

**DECISION
of the Fourth Board of Appeal
of 29 June 2020**

In Case R 1134/2019-4

Luis Miguel Pérez Ullivarri González

Calle Velázquez 69

28006 Madrid

Spain

Applicant / Appellant

represented by Ángel Díez Bajo, Calle Velayos 4, 2ª D., 28035 Madrid, Spain

v

Facebook, Inc.

1601 Willow Road

Menlo Park

California 94025

United States of America

Opponent / Defendant

represented by STOBBS, Building 1000 Cambridge Research Park, Cambridge
CB25 9PD, United Kingdom

APPEAL relating to Opposition Proceedings No B 3 016 824 (European Union trade
mark application No 17 248 238)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman and Rapporteur), C. Bartos (Member) and
E. Fink (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 On 26/09/2017, the applicant sought to register the figurative mark in colour



as a European Union trade mark for the services in Class 45 ‘On-line social networking services; online social networking services accessible by means of downloadable mobile applications’.

- 2 On 29/12/2017, Facebook Inc. (‘the opponent’) filed a notice of opposition. The grounds of the opposition were those laid down in Articles 8(1)(b), (5) EUTMR. Reputation was claimed in all Member States of the EU. Voluminous evidence in support of this was filed in the course of the proceedings.
- 3 The opposition was based on:
 - (a) EUTM No 9 151 192 registered on 17/12/2010 for the word mark FACEBOOK for a range of goods and services in Classes 9, 35, 38, 41, 42 and 45, including:

Class 9 – Computer software development tools; computer software for use as an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; /.../

Class 42 – Computer services, namely, creating virtual communities for registered users to organize groups and events, participate in discussions, and engage in social, business and community networking; computer services, namely, hosting electronic facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; /.../

Class 45 – Social introduction, networking and dating services; providing social services and information of a social nature in the field of personal development, namely self-improvement, self-fulfilment, charitable, philanthropic, volunteer, public and community services, and humanitarian activities; providing information regarding social and political matters from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks.

- (b) EUTMs No 5 585 518, No 9 776 618, No 24 283 857, No 4 535 381 and No 6 455 687 for the word mark FACEBOOK;

- (c) EUTMs No 9151168, No 12 873 981, No 14 496 707, and No 14 496 608 for the figurative marks



respectively;

- (d) EUTM No 9 507 161 for the word mark BOOK registered for services in Classes 35, 42 and 45.

- 4 By decision of 01/04/2019, the Opposition Division upheld the opposition in its entirety and ordered the applicant to bear the costs.
- 5 The Opposition Division based its decision on the earlier EUTM No 9 151 192 for the word mark FACEBOOK and on the grounds of Article 8(5) EUTMR. That EUTM was protected for identical services. There was a low degree of visual and aural similarity – and even a conceptual similarity – of the signs on account of the element ‘-BOOK’. In that context the Opposition Division stated that the applicant himself had recognised that it wished to refer to the sphere of ‘hunting’ so that the element ‘HUNT in the contested sign was weak. The ‘FACEBOOK’ mark enjoyed an extremely high degree of reputation, as was not even denied by the applicant. There was an unfair advantage in the sense of Article 8(5) EUTMR, and in particular consumers might decide to turn to the applicant’s services due to the mental association with the earlier mark. It was not examined for procedural economy whether there was also a detriment to the distinctive character of the earlier mark. Nor were the other earlier marks or grounds for opposition examined for procedural economy.
- 6 On 24/05/2019, the applicant filed a notice of appeal against the contested decision, followed by a statement of grounds of appeal on 01/08/2019. He requested that the Board annul the contested decision, reject the opposition regarding all earlier rights and grounds for opposition invoked, even though the applicant recognizes the reputation of the opponent, and order the opponent to bear the costs.
- 7 The applicant put forward:
 - The conflicting signs are totally different.
 - The applicant relies on the different graphic as well as on that the circle looks like the back of a cartridge. The word ‘FACEBOOK’ has no meaning, nor does the word ‘MYHUNTBOOK’ (as such) have.

