



**OPPOSITION No B 2 225 020**

**Apple and Pear Australia Limited**, 39 O'Connell Street, North Melbourne, Victoria 3051, Australia, and **Star Fruits Diffusion S.A.S.**, Route d'Orange, Caderousse, France (opponents), represented by **Nautadutilh**, Chaussée de la Hulpe, 120, 1000 Bruxelles, Belgium (professional representative)

a g a i n s t

**Pink Lady America**, PO Box 1420, N. 16th Ave., Yakima, Washington 98902, United States of America (applicant), represented by **Roberto Manno**, Geremia di Scanno, 65, 76121 Barletta (BA), Italy (professional representative).

On 23/12/2014, the Opposition Division takes the following

**DECISION:**

1. Opposition No B 2 225 020 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

**REASONS:**

The opponent filed an opposition against all the goods of Community trade mark application No 11 701 216. The opposition is based on, inter alia, Community trade mark registration No 2 042 679 and Community trade mark registration No 2 266 948. The opponent invoked Article 8(1)(b) and 8(5) CTMR.

**LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR**

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. For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier Community trade mark registration No 2 042 679 and Community trade mark registration No 2 266 948.

**a) The goods**

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

Community trade mark registration No 2 042 679

Class 31: *Agricultural, horticultural products including fruit, grains, plants and trees, especially apples and apple trees.*

Community trade mark registration No 2 266 948

Class 29: *Preserved, dried and cooked fruits; including apples.*

Class 30: *Confectionery including apple cakes and applies pies; cereal and oat based products including health bars; breads; and pastries such as apple strudel.*

Following a final decision of the Opposition Division given in Opposition No B 2 238 247, which refused the mark in respect of some of the claimed goods, the contested goods are the following:

Class 29: *Preserved, frozen, dried and cooked vegetables.*

Class 30: *Fruit flavourings, other than essences; Fruit vinegar; Pierozki containing mince.*

Class 31: *Mixed fruits [fresh]; Fruit, fresh; Fresh fruits and vegetables; Raw fruits; Mandarins (fresh fruit).*

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

The terms 'including' and 'such as', used in the opponent's list of goods, indicate that the specific goods are only examples of items included in the category and that protection is not restricted to them. In other words, they introduce a non-exhaustive list of examples (on the use of 'in particular' see a reference in judgment of 09/04/2003, T-224/01, 'Nu-Tride').

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 29**

Like the opponent's *preserved, dried and cooked fruits*, the contested *preserved, frozen, dried and cooked vegetables* are processed foodstuffs for consumption or conservation. These products target the same end users and more often than not are sold alongside or close to each other in retail outlets. Moreover, given the same or similar way of processing, these goods often have the same commercial origin. While the goods under comparison are essentially different types of food products, the abovementioned factors warrant a conclusion that they are similar to a low degree.

### **Contested goods in Class 30**

The contested *pierozki containing mince* are dough-based, fried or baked products stuffed with minced meat. They can have the same nature as the opponent's *cereal and oat based products; breads*, namely of dough-based foodstuffs. These goods target the same consumers, are sold in the same parts of shops or in the same

shops, such as bakeries, and have the same commercial origin. Accordingly, they are considered similar.

Conversely, the contested *fruit flavourings, other than essences; fruit vinegar* are not similar to any of the opponent's goods. The fact that the contested *fruit vinegar* can be made from some of the opponent's goods in Class 31 (e.g. grapes or apples) or that the contested *fruit flavourings, other than essences* can be added to others (e.g. the opponent's *confectionery; pastries*) is not sufficient for a finding of similarity, since the opponent's goods are different in nature (fresh produce or foodstuffs versus processed products not for direct consumption) and purpose (satisfying hunger or dietary needs versus flavouring food). Furthermore, the goods at issue have different natures, producers and methods of use and are displayed in different sections of supermarkets. It follows from the above that the contested *fruit flavourings, other than essences; fruit vinegar* are dissimilar to the opponent's goods.

### Contested goods in Class 31

The contested *mixed fruits [fresh]; fruit, fresh; fresh fruits and vegetables; raw fruits; mandarins (fresh fruit)* are instances of various agricultural or horticultural products. As such, they are included in the broad category of the opponent's *agricultural, horticultural products*. Therefore, they are considered identical.

### b) The signs

PINK LADY	WILD PINK
Earlier trade marks	Contested sign

The relevant territory is the European Union.

**Visually**, the signs are similar to the extent that they coincide in the element 'PINK'. However, they differ in all their remaining components and aspects. In particular, the coinciding element is placed in different positions, namely at the beginning of the earlier marks and the end of the contested sign. In addition, the signs differ in their other components, namely 'LADY' in the earlier marks and 'WILD' in the contested signs.

**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 'P-I-N-K' present identically in both signs, and to that extent the signs are aurally similar. The pronunciation differs in the sound of the remaining components of each sign. The fact that the common element is placed in different positions makes for a somewhat contrasting aural impression when each sign is pronounced.

