

DECISION
of the Fourth Board of Appeal
of 10 January 2017

In Case R 87/2015-4

Apple and Pear Australia Limited
Suite G01 128-132 Jolimont Road
EAST MELBOURNE Victoria 3002
Australia

Opponent / Appellant

represented by NAUTADUTILH SPRL, Chaussée de la Hulpe, 120, 1000 Bruxelles,
Belgium

v

Pink Lady America
N. 16th Ave.
Yakima, Washington 98902
United States of America

Applicant / Respondent

represented by Roberto Manno, Geremia di Scanno, 65, 76121, Barletta (BA), Italy

APPEAL relating to Opposition Proceedings No B 2 225 020 (European Union trade
mark application No 11 701 216)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairperson), C. Bartos (Rapporteur) and S. Martin
(Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 29 March 2013, the respondent sought to register the word mark

WILD PINK

for the following goods:

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).

- 2 On 30 July 2013, the appellant filed an opposition against the registration of the mark applied for. The grounds of opposition were those laid down in Articles 8(1)(b) and 8(5) EUTMR.
- 3 The opposition was based on the following earlier rights:
 - a) The Benelux trade mark No 559 177

PINK LADY

registered on 27 July 1994 and renewed until 27 July 2024 for the goods:

Class 31 – Agricultural, horticultural and silvicultural products and grains, not included in other classes; live animals; fresh fruits and vegetables; grains, live plants and flowers; foodstuff for animals, malt.

- b) The German trade mark No 2 903 690

PINK LADY

registered on 23 March 1995 and renewed until 31 July 2024 for the goods:

Class 31 – Fresh fruits and vegetables; fodder; malt; agricultural, horticultural and forestry products and grains; live animals; seeds; live plants and natural flowers.

- c) The United Kingdom trade mark No 1 582 849

PINK LADY

registered on 25 October 1996 and renewed until 26 August 2021 for the goods:

Class 31 – Fresh fruit and vegetables; seeds; plants which bear pink coloured foliage or flowers; all included in class 31.

d) The French trade mark No 92 420 538

PINK LADY

registered on 20 May 1992 and renewed on 6 July 2012 for the goods:

Class 31 – Apples, fruit trees and fresh fruit.

e) The European Union trade mark No 2 042 679

PINK LADY

registered on 27 February 2003 and renewed until 11 January 2021 for the goods:

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

f) The European Union trade mark No 2 266 948

PINK LADY

registered on 9 December 2004 and renewed until 8 June 2021 for the goods:

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.

g) The European Union trade mark 4 186 169



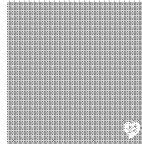
registered on 15 December 2005 and renewed until 23 November 2024 for the goods:

Class 29 – Preserved, dried, cooked and crystallised fruits; preparations made from preserved, dried, cooked and crystallised fruits; jams; compotes; fruit jellies; fruit salads; fruit yoghurts; fruit chips;

Class 30 – Preparations made from cereals; cakes; biscuits; confectionery; ices, sorbets and ice-creams; sugar confectionery;

Class 31 – Fresh fruit; apples; fruit trees; apple trees.

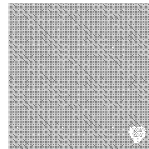
h) The European Union trade mark No 6 335 591



registered on 30 July 2008 and renewed until 4 October 2017 for the goods:

Class 31 – Agricultural and horticultural products; fruit, grains, plants and trees; apples and apple trees.

i) The European Union trade mark No 8 613 911



registered on 26 April 2010 and renewed until 14 October 2019 for the goods:

Class 29 – Preserved, dried, cooked and crystallised fruits, preparations made from preserved, dried, cooked and crystallised fruits, jams, compotes, fruit jellies, fruit salads, fruit yoghurts, fruit chips;

Class 30 – Preparations made from cereals, cakes, biscuits, confectionery, ices, sorbets and ice creams, sugar confectionery.

- 4 The appellant submitted ample evidence with the aim to prove enhanced distinctive character and reputation of its earlier trade marks for some of the goods at issue.
- 5 By decision of 23 December 2014 ('the contested decision'), the Opposition Division rejected the opposition in its entirety on the grounds that the signs are dissimilar and hence neither a likelihood of confusion in the meaning of Article 8(1)(b) EUTMR exists nor is there any link between the signs which could lead to an unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks in the meaning of Article 8(5) EUTMR.

