ranked 50 in the Retailers Industry;
- **Exhibits 17 - 19:** Interbrand's surveys of 'Best Global Brands' for 2011 to 2014 (GAP is mentioned each year in the field of retail apparel); Interbrand's survey of 'Best Retail Brands 2012' mentioning GAP as the world's megabrand for denim; Interbrand's 2013 analysis of the 'Best Global Brands' in the apparel sector including GAP ranked 100;
- **Exhibit 20:** CoreBrand's survey of the 'Most Familiar Brands 2014' including GAP in the sector Consumer-Cyclical;
- **Exhibit 21:** Article published in 2004, entitled 'GAP goes all technical' mentioning GAP jackets with interior headphone ports;
- **Exhibit 22:** Examples of Gap's clothing (hats and hoodies) with headphones and jacks (using integrated HB3 Technology) from the opponent's website and two further sites (dated in 2014) and a Google search report dated in 2014;
- **Exhibit 23:** Examples of 'O'NEILL' accessories: headphones;
- **Exhibit 24:** Examples of 'RALPH LAUREN' accessories: home furniture, lighting, phone cases, glasses, etc.;
- **Exhibit 25:** Examples of 'URBAN OUTFITTERS' accessories: speakers, record players, headphones, keyboards, radios, etc.;
- **Exhibit 26:** Examples of 'ZARA home' accessories: home furniture, CDs, lighting, glasses, etc.

On 15/01/2018, after expiry of the time limit, the opponent submitted additional evidence, consisting of two Affidavits issued by a representative of the opponent providing clarifications in relation to Exhibits 13 and 14 (confirming the periods and dates of the Exhibits concerned and stating that the information is true).

Even though, according to Rule 22(2) EUTMIR (in force at the moment of filing the request for proof of use), the opponent has to submit proof of use within a time limit set by the Office, this cannot be interpreted as automatically preventing **additional** evidence from being taken into account (18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 28). The Office has to exercise the discretion conferred on it by Article 95(2) EUTMR (18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 30).

Although the additional evidence was submitted outside the set time limit, it relates to the evidence previously submitted and is therefore relevant. At this point, the Opposition Division considers it appropriate to take into account in the examination

also the belated evidence submitted by the opponent, which will not be to the applicant's prejudice, as will be seen below.

In accordance with Article 10(3) EUTMDR, the indications and evidence required in order to provide proof of use must consist of indications concerning the place, time, extent and nature of use of the opponent's trade mark for the relevant goods and services.

These requirements for proof of use are cumulative (judgment of 05/10/2010, T-92/09, STRATEGI, EU:T:2010:424, § 43). This means that the opponent is obliged not only to indicate but also to prove each of these requirements.

As regards the extent of use, all the relevant facts and circumstances must be taken into account, including the nature of the relevant goods or services and the characteristics of the market concerned, the territorial extent of use, and its commercial volume, duration and frequency.

The assessment of genuine use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. Likewise, the territorial scope of the use is only one of several factors to be taken into account, so that a limited territorial scope of use can be counteracted by a more significant volume or duration of use.

The Opposition Division notes upfront that the opponent's evidence (as also clarified in the opponent's observations) concerns the following goods, covered by the opponent's specification in Class 9: sunglasses and goggles, 'music-related goods', CDs, mobile apps and USB memory sticks containing music and magnetic data carriers (such as consumer loyalty cards).

A significant part of the evidence is either not dated or is dated outside and does not refer to the relevant period, in particular Exhibit 2, part of Exhibit 3, Exhibits 7 - 10, 12a - 12h *bis* and 21 concern a period of time preceding the relevant period and Exhibits 12l - 12n are dated after the relevant period. Evidence referring to use made outside the relevant time frame is in general immaterial, unless it constitutes conclusive indirect proof that the mark must have also been put to genuine use during the relevant period. However, this is not the case with regard to the said evidence submitted by the opponent because it is mostly not close to the relevant period of time (by way of example, Exhibits 7 - 10 are dated years before the beginning of the relevant period) and, in any case, it does not contain conclusive indications as to use within the relevant period. Therefore, this evidence cannot prove useful for the purposes of establishing genuine use of the earlier marks within the relevant period.