- The similarity (sic) lying in the term ‘BOOK’ is negligible because ‘BOOK’ is a generic term. The Facebook company should not be allowed to monopolise ‘BOOK’.
 - The applicant denies to have taken, or to intend to take, unfair advantage from the opponent’s mark(s). People who love hunting would not use the FACEBOOK platform.
 - ‘MYHUNTBOOK’ is a platform where the hunter can fill in the information related to his hunting activities (example shown).
 - The applicant is acting in good faith and does not intend to free-ride. A hunter always has a hunting book at his disposal in which he writes down the information about the date of hunting, the dogs used, the routes, the hunting hours, etc.
 - The Spanish national office ruled that there is no likelihood of confusion with the FACEBOOK mark(s).
- 8 The opponent requested to dismiss the appeal and to make an award of costs. It concurred with the contested decision and also relied on all the other earlier marks and grounds for opposition.
- 9 The opponent in particular put forward:
- The opponent’s mark does address hunters. It has a sub-page for hunters with 1.8 million users;
 - On the other hand the application claims social networking services for all users, not just for hunters;
 - The graphic elements of the contested sign are simplistic and not distinctive. There is similarity between the signs, for which in view of the massive reputation, a low degree would suffice at any rate.

Reasons

- 10 The appeal is not well founded. The opposition succeeds on the grounds of Article 8(5) EUTMR on the basis of the earlier EUTM No 9 151 192, word mark ‘FACEBOOK’.
- 11 Pursuant to Article 8(5) EUTMR, upon opposition of the proprietor of an earlier trade mark which has a reputation, the trade mark applied for shall not be registered if trade mark applied for is identical or similar and its use without due cause for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark, and this so even when the goods and services in issue are dissimilar.

Reputation

- 12 The earlier mark on which the opposition is relied on is a European Union trade mark. The relevant territory for analysing the likelihood of confusion is the Euro-

pean Union including all its Member States. It would suffice under Article 8(5) EUTMR if there is a reputation, and a fulfilment of the other conditions of that provision, in, or with respect of, one or more Member States (06/10/2009, C-301/07, PAGO, EU:C:2009:611, § 29, 30). This point is not decisive in the present case, as the reputation of the earlier mark exists throughout the EU.

- 13 Extensive evidence has been filed by the opponent within the times limits set before the Opposition Division, which is listed on pages 4 to 16 of the contested decision.
- 14 Indeed, there is massive use by more than 200 Million users, for example 36 Million users in Germany (for a population of 83 Million). The opponent's company is listed on the stock exchange and one of the most fast-growing and brand-valued companies (see items of evidence D2 A.3 and D2.B.2.kk). It is not necessary to peruse each of these items of evidence as the picture is crystal-clear. And the reputation has been expressly acknowledged by the applicant, not because reputation could be subject to admission, but because no serious challenge could have been made.
- 15 It has not been demonstrated that a turnover is generated in the sense that users would have to pay subscription fees. However, reputation is basically (although not only, we add) a knowledge threshold, requiring that the mark is known to a significant portion of the relevant public (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 22, 23; 25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 34). Moreover, how the revenue for the mark is generated is not decisive. The company turnover may come from other sources than direct fees, e.g. through advertising.
- 16 The reputation exists – at least – for the services in Class 45 for which the earlier mark relied on is protected: 'social introduction, networking and dating services'.
- 17 For reasons of procedural economy it does not have to be examined whether the reputation also extends to other registered goods and services, such as 'Computer services, namely, creating virtual communities for registered users to organize groups and events, participate in discussions, and engage in social, business and community networking' (in Class 42) or for different types of 'computer software' in Class 9.
- 18 It suffices to say that the reputation exists for services which are identical to the contested services, namely 'On-line social networking services' and 'Online social networking services accessible by means of downloadable mobile applications', which are identical with 'social introduction, networking and dating services' for which the earlier EUTM is (inter alia) registered.

