



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

The Boards of Appeal

**DECISION
of the Second Board of Appeal
of 19 May 2009**

In Case R 819/2008-2

Elanko (H)ellas Aebe

Leof. Mesogeion 335
GR-152 31 Chalandri, Attikis
Greece

Applicant/Appellant

represented by Margarita Dalamaga – Kalogirou, 14, Sina-Street, GR-106 72 Athens,
Greece

v

Mars, Incorporated

6885 Elm Street
McLean, Virginia 22101-3883
United States of America

Opponent/Respondent

represented by Clifford Chance LLP Mars, Co-ordination team, 10 Upper Bank
Street, London E14 5JJ, United Kingdom

APPEAL relating to Opposition Proceedings No B 916 892 (Community trade mark
application No 4 107 413)

THE SECOND BOARD OF APPEAL

composed of T. de las Heras (Chairperson), H. Salmi (Rapporteur) and G. Humphreys
(Member)

Registrar: J. Pinkowski

gives the following

Language of the case: English

Decision

Summary of the facts

- 1 On 5 November 2004, Elanko (H)ellas Aebe (hereinafter ‘the applicant’) filed an application to register the following figurative mark in colour:



- 2 Registration was sought for ‘animal feed’ in Class 31.
- 3 The application was published in Community Trade Marks Bulletin No 28/2005 of 11 July 2005.
- 4 On 11 October 2005, Mars, Incorporated (hereinafter ‘the opponent’) filed a notice of opposition against the mark applied for based on the following earlier rights:
 - Community trade mark registration No 2 205 706 of the word mark:

PAL

filed on 4 May 2001 and registered on 17 June 2002 for ‘agricultural, horticultural and forestry products, grains and seeds, all included in Class 31; live animals, birds and fish; foodstuffs for animals, birds and for fish and preparations included in Class 31 for use as additives to such foodstuffs; malt; cuttlefish bone; bones for dogs; litter for animals; fresh fruit and fresh vegetables’ in Class 31. The opponent claims reputation of this Community trade mark in Ireland and the United Kingdom for ‘foodstuffs for animals, birds and fish and preparations included in Class 31 for use as additives to such foodstuffs; bones for dogs’ in Class 31.

- Community trade mark registration No 2 464 295 of the figurative mark:



filed on 15 November 2001 and registered on 17 July 2003 for the following goods and services:

Class 5 – Veterinary preparations and substances, but not including enemas; additives to foods for animals, birds and fish; disinfectants, all for use with animals; pesticides; fungicides; powders, sprays and collars, all for killing fleas and all for use with animals; medicated detergents, all for use with animals; medicated mouthwashes and dentifrices for animals; medicated breath fresheners for animals.

Class 21 – Identification barrels, trays and rings for birds and pet animals; brushes, combs, litter trays, food and water containers all for pet animals and birds; cages for birds and animals and parts and fittings therefore; covers for animal and bird cages; bird baths; artificial nest eggs.

Class 31 – Agricultural, horticultural and forestry products, grains and seeds, all included in class 31; live animals, birds and fish; foodstuffs for animals, birds and for fish and preparations included in class 31 for use as additives to such foodstuffs; malt; cuttlefish bone; edible bones and sticks for pets; litter for animals; fresh fruit and fresh vegetables and preparations of these for use as additives to foodstuffs.

