

Notification to the applicant/holder of a decision

Alicante, 26/11/2018

Leeway B.V.
Barbara Strozziilaan 101
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PAÍSES BAJOS

Your reference:

Opposition number:

B 002724154

Contested trade mark number:

W01293504

Name of the applicant/holder:

allGreen Group BV

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **26/11/2018**.



Paloma PERTUSA MARTINEZ

Enclosures (excluding the cover letter): 7 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 2 724 154

Barcelona de Serveis Municipals, S.A., Gran Via Carles III, 85 bis, 08028 Barcelona, Spain (opponent), represented by **R. Volart Pons y Cia., S.L.**, Pau Claris, 77, 2^o, 1^a, 08010 Barcelona, Spain (professional representative)

a g a i n s t

allGreen Group BV, Fahrenheitstraat 99, 1097 PP Amsterdam, Netherlands (holder), represented by **Leeway B.V.**, Barbara Strozziilaan 101, 1083HN Amsterdam, Netherlands (professional representative).

On 26/11/2018, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 724 154 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 international registration No 1 293 504 designating the European Union **ParkBee**, namely against all the goods and services in Classes 9 and 39. The opposition is based on Spanish trade mark registration No 3 064 872



. The opponent invoked Article 8(1)(b) EUTMR.

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.

a) The goods and services

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

Class 9: *Apparatus and instruments scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life saving and teaching; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic media registration discs; CDs, DVDs and other recording media digital; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; software; fire extinguishers.*

Class 39: *Transport; packaging and storage of goods; travel organization.*

The contested goods and services are the following:

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus.*

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

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

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus are identically contained in both lists of goods (including synonyms).

Contested services in Class 39

Transport; packaging and storage of goods; travel arrangement are identically contained in both lists of services (including synonyms).

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 and services found to be identical are directed at the public at large and (at least some of the goods and services) at professional consumers. The degree of attention is considered to range from average to high depending on the price and degree of sophistication of the goods and services.

c) The signs



Earlier trade mark

ParkBee

Contested sign

The relevant territory is Spain.

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).

When assessing the similarity of the signs, an analysis of whether the coinciding components are descriptive, allusive or otherwise weak is carried out to assess the extent to which these coinciding components have a lesser or greater capacity to indicate commercial origin. It may be more difficult to establish that the public may be confused about origin due to similarities that pertain solely to non-distinctive elements.

The earlier trade mark is a figurative mark containing a graphical depiction of a smartphone in grey with a green diamond on the part depicting the screen and, underneath, the sequence 'apparkB'. Both the figurative element and the verbal element are placed against a background formed by light grey squares with rounded corners, which will be perceived as purely decorative and accordingly non-distinctive. The word 'appark' of the verbal element is most likely to be perceived as a play on words, a combination of the word 'app' (understood by the Spanish public as 'application') and 'aparcar' (which means 'to park' in Spanish). Since this word as a whole is a rather playful and original combination, it does not lack distinctiveness. However, it strongly alludes to the concepts of 'parking' and 'an app', so its distinctiveness has to be considered lower than average for the goods and services related to parking or that can be used/arranged by a mobile application, for example *software* in Class 9 and *transport or travel organization* in Class 39. For the goods and services not associated with parking or with an application, it has a normal degree of distinctiveness. The remaining part of the verbal element, the letter 'B', will be perceived as a separate component of the sign on account of its separation from the rest of the verbal element by graphic means. It is a single letter with no obvious connection to any of the relevant goods or services and therefore is distinctive. The

holder states that the letter 'B' refers to 'Barcelona', where the opponent's goods and services are currently being offered; however, the Opposition Division does not uphold this claim, since this would not be obvious to the general consumer. The depiction of a smartphone will refer to the method of use of some of the relevant goods and services, and accordingly it will not be perceived as a distinctive element. The background will be perceived as merely decorative. In the earlier mark, there is no element that is clearly more visually dominant than any other elements.

The contested sign is a figurative mark formed by the sequence 'ParkBee' depicted in a standard black typeface with the letters 'P' and 'B' in upper case. Contrary to what has been stated by the opponent, the contested sign was filed as a figurative mark and protection is sought for the form of the mark as applied for, that is, with two upper and five lower case letters. 'ParkBee' as a whole does not have any meaning for the relevant public. However, due to the use of the two upper case letters, the contested sign will be broken down into two parts by consumers. The first part of the sign, the word 'Park', will be perceived as alluding to the word 'Parking', which is commonly used in Spanish as referring to 'an area where cars or other vehicles may be left temporarily'. Consequently, this word will be allusive of the characteristics of the relevant goods and services that are connected to parking (e.g. computer software, transport or travel arrangement services), in which case it will be weak; it will have a normal degree of distinctiveness for the rest of the relevant goods and services. The second part of the sign, the word 'Bee', will be meaningless for the relevant public, and accordingly is distinctive. The contested sign has no element that could be considered more dominant than any other elements.

