



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

The Boards of Appeal
The Registry

R420h

Alicante, 14/11/2012
R0084/2011-4

BARKHOFF REIMANN VOSSTUS
Grosjeanstr. 2
D-81925 München
ALEMANIA

Subject: Appeal No. R0084/2011-4
Your ref.: 662-36

Notification of a decision of the Fourth Board of Appeal

Please find enclosed the decision of the Fourth Board of Appeal dated 12/11/2012 concerning the appeal filed on 05/01/2011 in the name of Rössle & Wanner GmbH.

Article 65 of the Regulation on the Community Trade Mark provides that an action may be brought before the Court of Justice of the European Union (General Court) in Luxembourg against decisions of the Boards of Appeal within 2 months after notification of the decision.

Your attention is drawn to the fact that the proceedings before the European Court of Justice are regulated by specific requirements stated in the *Statute of the Court of Justice of the European Union*, in the *Rules of Procedure of the General Court* as well as in the *Court of First Instance Practice Directions to parties*. Further information concerning the proceedings before the General Court may be obtained on the homepage of the European Court of Justice 'curia.europa.eu' under *General Court : Procedure : Practice Directions to Parties*.

Information related to appeals filed against Boards of Appeal decisions may also be obtained on the same homepage indicated above.

To the extent that you are adversely affected by the attached decision and you nonetheless decide not to challenge it, we would appreciate you informing us accordingly as soon as possible.

Florence PIASER
Registry

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

The Boards of Appeal

DECISION
of the Fourth Board of Appeal
of 12 November 2012

In Case R 84/2011-4

Rössle & Wanner GmbH

Ulrichstr. 102
72116 Mössingen
Germany

Opponent / Appellant

represented by Ostertag & Partner, Epplestr. 14, 70597 Stuttgart, Germany

v

INVISTA TECHNOLOGIES S.à.r.l.

Kreuzackerstrasse 9
9000 St. Gallen
Switzerland

Applicant / Respondent

represented by Barkhoff Reimann Vossius, Grosjeanstr. 2, 81925 Munich, Germany

APPEAL relating to Opposition Proceedings No B 1 085 721 (Community trade mark application No 4 460 473)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman), C. Bartos (Rapporteur) and F. López de Rego (Member)

Registrar: P. López Fernández de Corres

gives the following

Decision

Summary of the facts

- 1 By an application of 27 May 2005, INVISTA TECHNOLOGIES S.à.r.l. ('the respondent') sought to register the figurative mark



as a Community trade mark for various goods and services in Classes 2-5, 8, 9, 11, 12, 14, 16-18, 20-28, 35, 41, 43 and 44. The following goods are relevant in the present appeal proceedings:

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.

- 2 On 4 December 2006, Rössle & Wanner GmbH ('the appellant') filed a notice of opposition against the application with respect to the aforementioned goods applied for in Class 20 on the grounds of opposition laid down in Article 8(1)(b) CTMR and based it on the following earlier trade marks:

- a) German trade mark No 397 131 00

LEGRA

registered on 22 April 1997 for 'electric drives for slatted frames in Class 7, 'mattress cores made from rubber or plastic material in Class 17 and 'slatted frames, bedsteads, bedroom furniture, underframes for slatted frames, mattresses' in Class20;

- b) German trade mark No 397 131 01



registered on 24 April 1997 registered for the same goods as indicated under paragraph 2 a).

- c) International trade mark registration No 697 606



for the Benelux, France, and Austria, registered for the same goods as indicated under paragraph 2 a).

- 3 The opposition was based on part of the goods covered by the earlier trade marks, namely:

Class 20 – Slatted frames, bedsteads, bedroom furniture, underframes for slatted frames, mattresses.
- 4 Upon the respondent's request, the Opposition Division invited the appellant to furnish proof of use of the earlier marks.
- 5 On 30 July 2009, the Opposition Division rendered a decision by which it rejected the opposition because the evidence filed to demonstrate genuine use of the earlier marks was insufficient.
- 6 This decision was appealed by the appellant and by decision of 27 May 2010 R 1153/2009-1, the First Board of Appeal annulled the Opposition Division's decision. The Board held that the proof of use filed at the opposition stage was sufficient to demonstrate genuine use of the earlier German trade mark No 397 131 00. It remitted the case back to the Opposition Division to assess whether a likelihood of confusion existed.
- 7 On 8 November 2010, the Opposition Division took a new decision ('the contested decision') by which it rejected the opposition in its entirety and ordered the opponent to bear the costs. Its arguments can be summarized as follows:
 - The contested goods are identical ('furniture, mattresses, mattress pads'), highly similar ('cushions, pillows, furniture coverings'), similar ('wood, cork, reed, cane, wicker') or dissimilar ('mirrors, photo frames, picture frames, baskets, hampers, jewellery boxes, deckchairs and folding chairs, door stops, soft furnishings, trays, horn, bone, ivory, whalebone shell, amber, mother of pearl, meerscham and substitutes for all these materials, or of plastic') to the opposing goods.
 - Visually, the signs are similar to a low degree. As regards the figurative elements, the signs are visibly different. Although the signs' word elements have the same number of letters and share the ending '-RA' and the first letter 'L', the beginnings 'LEG-' and 'LYC-' confer a different visual impression.
 - Aurally, the signs have a below average degree of similarity. The signs have the same number of syllables; however, their respective first syllables sound different.

