



OPPOSITION No B 1 891 335

JanSport Apparel Corp., 3411 Silverside Road, Wilmington, Delaware 19810, United States of America (opponent), represented by **Casalonga Et Associes**, Avenida Maisonnave, 41-6C, 03003 Alicante, Spain (professional representative)

a g a i n s t

Aigle International S.A., 17, rue Saint-Denis, 92100 Boulogne-Billancourt, France (applicant), represented by **Elzaburu S.L.P.** Miguel Angel, 21, 28010 Madrid, Spain (professional representative).

On 16/04/2013, the Opposition Division takes the following

DECISION:

1. Opposition No B 1 891 335 is upheld for all the contested goods.
2. Community trade mark application No 9 961 129 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 Community trade mark application No 9 961 129. The opposition is based on, *inter alia*, Community trade mark registration No 8 296 972. 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.

The opposition is based on more than one earlier trade mark. For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier Community trade mark No 8 296 972.

a) The goods

The goods on which the opposition is, *inter alia*, based are the following:

Class 25: *Clothing; footwear; headgear; snowsports outerwear clothing, articles of clothing for outdoor activities, articles of clothing for sportswear, articles of leisure clothing.*

The contested goods are the following:

Class 25: *Clothes (except clothing for medical and surgical purposes), Underwear, Footwear (other than orthopaedic footwear), Boots, Soles for footwear, Headgear.*

The contested *Clothes (except clothing for medical and surgical purposes), Underwear* are included in the earlier *clothing*; the goods are identical.

The contested *footwear (other than orthopaedic footwear), boots* are included in the earlier *footwear* and are, therefore, identical.

The contested *headgear* is reproduced in the opponent's list of goods; therefore, the goods are identical.

Since the earlier trade mark covers the entire class heading of Class 25, for the purposes of the present case it is necessary to note that, according to Communication No 2/12 of the President of the Office of 20/06/2012, as regards Community trade mark applications filed before 21/06/2012, the Office considers that the intention of the applicant (owner) was to cover all the goods or services included in the alphabetical list of the classes concerned in the edition of the Nice Classification in force at the time when the filing was made.

According to the above principle, the earlier Community trade mark is deemed to cover all the goods included in the alphabetical list of Class 25. It was filed on 13/05/2009; therefore, it is deemed to protect all items of the alphabetical list of the ninth edition of the Nice Classification.

Since the contested *soles for footwear* are contained in the alphabetical list of the ninth edition of the Nice Classification in Class 25, it has to be concluded that these contested goods are identical to the goods which are protected by the earlier trade mark.

b) The signs

Earlier trade mark



Contested sign

The relevant territory is the European Union. For reasons of procedural economy, the Opposition Division will focus the comparison of the signs on the Polish-, Czech- and Slovak-speaking part of the relevant public.

Visually, the signs are similar to the extent that they contain the upper case letters 'EAS PAK' written in standard script. On the other hand, they differ in the letter 'T' and the word element 'USA' of the earlier trade mark and in the letters 'Y – C' of the contested mark. The earlier trade mark also contains figurative elements, consisting of an elliptical background and a device which is likely to be seen as a representation of a globe, which are not present in the contested sign. The signs also differ in the rectangular frame and images of two arrows of the contested sign. The fact that the element 'EASTPAK' of the earlier trade mark is one word and the component 'EASY PACK' of the contested sign is made up of two words, which are placed above each other, forms a point of visual difference as well.

Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the marks coincides in the sound of the string of letters EAS, and also a substantial part of the public in the relevant territory will pronounce identically the parts PAK of the earlier trade mark and PA(C)K of the contested sign. However, the possibility that some of the consumers would pronounce the letter C in the contested mark cannot be totally excluded. Therefore, the sound of the letter C of the contested sign may form a certain point of phonetic difference. The pronunciation clearly differs in the sound of the letters T and USA of the earlier trade mark and in the sound of the letter Y of the contested mark.

Conceptually, neither the word EASTPAK of the earlier trade mark nor the words EASY PACK of the contested sign have a meaning for the public in the relevant territory. On the other hand, the letters 'USA' of the earlier trade mark will be associated with 'United States of America', and its figurative element, consisting in a representation of a globe, conveys the concept of the globe, the Earth etc. The figurative elements consisting in the image of the arrows of the contested mark will be perceived as having this concept (arrows, direction etc.). Since the signs will be associated with a dissimilar meaning, the signs are not conceptually similar.

