

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS)

Opposition Division

OPPOSITION No. B 1 788 879

DLG e.V., Eschborner Landstr. 122, 60489 Frankfurt am Main, Germany (opponent),

a g a i n s t

Certilogo SPA, Corso Magenta 32, 20123 Milano, Italy (applicant),

On 21/10/2011

the Opposition Division takes the following

DECISION:

1. Opposition number B 1 788 879 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against some of the services in classes 35, 38 and 42 of Community trade mark application No 9 257 122, based on International trade mark registration No 1 014 894 with designation to the European Union. The opponent invoked Article 8(1) (b) CTMR.

LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically-linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

a) The goods and services

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

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

Class 7: machines for agriculture, horticulture and forestry; machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements (not hand operated); incubators for eggs.

Class 16: paper, cardboard and goods made from these materials, not included in other classes; printed matter, in particular magazines, catalogues, prospectuses, posters and photographs; stationery; instructional and teaching material (except apparatus; plastic materials for packaging (not included in other classes).

Class 29: meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies; jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30: coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.

Class 31: agricultural, horticultural and forestry products and grains, not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

Class 32: beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33: alcoholic beverages (except beers).

Class 35: advertising services; business management services, business administration; office functions; business management and organization consulting services; business management and economical consultancy; providing information and consultancy for consumers in trade and business affairs; organisation of trade fairs and exhibitions for commercial or advertising purposes and for product presentations; consultancy with regard to the organisation and conducting of trade fairs and exhibitions, included in this class; organisation and conducting of trade fairs and exhibitions for commercial or advertising purposes, namely organisation of participation in exhibitions; presentation of companies and their products and services for advertising purposes, and sales promotion and organising of business contacts including on the Internet; administration and compilation of information into computer databases; on-line advertising on a computer network, advertising on the Internet for others as well as presentation of companies on the Internet and in other media; rental of advertising spaces on the Internet; public relations; rental of advertising spaces, marketing research and market analysis; providing and rental of equipment, namely sales and information stands for advertising and vending purposes, office machines and equipment, automatic vending machines, photocopying machines for stand areas and exhibition stands; publication of catalogues and prospectuses; publication of electronic catalogues and prospectuses, including on the Internet; publication of electronic catalogues and prospectuses online.

Class 38: telecommunications; providing access to information on the Internet; electronic exchange of messages by means of bulletin boards on the Internet; telecommunication by means of Internet platforms and portals; providing and rental of equipment, namely telephone, fax machines, communications and Decision on telecommunications installations for the recordal, transmission and reproduction of video, audio and data for stand areas and exhibition stands.

Class 39: transport; packaging and storage of goods; travel arrangement.

Class 41: organising and arranging of conferences, special shows for cultural, instructional and educational purposes, congresses, symposiums and competitions for cultural, instructional and educational purposes; publication of magazines and books; publication of electronic magazines and books, including on the Internet, publication of electronic books and magazines on-line; providing of on-line information in the field of education on the Internet; organising, arranging and conducting of seminars, workshops (training) and exhibitions for cultural or educational purposes; providing of training in the field of foodstuffs, agriculture, horticulture and forestry.

Class 42: quality testing and quality rating of foodstuffs, agricultural and forestry equipment, holiday accommodation and agricultural systems; surveying, in particular in the field of foodstuffs agriculture, horticulture and forestry; technical measuring and testing; chemical analysis; industrial analysis services;

awarding quality seals and/or certificates for tested goods, services and products; engineering, physics research, research in the fields of chemistry and biology; consultancy, expertise, testing and certification in the field of technology, in particular quality assurance for industry, agriculture, horticulture or forestry; investigations, searching in data bases and on the Internet for science and research; design, creation and maintenance of homepages and Internet sites.

Class 43: services for providing food and drink; providing temporary accommodation; hotel reservation services provided by means of the Internet and the world-wide web.

Class 44: veterinary medicine, agriculture, horticulture and forestry services; consultancy related to nutrition and physical health in the field of foodstuffs, agriculture, horticulture and forestry.

The contested services are the following:

Class 35: franchising, namely consultation and assistance in business management, organization and promotion.

Class 38: telecommunication services, namely transmission of data about authenticity, origin, composition, manufacturing techniques, distribution, marketing of products as well as any other information related to the manufacturer, the brand and the product; local and long distance telephone communication services; wireless broadband communication services; news agencies, namely the transmission of news items to news reporting organizations; communications via computer terminals, by digital transmission or satellite; electronic voice messaging, namely, recording and transmission of telephonic messages; transmission of digital data via the global communication network or via any other means of communication.