Submissions and arguments of the parties

- 6 The appellant filed a notice of appeal against the contested decision, followed by the statement of grounds, requesting to uphold the opposition in its entirety and to reject the mark applied for. The appellant argues that the conflicting signs are visually and aurally similar due to the common verbal element 'PINK' and their

common length and structure as word marks composed of two words. The conflicting signs are conceptually similar at least for the English-speaking part of the relevant public since both signs refer to the same colour. A likelihood of confusion exists bearing in mind that the shared term 'PINK' is highly distinctive whereas the term 'WILD' of the contested mark is very weak, if not totally descriptive, since it will be understood as an indication of the nature and the origin of the goods at issue, in particular fruits and vegetables.

- 7 In addition, the appellant refers to the judgement of the *Rechtbank van koophandel te Brussel* (Commercial Court of Brussels) of 28 June 2012, A.R. 05361/2010, acting as European Union Trade Mark Court of First Instance. This judgement concerns invalidity proceedings initiated by the appellant based on its earlier trade marks mentioned above under paragraph 3 a), e), g) and h) against two Benelux trade marks of a third party, namely 'Lady in Rose' and 'English Pink'. The Commercial Court of Brussels declared both trade marks invalid. According to the appellant, this judgment must be respected as *res iudicata* by the offices and the courts within the European Union.
- 8 The respondent endorses the Opposition Division's analysis, requests to dismiss the appeal and to order the appellant to bear the costs.

Reasons

- 9 The appeal is admissible and but not well founded. The opposition fails in its entirety because the signs are dissimilar and hence a prerequisite of Articles 8(1)(b) and 8(5) EUTMR is not fulfilled.

Article 8(1)(b) and 8(5) EUTMR

- 10 According to Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its identity with, or similarity to, the 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; the likelihood of confusion includes the likelihood of association with the earlier trade mark.
- 11 According to Article 8(5) EUTMR, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2 [of said Article], the trade mark applied for shall not be registered where it is identical, 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 EUTM, the trade mark has a reputation in the European Union 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 trade mark applied for would take unfair advantage of, or be detrimental to, the earlier trade mark's distinctive character or repute.

- 12 It follows that similarity of the signs is a prerequisite of both grounds of opposition invoked by the appellant, i.e. Articles 8(1)(b) and 8(5) EUTMR. Thus, the Board proceeds to the comparison of the signs.

Comparison of the signs

- 13 The global appreciation of the similarity between the signs includes an examination of whether the two signs concerned are visually, aurally or conceptually similar, which must be carried out on the basis of the overall impression created by them and bearing in mind, in particular, their distinctive and dominant components (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 25 and 27; 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).
- 14 The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23; and 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28). The assessment of the similarity between two marks cannot be confined to taking one sole component of a complex mark and comparing it with another mark, but that a comparison must be carried out wherein each of the marks in question is examined as a whole (C-120/04, § 29).

a) The earlier word marks

- 15 The earlier word marks (paragraph 3 a)-f) above) enjoy protection for the verbal element ‘PINK LADY’; the contested mark seeks protection for the word ‘WILD PINK’.
- 16 The appellant claims that the term ‘PINK’ is highly distinctive for the goods at issue and cites a statement from the Commercial Court of Brussels saying that ‘the colour pink is never present in the fruit concerned [apples]’. According to the appellant, the statement has become *res judicata* for the courts and offices in the Europe Union.
- 17 However, as the respondent pointed out, a Community Plant Variety protection has been granted for a variety of apples called ‘Cripps Pink’ which is characterized by a pinkish-red colour covering 40% to 70% of its surface. Furthermore, a short visit to any local fruit market is sufficient to see that apples exist in many shades of red, including pink. Obviously and as a matter of fact, the colour of pink could be present in apples.
- 18 It follows that the term ‘PINK’ in the conflicting signs could be understood by the relevant public as a descriptive term indicating a specific quality, namely the colour of the goods in question.
- 19 Visually and aurally, the conflicting signs are dissimilar. Although the signs of both parties include the term ‘PINK’, that term is in reversed positions within the signs, namely at the beginning in the earlier signs and at the end in the contested sign. In addition, the term has a minor impact in the comparison due to its descriptive character.