- Conceptually, the term 'LEGRA' is a fanciful expression. The respondent's assertion is rejected since it cannot be considered that the term will be understood by a relevant part of German consumers as an expression originating from the old Low Franconian dialect meaning 'bed' or 'to lie down'. The term 'LYCRA' will be understood by a part of consumers with the meaning of 'highly flexible synthetic fibre'. For the part of the public that comprehends this meaning, there is no conceptual similarity. For the remainder, a conceptual comparison is not possible.
- The distinctiveness of the earlier mark is average *per se*.
- Considering the goods at issue, the visual aspect plays an important role.
- Considering the visual and aural dissimilarities between the signs, their different beginnings and the principles of how the goods perceived, there is no likelihood of confusion, even though the goods are partially identical and similar.

Submissions and arguments of the parties

- 8 The appellant filed a notice of appeal against the contested decision, followed by a statement of grounds.
- 9 The appellant requests the Board to annul the contested decision and to reject the CTM application for all the goods applied for in Class 20. It does not contest the comparison of the goods as carried out by the Opposition Division.
- 10 Together with the statement of grounds, the appellant submits the following documents in order to support its allegations:
 - Extracts from '*Duden – Die deutsche Rechtschreibung – Band 1*', 24th edition, 2006, 16 pages, monolingual dictionary of the German language, showing diverse entries of words beginning with the letters 'L', 'O', and 'S';
 - Extract from SAEGIS in English, dated 8 March 2011, showing a hits overview of a trade mark search for various national trade marks, Community trade marks, and international registrations, protected for goods in Class 20, and containing the letter sequences 'L-CR-', 'L-GR-', 'L-KR-', or 'L-CHR-';
 - Print-outs from the online encyclopedia '*Wikipedia*', showing the article 'International Phonetic Alphabet' in English, the corresponding Article '*Internationales Phonetisches Alphabet*' in German, and the corresponding article '*Alphabet phonétique international*' in French;
 - Extract from '*Hacker/Ströbele, Markengesetz – Kommentar*', 9th edition, 2009, commentary on German trade mark law, in German, showing an

excerpt from the section '*Relative Schutzhindernisse*' (relative grounds), and '*Klangliche Ähnlichkeit*' (aural similarity);

- Extract from '*GRAND LAROUSSE – EN 5 VOLUMES – Tome 5*', 1994, monolingual dictionary of the French language, showing one page with entries of words beginning with the letter 'Y';
- Extract from '*PETIT LAROUSSE illustré*', 1973, monolingual dictionary of the French language, showing diverse entries of words beginning with the letter 'L'.

- 11 However, the appellant argues that the Opposition Division failed to give due consideration to the strength of the conflicting signs and to evaluate their overall similarity correctly. The signs are almost identical or similar to a very high degree, respectively. Neither the word 'LEGRA' nor the word 'LYCRA' has a meaning in German. They are of clearly above average distinctiveness, both in German as well as in French. The letter string 'L-GR-' and equivalents are very rare and, thus, distinctive, in the German language as can be seen from the *Duden* extract. This is corroborated by the extract from the SAEGIS search from which it can be inferred that only a few trade marks which comprise these letter strings are registered in Class 20. The appellant asserts that a large part of the relevant German consumers, will pronounce the letter 'y' like the vowel 'i'. Only the part of the public that is aware of the letter's Greek origin will pronounce it like the unlauded 'ü'. In German, words that audibly comprise the vowel 'i' are commonly spelled with the letter 'y'. German consumers are frequently unsure whether to such words are spelled with the letter 'y' or the vowel 'i'. The appellant claims that there is a likelihood of confusion in relation to the goods found identical, highly similar, or similar and, hence, the contested application is to be rejected to this extent.
- 12 The respondent requests the Board to dismiss the appeal and to allow the application for registration.
- 13 At the outset, the respondent objects to the fact that the additional evidence was filed in German and French at the appeal stage, and not in English. As to the substance, the respondent supports the contested decision. It reiterates that the signs are aurally dissimilar. The mark 'LYCRA' will be pronounced by German consumers either as [l-ü-k-r-a] or as [l-a-i-k-r-a]. In German, the consonant 'y' is typically pronounced like the unlauded 'ü', for example in the words 'Zyperm' and 'Sylt' which are pronounced as [z-ü-p-e-r-n] and [s-ü-l-t], respectively. As regards the appellant's assertion that French trade circles pronounce the conflicting signs in a different manner, the entire argumentation has to be rejected. The appellant was not able to demonstrate genuine use of its mark 'LEGRA' outside the German market.

