

OPPOSITION No B 2 534 686

CBS Studios Inc., 4024 Radford Avenue, Studio City, California 91604, United States of America (opponent), represented by **Casalonga Alicante, S.L.**, Avenida Maisonnave, 41-6C, 03003 Alicante, Spain (professional representative)

a g a i n s t

Baidu Online Network Technology (Beijing) Co., Ltd., Baidu Campus, No. 10, Shangdi 10th Street, Haidian District, Beijing, The People's Republic of China (applicant), represented by **Guy Delhaye**, 2, rue Gustave de Clausade, 81800 Rabastens, France (professional representative).

On 08/11/2016, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 534 686 is upheld for all the contested goods.
2. European Union trade mark application No 13 734 595 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 650.

REASONS:

The opponent filed an opposition against all the goods of European Union trade mark application No 13 734 595. The opposition is based on, inter alia, United Kingdom trade mark registration No 2 621 228. The opponent invoked Articles 8(1)(b), 8(5) and 8(4) EUTMR.

REPUTATION – ARTICLE 8(5) EUTMR

For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier United Kingdom trade mark registration No 2 621 228, for which the opponent claimed reputation in the United Kingdom.

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark shall not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds of refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: the use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The above-mentioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-345/08, & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) The signs



Earlier trade mark



Contested sign

The relevant territory is the United Kingdom.

Visually, the signs are similar to the extent that they both contain an arrowhead-shaped white device set against a black rectangular background. In both signs, the same left end of the device is elongated. The signs differ in that the device in the earlier mark only has white contours and is black inside with an additional element inside, namely a white star with one arm extended, so that it makes an impression of a falling star. The device of the contested sign is all white and surrounded by a white circle intersecting the longer end of the device. Furthermore, in the bottom right corner of the contested sign, there are the grey letters 'du'. Finally, the corners of the rectangular black background are rounded in the contested sign. Therefore, the signs are visually similar to a low degree.

Purely figurative signs are not subject to a phonetic assessment. As both signs are purely figurative, it is not possible to compare them aurally.

Conceptually, some consumers might perceive a rocket or arrowhead shape in both marks. The relevant public will also perceive the star in the earlier mark. The signs are conceptually similar to an average degree for these consumers. For the remaining part of the public, only perceiving the star in the earlier mark and not associating the signs with other concepts, the signs are not conceptually similar.

Taking into account the abovementioned visual coincidences, the signs under comparison are similar to a certain degree.

b) Reputation of the earlier trade mark

According to the opponent, the earlier trade mark has a reputation in the United Kingdom.

Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case the contested trade mark was filed on 12/02/2015. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation in the United Kingdom prior to that date. The evidence must also show that the reputation was acquired for the services for which the opponent has claimed reputation, namely

Class 38: *Telecommunications; broadcasting services, in particular the electronic and interactive transmission of downloads and streaming digital audio, voice, data, images, signals, video, graphics, text and data through the media of television, cable, satellite, radio, telephone and broadband systems, and via the Internet, and portable and wireless communication devices; provision of telecommunication access and links to computer databases and the Internet; streaming of audio and video content; providing downloadable audio, visual, audio visual recordings via the Internet; providing information via computer networks, global communications network, dial up service or via non-downloadable publications in electronic form; video-on-demand transmission services.*

Class 41: *Entertainment; providing interactive entertainment services, providing personalised television programming; providing an online and on-screen guide to personalised and interactive television programming; entertainment in the nature of television programming, cable television programming, satellite television programming, internet programming and programming via wireless and mobile networks; video programming via the internet and wireless and mobile networks; programming of television shows; production of television, cable, video-on-demand, digital, satellite, wireless, mobile, and internet programs and entertainment media content; production and programming of audio and video content; motion picture film production and distribution; providing entertainment information to others via a global computer network.*

In order to determine the mark's level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

On 04/02/2016 the opponent submitted the following evidence:

- Affidavit of Vice President, Assistant General Counsel Intellectual Property for CBS Corporation, dated 08/12/2015. It contains the information about the opponent and earlier mark, including the historical facts, revenue generated worldwide by the television broadcast licenses for these productions. It is explained that among the audio-visual programs produced by the opponent and its predecessor, are the following television series: 'Star Trek', 'Star Trek: The Next Generation', 'Star Trek: Deep space Nine', 'Star Trek: Voyager', 'Star Trek: Enterprise' and 'Star Trek: The Animated Series'. It is explained that since the introduction of 'STAR TREK' television series in 1966, they have achieved enormous popularity and that they have aired on broadcast, cable, satellite services and/or in syndication for almost fifty continuous years and have been viewed on television in more than 191 countries, including in Europe, on videocassettes, DVDs and via the Internet. The affidavit also contains the explanation of the evidence.
- Copies of articles from publications such as *Daily Mail*, *The Guardian*, about 'STAR TREK' series and movies with pictures of casts with arrowhead-shaped patches (called the 'Delta Shield' or 'Double Parabola' insignia, as explained in the affidavit) featured on their uniforms.
- Copies of pages from the websites www.liberation.fr, <https://fr.wikipedia.org>, www.tele5.de, <http://newsroom.chellzone.com>, www.cbcorporation.com, www.richmondevents.com, www.studiohansa.com, <http://memory-alpha.wikia.com>, www.syfy.co.uk, www.canalplus.fr and screenshots of pages from www.youtube.com and www.startrek.com, showing 'Syfy UK' advertisement for 'Star Trek Zone'. They contain information concerning the availability of 'STAR TREK' series on channels such as 'Jimmy', 'Syfy', 'Tele5', 'CBS Action', 'CBS Chello Zone', 'BBC' and 'Canal+'. Some of these pages contain dates in the years 2010-2013. On a page from <http://memory-alpha.wikia.com>, there is also a reference to the history of the series' broadcast dating back to 1960s.
- Copies of pages from www.boxofficemojo.com, showing foreign box office revenue for the movies 'Star Trek Into Darkness' (release date May 16, 2013), 'Star Trek XI' (release date May 8, 2009) and 'Star Trek Nemesis' (release date December 13, 2002). According to the information contained therein, the foreign box office revenue for France, Germany and the United Kingdom was the following:
 - 'Star Trek Into Darkness': 7 878 281 USD in France, 20 606 804 USD in Germany and 39 356 029 USD in the United Kingdom;
 - 'Star Trek XI': 6 976 214 USD in France, 12 798 139 USD in Germany and 35 392 062 USD in the United Kingdom;
 - 'Star Trek Nemesis': 265 455 USD in France, 8 284 148 USD in Germany and 7 628 023 USD in the United Kingdom.
- Printouts from www.imdb.com with the list of nominations and awards for 'Star Trek: The Next Generation' (1987-1994), showing 60 nominations and 33 wins in various years between 1988 and 2014, 'Star Trek: Deep Space Nine' (1993-1999), showing 49 nominations and 14 wins in various years between 1993 and 2005, 'Star Trek: Voyager' (1995-2001), showing 56 nominations and 26 wins in various years between 1995 and 2005, 'Star Trek: Enterprise' (2001-

2005), showing 29 nominations and 11 wins in various years between 2002 and 2006.

- Photographs of casts of the 'STAR TREK' series and movies with arrowhead-shaped patches (called the 'Delta Shield' or 'Double Parabola' insignia, as explained in the affidavit) featured on the upper left parts of their uniforms.
- Images of posters for the 'STAR TREK' movies with the 'Delta Shield' displayed on the posters or uniforms of casts appearing on the pictures. One poster is dated 05/08/2009 and some have 'IN THEATRES 2009' displayed on them. Copies of some pages from 'TV Gude' magazine with an article entitled 'J.J. Abrams takes command of the Star Trek franchise, boldly going for broke with a gripping new movie'. Printouts from www.nytimes.com with a review of a movie 'Star Trek Into Darkness', directed by J.J. Abrams. The article is dated 15/05/2013.
- A printout from www.asctec.de/en containing the article entitled '(F)lightshow über London – 30 AscTec Hummingbirds display the Star Trek Logo', dated 27/03/2013, informing about the harbinger for the film 'Star Trek – Into Darkness', starting in Europe's cinemas. It is reported about a light show made by 30 mini-helicopters drawing the Star Trek logo (the 'Delta Shield') with the LED lights on the sky over the city of London. There is also a picture of the night show.
- Printouts from www.rollingstone.com, www.nydailynews.com and copies of pages with reviews of the film 'Star Trek into darkness'. They are dated May 2013.
- Screenshots and printouts from websites, including www.amazon.fr, www.amazon.co.uk and www.amazon.de, with offers of the 'Star Trek' movies and series in DVD formats. The 'Delta Shield' appears on their covers.
- A list of the historic 'STAR TREK' licensees for various products and printouts from www.startrek.com/licensees, dated 22/07/2015 with the list of current official 'STAR TREK' licensees for various products. There are various countries of operations worldwide, including the United Kingdom and other countries of the European Union.
- Copies of pages from the official 'Star Trek Communicator' magazine. The 'Delta Shield' is displayed on the pages, uniforms of the cast on the pictures or licensed products.
- Printouts of pages from the official 'STAR TREK website's store at <http://shop.startrek.com>, with pictures of some licensed products, many of them bearing or in the form of the 'Delta Shield'.
- Printouts from the opponent's European licensees' websites and a list of the various European licensees and their respective territories, including in the United Kingdom and other countries of the European Union.
- Printouts from the opponent's official online store at <http://shop.startrek.com>, showing goods offered for sale and bearing the 'Delta Shield' sign.
- Printouts from the website of Simon & Schuster Inc., showing books tied to the 'STAR TREK' series and movies. The 'Delta Shield' appears on the book covers.
- Printouts from www.amazon.com, www.amazon.fr, www.amazon.co.uk and www.amazon.de, offering books tied to the 'STAR TREK' series and movies. The 'Delta Shield' appears on the book covers.
- Printouts from www.facebook.com concerning Star Trek Online game with more than 290 856 'likes'. There is information that the site was founded on 02/02/2010. A screenshot from www.arcgames.com/en/games/star-trek-online with 'Delta Shields' displayed on it.

