

**Notification to the applicant/holder of a decision**

Alicante, 11/03/2019

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PAÍSES BAJOS

*Your reference:*

*Opposition number:* **B 002981366**

*Contested trade mark number:* **016932436**

*Name of the applicant/holder:* **Alda Holding B.V.**

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **11/03/2019**.



**Lars HELBERT**

Enclosures (excluding the cover letter): 14 pages.

**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 Article 94(2) EUTMR.**

## OPPOSITION No B 2 981 366

**WE Brand S.à.r.l.**, 31-33 Avenue Pasteur, 2311 Luxembourg, Luxembourg (opponent), represented by **Merkenbureau Knijff & Partners B.V.**, Leeuwendeldseweg 12, 1382 LX Weesp, Netherlands (professional representative)

a g a i n s t

**Alda Holding B.V.**, Anthony Fokkerweg 61, 1059 CP Amsterdam, Netherlands (applicant), represented by **Quirijn Meijnen**, Raadhuisstraat 52C, 1016DG Amsterdam, Netherlands (professional representative).


On 11/03/2019, the Opposition Division takes the following



### DECISION:

1. Opposition No B 2 981 366 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 goods and services of

European Union trade mark application No 16 932 436 (figurative mark , namely against all the goods in Classes 9 and 25. The opposition is based on

international trade mark registration No 1 243 721 (figurative mark ) designating Austria, Croatia, Denmark, Finland, Greece, Italy, Malta, Romania, Spain, Sweden, Slovakia, Poland, Latvia, Hungary, France, the European Union, Cyprus, Benelux, Bulgaria, Czech Republic, Estonia, Germany, Ireland, Lithuania, Portugal, Slovenia, the United Kingdom and European Union trade mark registration No 960 021 (figurative mark ). The opponent invoked Article 8(1)(b) EUTMR.

### SUBSTANTIATION of IR No 1 243 721

According to Article 95(1) EUTMR, in proceedings before it the Office will examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office is restricted in this examination to the facts, evidence and arguments submitted by the parties and the relief sought.

It follows that the Office cannot take into account any alleged rights for which the opponent does not submit appropriate evidence.

According to Article 7(1) EUTMDR, the Office will give the opposing party the opportunity to submit the facts, evidence and arguments in support of its opposition

or to complete any facts, evidence or arguments that have already been submitted together with the notice of opposition, within a time limit specified by the Office.

According to Article 7(2) EUTMDR, within the period referred to above, the opposing party must also file evidence of the existence, validity and scope of protection of its earlier mark or earlier right, as well as evidence proving its entitlement to file the opposition.

In particular, if the opposition is based on a registered trade mark that is not a European Union trade mark, the opposing party must submit a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in Article 7(1) EUTMDR and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered — Article 7(2)(a)(ii) EUTMDR. Where the evidence concerning the registration of the trade mark is accessible online from a source recognised by the Office, the opposing party may provide such evidence by making reference to that source — Article 7(3) EUTMDR.

In the present case, the opponent relied on online substantiation for its earlier international trade mark registration No 1 243 721 designating Austria, Croatia, Denmark, Finland, Greece, Italy, Malta, Romania, Spain, Sweden, Slovakia, Poland, Latvia, Hungary, France, the European Union, Cyprus, Benelux, Bulgaria, Czech Republic, Estonia, Germany, Ireland, Lithuania, Portugal, Slovenia, the United Kingdom. While TMView serves to substantiate the IR with the designation for the European Union, which can be found in TMView, none of the other claimed designations is actually registered at WIPO, i.e. there are no such designations to be found neither in TMView nor in Madrid Monitor.

According to Article 8(1) and (7) EUTMDR, if until expiry of the period referred to in Article 7(1) EUTMDR, the opposing party has not proven the existence, validity and scope of protection of its earlier mark or earlier right, as well as its entitlement to file the opposition, the opposition will be rejected as unfounded.