Reasons

- 14 The appeal is admissible but not well-founded. A likelihood of confusion within the meaning of Article 8(1)(b) CTMR does not exist between the trade marks at issue.

On the proof of use

- 15 In decision R 1153/2009-1, the First Board of Appeal found that the adduced evidence proved that the earlier German trade mark No 397 131 00 has been put to genuine use. The First Board of Appeal did not assess the adduced evidence with respect to the remaining earlier trade marks on which the opposition was based. For reasons of procedural economy, the Board will first proceed with the assessment of the earlier German trade mark No 397 131 00.

The evidence submitted in the present appeal proceedings

- 16 As regards the additional evidence filed by the appellant at the appeal stage, as listed under paragraph 9, Rule 96(1) CTMIR excludes their consideration because translations thereof into the language of the proceedings could and should have been supplied within one month from the date of the submission of the original document, *i.e.* 8 March 2011. It is settled law that the rule according to which the evidence submitted in support of an opposition must be submitted in the language of the proceedings or be accompanied by a translation into that language is justified by the need to observe the principle of the right to be heard and to ensure equality of arms between the parties in *inter partes* proceedings (see judgments of 30 June 2004, T-107/02, ‘Biomate’, par. 72; and of 6 November 2007, T-407/05, ‘Revian’s’, par. 35).
- 17 However, the Board notes that the evidence produced by the appellant relates to dictionary entries and linguistic facts that will be taken into consideration as well-known facts in the context of the assessment of the first-instance decision and, *i.e.* in the context of the assessment of the existence of a likelihood of confusion, in any event.

Article 8(1)(b) CTMR

- 18 Under Article 8(1)(b) CTMR, a trade mark applied for is not to be registered if, because of its identity with or similarity to an 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.
- 19 A likelihood of confusion is to be understood as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings. The likelihood of confusion must be assessed globally, according to the relevant public’s perception

of the signs and goods or services concerned, taking into account all factors relevant to the circumstances of the case.

- 20 The earlier mark on which the opposition is based is a German trade mark. The goods at stake are everyday consumer goods. Therefore, the relevant territory for analysing the likelihood of confusion is Germany and the relevant public to be taken into consideration is the average German end consumer. The average end consumer is deemed to be reasonably well informed and reasonably observant and circumspect. Additionally, the goods at stake are normally acquired visually. Consequently, the visual impact of the signs plays a more important role in the overall assessment of the likelihood of confusion.

Comparison of the goods

- 21 The opposition was based on part of the goods covered by the earlier German trade mark, namely those registered in Class 20.
- 22 The assessment of the similarity between the goods must take into account all relevant factors, which include their nature, purpose and method of use, and whether they are in competition with each other or complementary (judgment of 29 September 1998, C-39/97, 'Canon', par. 23). Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (judgment of 11 July 2007, T-443/05, 'Pirañam', par. 37). The reference point is whether the relevant public would perceive the relevant products as having a common commercial origin (judgment of 4 November 2003, T-85/02, 'Castillo', par. 38) and whether consumers consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers or distributors of these products are the same (judgment of 11 July 2007, T-150/04, 'Tosca Blu', par. 37).
- 23 The Board endorses the findings of the contested decision insofar as it correctly found that some of the opposing goods are identical, i.e. 'mattresses' which are covered by the earlier mark with the same wording. As to the remainder the Opposition Division held that the goods concerned were partially similar and partially dissimilar. These findings were expressly acknowledged by the appellant and the Board cannot see any reasons why these findings could be incorrect. As regards the goods found dissimilar, Article 8 (1) (b) CTMR cannot be considered as fulfilled since its application is subject to several, cumulative conditions, one of them being identity or similarity of the goods concerned. In any event, likelihood of confusion is to be excluded even in relation to identical goods. As outlined below, the conflicting signs have only a low level of similarity from a visual and aural point of view, and no conceptual similarity. Such a low level of similarity is not of a nature so as to constitute the necessary condition for a likelihood of confusion in the sense of Article 8 (1) (b) CTMR. In addition to that, the distinctiveness of the earlier German trade mark "LEGRA" is only average.

