

Alicante, 18/05/2016

CASALONGA ALICANTE, S.L.
Avenida Maisonnave, 41-6C
E-03003 Alicante
ESPAÑA

Notification of a decision to the applicant

<i>Your reference:</i>	L14-4285EM
<i>Invalidity number:</i>	000012098 C
<i>Contested trade mark:</i>	012201687
	TRUCK MASTER
<i>Fax number:</i>	00 34-965131689

Please find attached the decision terminating the proceedings referred to above. The decision was delivered on **18/05/2016**.

Please note that decisions of the Cancellation Division are not signed by the responsible officials but only indicate their full name and bear a printed seal of the Office in accordance with Rule 55(1) EUTMIR.

Agueda MAS PASTOR



Enclosures (excluding the cover letter): 07 pages

CANCELLATION No 12098 C (INVALIDITY)

Renault s.a.s, 13/15, quai Alphonse le Gallo, 92100 Boulogne-Billancourt, France (applicant), represented by **Casalonga Alicante S.L.**, Avenida Maisonave, 41-6C, 03003 Alicante, Spain (professional representative)

a g a i n s t

UAB 'Truck master', Metalistų g. 6B 78107 Šiauliai, Lithuania (EUTM proprietor), represented by Professional Law Firm Zaboliene and Partners, Business Center Vertas, Gynėjų str. 16, 01109 Vilnius, Lithuania (professional representative).

On 18/05/2016, the Cancellation Division takes the following

DECISION:

1. The application for a declaration of invalidity is upheld.
2. European Union trade mark No 12 201 687 is declared invalid in its entirety.
3. The EUTM proprietor bears the costs, fixed at EUR 1 150.

REASONS

The applicant filed an application for a declaration of invalidity against all the goods and services of European Union trade mark No 12 201 687. The application is based on French trade mark registration No 1 551 948. The applicant invoked Article 53(1)(a) EUTMR in connection with Article 8(1)(b) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argued that, because of the significant similarity between the conflicting signs and because of the identity and similarity between the contested goods and services and the goods covered by the earlier right, there is a likelihood of confusion pursuant to Article 8(1)(b) EUTMR. The applicant asserted that the contested sign includes in its entirety its earlier national French mark, consisting of the word 'MASTER'. Moreover, the applicant underlined that the verbal element 'TRUCK MASTER' is the dominant element of the contested sign. However, the verbal element 'TRUCK' has a clear meaning in the relevant territory, namely 'vehicle for carrying goods and materials'; therefore, it is descriptive for the goods and services in question. According to the applicant, the verbal element 'TRUCK' of the contested sign has a weak distinctive character; therefore, it has less importance in the assessment of likelihood of confusion. Moreover, the additional figurative elements of the contested sign are not sufficient to exclude a likelihood of confusion.

The EUTM proprietor did not submit any observations in reply to the application for invalidity.

LIKELIHOOD OF CONFUSION — ARTICLE 53(1)(a) EUTMR IN CONNECTION WITH 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 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 on which the application is based are the following:

Class 12: *Motor vehicles; Vehicles for locomotion by land, their spare parts or replacement parts not included in other classes.*

The contested goods and services are the following:

Class 12: *Parts and fittings for land vehicles.*

Class 35: *The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), namely parts and fittings for vehicles, enabling customers to conveniently view and purchase those goods in retail stores, wholesale outlets, through mail order catalogues or by means of electronic media, through web sites or television shopping programmes.*

Class 37: *Vehicle maintenance and repair.*

Contested goods in Class 12

The contested *parts and fittings for land vehicles* include, as a broader category, the applicant's *their spare parts or replacement parts not included in other classes [vehicle of locomotion by land]*. Since the Cancellation Division cannot dissect *ex officio* the broad category of the contested goods, they are considered identical to the applicant's goods.

Contested services in Class 35

Retail services concerning the sale of particular goods are similar to a low degree to those particular goods. Although the nature, purpose and method of use of these goods

and services are not the same, they have some similarities, as they are complementary and the services are generally offered in the same places where the goods are offered for sale. Furthermore, they target the same public.

The same findings may be applied to services consisting in bringing together, for the benefit of others, a variety of goods (excluding the transport thereof) enabling customers to conveniently view and purchase those goods in retail stores or wholesale outlets, through mail order catalogues or by means of electronic media, through websites or television shopping programmes. Therefore, the contested *the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), namely parts and fittings for vehicles, enabling customers to conveniently view and purchase those goods in retail stores, wholesale outlets, through mail order catalogues or by means of electronic media, through web sites or television shopping programmes* is similar to a low degree to the applicant's *their spare parts or replacement parts not included in other classes [vehicles for locomotion by land]* in Class 12.

Contested services in Class 37

The contested *vehicles maintenance and repair* are similar to *vehicles for locomotion by land, their spare parts or replacement parts*. Usually, vehicle manufacturers offer services consisting in maintaining and repairing the vehicles themselves, in order to guarantee long-term efficiency. For this reason, consumers often entrust the manufacturer directly with fixing and maintaining the goods in question. Therefore, these goods and services have the same producers, distribution channels and relevant public.

b) Relevant public — degree 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 degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods and services found to be identical or similar to various degrees are directed at the public at large and at business customers with specific knowledge or expertise. The degree of attention may vary from average to high. In the case of expensive goods, such as vehicles, consumers are likely to pay a higher degree of attention than they would when making less expensive purchases.

c) The signs

MASTER



TRUCK MASTER

Earlier trade mark

Contested trade mark

The relevant territory is France.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression, bearing in mind their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The earlier mark is a word mark, 'MASTER'. The contested mark is a figurative mark composed of a figurative element followed by a verbal element, 'TRUCK MASTER', in yellow, upper case letters. The figurative element consists of a violet oval within which are several white and yellow lines of varying thickness and forms.