The opposition must therefore be rejected as unfounded, as far as it is based on the international trade mark registration No 1 243 721 designating Austria, Croatia, Denmark, Finland, Greece, Italy, Malta, Romania, Spain, Sweden, Slovakia, Poland, Latvia, Hungary, France, Cyprus, Benelux, Bulgaria, Czech Republic, Estonia, Germany, Ireland, Lithuania, Portugal, Slovenia and the United Kingdom.

### **LIKELIHOOD OF CONFUSION — 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.

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the

opponent's European Union trade mark registration No 960 021 (figurative mark **WE** ).

**a) The goods**

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

Class 3: *Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.*

Class 18: *Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks.*

Class 24: *Textiles and textile goods, not included in other classes; blankets and travelling rugs.*

Class 25: *Clothing, footwear, headgear.*

Class 26: *Ribbons and braids; buttons, hooks and eyes, pins and needles.*

The contested goods are the following:

Class 9: *Recordings of sound or images; records, compact discs, mini discs, laser discs, digital video discs, digital audio recordings, audio cassettes, video cassettes; magnetic tape, computer software and firmware, computer multimedia products; magnetic and optical programmes bearing media; floppy discs, CD-ROM, interactive compact discs; computer games, video games, interactive games; computer software, sound or video recordings, or publications, in electronic form supplied on-line or from facilities provided on the Internet; digital music provided from the Internet; digital recordings of performing arts entertainment provided from the Internet; sound recordings and images downloadable from the Internet.*

Class 25: *Clothing; footwear; headgear; t-shirts, caps, baseball caps, sweatshirts, jackets.*

As a preliminary remark, it is to be noted that according to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

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.

**Contested goods in Class 9**

The contested goods in this Class are recordings of sound and images, blank media storage containers, games and software. They have absolutely nothing in common with the opponent's goods in Classes 3, 18, 24, 25 or 26. They have a different nature and purpose; they are neither directed at the same public neither are these goods complementary nor in competition to each other. For these reasons, these goods are considered to be dissimilar.

## Contested goods in Class 25

*Clothing; footwear; headgear* are identically contained in both lists of goods.

The contested *t-shirts, sweatshirts, jackets* are included in the broad category of the opponent's *clothing*. Therefore, they are identical.

The contested *caps, baseball caps* are included in the broad category of the opponent's *headgear*. Therefore, they are identical.

### 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 found to be identical are directed at the public at large.

The degree of attention is considered to be average.

### c) The signs



Earlier trade mark



Contested sign

The relevant territory is the European Union.

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

The earlier mark is a figurative mark composed of the stylised word 'WE'.

The composition of the elements in the contested sign brings another layer to the sign, since it creates a rectangle and also makes it more difficult to read. Only with an analysing view, the stylised verbal elements 'WE ARE CONNECTED' are readable. The smiley on the first line is considered to be non-distinctive as it is commonly used in trade.

The word 'WE' included in both signs will either be perceived as a letter sequence or it refers to the first person plural pronoun in English (26/10/2018, R 260/2018-4,

WE/we are, § 24). Being a basic English word it will be understood by the relevant public if written on its own. Since it has no descriptive meaning in relation to the relevant goods, it is distinctive to an average degree. While it is of course true that the word 'WE' may sometimes be used in connection with the goods in question as indicating the first person plural, this factor on its own does not make it descriptive or otherwise devoid of distinctive character in relation to the goods that it covers (04/08/2014, R 2305/2013-2, WE (fig. mark) / WE, § 48).

The word 'connected' of the contested sign will be perceived as an English verb (brought together) by a part of the relevant public having a more than basic knowledge of English. In combination with the verbal element 'We' and the word 'are' (which is the plural for of the present tense of the verb 'to be' in English), it is understood as bringing us together, connecting. It will not be understood by another part of the public. Since it does not describe or allude to the characteristics of the goods, it is distinctive.

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).

Furthermore, the length of the signs may influence the effect of the differences between them. The shorter a sign, the more easily the public is able to perceive all of its single elements. Therefore, in short words, such as the earlier mark, small differences may frequently lead to a different overall impression. In contrast, the public is less aware of differences between long signs.

The signs have no elements which can be considered to be more dominant (eye-catching) than other elements.