Comparison of the signs

- 24 As regards the comparison of the conflicting signs, the global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the signs in question, must be based on the overall impression given by the signs, bearing in mind, in particular, their distinctive and dominant components. The average consumer normally perceives a sign as a whole and does not proceed to analyse its various details (judgments of 11 November 1997, C-251/95, ‘Sabèl’, par. 23; and of 6 October 2005, C-120/04 ‘Thomson Life’, par. 28).
- 25 In addition, the assessment of the similarity between two signs does not amount to taking into consideration only one component of a complex sign and comparing it with another sign, but such a comparison must, on the contrary, be made by examining the signs in question, each considered as a whole (judgment of 6 October 2005, C-120/04, ‘Thomson Life’, par. 29; and order of 28 April 2004, C-3/03 P, ‘Matratzen’, par. 32).
- 26 The earlier trade mark under comparison is a German trade mark, thus, the perception of the signs by the public in Germany is relevant for the case at hand.
- 27 From a visual perspective, the earlier sign consists of the standard, upper-case letters ‘LEGRA’ that are depicted with large character spacing in a black colour. Its font does not add anything to the distinctive character of the sign and can be neglected.
- 28 The contested sign is composed of a black coloured, right-angled triangle. The triangle is composed of two straight sides, equal in length, whilst its hypotenuse – the side opposite to the right angle – is formed by a wavy line. Additionally, the letters ‘LYCRA’ are positioned in the middle of the figurative device in white, standard upper-case letters that are placed together closely. It can be observed that the verbal elements of the respective signs share the same number of letters, and the identical first and final letters, namely the letter ‘L-’ and the letters ‘-RA’.
- 29 According to well-established case-law, figurative or stylistic elements of a composite sign cannot summarily be dismissed as negligible for the purposes of the comparison of the signs to the extent to which they can add to the differentiation between them or even contribute to a different overall impression (see judgment of 8 February 2007, T-88/05, ‘Nars’, par. 61).
- 30 In the present case, the figurative elements of the contested sign are not negligible. Although the graphic elements are not necessarily the dominant elements of the contested sign, the triangle with its wavy bottom side is of a considerably larger size than the verbal element ‘LYCRA’ placed in it and it has a distinctive character. Significant dissimilarities arise from the different graphic elements of the respective signs, as regards their colour, position, form and size. The verbal element of the contested sign is depicted in a white colour whilst the earlier mark features black coloured letters. The triangle with its prominent size

and design represent the visually eye-catching part of the contested sign. The figurative element of the contested sign confers on the conflicting signs a different structure and overall impression. Moreover, even if only the word elements were taken into account, since both signs comprise two relatively short words, the differences between them will be easily grasped by the consumers (see judgment of 18 October 2011, T-304/10, 'BALEA', pars 40 to 41). This is especially true considering that the targeted public will focus on the visual impression of the signs concerned considering the goods at stake.

- 31 It is, therefore, concluded that the signs at issue, considered in their entirety, are visually similar to a low degree only.
- 32 From an aural perspective, the earlier mark will be pronounced as [le-gra] and the contested sign most probably as [lü-kra] or [lai-kra] in accordance with German language rules. In this respect, the Board notes that the verbal elements of the conflicting signs are neither lexically verifiable in the German language nor generally comprehensible by the relevant German consumer. Relevant consumers will perceive the signs primarily as invented words and, hence, rely upon the rules of German pronunciation. Although the appellant's assertion that some words might exist in German that, when written, comprise the letter 'y' which, aurally, is pronounced like the vowel 'i' might be accurate, such a general grammatical rule does not exist in German phonetics. On the contrary, there is a tendency across the German public to pronounce the letter 'y' like the unlauded 'ü'. This is true as regards the vast majority of cases, in particular if the relevant consumer faces an unknown word as in the case at issue. By the same token, it is rather unlikely that German consumers will make an attempt to apply pronunciation rules of a foreign language, for example English as suggested by the respondent (see judgement of 9 March 2012, T-207/11, 'Isense', pars 22 and 23).
- 33 Whilst both signs consist of two syllables, it can be observed that each syllable will be pronounced differently according to German pronunciation rules. In particular the conflicting signs' first syllables, namely [le] and [lü] or [lai] respectively, despite the identical first letter, are markedly different in their pronunciation, mainly due to the variant sound created by the first syllables [lü] or [lai] respectively comprised in the contested sign as opposed to the syllable [le] comprised in the earlier sign. The ending of the signs' respective second syllable with the open vowel 'a' creates certain aural similarities. The figurative elements of the signs concerned are not aurally reflected.
- 34 In sum, the Board finds that the conflicting signs are aurally similar to a low degree.
- 35 From a conceptual perspective, neither sign has a meaning for the German public. As a result, the conceptual comparison remains neutral.

