



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

The Boards of Appeal

**DECISION  
of the Second Board of Appeal  
of 30 September 2015**

In Case R 1789/2014-2

**Shoe Branding Europe BVBA**

Meersbloem – Melden 42  
BE-9700 Oudenaarde  
Belgium

Applicant / Appellant

represented by SANDEL, LØJE & PARTNERE, Øster Allé 42, 6, DK-2100  
København Ø, Denmark

v

**Berghaus Limited**

8 Manchester Square  
London W1U 3PH  
United Kingdom

Opponent / Respondent

represented by STEVENS HEWLETT & PERKINS, 1 St Augustine's Place, Bristol  
BS1 4UD, United Kingdom

APPEAL relating to Opposition Proceedings No B 2 096 009 (Community trade  
mark application No 10 983 658)

**THE SECOND BOARD OF APPEAL**

composed of T. de las Heras (Chairperson), C. Negro (Rapporteur) and  
C. Govers (Member)

Registrar: H. Dijkema

gives the following

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Language of the case: English

DECISION OF 30 SEPTEMBER 2015 – R 1789/2014-2 – TWO STRIPES (fig) / COMBINATION OF  
GEOMETRIC SHAPES (fig.) *et al.*

## Decision

### Summary of the facts

- 1 By an application filed on 21 June 2012, Shoe Branding Europe BVBA ('the applicant') sought to register the figurative mark below claiming the colours red and blue



for the following goods:

Class 25 – Clothing.

- 2 The application was published in the Community Trade Marks Bulletin No 139/2012 of 24 July 2012.
- 3 On 24 October 2012, Berghaus Limited ('the opponent') filed a notice of opposition against the contested sign on the basis of the following earlier rights, for the figurative mark:



- Community trade mark registration No 8 864 837 filed on 8 February 2010 and registered on 2 August 2010, for *inter alia* the following goods on which the opposition is based:

Class 25 – Clothing, footwear, headgear.

- United Kingdom trade mark registration No 2 202 820 filed on 9 July 1999, registered on 17 March 2000 and duly renewed for *inter alia* the following goods on which the opposition is based:

Class 25 – Clothing, footwear, headgear.

- Non-registered trade mark used in the course of trade in the European Union, for the following goods on which the opposition is based:

Clothing, footwear, headgear.

- 4 The opponent based its opposition on the grounds laid down in Article 8(1)(b) and 8(4) CTMR and directed its opposition against all the goods in the application.

5 On 19 May 2014, the Opposition Division issued a decision on Opposition No B 2 096 009 ('the contested decision') whereby it upheld the opposition for all the contested goods, rejected the Community trade mark application in its entirety and ordered the applicant to bear the costs. The contested decision may be summarized as follows:

- For reasons of procedural economy, the Opposition Division first examined the opposition in relation to earlier CTM registration No 8 864 837.
- Both signs are figurative and consist of blue and red stripes, slanting in opposite directions; the earlier mark also includes a sort of light grey background. The stripes of the earlier mark are ordered as blue and red while the stripes of the contested sign are in an inverted order (the red one is on the left and the blue one on the right). The stripes of the earlier mark are shorter and thicker than the stripes of the contested sign.
- Visually, the signs coincide in the depiction of the same stripes in the same colours. On the other hand, they differ in their orientation, their size and in the order of their colours.
- As both signs are purely figurative, it is not possible to compare them aurally. Additionally, neither of the signs has a meaning.
- The marks under comparison have no elements which could be considered clearly more distinctive or more dominant (visually eye-catching) than other elements.
- The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation. The earlier mark as a whole has no meaning in relation to any of the goods at hand from the perspective of the public in the relevant territory. The distinctiveness of the earlier mark must be seen as normal.
- The goods covered by the signs in dispute are identical and they are directed at the public at large.
- The signs are visually similar overall. They are both figurative signs comprising the same number of elements, namely two slanting stripes, in the same colours, namely blue and red. It is true that they also have differences, namely the order of the colour of the stripes and the shape of the stripes, which are, in the case of the earlier sign, slightly thicker and shorter. However, such differences would either go unnoticed or would not be remembered by the consumer, who has an average degree of attentiveness. The colours of the signs are the same; the colour sequence of the earlier mark is basically reversed in the contested sign. Furthermore, consumers will not remember in what direction the stripes slant, the colour sequence or the slightly different shapes of the stripes.
- The different background of the earlier mark, which consists of a sort of irregular squared outline, does not provide the signs with a sufficiently distinguishing element either, as such a basic geometrical form does not possess the necessary distinctiveness to capture the interest of consumers.