- 5 The opponent based its opposition on all the goods covered by its registrations and directed it against all the goods applied for.
- 6 The opponent invoked Article 8(1)(a) and (b) and 8(5) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ('CTMR 1994') (OJ EC 1994 No L 11, p. 1; OJ OHIM 1/95, p. 52) as amended.
- 7 On 27 March 2008, the Opposition Division issued a decision ruling on Opposition B 916 892 ('the contested decision'). The Opposition Division rejected the CTM application for all the contested goods and ordered the applicant to bear the costs of the proceedings. The reasoning underlying the decision was, in essence, the following:
 - Article 8(1)(a) CTMR 1994 is not applicable; the signs are not identical.
 - The contested '*animal feed*' in Class 31 and the opponent's '*foodstuffs for animals, birds and for fish*' in Class 31 are both used for feeding animals, so the contested '*animal feed*' in Class 31 is considered to be identical to the goods of earlier rights.
 - Visually, due to the different colours, as well as the different size of the letters 'F' and 'P', the word 'FORPALS' is separated into two words, 'FOR' and 'PALS'. Therefore the word 'FOR' is perceived as an English preposition and the word 'PALS' is perceived as a plural of the word 'PAL', so the earlier mark is completely encompassed in the mark applied for. The signs in comparison are visually similar to a certain degree as far as they share the similar elements 'PAL' and 'PALS'. On the other hand, they differ in the colours, the violet line and the element 'FOR'.
 - Aurally, the word 'PAL', which represents the earlier mark in its entirety, is also perceived in the mark applied for. As a result, the pronunciation of the signs will be similar in as much as they share similar words 'Pal' and 'PALS' and dissimilar in the first part 'FOR' of the contested sign.

- Conceptually, taking into account the widespread knowledge of English language among the citizens of the European Union, the English meaning of the words is relevant. The word ‘PAL’ of the earlier mark means ‘friend’ or ‘chum’. The element ‘PALS’, as it is perceived in the mark applied for as a separate word, means the plural of the word ‘PAL’, so the conceptual meaning is the same. The word ‘FOR’ due to its position before ‘PALS’ is perceived as the preposition ‘for’ and conceptually emphasizes the sense of the word ‘PAL’, as the contested sign in its entirety means ‘for friends’. In conclusion, there is an average degree of similarity from a conceptual point of view as far as the signs in conflict share the same meaning of the English word ‘PAL’.
 - The documents submitted by the opponent are an acceptable means of evidence to support that the earlier trade mark enjoys enhanced distinctiveness to a high degree.
 - The opposition filed under Article 8(1)(b) CTMR 1994 is successful and must be upheld for the all contested goods.
 - As earlier Community trade mark No 2 205 706 leads to the success of the opposition and to the rejection of the mark applied for for all the goods against which the opposition was directed, there is no need to examine the other earlier right invoked by the opponent.
 - There is no need to examine the grounds of Article 8(5) CTMR 1994.
 - The coexistence of the marks in question in Greece is irrelevant for the purposes of the present opposition proceedings. The earlier mark is a Community trade mark and therefore the relevant territory for the comparison is the European Union, which encompasses more countries and the presence of the risk of confusion in one part of its territory, e.g. the United Kingdom or Ireland is sufficient for the refusal of the similar sign for registration under the CTMR.
- 8 On 27 May 2008, the applicant filed a notice of appeal. The statement of grounds of appeal was received on 25 and 28 July 2008.
- 9 The appeal was forwarded to the previous instance for consideration pursuant to Article 60(a) CTMR 2004 and remitted to the Boards of Appeal on 1 August 2008.
- 10 On 3 October 2008, the opponent filed its observations.
- 11 The applicant filed a reply on 13 November 2008.
- 12 The opponent filed a rejoinder on 13 January 2009.