The notion of similarity of the signs

- 19 The general principle is that the comparison of the signs must be made by means of a global appraisal of the visual, phonetic and conceptual similarity, on the basis of the overall impression given by them, bearing in mind in particular their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).
- 20 In general terms, two signs are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, namely the visual, aural and conceptual aspects (23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 30).
- 21 The case-law of the Court of Justice is not entirely clear as regards the question whether the standard under Article 8(5) EUTMR is the same as under Article 8(1)(b) EUTMR. What can be said with certainty is that on the one hand the comparison must be on an objective basis, and that two marks cannot become similar only because one of them is well-known (24/03/2011, C-552/09, TiMiKinderjoghurt, EU:C:2011:177, § 65, 66), and on the other hand that under Article 8(5) EUTMR the similarity test serves not whether the public will be confused about the trade origin, but whether it will make a mental link with the earlier mark (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 57, 58, 66).
- 22 The types of injury referred to in Article 8(5) EUTMR are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (12/03/2009, C-320/07, NASDAQ, EU:C:2009:146, § 43; 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 27, 29, 31).
- 23 Under Article 8(1)(b) EUTMR, marks with an enhanced distinctiveness through use enjoy a broader scope of protection than the ‘normal’ scope (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18), so that in that scenario the scope of protection under Article 8(1)(b) EUTMR may extend until younger marks which are only similar to a low degree. A fortiori, the scope of protection of mark which has a reputation can extend to younger marks which are only similar to a low degree.
- 24 The Board confirms the findings of the contested decision that the contested mark is similar to a low degree to the earlier word mark ‘FACEBOOK’ in such a manner and to such a degree that in the perception of the target public, when confronted with the mark applied for, the earlier mark will immediately be brought to mind.
- 25 Visually, the signs coincide in the word ‘BOOK’ and differ in ‘MYHUNT’ as well as in the graphic arrangement of the contested sign.
- 26 As regards the graphic element of the contested sign, the argument brought forward by the applicant that it symbolises a bullet appears to be far-fetched. First of all, the applied-for services do not refer to ‘hunting’ specifically. Second, the word element is ‘MYHUNT-’, which word is not necessarily associated with

bullets. Third, there is no reason for hunters to pay particular attention to the rear side of a bullet.

- 27 To conclude on this point, the graphic representation of the applied-for mark is just to be assessed as a simple geometric shape, a circular element in two colours, where the outer ring contains the word elements.
- 28 Even when the applicant has crafted the sign in such a way that the contrast of the letters making up the word element(s) is not high, it remains that the average consumer will try to refer first and foremost to the verbal elements of a composite sign. There is no reason to depart from the general principle that in such composite signs, the word element(s) are the most distinctive and dominant elements (31/01/2012, T-205/10, *La victoria de Mexico*, EU:T:2012:36, § 38; 15/12/2009, T-412/08, *Trubion*, EU:T:2009:507, § 45; 04/02/2013, T-159/11, *Walichnowy Marko*, EU:T:2013:56, § 40), in particular as the graphic element is not distinctive and merely serves as a circular background for the word element(s).
- 29 Contrary to many of the pleadings of either party, none of the word elements in issue exists as such in the English or in any other EU language.
- 30 A ‘BOOK’ is a book and a ‘FACE’ is a (human) face but a ‘facebook’ does not exist. There is no reason why to put ‘faces’ into books. Rather, ‘FACEBOOK’ is an invented term (28/01/2016, R 890/2015-2, *SENIORBOOK/FACEBOOK*, § 31) with no meaning as such and the distinctiveness of which resides in its combination, and which cannot, and will not be, split into separate elements by the average consumer.
- 31 In the unlikely event that a consumer believed that on the social media platform other users might be identified by their ‘FACE’(s), that would only reinforce the similarity in the word ‘BOOK’. However, an average consumer using a social media platform will not investigate whether the name of the platform has a relevance for any of the numerous and potentially unlimited functions that a platform may offer.
- 32 A similar reasoning applies to ‘MYHUNTBOOK’. ‘MY’ only refers to the personalised offer of the goods and services, which is extremely relevant for social media and interactive website (the Office’s electronic user interface used to be named ‘MyPage’). A ‘HUNTBOOK’ as such does not exist. The applicant has tried to argue this point on the basis of his own use, but that is not the relevant criterion. The applicant was unable to show dictionary references or third-party use about a term ‘HUNTBOOK’. A ‘HUNT’ does not have any connection to a ‘BOOK’. It is not plausible that hunters who take record of their achievements and experiences use s.th. like a ‘huntbook’ or call their personal notes ‘huntbook’.
- 33 To conclude, the verbal elements of both marks must be taken as composite terms in which none of the elements is more dominant than the other, and in which there is maybe no ‘element’ at all, except for ‘MY’, which is clearly weak for any interactive electronic service and especially any social media service.