Therefore, there is a noticeable visual similarity between the two signs, due to the presence of the figurative elements consisting of blue and red stripes.

- This evident visual similarity acquires particular importance in view of the goods in Class 25 covered by the signs in dispute. Generally, in clothes shops customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. The visual perception of the marks in question will generally take place prior to purchase. Therefore, the considerable visual similarity between the signs is particularly relevant when assessing the likelihood of confusion between them.
  - There is a likelihood of confusion on the part of the public.
  - Since the opposition is fully successful on the basis of the opponent's earlier CTM registration and on the ground of Article 8(1)(b) CTMR, there is no need to examine the other earlier rights claimed and the other ground of the opposition, namely Article 8(4) CTMR.
- 6 On 11 July 2014, the applicant filed a notice of appeal against the contested decision in its entirety.
  - 7 On 19 September 2014, the applicant submitted its statement of grounds.
  - 8 No revision was granted pursuant to Article 62 CTMR and the appeal was remitted to the Boards of Appeal on 13 October 2014.
  - 9 On 1 December 2014, the opponent submitted its observations in reply.

### **Submissions and arguments of the parties**

- 10 The applicant requests that the Board annul the contested decision, the contested sign be registered and the costs be borne by the opponent. It also refers to its submissions made during the opposition proceedings. Its arguments before the Board may be summarized as follows:
  - The signs at issue are not confusingly similar.
  - The question is to what extent the opponent's geometric logo, consisting of a grey frame containing two coloured fields in blue and red inclining to the right applied to clothing, footwear and headgear, enjoys protection against the applicant's trade mark, consisting of two sharp long parallel stripes in the colours red/blue with a steep inclination to the left (the opposite direction) and if yes, in fact against any mark consisting of sloping stripes / fields, no matter the inclination of the mark and the tone / shade of blue and red?
  - The Opposition Division failed to consider the two signs at issue in their proper context, the earlier mark's lack of strength and the obvious visual differences between the signs.

*The nature of the earlier mark*

- The opponent allegedly invokes a mark constituting two parallel stripes of equal appearance. If this description of the mark is accepted, the earlier mark must be considered a mark consisting of simple geometric elements. Such marks normally only enjoy limited and narrow protection (28/11/2013, R 1208/2012-2, Device of two parallel stripes (other type of mark) / Device of three parallel stripes (fig.) *et al.*, § 65).
- The applicant disagrees with the description of the earlier mark.
- The overall appearance of the invoked mark is obvious when looking at the trade mark as it appears when used by the opponent on its website .
- The mark viewed as a whole does not appear as two parallel stripes but rather as a slightly tilted square containing two equally large coloured fields / windows, the left one being dark blue and the right one being dark red. It is also obvious that the background colour of the two 'fields / windows' and the colour between the fields will always be the same, independent of the colour on to which the trade mark is applied.
- The applicant concurs with the Opposition Division in stating that the opponent did not claim that its mark is particularly distinctive by virtue of intensive use or reputation and the exhibits presented by the opponent do not support such a claim.
- However, the Opposition Division erred in finding that the distinctiveness of the earlier mark must be seen as normal if the mark is to be seen as consisting of simple geometric elements. It is only if considered in its entirety, including the slightly tilted surrounding square with two equally parts / windows, that the distinctiveness of the earlier mark could be seen as normal.

*The relevant public*

- Since sportswear branding customarily comprises attaching various, more or less, simple figurative elements to the goods, consumers of such goods will have developed an above average attention specifically as to the stripes.
- When considering the risk of confusion due consideration must be given to the nature of the trade marks as well as the practice within the relevant field of business.
- Especially within the trade of sporting articles, sporting clothing and footwear it is customary to use simple figurative elements as source identifiers, and customers are used to differentiate between them on that basis.
- The widespread use of stripes and figures on clothing / sports clothing narrows the protection granted to the opponent for its earlier mark (if

considered as stripes) and also shows the consumer's increased awareness of the trade marks affixed.