Submissions and arguments of the parties

- 13 The applicant requests the Board to annul the contested decision to register the mark applied for and to order the opponent to bear the costs of the proceedings. Its arguments are summarized as follows:
- The Office has accepted similar trade marks, i.e. including the suffix ‘PAL’ for goods in Class 31 (e.g. CTMs No 5 264 321 TROPAL and No 501 726 FRUPALE), which have coexisted with the opponent’s marks.
 - The Greek Trade Marks Office has granted protection to trade marks including the element ‘PAL’. Those trade marks which have coexisted peacefully with the opponent’s national and CTM registrations for ‘PAL’.
 - The applicant’s national trade marks similar to the mark applied for have coexisted with the opponent’s trade marks on the Greek market.
 - The opposition is clearly abusive and it must be noted that it is only when the applicant took the decision to expand into the European market that the opponent incorrectly and belatedly saw a risk of confusion.
 - There is no likelihood of confusion.
- 14 The opponent requests the Board to uphold the contested decision and to order the applicant to bear the costs. Its arguments are summarized as follows:
- The opponent reiterates its arguments stated during the opposition proceeding about the likelihood of confusion due to the inclusion of its trade mark in the mark applied for and the identity of the goods at hand.
 - The fact that the applicant’s national trade mark registration and other trade mark incorporating ‘PAL’ coexists with the opponent’s trade marks in Greece is irrelevant in these proceeding as similarity and likelihood of confusion have to be assessed in the whole Community.
 - The applicant did not substantiate its allegation of bad faith, which is a serious allegation and should be distinctly alleged and distinctly proved.

Reasons

- 15 The appeal complies with Articles 58, 59 and 60 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (‘CTMR 2009’) (OJ EC 2009 No L 78, p. 1) [ex-Articles 57 *et seq.* CTMR 1994] and Rule 48 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing the CTMR (‘CTMIR’) (OJ EC 1995 No L 303, p. 1; OJ OHIM 2-3/95, p. 258) as amended. It is, therefore, admissible.
- 16 Article 8(1)(b) CTMR 2009 provides:

‘1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

...

(b) 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.

...’

- 17 The likelihood of confusion lies in 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.
- 18 The likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.
- 19 That assessment entails certain interdependence between the factors taken into account and, in particular, the similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa.
- 20 Another relevant factor is the distinctive character of the earlier trade mark. The more distinctive the earlier mark the greater will be the likelihood of confusion.
- 21 The Board will first assess if the Opposition Division erred in considering that there was a likelihood of confusion between the contested trade mark and earlier Community trade mark registration No 2 205 706 of the word mark ‘PAL’. Only if there is no likelihood of confusion between these signs, will the Board assess the other rights and/or grounds invoked.

Relevant public

- 22 The perception of the marks in the minds of consumers of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. In this case, given the nature of the goods concerned (foodstuffs for dogs), which are everyday consumer items, and the fact that the earlier word mark is registered and protected in the Community, the target public by reference to which the likelihood of confusion must be assessed is composed of average consumers in the Community. The average consumer, who is deemed to be reasonably well-informed and reasonably observant and circumspect, normally perceives a mark as a whole and does not analyse its various details. Moreover, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place his trust in the imperfect image of them which he has retained in his mind (see

(see judgment of the Court of First Instance of 31 March 2004 in Case T-20/02 *Interquell GmbH v OHIM* ('Happy dog') [2004] ECR II-1001, at paragraph 37).

- 23 The applicant insists in the appeal proceedings, as in the opposition proceedings, on the situation in Greece.
- 24 However, the Board emphasizes that it follows from the unitary character of the Community trade mark laid down in Article 1(2) CTMR 2009 that an earlier Community trade mark is protected in the same way in all Member States. Earlier Community trade marks may therefore be relied on in opposition to any subsequent application to register a trade mark which infringes their protection, even if it does so only in the perception of the consumers of part of the Community. It follows that the principle laid down in Article 7(2) CTMR, according to which it suffices, in order for registration of a trade mark to be refused, that an absolute ground for refusal exists only in part of the Community, also applies by analogy to a relative ground for refusal under Article 8(1)(b) CTMR. Thus, 'a part' of the Community can consist of only one Member State (see judgment of the Court of First Instance of 14 December 2006 in Joined Cases T-81/03, T-82/03 and T-103/03 *Mast-Jägermeister AG v OHIM* ('Venado') [2006] ECR II-5409, at paragraphs 76 and 83 last sentence).
- 25 Since the opponent alleges that its earlier marks have a reputation in the United Kingdom and Ireland and the Opposition Division also mentioned that the presence of the risk of confusion in one part of its territory, e.g. the United Kingdom or Ireland, is sufficient for the refusal of the similar sign for CTM registration, the Board will now proceed to assess the likelihood of confusion in these two Member States.
- 26 If there is a likelihood of confusion in these two Member States, it is irrelevant, as also considered by the Opposition Division, if there were no such confusion in Greece.