**Visually**, the signs coincide in the verbal element 'WE', which is the only element of the earlier mark and placed in the first position of the contested sign. However, the signs differ substantially in their length as the verbal elements of the contested sign consist in total of 13 letters ('WE ARE CONNECTED') whereas the earlier mark only of two. The representation of the contested mark on five lines in equal lengths, creating a rectangular shape, differs substantially from the earlier mark which consists only of two letters on a single line. Moreover, in the case of the contested mark the word 'WE' it is somehow lost between all the other elements.

Therefore, the signs are similar to a very low degree.

**Aurally**, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the signs coincides in the syllable 'WE', present identically in both signs. The pronunciation differs in the sound of the letters 'are' and 'connected' in the contested mark, which have no counterparts in the earlier sign. As the signs are of a very different length, for example in the English language the earlier mark has one syllable while the contested mark has five, the signs are similar to a very low degree.

**Conceptually**, reference is made to the previous assertions concerning the semantic content conveyed by the marks. The signs will be associated by part of the relevant public with similar meanings on account of the word 'WE'. For that part of the public the signs are conceptually similar but the concept still differs because the earlier mark refers

to the first person plural as such while the contested mark makes a statement that we are connected. For consumers who do not attribute any meaning to the earlier mark or the contested mark, the conceptual comparison remains neutral (26/10/2018, R 260/2018-4, WE/we are, § 24), as the smiley in the contested mark is devoid of distinctive character.

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 opponent, the earlier 'WE' trade mark enjoys a high degree of distinctiveness as a result of its long standing and intensive use in the Benelux countries in connection with *clothing, bags and accessories*. This claim must be properly considered given that the distinctiveness of the earlier trade mark must be taken into account in the assessment of likelihood of confusion. Indeed, the more distinctive the earlier mark, the greater will be the likelihood of confusion, and therefore marks with a highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

The opponent submitted evidence to support this claim. As the opponent requested that certain commercial data contained in the evidence be kept confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data. The evidence consists of the following documents:

- Exhibit 3: WE shops in Europe;
- Exhibit 4: Worldwide trade mark overview;
- Exhibit 5: Witness Statement of 23/11/2015 signed by the Chief Financial Officer of the WE Fashion Group. The document contains information regarding the company marketing and media expenditure for the period 2010 until 2014;
- Exhibit 6: Documents showing sales information for the company WE Europe from 2012 until 2015 in the Netherlands, Germany, France and Luxembourg;
- Exhibit 7: A document referring to the advertising expenditure of seven clothing companies, among them also the company WE from 2011 until 2013.
- Exhibit 8-9: Press clippings for the years 2013, 2014, 2015 published in the Netherlands (i.e. in the magazines Elle, Linda, Jackie, Flair, Cosmopolitan, Men's Health, Glamour, etc.) for clothing under a trade mark 'WE'. Part of the evidence also contains articles referring to the earlier marks 'WE' and 'WE FASHION', however none of the articles is translated into the language of the proceedings;
- Exhibit 10: A copy and translation of a decision of the Court of Appeal in Brussels of 19/02/2018 in case between WE Netherlands B.V. and Famco N.V./Dor 1 N.V.

Even though it appears, for example from the submitted press clips, that products such as clothing, have been advertised and promoted, these pieces of evidence are insufficient to conclude how the advertising activity has affected the perception of the

relevant consumer regarding the sign in question. They do not contribute to assess the sign's degree of recognition in the mind of the relevant consumer, as there is no information provided about circulation figures these advertisements (magazines) have been circulated to. Without any further data showing how this advertising activity has affected the awareness of the relevant public regarding the earlier sign with respect to the relevant goods, it cannot be concluded that the earlier mark has acquired enhanced distinctiveness. In general, press clippings cannot be conclusive of enhanced distinctiveness on its own, due to the fact that it cannot give much information about actual trade mark awareness.

Furthermore, the documents containing tables regarding the claimed advertising expenses are coming from the opponent itself or from an unknown source and are not confirmed by a third party.