- 34 The arguments of the applicant challenge the distinctiveness of 'BOOK' taken on its own. However, not only has this method of analysis to be set aside, as it is not dealing with the earlier mark as a whole, it is also in itself to be rejected. The Boards have already held that in relation to social media the element 'BOOK' is not weak (29/01/2014, R 254/2013-2, PAROBOOK/FACEBOOK, § 41; 28/01/2016, R 890/2015-2, SENIORBOOK/FACEBOOK, § 20).
- 35 The low degree of visual and aural similarity on the basis of the overlap in 'BOOK' must thus be confirmed.
- 36 However, a conceptual similarity is to be ruled out, because neither mark has a meaning as such and consequently cannot refer to the same or a different concept. The concept of 'HUNT' is not linked to the one of a 'FACE' and the concept of a 'BOOK' is the same so this does not affect the comparison of the signs in either way.

Link between the two signs

- 37 From the identity of the services and the similarity of the signs follows the link between the two. The Court of Justice has held that the existence of such link also depends on whether the earlier mark is unique (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 56). That is the case. Again, the examination must be made with regard to 'FACEBOOK' as a whole, not as to whether 'BOOK' alone is (as the applicant argued) generic.
- 38 There are two elements on file which support the conclusion that the 'FACEBOOK' mark is indeed unique.
- 39 One is that the defendant has filed a list (Annex 1 to the statement of grounds) from a website 'SocialMediaToday', which appears to be a credible and sufficiently neutral source, which lists 'the world's 21 most important social media sites and apps' (where 'FACEBOOK' appears on position 2 after 'TWITTER'). None of these 20 other sites and media contains the term 'BOOK'. This also supports the finding that a social media page is not perceived by the public as some sort of virtual book.
- 40 The second is that the applicant did not argue that there are other social media sites ending on 'BOOK'. He rather argues the opposite, that his own site is unique in the world of hunting. This argument does not convince. To the contrary, the defendant (Annex 3 to the statement of grounds) has submitted a long list of cases where the 'FACEBOOK' mark has prevailed against younger EUTM applications ending on 'BOOK', which shows a successful enforcement so that by necessity those other younger marks could not have entered the market.
- 41 The 'FACEBOOK' mark is a social media platform which is not focused on particular hobbies or fields of interest of the users. It is a rather 'universal' site for

everybody. There is no reason, neither when reading the list of goods and services nor when looking at the use that has been made of the earlier mark, that the earlier mark could not also include matter related to the field of hunting. Indeed, the opponent has brought evidence that there is a subpage for hunting enthusiasts on its social media site.