- The applicant submits some examples of use of stripes and other geometrical figures on clothing / sports clothing.
- Since most athletes tend to be loyal to certain trade marks, the attention of the relevant consumer must be considered above average.

*Global assessment of likelihood of confusion*

- The applicant has presented evidence of long-term coexistence in the relevant marketplace. No conflict has ever arisen between the parties. The Opposition Division erred in leaving this aspect out of consideration.
- The Opposition Division erred when characterizing the two signs and determining their distinctive elements.
- The Opposition Division put specific emphasis on the fact that the two marks at issue contained the same two colours, but entirely disregarded the following important differences:
  - o The earlier mark consists of a grey rhombus containing two fields – the first in blue and the second in red – with a slight inclination to the right. The mark is registered with the colour indication ‘grey, red, blue’;
  - o The contested sign consists of two oblique stripes – the first in red and the second in blue – with a steep inclination to the left. The mark is applied for with the colour indication of only ‘red and blue’;
  - o The grey rhombus in the earlier mark plays an important role as the grey frame significantly adds to differentiate the mark from the contested sign and makes it obvious that the trade mark will be used as registered and that the background of the two coloured fields will always be grey;
  - o The frame in the earlier mark is important to its overall impression since it – with its rounded corners – strengthens the impression of the mark as ‘a rhomb containing two coloured fields’ rather than ‘two stripes’;
  - o The contested sign consists of two separated stripes on a neutral background (‘white’ is not mentioned in the colour indication), thus indicating that the colour of the background and the space between the stripes may vary depending on the colour onto which the mark is added;
  - o The dimensions of the blue and red fields in the earlier mark and the red and blue oblique stripes in the contested sign differ severely in proportions;
  - o The corners of the blue and red oblique lines in the earlier mark are rounded off, thereby creating a ‘soft’ impression, while the corners of

the red and blue oblique lines in the contested sign are sharp, thereby creating a distinct and ‘strong’ impression;

- o The colours which are claimed by both the earlier and the contested signs, i.e. ‘red’ and ‘blue’ (and not ‘grey’ which is only claimed by the opponent), are in different tones / shades. Red and blue cover, in principle, a wide range of tones and shades of which many are far from being even similar. The earlier mark covers dark tones of red and blue, whereas the contested sign covers bright tones of blue [*sic red*] and blue.
- The abovementioned differences become even more obvious when comparing the signs as used on the respective websites and goods.
- The fact that the two signs contain the same combination of colours cannot, in itself, result in that the two trade marks would be considered confusingly similar. The addition of an extra colour to one of the signs will naturally add to a further distinction. The two colours shared by the signs in question are two extremely well-known colours and a combination that is often used.
- Furthermore, the colour element cannot be considered the only feature, which plays a role in determining the likelihood of confusion.
- In 10/04/2008, R 297/2007-1, T (fig.) / T (fig.), the First Board of Appeal

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found *inter alia* that  ≠  and stated that ‘... the graphical dissimilarities between the marks outweigh any visual similarities due to the common element of the existence of a “T”. Any colour indications of the marks cannot change this fact’. The Board further stated that ‘It is obvious that the colours “red” and “magenta” cannot be considered similar’.

- 11 The opponent requests that the Board uphold the contested decision, refuse the contested sign and order an award of costs in its favour. Its arguments may be summarized as follows:

- The second and third paragraphs in the applicant’s statement of grounds, under the subheading ‘Summary of grounds’, are incoherent. The opponent requests that these paragraphs be ignored.
- As regards the excerpt from the decision of 28/11/2013, R 1208/2012-2, Device of two parallel stripes (other type of mark) / Device of three parallel stripes (fig.) *et al.* provided by the applicant about the banality of stripes as decorative elements applied to clothing and footwear, it is noted that the case referred to involved the applicant and that the signs at issue were in fact position marks consisting of stripes. The facts and the context therein are distinctly different to the present case involving figurative marks. Therefore, the reference should be ignored.
- Whether the signs are described as coloured stripes or coloured fields are immaterial when assessing the visual and conceptual similarities between the signs.