The remaining documents filed do not provide the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use.

According to the case-law, there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Moreover, the condition of genuine use of the mark requires that that mark, as protected in the relevant territory, be used publicly and outwardly (08/05/2014, T-38/13, Pedro, EU:T:2014:241, § 15).

The brand rankings submitted as Exhibits 16 – 20 show that the opponent's marks 'GAP' are listed among the leading retail apparel brands but contain no reference to the relevant goods in Class 9. The analysis in the 2013 Interbrand report as regards efficient e-commerce and the need for change for apparel brands and the reference to clothing brands which already have expanded to Class 9 goods (with examples submitted in Exhibits 23 – 26) do not automatically imply that the opponent's mark has been used with respect to goods in Class 9.

While it is true that in the evidence submitted as Exhibits 21 and 22 references to GAP going 'technical' and to clothing with headphone ports and headphones can be found, account is to be taken of the fact that Exhibit 21 is dated outside the relevant period and the few printouts of websites and the one page Google search report cannot be sufficient evidence as to the extent of use of GAP in relation to goods in Class 9. The mere presence of a trade mark on a website is, of itself, not sufficient to prove genuine use unless the website also shows the place, time and extent of use or unless this information is otherwise provided which is not the case.

It is not possible to deduce the existence of actual business activities, and even less of activities which have a certain economic dimension, from the mere presence of an Internet site. The existence of a website that is established by the submission of screen shots does not establish the intensity of the alleged commercial use of the rights relied on, which may be shown by, inter alia, a certain number of visits to the site, the emails received via the site or the volume of business generated.

The opponent submitted several affidavits with a view to establishing genuine use for the relevant goods, in particular as regards sunglasses, magnetic data carriers and the mobile apps.

Article 10(4) EUTMDR (former Rule 22(4) EUTMIR, in force before 01/10/2017) expressly mentions written statements referred to in Article 97(1)(f) EUTMR as admissible means of proof of use. Article 97(1)(f) EUTMR lists means of giving evidence, amongst which are sworn or affirmed written statements or other statements that have a similar effect according to the law of the State in which they have been drawn up. As far as the probative value of this kind of evidence is concerned, statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by its personal interests in the matter.

However, this does not mean that such statements do not have any probative value at all.

The final outcome depends on the overall assessment of the evidence in the particular case. This is because, in general, further evidence is necessary to establish use, since such statements have to be considered as having less probative value than physical evidence (labels, packaging, etc.) or evidence originating from independent sources.

Bearing in mind the foregoing, it is necessary to assess the remaining evidence to see whether or not the contents of the declaration are supported by the other items of evidence.

The excerpts of the presentation books for the 'GAP' sunglasses collection are not proof that the respective goods have been effectively commercialised within the relevant market. They neither contain any reference regarding commercial

transactions nor indicate when or to what extent the earlier signs have come to the attention of the public.

The materials submitted as Exhibit 14 are internal documents of the opponent and are not convincing proof that they were distributed to a potential clientele, the extent of any distribution or the amount of sales of goods (loyalty cards) resp. the turnover achieved under the earlier marks.

The opponent has submitted various pieces of evidence in relation to its mobile applications. As explained above, most of the evidence does not relate to the relevant period and, moreover, cannot corroborate that part of the evidence that does fall within the relevant period. Indeed, several publications dated within the relevant period make reference to opponent's apps (e.g. GapStyleMixer and GAP +). Furthermore, the evidence in Exhibit 13 seems to contain further indications in relation to the app GAP +. However, even taking into account the opponent's affidavit submitted together with the opponent's last observations, it remains unclear what the source of the document and of the information in the document is and, moreover, there are no indications how the earlier marks were used in relation to the goods in question. In particular, it remains unclear what the term 'recruitment' means and what a 'membership' entails (does the data refer to clients who have accessed the app, downloaded the app, made orders by means of the app, paid for the app, is the use of the app with a view to promotion of apparel, etc.). The materials in Exhibit 13 cover a limited period of time within the relevant period and, furthermore, from the totality of the evidence on file and not applying a piecemeal approach, no conclusive data on the territorial scope, duration and frequency of use as well as on the commercial volume under the earlier marks in relation to apps can be deducted.