Global assessment of likelihood of confusion

- 36 A likelihood of confusion on the part of the public must be assessed globally and that global assessment implies some interdependence between the factors taken into account and in particular the similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (judgments of 29 September 1998, C-39/97, 'Canon', par. 17; and of 22 June 1998, C-342/97, 'Lloyd Schuhfabrik', par. 19). The more distinctive the earlier mark, the greater the risk of confusion, and 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 (judgment of 29 September 1998, C-39/97, 'Canon', par. 18).
- 37 The appellant has not explicitly claimed that the earlier trade mark enjoys particular distinctive character by virtue of intensive use or reputation. The evidence submitted as proof of genuine use of the earlier trade mark is, in any event, insufficient to prove an enhanced distinctiveness. Whilst the documents demonstrate that sales activities under the earlier mark have taken place to a certain extent, they do not prove how the earlier trade mark is actually perceived by the public.
- 38 The appellant claimed that the earlier trade mark 'LEGRA' enjoys particular distinctive character due to the fact that the letter string 'L-GR-' is very rare in the German language. The Board observes that the mere fact that a specific sequence of letters is rather rare in a language without considering the goods and services for which the trade mark in question is registered does not impact on the inherent distinctive character of a trade mark. Distinctive character has to be assessed with respect to the specific goods concerned. The earlier trade mark has, however, no descriptive meaning in relation to the goods at issue and, therefore, its inherent distinctive character has to be considered as average.
- 39 The Board finds that the fact that the verbal elements of the conflicting signs coincide in some letters is clearly outweighed by the considerable visual and phonetic differences in the verbal elements of the signs and the additional figurative elements in the contested sign which have no equivalent in the earlier sign. The latter is of considerable importance given that, in relation to the goods at issue, the visual impression conferred by the marks will prevail in the relevant public's perception of them. It follows from the foregoing, considered cumulatively and taking into account the fact that the earlier mark is distinctive to an average degree, that the significant differences between the signs exclude a likelihood of confusion on part of the German public. The Board concludes that the targeted consumer will not be led to consider that the signs at issue, used in connection with similar or even identical goods, come from the same or economically-linked undertakings. Consequently, the risk that the relevant public establishes the same commercial origin to the goods marketed under the conflicting marks can be excluded.

- 40 The Board must therefore conclude that the conditions for the application of Article 8 (1) (b) CTMR are not satisfied with regard to earlier German trade mark No 397 131 00 , not even for identical goods.
- 41 As regards earlier German trade mark No 397 131 01 and international trade mark registration No 697 606, both of which are registered for the figurative sign 'RÖWA LEGRA', a fortiori, likelihood of confusion can be safely excluded since these trade marks include the additional distinctive word element 'RÖWA' which is separated by the striking graphic device of a horse head in red colour. The signs are dissimilar to the contested sign. Since one precondition of Article 8(1)(b) CTMR is missing, no likelihood of confusion exists. As a consequence, it is unnecessary to rule on the question whether the request for proof of genuine use with respect to these earlier trade marks was admissible or to assess the evidence submitted by the appellant as proof of use.
- 42 Taking into account the above considerations, the appeal is dismissed.

Costs

- 43 As the appellant is the losing party within the meaning of Article 85(1) CTMR, it must be ordered to bear the costs in the opposition and appeal proceedings.

Fixing of costs

- 44 In accordance with Article 85(6) CTMR in conjunction with Rule 94(7)(d)(ii) and (vi) CTMR, the Board fixes the amount of costs to be paid by the appellant to the respondent at EUR 550 for the representation costs with respect to the appeal proceedings and at EUR 300 for the representation costs of the opposition proceedings, in total EUR 850.

Order

On those grounds,

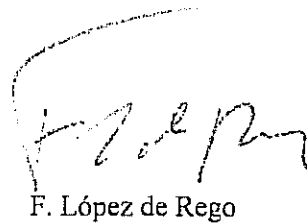
THE BOARD

hereby:

1. Dismisses the appeal;
2. Orders the appellant to bear the respondent's costs of the opposition and appeal proceedings;
3. Fixes the amount to be paid by the appellant to the respondent at EUR 850.


D. Schenker


G. Bartos


F. López de Rego


P. López Fernández de Corres

Registrar: P. López Fernández de Corres