- The applicant's argument regarding the overall appearance of the earlier mark is fatally flawed, and should be ignored.
- The applicant has artificially dissected the earlier mark in an attempt to argue that it is 'slightly tilted square containing two equally big coloured fields/windows, the left one being dark blue and the right one being dark red'. No member of the relevant public would describe the earlier mark in such a verbose way. They would instead refer to the mark as 'two coloured sloping stripes; one red, one blue'. Further, they would also describe the applicant's mark as 'two coloured sloping stripes; one red, one blue', and would therefore come to the conclusion that the marks are the same, or are different versions of the same.
- The relevant public would not have the opportunity to analyse the signs in question alongside each other. They would, instead, rely on the overall impression created by both, the recalled earlier mark and the mark applied for. As the overall impression created by both signs is identical, the public would be confused into believing that the signs are the same or are different versions of the same.
- The opponent did not claim additional distinctiveness of the earlier mark in the opposition proceedings, as it was not necessary to do so. The mark as registered and without consideration of its use is, as the Opposition Division held, of normal distinctiveness.
- The applicant argues that consumers have developed an above average attention specifically as to stripes. This is a direct contradiction of the applicant's arguments, in particular its citation decision 28/11/2013, R 1208/2012-2, Device of two parallel stripes (other type of mark) / Device of three parallel stripes (fig.) *et al.* and the comments regarding the banality of stripes. The applicant attempts to argue that due to the widespread use of stripes, the public has an 'increased awareness' of them. The definition of the English word 'banal' is 'so lacking in originality as to be obvious and boring'. Therefore, the applicant has misdirected itself, as the suggestion that pure stripes are banal would mean that they would be ignored by the relevant public, and would not be given an above average degree of attention. Overall, the applicant's arguments surrounding stripes is contradictory.
- The matter at hand does not concern the use of, or comparison of, simple stripes. Both the earlier marks and the contested sign are figurative marks, which consist of stripes. The relevant public will view the marks as they are, that is, as figurative or 'logo' marks.
- The applicant itself acknowledges that it is customary to use simple figurative elements as source identifiers. The public will, therefore, see the contested sign as consisting of two coloured sloping stripes; one red, one blue, and will call to mind the opponent's mark, consisting of two coloured sloping stripes; one red, one blue, and will believe that the two are the same, or versions of the same.

- The examples of sportswear provided by the applicant are completely irrelevant. The use of stripes by sports brands does not have any relevance to the present case.
- The applicant's statement that 'most athletes tend to be loyal to certain trademarks' is completely without reason or fact. The relevant public for the purposes of this matter is not athletes, regardless of their brand loyalty. The relevant public must comprise any consumer in the EU.
- The evidence filed by the applicant claiming 'long time co-existence in the relevant market place' of the signs at issue does not show use of the mark as applied for. The Opposition Division correctly ignored this evidence.
- The Opposition Division correctly placed emphasis on the fact that the signs at issue both contain the same two colours, as this element of each sign will have the greatest impact on the viewer. Logos applied to clothing will rarely be seen entirely flat, therefore some of the minor details of shape or inclination may be lost. However, the colour of the signs will always remain visible and will be the first and most dominant part of the sign that the viewer will notice. Therefore, use of the mark applied for would cause confusion with the earlier mark.
- The identity of colour does play a significant role in the similarity of the marks. In addition, the fact that both signs consist of two sloping stripes is another feature which plays a role in determining the likelihood of confusion. When these features are viewed in combination, it is clear that there is no other possible conclusion than to find the signs similar.

## **Reasons**

- 12 The appeal complies with Articles 58, 59 and 60 CTMR and Rule 48 CTMIR. It is, therefore, admissible.
- 13 For reasons of procedural economy, and following the Opposition Division's approach, the Board will proceed with the examination of the opposition as based on earlier CTM No 8 864 837, before assessing the opposition as based on the other earlier rights, if necessary.

### *Article 8(1)(b) CTMR*

- 14 Article 8(1)(b) CTMR provides that 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.

- 15 According to the case-law of the Court of Justice, 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, constitutes a likelihood of confusion (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29; & 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17). The likelihood of confusion must be assessed globally, according to the relevant public's perception of the signs and the goods or services concerned and account being taken of all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated. Accordingly, a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks and vice versa (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 19).
- 16 On the other hand, there are absolute limits to the similarity of the signs. Signs cannot become similar merely because they are affixed on identical goods. An opposition must fail in the case of dissimilarity of the signs regardless of the degree of similarity of the goods or a reputation of the earlier mark (02/09/2010, C-254/09 P, CK Creaciones Kenny, EU:C:2010:488, § 53).