Along a similar line of reasoning, the isolated mentioning in a publication originating from the opponent as regards the sale of CDs (Exhibit 12j) cannot be deemed sufficient evidence as regards the extent of use of the earlier marks with regard to such goods. Even more so, a statement that GAP is known for the music played in its stores does not constitute sufficient evidence of genuine use.

The affirmations of the opponent are not backed by any additional evidence such as figures provided regarding promotional or advertising expenditure, proof originating from independent sources of information, invoices, turnover generated under the earlier signs, information on the quantity of products actually sold under the earlier signs. In short, there is nothing to indicate the scale of commercial activity undertaken by the opponent in relation to the marketing and promotion of the goods concerned under the earlier signs.

Therefore, the Opposition Division considers that the opponent has not provided sufficient indications concerning the extent of use of the earlier marks.

The Court of Justice has held that there is 'genuine use' of a mark where it is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Furthermore, the condition of genuine use of the mark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145 and 12/03/2003, T-174/01, *Silk Cocoon*, EU:T:2003:68).

The Opposition Division concludes that the evidence furnished by the opponent is insufficient to prove that the earlier trade mark was genuinely used in the relevant territory during the relevant period of time.

Consequently, even taking into account the belated evidence submitted by the opponent, the required genuine use of the earlier trade marks has not been proven and the Opposition Division considers it unnecessary to reopen the proceedings and give the applicant an opportunity to comment on that evidence.

Therefore, the opposition must be rejected pursuant to Article 47(2) EUTMR and Article 10(2) EUTMDR (former Rule 22(2) EUTMIR, in force before 01/10/2017), as far as it is based on the goods in Class 9 covered by the earlier EUTMs No 4 550 778 and No 8 784 027. The examination of the present opposition will continue with regard to the remaining goods and services covered by EUTM No 8 784 027 and with regard to EUTM No 10 658 102 which were not subject to proof of use.

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

EUTM No 8 784 027

Class 14: *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.*

Class 35: *Providing on-line retailing services and on-line ordering services in the field of bags, bedding, clothing, clothing accessories, cosmetics, footwear, food and beverage products, fragrances, giftware, glassware, hair accessories, headgear, house wares, home furnishings, jewelry, leather goods, personal care products, stationery, sunglasses, toiletries, toys and games, and other merchandise connected to the aforementioned products; computer on-line ordering services; business management; business administration; office functions; operation of consumer loyalty programs; mail order catalogue services; promotional services in a wide variety of general merchandise; rental of advertising space on the Internet.*

EUTM No 10 658 102

Class 9: *Computer application software for mobile phones that enables customers to search an online searchable database in the field of*

clothing, accessories, bags, shoes, personal care products and home products to purchase consumer goods and view retail product information.

The contested goods are the following:

Class 9: *Semi-conductors; integrated circuits; microprocessors; micro controllers; embedded microprocessors; integrated circuit cards; integrated circuit chips; printed electronic circuits for integrated circuit apparatus and cards.*

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 main point of dispute between the parties as regards the comparison of the goods and services is the issue whether the opponent's software may be considered to be similar to the contested goods in Class 9. Both parties provide extensive arguments and make references to previous case-law they consider relevant.

The opponent's goods in Class 9 are application software, also known as 'an app', that is *computer software* that is designed to help the user perform various tasks on a mobile phone. Application software differs from system software in that it can be accessed by the user and run on a mobile device. Application software is usually designed with the user in mind. As evident from the opponent's specification, the target users of its app are general consumers of ordinary consumer goods (clothing, accessories, home products, etc.).