Comparison of the goods

- 27 As correctly considered in the contested decision and which the parties have not disputed, the goods at issue are identical.

Comparison of the signs

- 28 The global assessment of the likelihood of confusion, as far as concerns the visual, aural or conceptual similarity of the opposing signs, must be based on the overall impression given by the signs, bearing in mind, *inter alia*, their distinctive and dominant components (see judgment of the Court of First Instance of 14 October 2003 in Case T-292/01 *Phillips-Van Heusen Corp. v OHIM* ('Bass') [2003] ECR II-4335, at paragraph 47, and case-law cited therein).
- 29 The signs to be compared are:

	<p style="text-align: center;">PAL</p>
<p style="text-align: center;">CTM applied for</p>	<p style="text-align: center;">Earlier trade mark</p>

- 30 From a visual point of view, the Board stresses that the trade mark applied for will not be perceived as the single meaningless word 'FORPALS'. As correctly considered in the contested decision, due to the different colours of 'FOR' and 'PALS' (violet and blue respectively), as well as the different size of the letters 'F' and 'P', the public will separate the component 'FORPALS' into the two words, 'FOR' and 'PALS'.
- 31 As to the two word components in the trade mark applied for, the second element 'PALS' encompasses the entire earlier trade mark 'PAL', but differs in its ending due to the additional letter 'S. Moreover, the beginning of the trade mark applied for contains the word 'FOR' which is not present in the earlier trade mark. The differences between the signs would be strengthened if in the case at hand the principle applies that the beginning is generally understood as the part that primarily catches the consumer's attention and is therefore remembered more clearly than the rest of the signs. The Board considers this not to be the case, bearing in mind that, at this stage, the signs are compared as perceived by the average consumer in the United Kingdom and Ireland.
- 32 'FOR' is a mere common English preposition, which complements the noun 'PALS' and can be perceived as meaning 'on behalf of or to the benefit of pals'. The word 'pal' means, informally, 'friend' in English; the additional 'S' in 'PALS' serves to indicate that it is the plural form of 'PAL'.
- 33 In the light of the foregoing, the consumer's attention will focus on the noun 'PAL' which, albeit not highly inherently distinctive for the goods at issue, is the most distinctive and dominant word component of the trade mark applied for. Thus, in the present case the beginning cannot be understood as the part that primarily catches the consumer's attention.
- 34 As to the somewhat stylized typeface in two different colours of the word 'FORPALS', as well as the violet horizontal line under it in the contested trade mark, these are rather banal and do not have any relevant differentiating effect on the overall impression of the signs.
- 35 The signs have in common what is the entire earlier trade mark and the distinctive and dominant component of the trade mark applied for, namely the word 'PAL'. In the light of the foregoing, this common feature outweighs the abovementioned differentiating components. The signs are visually similar.
- 36 From a phonetic point of view, the signs to be compared are 'FOR PALS' and 'PAL'. In spite of the different length and structure, bearing in mind the above

considerations on the role of the various components within the trade marks applied for, the Board also considers that the signs are phonetically similar.

- 37 Conceptually, the Board concurs with the reasoning in the contested decision, which leads to the finding that the signs are also similar from a semantic point of view.

