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

Trade Marks Department

B206b

Notification to the applicant/holder of a decision

Alicante, 08/11/2010

BARKHOFF REIMANNVOSSIUS
Grosjeanstr. 2
D-81925 München
ALEMANIA

Your reference:	**37398/316478**
Number of the opposition:	**B 001085721**
Trade mark number:	**004460473**
Name of the applicant/holder:	**INVISTA TECHNOLOGIES S.à.r.l.**

Please see the attached decision which ends the opposition proceedings referred to above. It was delivered on <**08/11/2010**>.

QUAY Peter
Enclosures (excluding the cover letter): 07 pages

Sent to fax number: 004989904755455

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office according to Rule 55(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 207/2009 on the Community trade mark (codified version of Council Regulation (EC) No 40/94).

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

Opposition Division

B280

DECISION

Of 08/11/2010

RULING ON OPPOSITION No B 1 085 721

Opponent: **Rössle & Wanner GmbH**
Ulrichstr. 102
72116 Mössingen
Germany

Representative: **Ostertag & Partner**
Epplestr. 14
70597 Stuttgart
Germany

Trade mark(s):

against

Applicant/holder: **Invista Technologies S.à.r.l.**
Pestalozzistr. 2
9000 St. Gallen
Switzerland

Representative: **Barkhoff Reimann Vossius**
Grosjeanstr. 2
81925 München
Germany

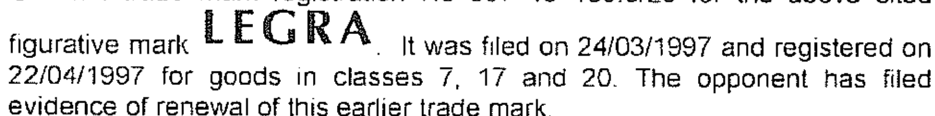
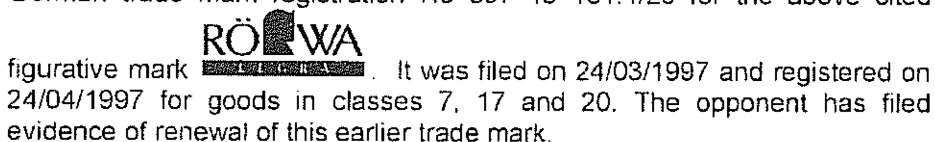
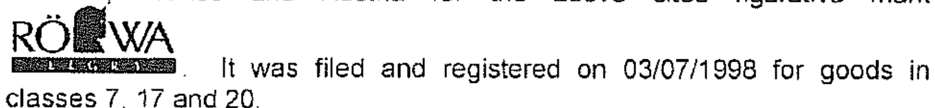
Contested trade mark:

I. FACTS AND PROCEDURE

On 27/05/2005 the applicant filed application No 4 460 473 to register the above cited figurative mark as a trade mark for goods and services in classes 2, 3, 4, 5, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 35, 41, 43 and 44.

The opposition is directed against part of the goods covered by the contested trade mark, namely against those in class 20.

The opposition is based on the following earlier trade marks:

1. German trade mark registration No 397 13 100.3/20 for the above cited figurative mark  . It was filed on 24/03/1997 and registered on 22/04/1997 for goods in classes 7, 17 and 20. The opponent has filed evidence of renewal of this earlier trade mark.
2. German trade mark registration No 397 13 101.1/20 for the above cited figurative mark  . It was filed on 24/03/1997 and registered on 24/04/1997 for goods in classes 7, 17 and 20. The opponent has filed evidence of renewal of this earlier trade mark.
3. International trade mark registration No 697 606 for the Member States Benelux, France and Austria for the above cited figurative mark  . It was filed and registered on 03/07/1998 for goods in classes 7, 17 and 20.

The opponent bases its opposition on part of the goods that are covered by its registrations, namely those in class 20.

The grounds of the opposition are those laid down in Article 8(1)(b) of the Community Trade Mark Regulation (CTMR).

The opponent argues that the goods are partially identical and partially similar. Since the signs are visually and aurally very similar as regards the components "LEGRA" and "LYCRA" there is a likelihood of confusion.

The applicant requested proof of use of the earlier trade marks. It denies that the opponent has used the relevant goods in question. Furthermore, the marks do not contain any element which may suggest a link between the relevant marks in question. Since the goods are also partially dissimilar, there is no likelihood of confusion.