The contested goods are all electrical and electronic components which can be used as components/parts of computers/mobile devices, etc. While it is true that both the applicant's and the opponent's goods may be found to belong, broadly speaking, to the information technology field, this, on its own, is not sufficient for establishing a relevant similarity. Even if a general link between software and the contested goods can be established (because the goods could be used together or even a certain complementarity relationship may exist), in today's high-tech society, almost all electronic or digital apparatus and devices function using integrated software and software is used on hardware. This does not, however, lead to the automatic conclusion that all software is similar to goods that use software to function successfully and vice versa. It is also to be taken into account that there are many types of software, and although software by nature is the same, this does not mean that their specific purpose is the same.

The opponent maintains that the conflicting goods have the same nature, end users and distribution channels. The Opposition Division does not concur with these allegations. In the first place, it cannot be claimed that the goods have the same nature, the contested being electrical and electronic components and the opponent's goods being programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation.

The contested goods are rather specialised goods normally directed at manufacturers of various devices (within and outside the IT industry) while the opponent's goods in Class 9 target the public at large. Admittedly, it cannot be excluded that the relevant consumer of the contested goods comprises also non-professional end users who

assemble the component parts of their computer hardware themselves (as indicated in the some of the previous cases referred to by the opponent).

However, the mere fact that the potential customers coincide does not automatically constitute an indication of similarity. The same group of customers may be in need of goods or services of the most diverse origin and nature. The fact that, for example, television sets, cars and books are bought by the same relevant public, namely the public at large, has no impact on the analysis of similarity. In the present case, even if it is held that both lists of conflicting goods target the public at large, the purpose (of covering customers' needs) is clearly different in each case. Such circumstances weigh against similarity.

The conflicting goods have in addition a different purpose and do not coincide in distribution channels. They are not complementary to or in competition with each other and are normally produced by different companies. Therefore, the conflicting goods in Class 9 are dissimilar.

The above findings are not called into question by the opponent's reference to numerous previous decisions of the Office (first instance as well as Boards of Appeal) and even a judgment of the General Court because in none of the cases a similarity was established on account of the particular type of application covered by the earlier mark. Furthermore, the comparison in the cases referred to by the opponent in relation to the principle of sound administration did not extend to these goods covered by its earlier marks.

The remaining opponent's goods and services are even further away from the contested goods.

The opponent's goods in Class 14 are various goods of precious metals and their alloys, jewelry, precious stones, timepieces and chronometric instruments. The goods under comparison have different nature and method of use. In addition, the intended purpose of these goods is entirely different and they do not have the same commercial origin. Furthermore, they are normally distributed through different channels and they are neither complementary to nor in competition with each other. Consequently, the contested goods are dissimilar to all the opponent's goods in Class 14.

The opponent's services in Class 35 are either online retailing or online ordering services in relation to various goods or specialised services aimed at supporting or helping other businesses to do or improve business.

The opponent's *online retailing or online ordering* services and the contested goods are not similar. Apart from being different in nature, since services are intangible whereas goods are tangible, they serve different needs. *Retail services* 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. This is not the purpose of goods. Furthermore, goods and services have different methods of use and are neither in competition nor complementary.

Similarity between retail services of specific goods covered by one mark and specific goods covered by another mark can only be found where the goods involved in the retail services and the specific goods covered by the other mark are identical. This condition is not fulfilled in the present case, since the goods at issue are not identical.

As regards the business-to-business services in Class 35, they also have no relevant points of contact with the contested goods. Apart from being different in nature, they

have different purposes, distribution channels and origins. Furthermore, they are not in competition with or complementary to each other. Therefore, they are also dissimilar.

b) Conclusion

According to Article 8(1)(b) EUTMR, 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) EUTMR is not fulfilled, and the opposition must be rejected.

The opponent stated that the applicant filed the contested trade mark in bad faith. This cannot be a basis for the opposition. Article 46 EUTMR states that an opposition can only be filed on the grounds set forth in Article 8 EUTMR. Since this Article does not include bad faith as a ground for opposition, this argument of the opponent cannot succeed.

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) EUTMIR (former Rule 94(3) and Rule 94(7)(d)(ii) EUTMIR, in force before 01/10/2017), 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

Claudia MARTINI

Denitza STOYANOVA-
VALCHANOVA

Martin EBERL

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.