- 42 Rather, it is likely that the average consumer who is familiar with the earlier mark will tend to believe that 'MYHUNTBOOK' is a subpage of 'FACEBOOK' dedicated specifically to hunting.
- 43 The arguments brought forward by the appellant on this point, and on the issue of similarity of the signs, do not convince; they are contradictory.
- 44 In the first place the applicant has applied for 'social media' *tel quel* without any restriction to a particular field of activity such as hunting, and most naturally, one would have to ask oneself why then the mark reads not only HUNT, but even (MY) HUNTBOOK. The argument that the consumer would perceive the sign as a virtual book to record one's hunting achievements appears implausible from that perspective.
- 45 If on the other hand the applicant relies on the actual use, which apparently is not intended but has already started, then the arguments lose even more credibility. By that token the element 'HUNT' would only become descriptive.
- 46 Moreover one has to ask the applicant why he uses a sign made up of English words when targeting the Spanish public. In the image presented by him, on page 27 of the statement of grounds,

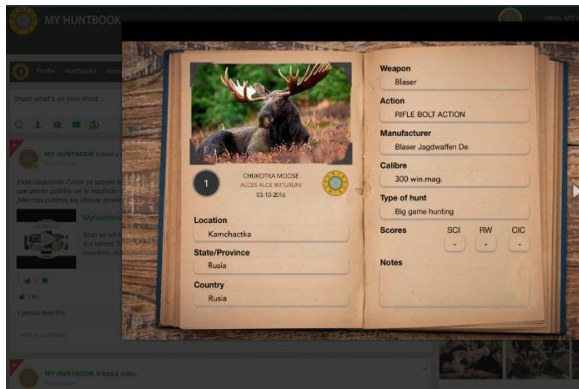
MyHuntbook, la red donde los cazadores no sufren la censura

MY HUNTBOOK Noticias 13 Noviembre 2017



he uses the sign together with text in Spanish addressing Spanish hunters ('the network where hunters don't suffer censorship'). Given that the average consumer in Spain does not have a high command of English (25/06/2008, T-36/07, Zipcar, EU:T:2008:223, § 45), the only reason to call the applicant's platform 'MyHuntbook' could be that he wanted to create a link to the 'FACEBOOK'

mark. Another image showing the actual use the applicant claims to have made is, on page 26 of the statement of grounds,



Whether or not this use was made in good faith is not relevant, as Article 59(1)(b) EUTMR is not a ground raised in the opposition. This rather seems to be an artificial attempt to use a design of a ‘book’.

- 47 To conclude, the applicant’s defence only furnishes further reasons to make a finding that there is not only an (objective) similarity, but also a link in the sense of Article 8(5) EUTMR with the earlier mark.

Unfair advantage

- 48 The concept of taking unfair advantage of the distinctive character or the repute of the earlier mark, referred to in Article 8(5) CTMR, encompasses instances where there is clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation (25/05/2005, T-67/04, Spa- Finders, EU:T:2005:179, § 51). In other words, this concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation (22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40).
- 49 The existence of an unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, must be assessed by reference to average consumers of the goods or services for which the later mark is to be registered, who are reasonably well informed and reasonably observant and circumspect (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 35, 36; 12/03/2009, C-320/07, NASDAQ, EU:C:2009:146, § 46-48).
- 50 The contested services are identical to those for which reputation has been established. Out of necessity the relevant public is then the same. Even when the part of the public is taken into consideration which is actually targeted by the use of the younger mark, the public remains the same. Every ‘hunter’ is also part of the general public and will also consume social media sites which are not limited

to hunting. As long as the specification of the list of goods and services of the contested application is not limited in that way, any limitation in the use for hunting-related activities is presently just a marketing strategy of the applicant, which may change, and be expanded into other fields of activity or interest, at any time, should the contested application be allowed to proceed to registration.