It is not possible to discern the earlier mark on the various magazine pages submitted and no explanation has been provided as to why these pages could contribute to the assessment of enhanced distinctiveness.

The opponent also invoked a decision of a Court in Belgium that has accepted the reputation/enhanced distinctiveness of the earlier mark. Even though national decisions are admissible evidence and may have evidentiary value, especially if they originate from a Member State the territory of which is also relevant for the opposition at hand, they are not binding for the Office, in the sense that it is not mandatory to follow their conclusion. The European Union trade mark system is an autonomous system, consisting of a set of rules and objectives that are specific, and applied independently of any national system.

The probative value of national decisions should be assessed on the basis of their contents and it may vary depending on the case. The probative value of national decisions will be considerably enhanced if the conditions of law and facts on the basis of which they were taken are made abundantly clear. This is because, in the absence of these elements, it will be more difficult both for the applicant to exercise its right of defence and for the Office to assess the decision's relevance with a reasonable degree of certainty. Similarly, if the decision is not yet final, or if it is outdated due to the time that has elapsed between the two cases, its probative value will be diminished accordingly.

Having examined the material listed above, the Opposition Division concludes that the evidence submitted by the opponent does not demonstrate that the earlier trade mark acquired a high degree of distinctiveness through its use.

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 are identical or dissimilar and target consumers with an average degree of attention. The signs are visually similar to a very low degree and aurally similar to a low degree as they only have the two letters, 'WE' in common. They are either conceptually similar or the conceptual comparison remains neutral. The contested




sign includes another concept (at least for a part of the public) in the element '(are) connected' that is not weak for the relevant goods.

The distinctiveness of the earlier mark is normal since the enhanced distinctiveness has not been proven. The documents submitted by the opponent do not allow any conclusions as to the market share held by the earlier mark, the intensity, geographical extent, duration of its use and the size of the investment made by the opponent in promoting it (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 23). The decision of the Appeal Court Brussels of 19/02/2008 refers to Benelux registrations and evidence regarding 'advertising and promotion' and 'intensive use for years' which, however, was not submitted in the case at hand. The same applies to the decision of the Benelux Bureau for Intellectual Property of 12/04/2011 which essentially relies on the decision of the Appeal Court Brussels of 2008.

Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 50). Therefore, the considerable visual differences between the signs caused by the additional verbal elements in the contested mark, and its rather striking composition, are particularly relevant when assessing the likelihood of confusion between them.

The Opposition Division considers that the additional different elements of the contested mark are sufficient to exclude any likelihood of confusion between them. The visual and aural coincidence in the word 'WE' does not constitute a significant factor in the present case. The signs leave clearly a different general impression. In fact, in the contested mark, due to its composition, the word 'WE' is somehow lost between other elements and cannot be immediately identified as a component with an independent role. Therefore, the relevant consumer of the goods in question is not likely to recollect the earlier sign when confronted with the contested sign even on identical goods.

Considering all the above, there is no likelihood of confusion on the part of the public. Therefore, the opposition must be rejected, insofar it is based on the European Union trade mark registration No 960 021. The Opposition Division will now proceed with the opposition by comparing the contested sign with the remaining earlier

international trade mark registration No 1 243 721 (figurative mark ) designating the European Union.

#### **f) The goods and services**

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

Class 9: *Software, especially downloadable user programs (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices, downloadable music files, downloadable files, downloadable movies; eyewear, including sunglasses; spectacle frames; pouches and cases for eyeglasses.*

Class 25: *Clothing, footwear, headgear, namely woollen hats, hats and caps; belts.*

Class 35: *Advertisement; business management; business administration; administrative services; business mediation in the purchase and sale of goods in classes 9 and 25; retail services relating to the goods in classes 9 and 25; the aforesaid services also to be provided electronically, including the internet; management of a customer loyalty program or organization of promotional activities to promote customer loyalty; supervision of customer loyalty.*

The contested goods are the following:

Class 9: *Recordings of sound or images; records, compact discs, mini discs, laser discs, digital video discs, digital audio recordings, audio cassettes, video cassettes; magnetic tape, computer software and firmware, computer multimedia products; magnetic and optical programmes bearing media; floppy discs, CD-ROM, interactive compact discs; computer games, video games, interactive games; computer software, sound or video recordings, or publications, in electronic form supplied on-line or from facilities provided on the Internet; digital music provided from the Internet; digital recordings of performing arts entertainment provided from the Internet; sound recordings and images downloadable from the Internet.*

Class 25: *Clothing; footwear; headgear; t-shirts, caps, baseball caps, sweatshirts, jackets.*

An interpretation of the wording of the list of goods and services is required to determine the scope of protection of these goods and services.