**Conceptually**, different scenarios can be foreseen for the public in different parts of the relevant territory.

First, both signs are meaningful for the English-speaking part of the relevant public. The earlier marks will be understood as a 'woman, normally from a high social position or of moral character, in pink, for example dressed in such colour' whereas the contested sign will be perceived as referring to 'an intense, vivid, wild shape of the colour pink'.

While both signs refer to the colour pink, their overall meanings are rather different given that the earlier marks refer to a person and the contested sign to a colour.

For the non-English-speaking part of the public, the marks as such have no clear meaning. Nevertheless, the element 'WILD' of the contested sign will be understood by the German-speaking public as referring to something which is not domestic or processed and the element 'PINK', present in both marks, will be understood as a colour reference. The Danish-speaking public will also understand the element 'PINK' of the marks as referring to a colour, whereas for the Dutch-speaking public this word will refer to the little finger of a hand. Finally, for the Estonian-speaking public 'PINK' would refer to 'a bench'. Therefore, for the aforementioned parts of the public the marks are conceptually similar to the extent that they have the word 'PINK' in common.

For the rest of the public, who will grasp no meaning in the elements of the marks under comparison, they are not conceptually similar.

Taking into account the abovementioned visual, aural and, for some of the relevant the public, conceptual coincidences, it is considered that the signs under comparison are similar to some degree.

#### **c) Distinctive and dominant elements of the signs**

In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

The element 'PINK', present in both marks, will be associated by part of the relevant public as referring to a colour. Given that some of the earlier marks' goods include fruit and plants (such as flowers) and that the contested goods include fruit, that element will be perceived as indicative of a characteristic of those goods, namely their colour. In this regard, the opponent's view that fruit, and in particular apples, do not come in the colour pink cannot be upheld since, albeit not the most typical colour for that fruit, apples can come in a shade of red which is, or closely resembles, pink. It follows from the above that from the perspective of that part of the relevant public that understands it as a colour reference, the element 'PINK' is non-distinctive for some of the goods at issue, namely for *agricultural, horticultural products including fruit, grains, plants and trees, especially apples and apple trees* in Class 31 in respect of earlier Community trade mark registration No 2 042 679 and for *mixed fruits [fresh]; fruit, fresh; fresh fruits and vegetables; raw fruits* in respect of the contested sign.

The marks under comparison have no elements which could be considered clearly more dominant (visually eye-catching) than other elements.

#### **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 mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in

the present case (see below in '*Global assessment*'). The examination will proceed on the assumption that the earlier mark has enhanced distinctiveness.

**e) Relevant public – level 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 level 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 to varying degrees are directed at the public at large. Given that the goods are purchased on an everyday basis in a repetitive manner, it must be ruled that the level of attention of the relevant public is low.

**f) Global assessment, other arguments and conclusion**

In the present case the goods were found to be identical, similar or similar to a low degree and dissimilar.

The signs display some similarities stemming from the common element 'PINK'.

The Opposition Division has assumed in part d) of this decision that the earlier marks have been extensively used and enjoy an enhanced scope of protection. The examination of likelihood of confusion will, therefore, proceed on the premise that the earlier marks have an enhanced degree of distinctiveness. 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 (judgment of 29/09/1998, C-39/97, 'Canon', paragraph 18).

The signs coincide in one of their elements and differ in the other one. With this in mind, it must be determined whether the overall impression created by each sign is such as to create a likelihood of confusion on the part of the public.

The Opposition Division, for the reasons set out below, does not consider this to be the case.

Firstly, the coinciding element is placed in a diametrically opposite position in the competing signs. This difference is easily noticeable, especially when taking into account the fact that the relevant public pays more attention to the beginning of a sign. In view of this, the different position of the coinciding element produces a different impression of each sign on both a visual and aural level.

Secondly, for the part of the relevant public that understands the meaning of both signs, there are clear conceptual differences between them, even taking into account that they have the element 'PINK' in common. Consequently, the existing conceptual coincidence does not carry a lot of weight for establishing a likelihood of confusion between the marks.

In addition, the coinciding element, 'PINK', is non-distinctive for some of the goods, notably for those found to be identical, even for that part of the relevant public that does not understand the signs as a whole. As regards the remaining goods, for which

the coinciding element is of normal distinctiveness, the similarity stemming from that element is counterbalanced by the fact that some of those goods are similar to a low degree.

Finally, it is settled case-law that a compound trade mark and another trade mark which is identical or similar to one of the components of the compound mark cannot be regarded as being similar unless that component forms the dominant element within the overall impression created by the compound mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (see, inter alia, judgment of 23/10/2002, T-6/01, 'Matratzen', paragraphs 33-34; judgment of 06/10/2005, C-120/04, 'Thomson Life', paragraph 29).

As is clear from the above paragraphs, the coinciding element does not dominate the overall impression produced by either sign on the relevant public. The opponent has not established this and does not claim it to be the case.