- 51 The opponent is also required to submit arguments on the existence of actual and present harm to his mark for the purposes of Article 8(5) EUTMR. The opponent must prove that there is a serious risk that such an injury will occur in the future, or at least adduce *prima facie* evidence of a future risk of unfair advantage, which is not hypothetical, (27/11/2008, C-252/07, Intel EU:C:2008:655, § 38; 25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 40; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 46). To this end the opponent must also establish that there is, or would be, a change of economic behaviour of the target consumers (14/11/2013, C-383/12, Outils Wolf, EU:C:2013:741, § 34; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 77, 81), so that eventually the applied-for mark would benefit of the association with the value of the earlier mark, such as image, prestige, high quality, reliability, or style (22/03/2007, T-215/03 VIPS, EU:T:2007:93, § 58).
- 52 In the present case we do not have to enter into the field of hypotheses; we have evidence on how the younger mark is already used.
- 53 The younger mark is already used, targeting the Spanish public, where reference is made to a purported ‘censura’ (censorship), and the applicant admitted the controversial nature of the activity of hunting. On the other hand, the ‘FACEBOOK’ social media page has in itself a positive image, to share experiences with other people and to stay connected with them over a distance. It appears highly plausible that the target public will be inclined to use the applicant’s page because of the similarity of the signs vis-à-vis the earlier mark.
- 54 The Board thus confirms the findings of the contested decision that consumers might decide to turn to the applicant’s services due to the mental association with the earlier mark, and that this may stimulate the sale or usage of the applicant’s services to an extent which will be disproportionally high in comparison to his own investment.
- 55 It suffices that in view of the use already made such may appear highly likely, and it is not required that actual damage already occurred on the part of the opponent. The opponent needs not adduce evidence of actual detriment; it suffices that there is a serious risk of such detriment, based on logical deductions (14/11/2013, C-383/12, Outils Wolf, EU:C:2013:741, § 42).
- 56 It can be safely expected, thus, that the applicant’s mark will benefit from the reputation built up by the earlier mark in the sense that it is easier for him to market his own services, and that the target public will be lead to believe that the two marks are in some way connected.

Due cause

- 57 The fact that the applicant intends to use (and already does use) the applied-for mark in relation to the field of hunting does not constitute a due cause; it only reinforces the relevance of the overlap of both signs in the term ‘BOOK’.
- 58 As indicated bad faith or good faith is not in issue and the absence of bad faith is not tantamount to a due cause.

Result

- 59 The finding that the conditions laid down in Article 8(5) EUTMR are fulfilled has been reached in the course of an overall assessment, taking into account the specific evidence on file. This finding cannot be called into question by referring to supposedly different decision of a nation a trade mark office, taken as the result of their own assessment and on facts or evidence on file there but unbeknown to the Board. The general principle remains that in inter partes proceedings such decisions taken at national level cannot call into question the assessment reached in the present case 11/05/2005, T-390/03, CM/CM Capital Markets, EU:T:2005:170, § 68; 07/06/2017, T 258/16, Ginraw, EU:T:2017:375, § 58). Such decisions cannot give rise to a claim for equal treatment (27/02/2002, T-106/00, Streamserve, EU:T:2002:43, § 66, 67). It must be emphasized that the decision of the Spanish trade mark office referred to by the applicant concerns a different legal basis, namely likelihood of confusion (in the EUTMR: Article 8(1)(b)), and only the situation in Spain.
- 60 The opposition is successful on the basis of the earlier EUTM No 9 151 192 and the grounds for opposition laid down in Article 8(5) EUTMR, specifically on the basis of a risk that there will be unfair advantage taken of the reputation of the earlier mark, and it is not necessary to examine any of the other earlier marks or any of the other types of injuries to which Article 8(5) EUTMR refers, nor to examine the ground for opposition laid down in Article 8(1)(b) EUTMR (see 16/09/2004, T-342/02, Moser Grupo Media, EU:T:2004:268, § 36, 45).
- 61 The appeal is dismissed.

Costs

- 62 Since the appellant (applicant) is the losing party within the meaning of Article 109(1) EUTMR, it must bear the costs incurred by the defendant in the opposition and appeal proceedings.

Fixing of costs

- 63 In accordance with Article 109(7) and (1) EUTMR and Article 18(1)(c)(i), (iii) EUTMDR, the Board fixes the representation costs to be paid by the appellant to the defendant for the appeal proceedings at EUR 550 and for the opposition proceedings at EUR 300, plus the opposition fee of EUR 320, in total EUR 1,170.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the appellant to bear the costs of the proceedings, which are fixed at EUR 1,170**

Signed

D. Schennen

Signed

C. Bartos

Signed

E. Fink

Registrar:

Signed

H.Dijkema