- Printouts from <https://itunes.apple.com> with 'STAR TREK' with offers of mobile applications, games, audio alerts and ring tones. 'Delta Shields' appears on these pages.
- Screenshots from www.facebook.com/StarTrek page, showing 3 504 666 'likes', and from www.facebook.com/StarTrekTheNextGeneration page showing 1 499 366 'likes'.
- Printouts from STAR TREK fan websites such as <http://de.memory-alpha.wikia.com/wiki>, <http://www.stic.it>, <http://www.trekmate.org.uk> and a screenshot from www.clubstartrek.es. The 'Delta Shields' appear on some of them.
- A page containing the photograph from the first 'STAR TREK' Convention in 1972. Printouts from www.creationent.com with, inter alia, 'STAR TREK' convention schedule in June and August 2014. Printouts from www.startrek.com with information on various 'STAR TREK' related events in, inter alia, London and Frankfurt, in 2014.
- Printouts from www.destinationstartrek.com and www.startrek.com and <https://twitter.com> and <http://bbc.com>, promoting 'Destination Star Trek' events or convention.
- Copies of pages concerning the 'STAR TREK World Tour' which was an event giving the public the possibility to explore the Star Trek universe through show-based simulators, multimedia attractions, ships, sets and costumes. Printouts from the website [http://en.memory-alpha.org/wiki/Star Trek The Exhibition](http://en.memory-alpha.org/wiki/Star_Trek_The_Exhibition) with information about Star Trek The Exhibition (formerly Star Trek The Tour), described as 'a travelling Star Trek-themed attraction. There is a list of locations in the United States and Europe (Spain and Germany) with the dates between 2008 and 2014.
- Printouts from the website <http://www.startrek.com> promoting 'STAR TREK LIVE IN CONCERT' in May-July 2014. A printout from <http://www.kkl-luzern.ch> referring to 'Star Trek Into Darkness'.
- Copies of pages promoting 'STAR TREK LIVE IN CONCERT' and 'STAR TREK THE ULTIMATE VOYAGE', movie shows backed by orchestra in North America, Asia and Europe. Printouts from <http://startrekultimatevoyage.com> promoting the event 'STAR TREK THE ULTIMATE VOYAGE' to be held in London in November 2015 and various cities in North America in 2016.
- Printouts from <http://www.giantfreakingrobot.com/>, dated 28/06/2013 and <http://www.thetrekcollective.com>, dated 04/07/2013, concerning the Star Trek-themed hotel suite in Brazil. It can be seen on the pictures that the 'Delta Shield' is displayed on various objects. Printouts from <http://blogs.wsj.com> with the article entitled 'Chinese Firm's Headquarters Shaped Like 'Star Trek's Enterprise'', dated 25/05/2015. In the article and on the attached picture, there are images of the building, the shape of which is, according to the information in the article, inspired by the spaceship which appeared in three 'Star Trek' movies in the 1990s/2000s. The image of the king Abdullah of Jordan in the uniform with 'Delta Shield'. Pictures of projects of Star Trek-themed constructions and images which concern attractions scheduled for 2017 in Jordan and Spain and 2020 in London. 'Deltha Shield' appears in the prominent places of the constructions.