II. DECISION

Preliminary remark

In the decision dated 30/07/2009, the Office rejected the opposition as the evidence of use was found insufficient. With decision R 1153/2009-1 of 27/05/2010, the Board of Appeal decided that the evidence submitted at the opposition stage duly proved that the German registration No 397 13 100.3/20 had been used for all the goods mentioned in the registration. The merits of the opposition should be examined on that basis (par. 22 and 23). It remitted the file to the Opposition Division for a ruling on the merits.

Likelihood of Confusion – Article 8(1)(b) CTMR

According to Article 8(1) CTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

> (b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

a) **Comparison of the goods**

In assessing the similarity of the goods concerned, all the relevant factors relating to these goods should be taken into account. These factors include, inter alia, their nature, their purpose of use and their method of use and whether they are in competition with each other or are complementary (see Judgment of 29 September 1998, Case C-39/97, *Canon*, ECR I-5507).

Further factors include the purpose of the goods, whether or not they may be expected to be manufactured, marketed or provided by the same undertaking, or by economically linked undertakings, as well as their distribution channels and sales outlets.

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

Class 20
Bedroom furniture, bedsteads, lath grids, mattresses, supporting structures for lath grids.

The contested goods are the following:

Class 20
Furniture, cushions, pillows, mattresses, mattress pads; mirrors, photo frames, picture frames, baskets, hampers, jewellery boxes, furniture coverings, deckchairs and folding chairs, door stops, soft furnishings, trays; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone shell, amber, mother of pearl, meerschaum and substitutes for all these materials, or of plastic.

Furniture is **identical** to the goods of the earlier trade mark *Bedroom furniture*. The Office cannot dissect *ex officio* the broad category of the applicant's goods.

Mattresses, mattress pads are **identical** to the goods of the earlier trade mark *mattresses*.

Cushions, pillows, furniture coverings are **highly similar** to the goods of the earlier trade mark *Bedroom furniture, bedsteads, mattresses* because they have the same purpose, are directed at the same clients, are complementary and are sold in the same shops.

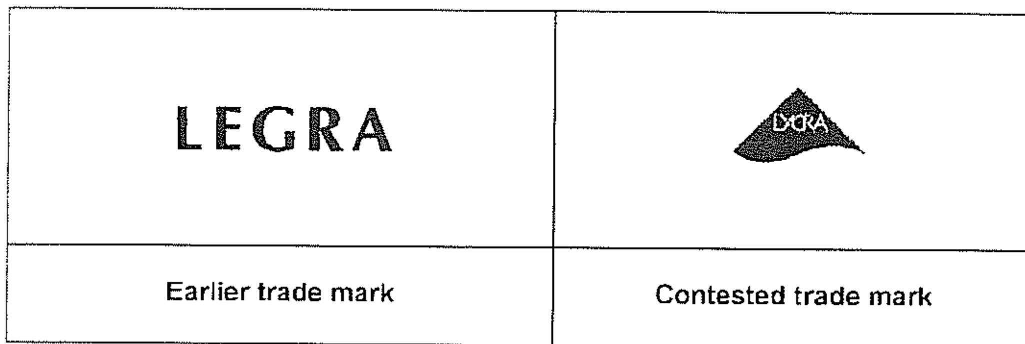
The contested goods *Mirrors, photo frames, picture frames, baskets, hampers, jewellery boxes, deckchairs and folding chairs, door stops, soft furnishings, trays* are not made by the same producers as the goods of the earlier trade mark, have different distribution channels, a different nature and purpose and are therefore **dissimilar**.

Further, *Bedroom furniture, bedsteads*, are usually made of *wood, cork, reed, cane, wicker* and therefore the contested goods made of these materials are **similar** to the goods of the earlier right mentioned before.

However, the remaining goods made of other materials, such as of *horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum and substitutes or of plastics* are **dissimilar**, since beds and their parts are usually not made of these materials.

b) Comparison of the signs

The marks under comparison are the following:



Earlier trade mark	Contested trade mark

The relevant territory is Germany.

Visually, both trade marks are combined signs with word and figurative elements. The figurative elements in the earlier trade mark are limited to bold letters in a face type. The figurative element of the contested trade mark is a wave device with a dark background and the word "LYCRA", written across the middle. As regards the figurative elements, the signs are visibly different. The word elements "LEGRA" and "LYCRA" have the same number of letters, namely five. Although the ending "RA" and the first letter "L" are identical, the beginnings of the signs "LEG" and "LYC" give a different visual impression. Thus, there is a low degree of visual similarity.

