

OPPOSITION No B 3 165 519

Restaurante La Maquina, S.A., Paseo de la Castellana, 121, 28046 Madrid, Spain (opponent), represented by **Polopatent**, Dr. Fleming, 16, 28036 Madrid, Spain (professional representative)

a g a i n s t

Metropolitan Gaming Holdco Limited, Suite 1, 3rd Floor 11 – 12 St James's Square, SW1Y 4LB London, United Kingdom (applicant), represented by **Allen & Overy**, 32 Rue François 1er, 75008 Paris, France (professional representative).

On 28/08/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 165 519 is upheld for all the contested services.
2. European Union trade mark application No 18 610 733 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 09/03/2022, the opponent filed an opposition against all the services of European Union trade mark application No 18 610 733 'M BAR' (word mark). The opposition is

based on European Union trade mark registration No 14 887 401



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

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

Pursuant to 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 services

The services on which the opposition is based are, inter alia, the following:

Class 43: *Services for providing food and drink; expressly not including providing any service relating to accommodation and hotels.*

The contested services are the following:

Class 43: *Bar services.*

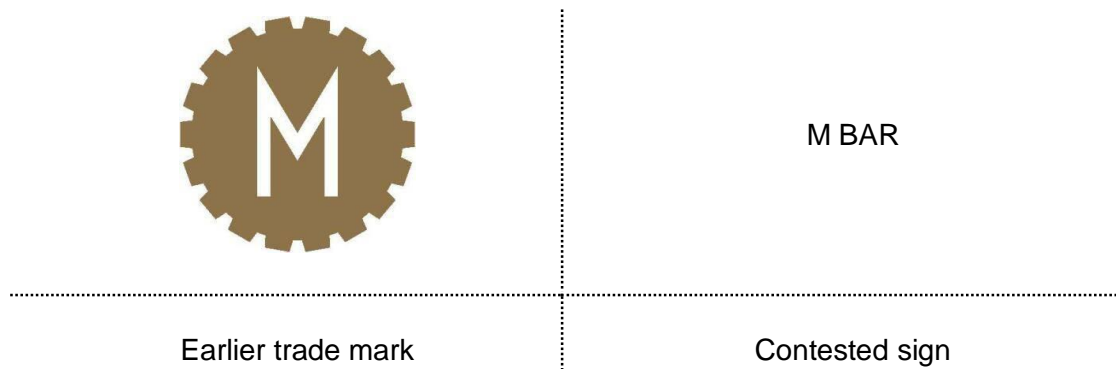
The contested *bar services* overlap with the opponent's *services for providing food and drink; expressly not including providing any service relating to accommodation and hotels.*

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 services found to be identical are directed at the public at large whose degree of attention is considered to be average.

c) The signs

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 coinciding letter 'M' will be merely associated with the letter it represents and, consequently, is considered distinctive since it is not descriptive or otherwise related to the services concerned (09/09/2010, C-265/09 P, α, EU:C:2010:508, § 35).

The stylisation of the letter 'M' in the earlier mark is quite standard and it does not make the letter illegible or draw attention away from it (22/04/2009, R 252/2008-1, THOMSON / THOMSON (fig.), § 35). It is merely decorative and, therefore, non-distinctive.

The earlier mark's figurative element, namely a cogwheel of a brown or dark gold colour wherein the letter 'M' is placed in white, cannot be considered a simple geometrical shape. Therefore, it retains a certain degree of distinctiveness. However, 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 / SELENIUM SPEZIAL A-C-E (fig.), EU:T:2005:289, § 37). Consequently, the consumers will focus their attention on the letter 'M'.

The contested sign's verbal element 'BAR' is a word that is generally used throughout the European Union according to its meaning in English: 'a counter, room, or establishment where a particular range of goods, food, services, etc, are sold' (information extracted from *Collins English Dictionary* on 18/08/2023 at <https://www.collinsdictionary.com/dictionary/english/bar>). In the context of the relevant services, which are essentially related to the provision of food and drink, 'BAR' is considered non-distinctive as it refers to a place where the services are rendered (02/05/2018, R 1879/2017-4, Hugo's Burger Bar / H'ugo's et al., § 19; 09/07/2019, T-397/18, Hugo's Burger Bar (fig.) / H'ugo's et al., § 63).

Visually, the signs coincide in the distinctive letter 'M'. They differ in the additional word 'BAR' of the contested sign, which, however, has a minimal impact on the sign's overall impression due to its non-distinctive character for the services at issue, as explained above. The signs also differ in the stylisation of the letter 'M', which is non-distinctive, and the figurative element of the earlier mark, which, although having a certain degree of distinctiveness, will not draw consumers' attention away from the letter 'M'.

The applicant argues that the signs are short signs and that, consequently, small differences may frequently lead to a different overall impression. Even if this may be true, the fact is that the contested sign is a word mark, which means that the differences in stylisation (of the earlier mark) do not come into play. In addition, the impact of the difference caused by the presence of the word 'BAR' is very minor, as it is non-distinctive in the present case.