*The relevant public*

- 17 As the earlier mark is a Community trade mark, the relevant public consists of consumers in all the Member States of the European Union.
- 18 The goods at issue (clothing, footwear and headgear) target the average consumer (27/06/2013, T-89/12, R, EU:T:2013:335, § 44). The average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, §§ 17-26). It should, however, be recalled that the average consumer's level of attention is likely to vary according to the category of goods or services in question and that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his/her trust in the imperfect picture of them that he/she has kept in his/her mind (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). The goods are everyday products directed at a wide range of consumers with an average degree of attentiveness (16/01/2014, T-304/12, Absacker of Germany, EU:T:2014:5, § 28).
- 19 The applicant claims that, especially within the trade of sporting articles, sporting clothing and footwear, the branding of these goods by attaching various, more or less, simple figurative elements to them is customary, thus, the consumers of such goods will have developed an above average degree of attention especially as to stripes. The applicant provided some photographs as examples of the use of stripes and some other geometrical figures on sports clothing and footwear manufactured by different companies in the sports sector. The applicant asserts that, since most athletes tend to be loyal to certain trade marks, the relevant consumer's attention must be considered above average. The opponent disputes this argument, which it considers irrelevant. The Board recalls that the comparison of goods tackles, on one hand, the earlier mark's goods (i.e. 'clothing, footwear, headgear') and, on

the other, the description of the goods as applied for by the applicant (i.e. ‘clothing’). Therefore, the applicant’s argument cannot be taken into account as it refers to the trade of sports articles, which are not the goods at issue and which constitute a special sector within the clothing industry to which the present examination cannot be limited.

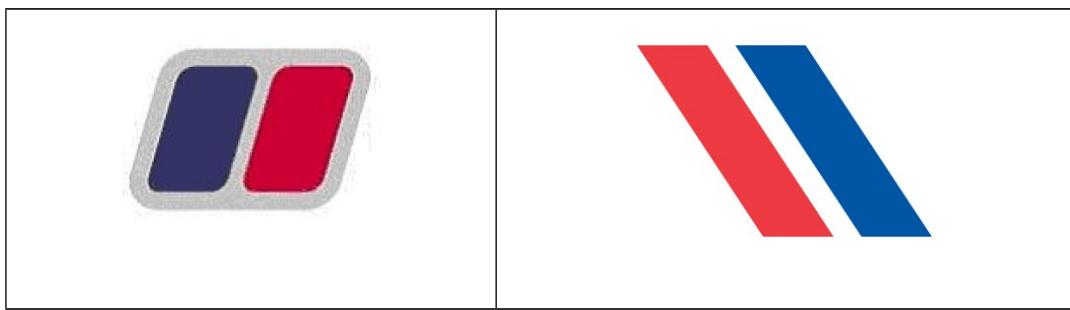
*Comparison of the goods*

- 20 The Opposition Division correctly found that the contested goods ‘clothing’ are covered by the description of goods of the earlier mark ‘clothing, footwear, headgear’ in Class 25. Therefore, the goods are identical. The Board endorses this finding, which has not been contested by the parties.

*Comparison of the signs*

- 21 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 marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).
- 22 The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it to another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (28/04/2004, C-3/03 P, Matratzen, EU:C:2004:233, § 32). In the case of a complex mark, such a mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the composite mark, unless that component forms the dominant or co-dominant element within the overall impression created by the complex mark. With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components (23/10/2002, T-6/01, Matratzen, EU:T:2002;261, §§ 33 and 35).
- 23 Given the relevance of the issue regarding the dominant element for the assessment of the similarity between the signs, the arguments in this respect must be examined before a comparison of those signs is undertaken (17/02/2011, T-10/09, F1-Live, EU:T:2011:45, § 37). Accordingly, the comparison of the signs at issue must be conducted by identifying any dominant or negligible elements first in respect of the earlier mark, and then in respect of the contested sign (03/09/2010, T-472/08, 61 a nossa alegria, EU:T:2010:347, § 57 and the case-law cited therein).
- 24 The figurative signs to be compared are the following:

<i>Earlier mark</i>	<i>Contested sign</i>



- 25 The earlier mark is a pure figurative mark formed by a grey rhomb with rounded corners, slightly inclined to the right and containing two rhomboids with the same inclination and rounded corners, the one on the left being blue and the one on the right red.
- 26 The contested sign consists of a fairly simple figurative mark depicting two parallel stripes inclined to the left, where the one on the left is red and the one on the right is blue.
- 27 The contested decision considered that the graphic elements depicted in both signs are stripes and proceeded to the comparison of the signs accordingly. The description of the earlier mark provided by the Opposition Division has been contested by the applicant. The Board observes that the graphic elements included in the earlier mark cannot be identified as stripes by reference to their design. According to the Collins English Dictionary ([www.collinsdictionary.com](http://www.collinsdictionary.com)) ‘stripe’ means ‘a relatively long band of distinctive colour or texture that differs from the surrounding material or background’. This definition clearly suits as regards the contested sign where two long red and blue bands are depicted. However, the earlier mark consists of a grey rhomb defined as ‘an oblique-angled parallelogram having four equal sides’ and containing two parallel rhomboids defined as ‘a parallelogram having adjacent sides of unequal length’ (definitions obtained from the same dictionary [www.collinsdictionary.com](http://www.collinsdictionary.com)).
- 28 Therefore, the present case confronts pure figurative signs, namely stripes versus geometric shapes (a rhomb and two rhomboids). As the opponent correctly pointed out, the signs at issue cannot be considered position marks. A position mark is a sign positioned on a particular part of a product in a constant size or particular proportion to the product. This is not the case at hand.
- 29 The contested decision rightly found that the signs under comparison have no elements which could be considered clearly more distinctive or more dominant (visually eye-catching) than other elements. The opponent holds that the colours of the signs will be the most dominant part that the consumer will notice. Even though the combination of the colours, red and blue, plays a role in both signs which is far from being negligible, the signs display important differences which, in the Board’s opinion, have not been given due weight in the contested decision. In fact, as observed, the earlier mark depicts a grey rhomb containing a blue rhomboid and a red rhomboid. The contested sign depicts two stripes, red and blue. In this regard, the Board observes that, not only the order (blue-red / red-blue) and the inclination of the graphic elements (right / left) is different between the signs, but also the shapes and contours of these two coloured elements. The applicant further points out that the earlier mark covers dark tones

of blue and red, whereas the contested sign covers bright tones of red and blue. Although this discrepancy is true, it can only be noticed through carefully looking at both signs together and according to the principle of imperfect recollection already mentioned, the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his/her trust in the imperfect picture of them that he/she has kept in his/her mind (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Therefore, it cannot be safely assumed that the relevant public, composed of the average consumer, will retain the different tones of the colours red and blue applied to the signs in question. On the contrary, it is more likely that the target public will remember the global impression of the respective signs, which differ in the structure of their graphic elements, colour combination and disposition of the colours.

- 30 Visually, the earlier mark depicts a grey rhomb with rounded corners containing one blue and one red rhomboid, respectively, both with rounded corners as well, whereas the contested sign depicts two stripes. The Board disagrees with the contested decision in finding that the signs ‘coincide in the depiction of the same stripes in the same colour’. As has been previously described, the contested sign does contain two stripes, but the earlier mark rather consists of the combination of geometric elements (a rhomb and two rhomboids, all with rounded corners). In fact, the comparison of the signs results in a different visual impression due to the different nature of the graphic elements represented in each sign. The rounded corners of the parallelograms contained in the earlier mark reinforce the visual aspect of these geometric figures (a rhomb and two rhomboids), whereas the stripes of the contested sign are two long parallel bands which differ from the surrounding material or background (as provided by the definition of ‘stripe’ in paragraph 27). The Opposition Division correctly found that the signs differ in their orientation, their size and the order of their colours. However, the Opposition Division neglected to mention the fact that the marks also differ in the shape of the respective blue/red colour elements, as well as in the fact that those differently-shaped elements are set against a grey rhomb label with rounded corners in the earlier mark. The opponent’s unsubstantiated argument that the shape or inclination of the marks are minor details which may be lost, has to be rejected. Both marks will be perceived as wholes and there is no reason to assume that the public will merely remember the common colours of the marks and will pay no attention to their different shapes, orientation, positions as well as the additional grey background label of the earlier mark. Bearing in mind the above, there are significant visual differences between the signs as the earlier mark clearly depicts a grey rhomb which contains two coloured rhomboids (blue and red), whereas the contested sign depicts two coloured stripes (red and blue) which are not framed (unlike the blue/red shapes of the earlier mark). Therefore, despite sharing the colours blue/red, in their overall visual impression the signs are dissimilar (see, by analogy, 17/05/2013, T-502/11, Stripes, EU:T:2013:263, § 47-48).
- 31 Since both signs are purely figurative and abstract in their appearance, an aural comparison cannot be made (17/05/2013, T-502/11, Stripes, EU:T:2013:263, § 49).