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 earlier Community trade mark registration No 2 042 679 and Community trade mark registration No 2 266 948 in respect of Article 8(1)(b) CTMR.

Likewise, even assuming that the earlier marks enjoy an enhanced distinctiveness due to reputation, the outcome of no likelihood of confusion remains the same. Therefore, it is not necessary to examine the evidence of reputation.

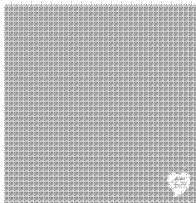
As regards the goods which were found to be dissimilar, it must be observed for the sake of completeness that as similarity of goods and services is a necessary condition for the application of Article 8(1) CTMR, the opposition based on this article and directed at these goods cannot be successful.

The opponent has also based its opposition on the following earlier trade marks:

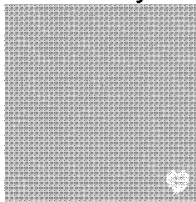
1. Community trade mark registration No 4 186 169 for the figurative mark



2. Community trade mark registration No 6 335 591 for the figurative mark



3. Community trade mark registration No 8 613 911 for the figurative mark



4. Benelux trade mark registration No 559 177 for the word mark 'PINK LADY'.

5. French trade mark registration No 92 420 538 for the word mark 'PINK LADY'.
6. German trade mark registration No 2 903 690 for the word mark 'PINK LADY'.
7. United Kingdom trade mark registration No 1 582 849 for the word mark 'PINK LADY'.

Since the aforementioned national trade mark registrations (Nos 4-7) are identical (word marks 'PINK LADY') to the ones which have been compared, the outcome cannot be different with respect to goods for which the opposition has already been rejected. Therefore, no likelihood of confusion exists with respect to those goods.

The other earlier rights (Nos 1-3) invoked by the opponent are less similar to the contested sign. This is because they contain further figurative elements, such as a large pink geometrical shape, a heart and/or a stylised representation of the verbal components, none of which is present in the contested sign. Therefore, the outcome cannot be different with respect to the goods for which the opposition has already been rejected; no likelihood of confusion exists with respect to those goods.

#### **REPUTATION – ARTICLE 8(5) CTMR**

For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier Community trade mark registration No 2 042 679 for which the opponent claimed repute in the EU.

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds of refusal of Article 8(5) CTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Encroachment upon reputation: the use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) CTMR (judgment of 16/12/2010, joined cases T-345/08 and T-357/08, 'Botolist/Botocyl'),

paragraph 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested sign. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

#### **a) The signs**

The signs have already been compared above under the grounds of Article 8(1)(b) CTMR. Reference is made to those findings, which are equally valid for Article 8(5) CTMR.

#### **b) The 'link' between the signs**

As seen above, the earlier marks are assumed to be reputed and the signs are similar to some extent. In order to establish that a later trade mark will encroach upon the reputation of an earlier mark, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) CTMR but has been confirmed in the judgment of 23/10/2003, C-408/01, 'Adidas', paragraphs 29 and 31, and the judgment of 27/11/2008, C-252/07, 'Intel', paragraph 66. It is not an additional requirement but merely reflects the need to determine, after all the factors relevant to the particular case have been assessed, whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur.

Possible relevant factors for the examination of a 'link' include (judgment of 27/11/2008, C-252/07, 'Intel', paragraph 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

In the present case, the signs have some similarities. This does not necessarily mean that the relevant public is likely to establish a link between them.

In particular, it has been demonstrated that the coinciding element does not play an independent role in the perception of either sign.



For that part of the public that understands both signs as a whole, the component 'PINK' forms different conceptual units with the additional element of each mark. Accordingly, the public will perceive the component as forming part of two differing expressions, which will not lead to a link being established between the marks.

Moreover, even assuming that some of the relevant public does not understand any of the components of the signs or understands only one of them, that public will not establish a link, not least because the coinciding element will be perceived, both visually and aurally, in combination with the additional element of each mark. In other words, it does not play an independent role in this case, either.

The above reasoning is further reinforced in those cases where the coinciding element is non-distinctive for some of the goods at issue.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that it is unlikely that the relevant public will make a mental connection between the signs in dispute, that is to say, establish a 'link' between them. Therefore, the opposition is not well founded under Article 8(5) CTMR and must be rejected.

As set out above by the Opposition Division in its analysis under Article 8(1)(b) CTMR, the remaining earlier marks on which the opposition is based are either identical or less similar to the contested sign, and the goods and services covered by them are the same or within a narrower scope. In view of this, the Opposition Division's conclusion in respect of those marks cannot be different and, accordingly, the opposition Article 8(5) CTMR based on those marks must equally fail.

## **COSTS**

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

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

According to Rule 94(3) and (7)(d)(ii) CTMIR, the costs to be paid to the applicant are the costs of representation which are to be fixed on the basis of the maximum rate set therein.



### **The Opposition Division**

Zuzana WALTHER

Orlin DENKOV

Justas IVANAUSKAS

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

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.