Taking into account the abovementioned visual and aural coincidences, it is considered that the signs under comparison are similar.

c) Distinctive and dominant elements of the signs

In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

The contested sign has no elements which could be considered clearly more dominant (visually eye-catching) than other elements.

The rectangular frame of the contested trade mark, having a typical label shape, is of rather a decorative nature. It is for this reason that the remaining elements of the mark are considered more distinctive. Consequently, the rectangular figurative element has a limited impact when assessing the likelihood of confusion between the marks.

The element 'USA' of the earlier mark will be associated with 'United States of America'. Bearing in mind the fact that this element can evoke the idea that the relevant goods are produced, designed or imported from the USA or exported there, it is considered that this element is non-distinctive for all the relevant goods. The public understands the meaning of the element and will not pay as much attention to this non-distinctive element as to the other more distinctive elements of the mark. Consequently, the impact of this non-distinctive element is limited when assessing the likelihood of confusion between the marks at issue.

Moreover, the concept of the image of the globe in the earlier trade mark can be associated with the idea of international business or with export activities related to the relevant goods and, therefore, this element is not very distinctive either.

Furthermore, the dark elliptical background of the earlier mark outlined in white, against which the remaining elements are placed, is of rather a decorative nature (having a typical label shape). It is for this reason that this element, as such, is also not very distinctive and will not have a major impact on consumer.

The element 'USA' of the earlier trade mark, by virtue of its small size, is overshadowed by the remaining elements of the earlier trade mark, which form the more striking and, therefore, dominant part of the mark.

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 opponent, 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 opponent 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 in relation to any of the goods at hand from the perspective of the public

in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal, despite the presence of some non-distinctive and not very distinctive elements in the mark, as stated above in section c) of this decision.

e) Relevant public – level of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

In the present case, the relevant goods are directed at the public at large.

f) Global assessment, other arguments and conclusion

The marks under comparison are both figurative signs.

The goods have been found to be identical. This circumstance brings into consideration the principle of interdependence, whereby a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services.

Therefore, although Class 25 goods are concerned (for which visual impact plays a more important role), the fact that the distinctive word elements of the marks EASTPAK and EASY PACK share their first three letters, EAS, and also have other letters (PAK) in common is of important relevance.

Moreover, as has been mentioned above, the figurative elements of the earlier trade mark have limited distinctiveness, as does the rectangular device of the contested mark. In this regard, it has to be noted that, although the distinctiveness of the images of arrows of the contested mark is normal, their graphic representation is neither particularly stylised nor striking.

Therefore, although the differences between the trade marks will not be completely overlooked, they are not capable of counteracting the similarities between the signs, and the consumers might think that the relevant goods bearing these marks come from the same or economically linked undertakings.

In view of the foregoing, and taking into account all the relevant circumstances of the case, as well as the interdependence principle and the fact that consumers rarely have the opportunity to directly compare two signs and their global impression will be based on their imperfect recollection of one or the other of the signs, the Opposition Division deems that there exists a likelihood of confusion including a likelihood of association, within the meaning of Article 8(1)(b) CTMR, on the part of the public in the European Union (at least as far as the Polish-, Czech- and Slovak-speaking part of the relevant public is concerned) between the contested sign and the earlier Community trade mark.

Therefore, the opposition is well founded on the basis of the opponent's Community trade mark registration. It follows that the contested trade mark must be rejected for all the contested goods, and consequently in its entirety.

It is a result of the unitary character of the Community trade mark, laid down in Article 1(2) CTMR, that an earlier Community trade mark has identical protection in all Member States. Earlier Community trade marks may therefore be relied upon to challenge any subsequent application for a trade mark which would prejudice their protection, even if this is only in relation to the perception of consumers in part of the European Community. It follows that the principle laid down in Article 7(2) CTMR, which provides that it is sufficient that an absolute ground for refusal exists in only part of the Community for a trade mark application to be refused, applies, by analogy, to a relative ground for refusal under Article 8(1)(b) CTMR.

Since the opposition 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 opposing mark due to its extensive use and reputation as claimed by the opponent. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

As the earlier Community trade mark No 8 296 972 leads to the success of the opposition and to the rejection of the contested trade mark for all the goods against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent (see judgment of 16/09/2004, T-342/02, 'Moser Grupo Media').



Given that the earlier Community trade mark No 8 296 972 was registered less than five years prior to the publication of the contested application, it is unnecessary to examine the evidence of use filed by the opponent in relation to some of the other earlier rights.

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 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), (6) and (7)(d)(i) CTMIR, 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

Solveiga BIEZA

Eva PEŘINOVÁ

Janja FELC

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.