Therefore, contrary to the applicant's arguments, the signs are visually similar to an average degree.

Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory, the signs coincide in the pronunciation of the letter 'M', present identically in both signs. They differ in the pronunciation of the additional word 'BAR' of the contested sign, which, as stated above, has a minimal impact due to its non-distinctive character.

Therefore, and contrary to the applicant's arguments, the signs are aurally similar to an above-average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. In the present case, as stated above, the coinciding letter 'M' will be associated only with a letter of the alphabet. In principle, signs perceived as a letter of the alphabet are only capable of conveying the 'generic concept' of the specific letter (26/03/2021, R 551/2018-G, Device (fig.) / Device (fig.), § 78, 85). The

mere fact that there is a generic term that includes the terms used to describe the semantic content of the signs at issue is not a relevant factor in the context of the conceptual comparison (31/01/2019, T-215/17, PEAR (fig.) / APPLE BITE (fig.) et al., EU:T:2019:45, § 69). However, the signs differ in the concepts evoked by the earlier mark's figurative element and the additional word 'BAR' of the contested sign.

Therefore, even if the conceptual difference caused by the word 'BAR' is of very limited relevance in the overall comparison of the signs, as it stems from a non-distinctive meaning, the marks are conceptually not similar because of the earlier mark's figurative element which, due to its depiction (not a simple circular shape), has a certain degree of distinctiveness.

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 any of the services 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

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.

The relevant services are identical. They target the public at large, whose degree of attention is average. The signs are visually similar to an average degree and aurally similar to an above-average degree. Conceptually, the signs are not similar.

In the present case, the differences between the signs are not sufficient to counteract their similarities. According to the Office's practice, the fact that the signs comprise the same single letter can lead to a finding of visual similarity between them, depending on the particular way the letters are depicted. In the present case, the stylisation of the letter 'M' of the earlier mark is quite standard, and consequently, it is considered decorative and non-distinctive. The figurative element of the earlier mark, although having a certain degree of distinctiveness, will not be sufficient to draw consumers' attention away from the coinciding letter 'M', as stated above in section c). Furthermore, the contested sign's additional word 'BAR' is also considered non-distinctive.

Considering that both marks share the distinctive letter 'M', it is highly conceivable that the relevant public will perceive the contested sign as a sub-brand, a variation of the earlier mark, configured in a different way according to the type of services that it

designates (23/10/2002, T-104/01, Miss Fifties (fig.) / Fifties, EU:T:2002:262, § 49). Indeed, although consumers will certainly detect the presence of an additional term in the contested sign, they may legitimately believe that the contested sign is a new extension/continuation, or a new brand/line of services provided under the opponent's mark. In fact, it is common practice on the relevant market for providers of the relevant services to make variations in their trade marks, for example, by altering the typeface or colours or by deleting or adding verbal or figurative elements, to denote a new product under the same badge of origin. Conversely, it cannot be excluded that the earlier mark will be perceived as a sub-brand of the contested sign.

The applicant refers to previous decisions of both the General Court and the Office to support its arguments. However, the Office is not bound by its previous decisions, as each case has to be dealt with separately and with regard to its particularities.

This practice has been fully supported by the General Court, which stated that, according to settled case-law, the legality of decisions is to be assessed purely with reference to the EUTMR, and not to the Office's practice in earlier decisions (30/06/2004, T-281/02, *Mehr für Ihr Geld*, EU:T:2004:198).

While the Office does have a duty to exercise its powers in accordance with the general principles of European Union law, such as the principle of equal treatment and the principle of sound administration, the way in which these principles are applied must be consistent with respect to legality. It must also be emphasised that each case must be examined on its own individual merits. The outcome of any particular case will depend on specific criteria applicable to the facts of that particular case, including, for example, the parties' assertions, arguments and submissions. Finally, a party in proceedings before the Office may not rely on, or use to its own advantage, a possible unlawful act committed for the benefit of some third party in order to secure an identical decision.

In view of the above, it follows that, even if the previous decisions submitted to the Opposition Division are to some extent factually similar to the present case, the outcome may not be the same. This is because, in the present case, the contested sign is a word mark, and the stylisation of the letter 'M' in the earlier mark is considered quite standard, and therefore, non-distinctive.

The applicant refers to a previous case of the General Court (09/11/2022, T-610/21, *K K WATER*, EU:T:2022:700). However, this case is not applicable here. In the previous case the Court had to assess the differences in the stylisation of the marks at issue as they were figurative marks, whereas in the present case, the contested sign is a word mark.

Considering all the above, there is a likelihood of confusion on the part of the public.

Therefore, the opposition is well founded on the basis of the opponent's European Union trade mark registration No 14 887 401. It follows that the contested trade mark must be rejected for all the contested services.

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 applicant is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Monika CISZEWSKA

Claudia SCHLIE

Christophe DU JARDIN

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.