Class 42: design and creation of Internet sites for third parties; quality control and quality guarantee of production processes for others; online security services, namely, restricting access to information systems and information security systems, and online security services for data processing networks, data processing accesses and computerized transactions; quality control for others; services related to testing, analysis and evaluation recognized at national and international levels of the goods and services of others for the purpose of certification; technical and technological consultancy in the field of security systems and anti-counterfeiting solutions; technical and technological consultancy in the field of identification, marking, certification and tracking of products; computer programming; computer rental; updating of computer software; computer software design; development of data processing software; consultancy in the field of computer hardware; professional consulting services in the field of security systems and anti-counterfeiting solutions, of identification, marking, certification and tracking of products, of electronic storage of data for others, of planning, development, operation and maintenance of computer systems for the purpose of fighting counterfeiting, of planning, development, operation and maintenance of computer systems for the purposes of marking, identifying, certifying and tracking of products; planning, development, operation and maintenance of computer systems for the purpose of fighting counterfeiting, for the purpose of marking, identifying, certifying and tracking of products; planning and layout design for the interior space of retail business establishments; technical consulting in the field of electronic storage of data for others; technical consultancy in software development for anti-counterfeiting purposes; technical consultancy in software development for the marking, identifying, certifying and tracking of products; technical consultancy in the field of knowledge and information management solutions for anti-counterfeiting purposes; technological consulting services, namely, developing and providing made-to-measure solutions for the marking, identification, certification and tracking of products by means of digital and/or mechanical and/or electronic and/or chemical and/or biological and/or nano-technologies.

Some of the contested services are identical to the services on which the opposition is based. For reasons of procedural economy, the Opposition Division will not undertake a full comparison of the goods and services

listed above. The examination of the opposition will proceed on the assumption that all the contested goods and services are identical to those covered by the earlier trade mark.

b) The signs

DLG - Earlier trade mark

X CLG - Contested sign

The relevant territory is the European Union.

The earlier mark is a word mark composed of the letters "D-L-G".

The contested sign is a figurative mark consisting of a small black device representing a thick lowercase and wider than normal letter "x", followed by the letters "C-L-G", written in black standard capital letters.

Visually, the marks are similar to the extent that they coincide in their two final letters "LG". On the other hand, they differ in that the common sequence is preceded by only one letter "D", in the earlier mark and by two letters, namely "X" and "C" in the contested application.

Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the marks coincides in the sound of their final letters "L" and "G" present identically in both signs, and to that extent the marks are aurally similar. The pronunciation differs in their beginnings, in the sound of the letter "D" of the earlier mark versus the sound of the letters "X" and "C" of the contested application.

Conceptually, neither of the two signs has a meaning from the perspective of the public in the relevant territory. Therefore, they have no concept in common.

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

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 marks under comparison have no elements which could be considered clearly more distinctive or dominant (visually eye-catching) in comparison to other elements.

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.

The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.

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 the goods and services at hand from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

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 case at hand, some of the goods and services are directed at the public at large and some others at business customers with specific professional knowledge or expertise (in different areas such as Information Technology, business administration, etc).

f) Global assessment, other arguments and conclusion

It has been established in previous sections of the present decision that some of the services in conflict were identical and that for reasons of procedural economy the remaining goods and services would be considered to be identical. It has also been concluded that the signs were similar to the extent that they shared some visual and phonetic similarities due to the coincidence in two final letters and that the signs differed due to the inclusion of additional elements in their initial part, which had no counterpart in the opposing sign.

From the descriptions provided in section b) it can be concluded that the additional elements are clearly perceivable and sufficient to exclude any likelihood of confusion between the marks, bearing also in mind that the common elements are not the dominant elements of the signs.

In that sense, it should be noted that consumers generally tend to focus on the first element of a sign when being confronted with a trade mark. This is justified by the fact that the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader.

Consequently, the dissimilar first elements of the marks at issue have to be taken into account when assessing the likelihood of confusion between the marks.

Furthermore, the signs in dispute having three and four letters respectively; it is considered that the fact that they differ in one and two letters is a relevant factor to consider when evaluating the likelihood of confusion between the conflicting signs.

Furthermore, it is considered that the different letters are neither phonetically or visually similar letters.

Considering all the above, the Opposition Division finds that there is no likelihood of confusion on the part of the public. This would be the case even if the goods and services were identical. Therefore, the opposition must be rejected.