The terms 'including' and 'especially', used in the opponent's list of goods and services, indicates that the specific goods and services are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107).

However, the term 'namely', used in the opponent's list of goods and services to show the relationship of individual goods and services to a broader category, is exclusive and restricts the scope of protection only to the goods and services specifically listed.

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.

### **Contested goods in Class 9**

The contested *computer games, video games, interactive games; computer software and firmware; computer software, in electronic form supplied on-line or from facilities provided on the Internet* overlap with the opponent's goods *software, especially downloadable user programs (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices, downloadable music files, downloadable files, downloadable movies* and are therefore identical.

The contested *recordings of sound or images; digital audio recordings, computer multimedia products; magnetic and optical programmes bearing media; sound or video recordings, or publications, in electronic form supplied on-line or from facilities provided on the Internet; digital music provided from the Internet; digital recordings of performing arts entertainment provided from the Internet; sound recordings and images downloadable from the Internet* are similar to the opponent's software, especially downloadable user programs (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices, downloadable music files, downloadable files, downloadable movies as they usually coincide in producer, relevant public and distribution channels. Furthermore they are complementary.

However, the contested *records, compact discs, mini discs, laser discs, digital video discs, audio cassettes, video cassettes; magnetic tape; floppy discs, CD-ROM, interactive compact discs* as media storage units as such are dissimilar to the opponent's goods and services in Classes 9, 25 and 35. They are neither complementary nor in competition to each other and have a different purpose. They are also dissimilar to the retail services relating to the goods in Class 9 as they refer not to all possible goods in Class 9 but only the ones mentioned in Class 9 of the earlier mark. Apart from being different in nature, since services are intangible whereas goods are tangible, they serve different needs. *Retail services* consist in bringing together, and offering for sale, a wide variety of different products, thus allowing consumers to conveniently satisfy different shopping needs at one stop. This is not the purpose of goods. Furthermore, goods and services have different methods of use and are neither in competition nor complementary.

Similarity between retail services of specific goods covered by one mark and specific goods covered by another mark can only be found where the goods involved in the retail services and the specific goods covered by the other mark are identical. This condition is not fulfilled in the present case, since the goods at issue are not identical.

Advertising services consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing a client's position in the market and acquiring competitive advantage through publicity. Many different means and products can be used to fulfil this objective. These services are provided by specialist companies, which study their client's needs, provide all the necessary information and advice for marketing the client's goods and services, and create a personalised strategy for advertising them through newspapers, websites, videos, the internet, etc.

*Advertising services* are fundamentally different in nature and purpose from the manufacture of goods or the provision of many other services. The fact that some goods or services may appear in advertisements is insufficient for finding similarity. Therefore, *advertising* is dissimilar to the goods or services being advertised and consequently also to the contested *records, compact discs, mini discs, laser discs, digital video discs, audio cassettes, video cassettes; magnetic tape; floppy discs, CD-ROM, interactive compact discs*.

### **Contested goods in Class 25**

*Clothing; footwear; caps* are identically contained in both lists of goods.

The contested *headgear* includes, as a broader category, the opponent's *headgear, namely woollen hats, hats and caps*. Since the Opposition Division cannot dissect ex

*officio* the broad category of the contested goods, they are considered identical to the opponent's goods.

The contested *t-shirts, sweatshirts, jackets* are included in the broad category of the opponent's *clothing*. Therefore, they are identical.

The contested *baseball caps* are included in the broad category of the opponent's *headgear, namely woollen hats, hats and caps*. Therefore, they are identical.