- 32 As none of the conflicting marks convey a concept, the signs are also not comparable from a conceptual point of view (17/05/2013, T-502/11, Stripes, EU:T:2013:263, § 50).

*Distinctiveness of the earlier mark*

- 33 The assessment of the likelihood of confusion involves a comparative balance of similarities and differences, the weighing up of which depends on the distinctiveness of each of the elements. The less distinctive they are, the less weight they should be attributed. On the other hand, trade marks with a highly distinctive character, either *per se* or because of the recognition they possess on the market, enjoy broader protection than trade marks with a less distinctive character (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24, and 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20).
- 34 The contested decision found that the earlier mark's distinctiveness must be seen as normal. The opponent agrees with the Opposition Division's finding.
- 35 The Board recalls that, as a general rule, a simple abstract graphic sign consisting of just one or two basic geometric forms is an inherently weak distinctive element of a sign, since it will neither attract the consumer's attention nor can be monopolized by a single applicant. Such a minimum degree of distinctiveness allows the registration of the sign, but can only grant it a corresponding low degree of protection. In this regard, taking into account the description of the earlier mark (see paragraph 25 above), it has to be considered that the earlier mark has a weak distinctive character. The earlier mark consists of simple geometric shapes, namely a rhomb and two rhomboids, with rounded corners, which may not attract the consumer's attention. In fact, elementary geometric shapes include, in addition to basic shapes such as triangles or circles, ellipses or structures like sickles (17/05/2013, T-502/11, Stripes, EU:T:2013:263, §§ 57-58). As regards the blue/red (and grey) colour combination, it is composed of basic colours which are not at all unusual in the relevant sector (clothing), especially in the sportswear and casualwear sectors. Therefore, this colour combination is insufficient to endow the mark with a particular distinctive feature (see, by analogy, 16/06/2015, T-654/13, FORM EINER VERPACKUNG, EU:T:2015:381, § 31).
- 36 Therefore, the contested decision erred on the assessment of the earlier mark's distinctiveness and the Board concludes that the earlier right, being a mere abstract graphic sign composed of basic coloured geometric shapes, is imbued with a weak distinctive character that has not been shown to have been enhanced in any way by use or reputation. In this respect, the opponent expressly admits not having claimed any enhanced distinctiveness of its mark (see point 10 of the opponent's observations in reply to the appeal of 1 December 2014). It must, therefore, be concluded that the earlier sign enjoys a limited scope of protection.

*Overall assessment*

- 37 The comparison between the contested mark and the earlier mark on which the opposition was based leads to a finding of an overall dissimilarity. For the

purposes of applying Article 8(1)(b) CTMR, the likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered in the application for registration are identical or similar to those in respect of which the earlier mark is registered. These conditions are cumulative. Having found no similarity between the earlier mark and the mark applied for, whatever the reputation or distinctiveness of the earlier marks and regardless of the degree of identity or similarity of the goods concerned, there can be no likelihood of confusion (02/09/2010, C-254/09 P, CK Creaciones Kenny, EU:C:2010:488, § 53; 27/11/2007, T-434/05, Activy Media Gateway, EU:T:2007:359, §§ 50-51, confirmed by judgment of 11/12/2008, C-57/08 P, Activy Media Gateway, EU:C:2008:718, §§ 56-57).