Aurally, figurative elements will not be taken into account. The following syllables have to be compared:
Earlier trade mark = "LE-GRA" or "LEG-RA;
Contested trade mark = "LIK-RA" or "LÜK-RA".
The signs have the same number of syllables, namely two. Nevertheless, the first syllables of the signs, "LE" or "LEG" of the earlier trade mark, and "LIK" or "LÜK" of the contested trade mark, sound different. Even if the second syllable "RA" is pronounced in the same way, there is only a below average degree of aural similarity.

Conceptually, the applicant points out that "LEGRA" has a meaning in "altniederfränkisch" (Altniederfränkisches Wörterbuch) in the sense of "bed" or "to lie down". It cannot be considered that this term would be understood by a relevant part of the German consumers. Therefore, this is a fanciful expression. "Lycra" will be understood by a part of the consumers as "hochelastische Kunstfaser" (DUDEN, Deutsches Universalwörterbuch) with the meaning "highly flexible synthetic fibre". Taking into account the sign in this sense, there is no conceptual similarity. For the rest of the consumers a conceptual comparison is, thus, not possible.

c) Global assessment

According to the case-law of the Court of Justice, in determining the existence of likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, phonetic and conceptual similarities between the marks. The comparison "must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components" (see Judgment of 11 November 1997, Case C-251/95, *Sabel*, ECR. I-6191).

Likelihood of confusion must be assessed globally, taking into account all the circumstances of the case. Likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa. Furthermore, the more distinctive the earlier mark, the greater the risk of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (see Judgment of 29 September 1998, Case C-39/97, *Canon*, ECR I-5507).

For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. 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 (see Judgment of 22 June 1999, Case C-342/97, *Lloyd Schuhfabrik Meyer*, ECR. I-3819).

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make a global assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. In making that assessment, account should be taken of all relevant factors and, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered (see Judgment of 22 June 1999, Case C-342/97, *Lloyd Schuhfabrik Meyer*, ECR. I-3819).

As to the distinctive character of the earlier trade mark, the opponent did not claim that its mark was particularly distinctive by virtue of intensive use or reputation. The distinctiveness of the earlier marks must rest on the distinctiveness *per se* of these meaningless signs which must be seen as normal in the present case.

Consumers generally tend to focus on the first part of a sign when confronted with a trade mark (see Judgment of the Court of 17 March 2004 in Joined Cases T-183/02 and T-184/02 *El Corte Inglés, SA* v *OHIM* ('Mundicor') [2004] ECR II-965, at paragraph 81; Judgment of the Court of 16 March 2005 in Case T-112/03 L'Oréal SA v OHIM ('Flexi Air') [2005] ECR II-949, at paragraph 64). The different beginnings of the signs "LEG" and "LYC" will be taken into account.

Furthermore, it has to be taken into account that for the goods in question the visual aspect plays an important role. Before buying goods such as furniture, parts thereof and accessories in class 20, the consumers will try to get a personal impression of the relevant products in question. These kinds of goods are in general sold after obtaining an extensive visual impression of them. Therefore, the visual aspect is more important than the aural impression because the goods will normally not be sold over the counter.

The relevant goods are partially identical, partially similar and partially dissimilar. As the goods are dissimilar, one of the necessary requirements for a likelihood of confusion is not fulfilled.

Considering all of the above, namely the visual and aural dissimilarities of the signs, their different beginnings and the principles of perception for the goods in question, the Office finds that there is no likelihood of confusion on the part of the public and therefore the opposition is not well founded on the basis of the opponent's German trade mark registration even though the goods are partially identical and similar.

Since there is no likelihood of confusion, the opposition must be rejected according to Article 8(1)(b) CTMR. Since the Boards of Appeal has only considered a proof of use for the above cited German trade mark registration, it is not necessary to examine the other earlier German trade marks. In addition, they have a lesser degree of similarity to the contested trade mark because they have further different word and figurative elements.

III. 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 opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) of Community Trade Mark Implementing Regulation (CTMIR), 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 OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET

(TRADE MARKS AND DESIGNS)

DECIDES TO:

1. Reject opposition B 1 085 721 in its entirety

2. Order the opponent to bear the costs, which are fixed as follows:

Costs of representation	EUR 300
Total amount	EUR 300

The Opposition Division

Maria Belén IBARRA DE DIEGO	Peter QUAY	Angel ESCRIBANO

Notice on the availability of an appeal:

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

Notice on the review of the fixation of costs:

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. Under 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) of the Community Trade Mark Fees Regulation (CTMFR)) has been paid.