#### **g) 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 found to be identical or similar are directed at the public at large.

The degree of attention is considered to be average.

#### **h) The signs**



Earlier trade mark



Contested sign

The relevant territory is the European Union.

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

The word 'WE' on its own and included in both the signs refers to the first person plural pronoun in English and will be understood at least by the English-speaking public. However, since it has no meaning in relation to the relevant goods and services, it is distinctive to an average degree. The same applies to the word 'ME' in the earlier mark, which refers to the first person singular.

However, the combined words 'WE ARE CONNECTED' of the contested sign will be perceived as such from the perspective of the English-speaking public. These words will be understood by the part of the relevant public having a basic knowledge of English throughout the European Union. This combination is considered to be non-distinctive for the goods in Class 9, as it will be seen as a banal slogan for goods such as software which can connect people (for example providing video call

software). For the part of the public who does not grasp that meaning and for the other goods in Class 25 which cannot be connected through the internet, these words are considered to be of normal distinctive character.

The word 'IS' of the earlier sign will be perceived as third person singular of the verb "to be" from the perspective of the English-speaking public. This word will be understood by the part of the relevant public having a basic knowledge of English throughout the European Union. Since it does not describe or allude to the characteristics of the goods and services, it is distinctive.

The marks have no element that could be considered clearly more dominant than other elements.

**Visually**, the signs coincide only in the word 'WE'. However, they differ in the words 'ARE CONNECTED' of the contested mark and the words 'IS ME' as well as the graphic representations in both signs.

Moreover, the contested mark contains an additional figurative element, namely the smiley which, despite being non-distinctive, will not go completely unnoticed. Since the signs only share the verbal element 'WE', they are visually similar to a low degree.

**Aurally**, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the signs coincides in the sound of the letters 'WE', present in both signs. The pronunciation differs in the rest, namely in 'IS ME' of the earlier mark and 'ARE CONNECTED' of the contested mark.

Consequently, the marks are considered aurally similar to a low degree.

**Conceptually**, the signs will be associated with a similar meaning, at least for the English-speaking part of the public, to the extent that they all refer to the pronoun 'WE', a word used by the speaker to refer to him- or herself and more persons, although the concepts of *we is me* and *we are connected* are quite far apart. For consumers who do not attribute any meaning to the earlier mark or the contested mark, the conceptual comparison remains neutral (26/10/2018, R 260/2018-4, 'weare', § 24).

Consequently, the marks are considered conceptually similar to a low degree for a part of the relevant public.

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

#### **i) 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 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.

#### **j) Global assessment, other arguments and conclusion**

The goods are partially identical, partially similar and partially dissimilar and target consumers with an average degree of attention. The earlier mark has an average degree of distinctiveness. The signs are visually and aurally similar to a low degree on account of the two letters, 'WE', that they have in common. Conceptually, the only similarity is that both signs refer to 'WE', while the message of the two signs is quite different.

Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion (06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 50). Therefore, the considerable visual differences between the signs caused by the different verbal and figurative elements are particularly relevant when assessing the likelihood of confusion between them.

The Opposition Division considers that the different elements of the contested mark are sufficient to exclude any likelihood of confusion between them. The visual and aural coincidence in the word 'WE' does not constitute a relevant and significant factor in the present case: the differing elements of the marks are much longer and are clearly perceptible. The additional elements of the contested sign (despite the fact that some of them are non-distinctive for part of the public and for part of the goods) are sufficient to exclude any likelihood of confusion between them. The relevant consumer of the goods in question and services is not likely to recollect the earlier sign when confronted with the contested sign even on identical goods.

Considering all the above, there is no likelihood of confusion on the part of the relevant public.

Therefore, the opposition must be rejected.

#### **COSTS**

According to Article 109(1) EUTMR, 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 Article 109(7) EUTMR and Article 18(1)(c)(i) EUTMR (former Rule 94(3) and Rule 94(7)(d)(ii) EUTMR, in force before 01/10/2017), 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 Opposition Division**

Tu Nhi VAN

Lars HELBERT

Swetlana BRAUN

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 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 for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.