It is clear from the evidence that the earlier trade mark has been subject to long-standing and intensive use and is generally known in the relevant market, where it enjoys a consolidated position among the leading brands, as has been attested by diverse independent sources. The sales figures, marketing expenditure and market share shown by the evidence and the various references in the press all

unequivocally show that the earlier trade mark has a reputation in the United Kingdom for *entertainment* services in Class 41. For reasons of procedural economy the Opposition Division will refrain from examining the evidence in relation to other, more specific services in Class 41 and services in Class 38 for which the opponent has also claimed reputation.

c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are visually similar to a low degree. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) EUTMR but has been confirmed in the judgments of 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29 and 31, and of 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66. It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

Possible relevant factors for the examination of a 'link' include (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

Given the substantial degree of reputation of the earlier mark, the degree of similarity between the signs at issue is sufficient for the relevant public to make a connection between the sign applied for and the earlier UK trade mark, that is to say, to establish a link between them.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that when encountering the contested mark the relevant consumers will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 96).

d) Risk of injury

Use of the contested mark will fall under Article 8(5) EUTMR when any of the following situations arise:

- it takes unfair advantage of the distinctive character or the repute of the earlier mark;
- it is detrimental to the repute of the earlier mark;
- it is detrimental to the distinctive character of the earlier mark.

Although detriment or unfair advantage may be only potential in opposition proceedings, a mere possibility is not sufficient for Article 8(5) EUTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must 'adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment' (06/06/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 53).

It follows that the opponent must establish that detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that purpose, the opponent should file evidence, or at least put forward a coherent line of argument demonstrating what the detriment or unfair advantage would consist of and how it would occur, that could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.

The opponent claims that the contested goods are likely to be seen as merchandising products originating from the opponent and that by using the contested sign which is very similar to the opponent's earlier reputed mark the applicant will unfairly free-ride on the investment made by the opponent in promoting and building up the reputation of its mark.

Before examining the opponent's claim, it is appropriate to recall that the opposition is directed against the following goods:

Class 9: *Electronic publications (downloadable); computer peripheral devices; computer software (recorded); computers; computer programs (downloadable software); intercommunication apparatus; portable telephones; computer game programs; USB flash drives; optical discs.*

As seen above, the earlier trade mark was found to have a reputation for:

Class 41: *Entertainment.*

Unfair advantage (free-riding)

Unfair advantage in the context of Article 8(5) EUTMR covers cases where there is clear exploitation and 'free-riding on the coat-tails' of a famous mark or an attempt to trade upon its reputation. In other words, there is a risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods and services covered by the contested trade mark, with the result that the marketing of those goods and services is made easier by their association with the earlier mark with a reputation (06/06/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 48, and 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40).

The opponent bases its claim on the following.

- The contested goods are likely to be seen as the opponent's merchandising products.
- The popularity of the 'STAR TREK' television series and movies resulted in the creation of the entire subculture and lifestyle.
- The use of a sign, which is very similar to the earlier reputed mark, in relation to the contested goods would result in the transfer of the image associated with the earlier mark to the goods covered by the contested application, thus facilitating their marketing.
- This could significantly impact the opponent's licensing opportunities as the potential licencing partners as the applicant could afford offering more attractive terms due to lesser investment in its mark.

According to the Court of Justice of the European Union:

'... as regards injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, insofar as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to the average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect.'

(27/11/2008, C-252/07, Intel, EU:C:2008:655, § 36.)

In the present case, the signs show visual similarities resulting from the presence in both marks of the arrowhead-shaped white device. The earlier mark enjoys a substantial degree of recognition among the relevant public. In view of the earlier trade mark's attractiveness, it may be exploited even outside its natural market sector, by licensing and merchandising. The opponent presented evidence to show that its mark appears on various licensed goods or pages on which these goods are offered. The goods include publications, mobile applications, games, audio alerts and ring tones. Therefore, using the contested goods in Class 9 bearing the contested mark may be considered as a message of belonging to the subculture with which the earlier mark is associated. This would give the applicant a competitive advantage as the marketing of the contested goods would benefit from attractiveness gained by association with the opponent's mark. It is also likely, that certain of the contested goods in Class 9 may be used for merchandising purposes. Items such as USB flash drives are often used as marketing means bearing trade marks which relate to distinct goods and services. Consequently, the relevant public, when confronted with these goods bearing the contested sign, would make a mental connection with the opponent's reputed sign and the services for which it is reputed.

On the basis of the above, the Opposition Division concludes that the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.

e) Conclusion

Considering all the above, the opposition is well-founded under Article 8(5) EUTMR. Therefore, the contested trade mark must be rejected for all the contested goods.

Given that the opposition is entirely successful under Article 8(5) EUTMR it is not necessary to examine the remaining grounds and earlier rights on which the opposition was based.

COSTS

According to Article 85(1) EUTMR, 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) and (6) and Rule 94(7)(d)(i) EUTMIR, 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**

Rhys MORGAN

Justyna GBYL

Arkadiusz GÓRNY

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 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 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 720 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) EUTMIR, 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 (Annex I A(33) EUTMR) has been paid.