Distinctive character of the earlier trade mark

- 38 The Opposition Division considered that the opponent has proven that the earlier trade mark has obtained enhanced distinctiveness in the United Kingdom and Ireland, namely that it is distinctive to a high degree. The applicant does not dispute this. The Board notes that even if the evidence on file were not sufficient to prove a high degree of distinctive character, a certain enhanced distinctiveness can be assumed. In any event, even if no enhanced distinctiveness were proven, inherently the earlier trade mark is not devoid of distinctive character.
- 39 Although the lesser distinctive the earlier trade mark the lesser the likelihood of confusion, even if the earlier trade mark were to have a low degree of distinctive character, this does not exclude a likelihood of confusion (see judgment of the Court of First Instance of 15 March 2006 in Case T-35/04 *Athinaiki Oikogeniaki Artopoiia AVEE v OHIM* ('Ferró') [2006] ECR II-785, at paragraph 69 and confirmed in the order of the Court of 11 September 2007 in Case C-225/06 P *Athinaiki Oikogeniaki Artopoiia AVEE v OHIM* ('Ferró') [2007] ECR I-111*, at paragraph 21). As mentioned in the beginning of the reasoning, the distinctive character is only one factor among others involved in the assessment.

Global assessment / Conclusion

- 40 The signs are phonetically and visually similar. Moreover, the signs refer to a similar concept that strengthens the visual and phonetic similarities between the marks.
- 41 Taking into account all the above and in particular that the signs at issue are similar and the goods under comparison are identical, as well as the interdependence between the similarity of the signs and the identity of the goods designated, the relevant public in the United Kingdom and Ireland confronted with the marks at issue for '*animal feed*' will be misled into thinking that the marks indicate a shared commercial origin.
- 42 Accordingly, the Opposition Division did not err in rejecting the applicant's trade mark on the basis of the applicability of Article 8(1)(b) CTMR 2009. Therefore, there is no need to assess the applicability of Article 8(1)(b) CTMR 2009 in relation to the other Member States, nor is there a need to assess the opposition insofar it was based upon the remaining marks and grounds invoked.
- 43 This conclusion cannot be undermined by the following arguments advanced by the applicant.

- 44 The applicant argues that the Office has accepted similar trade marks with the suffix 'PAL' for goods in Class 31 which have coexisted with the opponent's marks. Even if the Office were to have accepted similar 'PAL' trade marks in the register, this does not mean that they coexist with the opponent's marks in the market and even less that there can be no likelihood of confusion between the various 'PAL' marks, including those at issue. Therefore, this argument fails.
- 45 Insofar as the applicant refers to the practice of the Greek Trade Marks Office and coexistence in Greece, the Board reiterates that in the present case there is a likelihood of confusion in the United Kingdom and Ireland which is sufficient to reject the entire trade mark application under Article 8(1)(b) CTMR 2009. Whether or not there is no such likelihood of confusion in Greece is irrelevant for the present proceedings. Therefore, these arguments fail.
- 46 The applicant argues that it is only when the applicant took the decision to expand into the European market that the opponent incorrectly and belatedly saw a risk of confusion. Such an attitude, the applicant argues, is clearly abusive and in bad faith. It might be true that the opponent only took action when the applicant expanded its market. However, this does not mean that the opponent acted in bad faith, nor is this a reason for the Office to reject the opposition. As follows from the above, the conditions of Article 8(1)(b) CTMR 2009 are fulfilled and thus the trade mark has to be rejected accordingly.
- 47 Consequently, the appeal is dismissed.

Costs

- 48 Pursuant to Article 85(1) CTMR 2009 [ex-Article 81(1) CTMR 1994], the applicant, as the losing party, must bear the costs of the appeal proceedings. Pursuant to Article 85(6) CTMR 2009 [ex-Article 81(6) CTMR 1994] and Rule 94(3) last sentence CTMIR, the applicant is therefore ordered to reimburse the costs of professional representation for the appeal proceedings at the level laid down in Rule 94(7)(d) CTMIR (EUR 550). As to the opposition proceedings, the Opposition Division ordered the applicant to bear the opponent's representation costs in the amount of EUR 300 and the opposition fee of EUR 350.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to bear the total amount of EUR 1 200 in respect of the costs of the opponent in the appeal and opposition proceedings.**

T. de las Heras

H. Salmi

G. Humphreys

Registrar:

J. Pinkowski