The verbal element 'TRUCK' of the contested sign, although it is an English word, will be associated by part of the relevant public with 'a small wagon for carrying logs' (information extracted on 12/04/2016 from the French dictionary *Larousse* at <http://www.larousse.fr/dictionnaires/francais/truck/80052?q=truck#79084>); therefore, the word 'TRUCK' is descriptive of the goods and the subject of the services for which the contested sign is registered, and consequently it is a weak element. For the part of the relevant public that does not understand the meaning of 'TRUCK', this element has a normal degree of distinctiveness.

The element 'MASTER', included in both signs, will be perceived by the relevant public as referring to a 'master's degree' in postgraduate education or to a 'commander, captain, manager' (information extracted on 12/04/2016 from the dictionary of the Centre National de Ressources Textuelles et Lexicales at <http://cnrtl.fr/definition/master>).

Neither of the marks has any element that could be considered more dominant (visually eye-catching) than other elements.

Visually, the contested sign includes the earlier sign 'MASTER' in its entirety. The signs differ in the verbal element 'TRUCK' and in the typeface, colours and figurative element of the contested sign, which have no counterparts in the earlier sign.

Regarding the earlier sign's graphic depiction, it should be noted that, when signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; decisions of 19/12/2011, R 233/2011-4, Best Tone (fig.) / BETSTONE (fig.), § 24; 13/12/2011, R 53/2011-5, Jumbo (fig.) / DEVICE OF AN ELEPHANT (fig.), § 59). Therefore, the signs are visually similar to an average degree.

Aurally, the signs coincide in the pronunciation of the syllables 'MAS-TER', present identically in both signs. The signs differ in the pronunciation of the letters 'TRUCK' of the contested mark, which have no counterparts in the earlier sign. Therefore, the signs are aurally similar to an average degree. The figurative element of the contested sign will not be pronounced, so it does not affect the aural comparison.

Conceptually, the verbal element 'TRUCK' will be perceived by part of the relevant public as referring to 'a small wagon for carrying logs'; the verbal element 'MASTER' will be perceived by the relevant public as referring to a 'master's degree' in postgraduate education or to a 'commander, captain, manager'. Therefore, the conflicting signs have in common the meaning of 'MASTER', and therefore they are conceptually similar to an average degree.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

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.

According to the applicant, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the applicant to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

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 for any of the goods in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

The goods and services are partly identical and partly similar to different degrees. They target the public at large and business customers with specific knowledge or expertise; taking into account the different natures of the goods and services at issue, the public's degree of attention may vary from average to high when purchasing them.

The signs are similar to an average degree, since they have in common the verbal element 'MASTER'. The signs differ in the word 'TRUCK' and in the typeface, colours and figurative element of the contested sign.

In this regard, it should be noted that less attention will be paid by the relevant public to elements that are weak or devoid of any distinctive character; consequently, less attention will be paid to the word 'TRUCK' by the part of the relevant public that perceives it as referring to 'a small wagon for carrying logs'.

For the part of the relevant public that does not understand the meaning of 'TRUCK', this element has a normal degree of distinctiveness. However, considering the normal degree of distinctiveness of the earlier sign, and its inclusion in its entirety in the contested mark, this difference is not sufficient to exclude the likelihood of confusion, including the likelihood of association.

Moreover, although more attention is usually paid to the beginning of a sign, the case law of the Court makes clear that, generally, it does not matter much whether the coinciding element constitutes the first or the second element of the mark. The protection against likelihood of confusion applies in both directions: the owner of the earlier mark is protected not only against the fact that the more recent mark will be understood as referring to the goods and services covered by the earlier mark, but also vice versa (26/01/2006, T-317/03, Variant, EU:T:2006:27, § x).

Regarding the typeface, colours and figurative element of the contested sign, as has been stated above, it is considered that relevant consumers will focus their attention on the word elements of the mark. This is because the average consumer will more readily

refer to the goods and services in question by quoting their name than by describing their figurative elements.

Taking into account the visual, aural and conceptual similarities between the marks residing in the coinciding and distinctive word, 'MASTER', it is very likely that the consumer in the relevant territory will assume that the conflicting marks have the same commercial origin, for example that the contested mark represents a new line or a parallel line of the applicant's.

In relation to the contested services in Class 35, it is necessary to underline that the likelihood of confusion, including the likelihood of association, is not excluded by the low degree of similarity between the contested services and the applicant's goods. The goods and services are complementary and are generally offered in the same places; consequently, the relevant public may think that they come from the same undertaking or from economically linked undertakings.

In view of all the relevant factors in the present case and also the principle of interdependence between them, that is, the principle that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, the relevant public, including the public with a high degree of attention, could be mistaken with regard to the origin of those goods and services that are identical and similar, even if they are similar only to a low degree. The similarity between the signs outweighs the low degree of similarity between the goods and services.

Considering all the above, there is a likelihood of confusion on the part of the public.

Therefore, the application is well founded on the basis of the applicant's French trade mark registration No 1 551 948. It follows that the contested trade mark must be rejected for all the contested goods and services.

Since the cancellation application is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the earlier mark due to its reputation as claimed by the applicant. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

COSTS

According to Article 85(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the EUTM proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (6) and Rule 94(7)(d)(iii) EUTMIR, the costs to be paid to the applicant are the cancellation fee and the representation costs, which are to be fixed on the basis of the maximum rate set therein.

**The Cancellation Division**

Victoria DAFAUCE
MENÉNDEZ

Agueda
MAS PASTOR

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SLIWINSKA

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 Cancellation Division on request. According to Rule 94(4) EUTMR, 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.