- 38 For the sake of completeness, the outcome would not be different even if some vague visual similarities were found. In the overall assessment of the likelihood of confusion, a merely remote visual similarity between the conflicting marks would not be sufficient for there to be a likelihood of confusion within the meaning of Article 8(1)(b) CTMR, even if the goods were identical. This conclusion is reinforced by the fact that the earlier mark enjoys a lower than average degree of inherent distinctiveness.
- 39 Contrary to the Opposition Division's finding, the signs do not coincide in their elements. In fact they consist of a rhomb containing two rhomboids versus two stripes, respectively. The Board notes that, even if the relevant public were not to describe the geometric elements in the earlier mark by properly identifying each of these parallelograms, they are not likely to perceive them as stripes since their width and relatively short and compact structure are not common features of stripes. Further, the colours are not exactly the same (grey, blue and red versus red and blue), they are not placed in the same order and for those consumers who will perceive the tones of the colours, they will notice the darker shades of blue and red depicted in the earlier mark in contrast to the brighter tones of these colours in the contested sign. The opponent insists that the use of identical colours would cause confusion between the signs. The Board reiterates that, given the particular circumstances of the present case, even if a remote visual similarity between the signs at issue were to be perceived, due to the colours red and blue, it would not change the fact that the graphic dissimilarities pointed out above clearly outweigh any remote similarity.
- 40 In light of all the foregoing considerations, despite the identity of the respective goods, there is no reason to assume that the relevant signs, between which there exist sufficiently significant differences, come from the same undertaking or, as the case may be, from undertakings that are economically linked.
- 41 Therefore, contrary to the contested decision's finding, there is no likelihood of confusion within the meaning of Article 8(1)(b) CTMR between the contested sign and the earlier mark.
- 42 Consequently, the Board's opinion is that the applicant's sign may coexist with the opponent's earlier mark and that coexistence will not cause confusion in the marketplace. Therefore, the evidence presented by the applicant to show the alleged long-term coexistence on the relevant market of the signs at issue does not need to be assessed.

- 43 The other earlier right invoked by the opponent under Article 8(1)(b) CTMR, i.e. UK trade mark registration No 2 202 820, covers the same figurative mark and the same goods as earlier CTM 8 864 837, so the outcome cannot be different.

#### *Article 8(4) CTMR*

- 44 Article 8(4) CTMR determines:

'Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing the sign:

a) rights to that sign were acquired prior to the date of application for registration of the community trade mark, or the date of priority claimed for the application for registration of the community trade mark;

b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.'

- 45 Even though the ground of opposition of Article 8(4) CTMR has not been touched upon by the parties before the Board, it was claimed by the opponent before the Opposition Division.

- 46 The Board notes that, in the notice of opposition, the opponent marked the EU as the territory to claim use of the earlier non-registered trade mark, for the same figurative sign and goods protected under the remaining earlier rights invoked in the present case. However, in its statement of grounds, the opponent indicated that the relevant Member State is the United Kingdom and relied on the law of passing-off within this country.

- 47 The opponent has asserted that 'the use and registration of the applicant's mark on clothing would amount to a misrepresentation of the opponent's mark, which would likely lead to damage to the opponent's business. Such damage could be in the form of loss of sales, and or damage to the goodwill or reputation in the mark' (see point 33 of the opponent's observations of 6 May 2013).

- 48 Since it has been concluded that no likelihood of confusion exists between the signs in view of their overall dissimilarity, the Board considers that no 'misrepresentation' of the opponent's mark is likely to occur in the minds of the consumers targeted, irrespective of any goodwill or reputation that the earlier mark might have in the United Kingdom.

- 49 As a result, the opposition based on Article 8(4) CTMR has to be rejected.

- 50 The appeal is, therefore, upheld and the contested decision annulled.

#### **Costs**

- 51 Pursuant to Article 85(1) CTMR, the opponent, as the losing party, shall bear the fees and costs incurred by the applicant in the appeal proceedings. Pursuant to

Article 85(6) CTMR and Rule 94(3) last sentence CTMIR, the opponent is, therefore, ordered to reimburse to the applicant the appeal fee (EUR 800), as well as the costs of professional representation for the appeal proceedings at the level laid down in Rule 94(7)(d) CTMIR (EUR 550). As the Opposition Division's decision has been annulled and the result is that the applicant succeeds on all heads, the Board must also fix the costs of the opposition proceedings. These are fixed at EUR 300 in respect of the applicant's representation costs.

**Order**

On those grounds,

THE BOARD

hereby:

1. **Annuls the contested decision;**
2. **Rejects the opposition in its entirety;**
3. **Orders the opponent to bear the total amount of EUR 1 650 in respect of the applicant's fees and representation costs in the appeal and opposition proceedings.**

Signed

T. de las Heras

Signed

C. Negro

Signed

C. Govers

Registrar:

Signed

H. Dijkema