Visually, the signs coincide in the letters 'PARK', in the middle of the earlier mark and at the beginning of the contested sign, and 'B', at the end of the earlier mark and in the middle of the contested sign. In the earlier mark, some of the coinciding letters (i.e. '*ark') are depicted in a light grey colour that is very similar to the colour of the background squares, which makes these letters less perceptible than the other letters, which are bold and in stronger colours. On account of the different positions of the letters 'park' in the marks, and the fact that these letters in the earlier mark form merely part of the element 'appark', which will be perceived as a whole as explained above, this commonality is not obvious. Moreover, the coinciding string of letters 'park' is weak for some of the goods and services. The signs differ in the first letters of the earlier mark, 'ap*****', and in the second part of the contested sign, '*****ee'; the fact that these differing letters are placed at the beginning of one sign and at the end of the other results in the marks having very different beginnings and endings, which are the parts that attract the most attention. Moreover, the marks also differ in the display of the letters in both signs, and in the graphical elements of the earlier mark, which have no counterparts in the contested sign. Since the signs coincide in a sequence of letters that due to its different depictions and positions will convey different impressions to the relevant public, and due to the additional colours and figurative elements of the earlier mark, which do not have any counterparts in the contested sign, the signs are visually similar to only a low degree.

Aurally, the public will pronounce the earlier mark as /ap(p)arkb(e)/. Consequently, the signs coincide in the sound /park/, in the middle of the earlier mark and at the beginning of the contested sign, and in the sound 'B(e)', at the end of both signs, since for the Spanish public the element 'Bee' of the contested sign will have the same sound as the single letter 'B'; however, they will differ in the sound of the first letter 'a' of the earlier mark. Despite the different structures of the marks, as explained above, and the lower than average degree of distinctiveness of the coinciding sequence 'park' for some of the goods and services, the aural differences

are very limited, mostly on account of the identical pronunciation of the single letter 'B' and the ending, 'Bee', of the contested mark.

Therefore, the signs are aurally similar to a high degree.

Conceptually, reference is made to the assertions explained above. Both marks allude to the concept of 'parking', which is weak for some of the goods and services. However, the earlier sign also evokes the concept of an application and the depiction of a smartphone conveys a concept as well. Therefore, the signs are conceptually similar to a low degree.

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.

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 some of the goods and services in question. Some of its elements have a lower than average degree of distinctiveness in relation to other goods and services. However, the mark contains a component that is of average distinctiveness, namely the letter 'B', the rest of its verbal element, 'appark', is weak but does not completely lack distinctiveness and the mark contains a number of elements, both verbal and figurative, that, in combination, also add to its overall degree of distinctiveness. Therefore, the degree of distinctiveness of the earlier mark must be seen as normal for some of the goods and services, while it will be low for the others, as stated above in section c) of this decision.

e) Global assessment, other arguments and conclusion

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings.

In the present case, the goods and services are identical; they target the public at large and professional consumers whose degree of attention may vary from average to high. Furthermore, the earlier trade mark has a normal degree of distinctiveness for some of the goods and services in question, even though many of its elements have a lower degree of distinctiveness in relation to other goods and services. The signs are visually similar to a low degree, aurally highly similar and conceptually similar to a low degree.

The signs coincide in the sequence of letters 'park', in the middle of the earlier mark and at the beginning of the contested sign, and in the letter 'b', at the end of the earlier mark and in the middle of the contested sign. However, the signs differ in the additional letters 'ap' at the beginning and 'ee' at the end of the earlier and the contested signs, respectively. The General Court has held that the same number of letters in two marks is not, as such, of any particular significance for the relevant public, even for a

specialised public. Since the alphabet is made up of a limited number of letters, which, moreover, are not all used with the same frequency, it is inevitable that many words will have the same number of letters and even share some of them, but they cannot, for that reason alone, be regarded as visually similar. In addition, the public is not, in general, aware of the exact number of letters in a word mark and, consequently, will not notice, in the majority of cases, that two conflicting marks have the same number of letters (25/03/2009, T-402/07, ARCOL / CAPOL, EU:T:2009:85, § 81-82; 04/03/2010, C-193/09 P, ARCOL / CAPOL, EU:C:2010:121).

Moreover, the signs also differ in the graphical depictions of their verbal components and in the figurative elements of the earlier mark.

As explained above, the coinciding sequence of letters in the marks is not obvious, in particular from the visual perspective, as it is placed in different positions in the marks and therefore the marks have different beginnings (and visually also different endings). Moreover, the structures of the marks will be perceived as very different. Whereas the earlier mark is a combination of a play on words, 'appark', and a single letter, 'B', together with some figurative elements, the contested mark is formed by the juxtaposition of an abbreviation for the word 'parking' and a meaningless foreign word, 'Bee'. These different structures and perceptions of the marks play a decisive role in the assessment of their visual and conceptual similarities. Although the marks are aurally highly similar, this aural similarity will be offset by the abovementioned visual and conceptual differences, in particular taking into account that consumers will pay a higher degree of attention in relation to some of the goods and services. Moreover, for at least some of the goods and services the largest coincidence lies in a weak element, 'park', which, for these goods and services, cannot lead to a likelihood of confusion when both signs contain other, more distinctive elements.

Considering all the above, the Opposition Division considers that the differences between the marks are sufficient to exclude any likelihood of confusion between them on the part of the public, even though the goods and services are identical. 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 holder in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(i) EUTMIR (former Rule 94(3) and Rule 94(7)(d)(ii) EUTMIR, in force before 01/10/2017), the costs to be paid to the holder are the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

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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.