- 20 Conceptually, the conflicting signs are dissimilar. The terms ‘Lady’ and ‘pink’ are basic English words which will be understood in the entire European Union. The combination ‘PINK LADY’ will be perceived as referring to the concept of a ‘lady’, in particular a ‘lady in pink’, the adjective ‘pink’ specifying that lady as being dressed in pink or otherwise characterized by the colour pink. In contrast, the combination ‘WILD PINK’ will be understood as referring to a colour, namely a sort of pink which is somehow ‘wild’. The concept of a lady is not the same as the concept of a colour.
- 21 To sum up, the earlier word marks are visually, aurally and conceptually dissimilar. They are dissimilar overall.

b) The earlier figurative marks

- 22 The earlier figurative marks (paragraph 3 g)-i) above) enjoy protection for the verbal element ‘PINK LADY’ in combination with some graphic features and colours.
- 23 These graphic features, even if not very distinctive, add further differences to the comparison of the signs. Consequently, the opposing signs are all dissimilar to the sign applied for.

Conclusion

- 24 The opposition must be rejected in its entirety, irrelevant of any reputation the earlier marks may enjoy, since the conflicting signs are dissimilar and since similarity of the signs is a prerequisite of Articles 8(1)(b) and 8(5) EUTMR.

Remark on the judgment of the Commercial Court of Brussels and other decisions

- 25 The legality of decisions of the Office, including therefore of the Boards of Appeal, must be evaluated solely on the basis of the EUTMR, as interpreted by the Courts of the European Union, and not on the basis of earlier judicial decisions (see, to that effect, judgment of 26 April 2007 in *Alcon v OHIM*, C-412/05 P, ECR, EU:C:2007:252, paragraph 65), which considerations also hold true for opposition proceedings brought on the basis of Article 8(1)(b) or (5) EUTMR. *A fortiori* the same holds true for the effect of earlier national judicial decisions for the outcome of the present dispute. The European Union trade mark regime is an autonomous system, made up of a set of rules pursuing objectives specific to it, its application being independent of any national system. It follows that a refusal to register must be assessed solely on the basis of the relevant European Union legislation; earlier decisions by national courts cannot, in any event, cast doubt on the lawfulness of the decision at issue (judgment of 25/03/2015, T-378/13, *English Pink / PINK LADY* EU:T:2015, paragraph 59; 63)
- 26 For reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. That examination must be

undertaken in each individual case. The registration of a sign as a trade mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (T-378/13, § 45)

- 27 The decision of a national court sitting as a European Union trade mark court in an action for infringement of a European Union trade mark carries no such weight of *res judicata* for the departments of the Office in opposition proceedings concerning the registration of a European Union trade mark, not even if it were identical to the national trade mark which was subject of the action for infringement. (T-378/13, § 57)
- 28 It must also be noted that the EUTMR does not contain any provision by which the Office is bound by a judgment made by a European Union trade mark court and delivered in an action for infringement when it exercises its exclusive jurisdiction over registration of European Union trade marks and when, in so doing, it examines oppositions lodged against applications to register European Union trade marks, not even if the trade marks involved are identical (T-378/13, § 60).
- 29 However, the Office has to take that judgment into consideration and to reason why it cannot follow it (judgement of 12/09/2013, T-492/11, Tampon, § 33).
- 30 In the case at hand, the trade marks involved are firstly not identical and secondly, the parties are not identical. Thirdly, though the Commercial Court held that the element 'pink' has a dominant character and did not give any importance to the other elements, the Board cannot follow this approach for the reasons set out above. The signs for which the relevant trade marks enjoy protection and the opposed EUTM application seeks protection cannot be split and – moreover – the element 'pink' plays a minor role when comparing the signs.

Result

- 31 The appeal is dismissed.

Costs

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

Fixing of costs

- 33 Pursuant to Article 85(6) EUTMR and Rule 94(7)(d)(ii) and (vi) CTMIR, the Board fixes the amount of representation costs to be paid by the appellant to the respondent for the appeal proceedings at EUR 550 and for the opposition proceedings at EUR 300. The total amount is EUR 850.

Order

On those grounds,

THE BOARD

hereby:

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

Signed

D. Schennen

Signed

C. Bartos

Signed

S. Martin

Registrar:

Signed

H. Dijkema

