



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

OPERATIONS DEPARTMENT

B206b

Notification to the applicant/holder of a decision

Alicante, 24/09/2012

CONTEGO IP LLP
90 Long Acre
Covent Garden
London WC2E 9RZ
REINO UNIDO

Your reference: **LEUN/01/0001/nht**
Opposition number: **B 001964462**
Contested trade mark number: **010254985**
Name of the applicant/holder: **Lorenz Toys Co Limited**

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **24/09/2012**.

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Enclosures (excluding the cover letter): 04 pages.

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office in accordance with Rule 55(1) CTMIR.



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET

(TRADE MARKS AND DESIGNS)

Opposition Division

OPPOSITION No B 1 964 462

Jan Hoorens, Ten Beukenboom29, 9400 Ninove, Belgium (opponent), represented by **Bureau Callewaert**, Brusselsesteenweg 108, 3090 Overijse, Belgium (professional representative)

a g a i n s t

Lorenz Toys Co Limited, Suite 2103, 21st Floor China United Plaza No.1008 Tai Nan West Street, Cheung Sha Wan Kowloon, Hong Kong, People's Republic of China (applicant), represented by **Contego IP LLP**, 90 Long Acre, Covent Garden, London WC2E 9RZ, United Kingdom (professional representative).

On 24/09/2012, the Opposition Division takes the following

DECISION:

1. Opposition No B 1 964 462 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against some of the goods of Community trade



mark application No 10 254 985, namely against some of the goods in Classes 21 and 28. The opposition is based on Community trade mark registration No 4 300 497 'TIMBOO'. The opponent invoked Article 8(1)(b) CTMR.

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

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically-linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

a) **The goods**

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

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

Class 20: *Mattresses, cushions, pillows, head boards, bumper pads, bolsters, air mattresses, sleeping bags, sleeping mats, cribs, bedding, the aforesaid goods intended in particular for children and babies.*

Class 24: *Textiles and textile goods not included in other classes, cloths, blankets, sheets, covers for pillows and cushions, pillowcases, bed linen and bedspreads, towels, the aforesaid goods intended in particular for children and babies.*

Class 25: *Clothing, footwear, headgear, shawls, sleepwear, bibs, thermal clothing, in particular clothing for children and babies.*

The contested goods are the following:

Class 21: *Baby baths; Toothbrushes; Feeding cups for babies and children; Cleaning towels; Non-electric heaters for feeding bottles; Lunch boxes.*

Class 28: *Toys; Games; Playthings; Action skill games; Action figures; Board games; Card games; Children's toys; Bath toys; Beach balls; Bean bags; Bean bag dolls; Toy building blocks; Bubble making wands; Bubble making sets; Bubble making solution; Chess sets; Children's play cosmetics; Collectable toy figures; Disc toss toys; Dolls; Dolls clothing; Doll accessories; Doll play sets; Electric action toys; Playing card equipment; Games; Infant toys; Inflatable toys; Jigsaw puzzles; Jump ropes; Kites; Magic tricks; Marbles; Manipulative games; Mechanical toys; Music box toys; Musical toys; Parlour games; Small toys; Party games; Playing cards; Plush toys; Puppet roller skates; Rubber balls; Spinning tops; Squeeze toys; Stuffed toys; Talking toys; Target games; Teddy bears; Toy action figures; Toy buckets; Shovel sets, Toy scooters; Toy cars; Toy model hobby craft kits; Toy figures; Toy banks; Toy vehicles; Toy trucks; Toy watches; Toy weapons; Wind-up toys; Yo-yos.*

As a preliminary remark, it should be noted that the term *in particular*, used in the opponent's list of goods, indicates that the specific goods are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (on the use of *in particular* see a reference in judgment of 09/04/2003, T-224/01, 'Nu-Tride').

The opponent's goods in Class 20 are to be defined generally as bedding. The opponent's goods in Class 24 are textile covers for household use and the opponent's goods in Class 25 are mainly clothing, footwear and headgear.

The contested goods in Class 21 are generally household utensils, brushes, some small, hand-operated utensils and apparatus while the contested goods in Class 28 are toys, games and playthings.

It is obvious that the compared groups of goods are quite different. The opponent's goods are beddings and products for covering them or the human body for protecting them from the impact of the surrounding environment, and a certain degree of aesthetics is attributed to the products. The contested goods in Class 21 on the other hand, being household utensils, are quite specific depending on their intended purpose. None of the contested goods serves the purpose of covering beds or the human body. The same is valid also for the contested goods in Class 28, whose main purpose is to keep children busy in an entertaining way. The opponent's and applicant's groups of goods differ in nature because, as pointed out above, their essential qualities and characteristics are quite different. Obviously they are also used in totally different ways in order to achieve their intended purpose meaning that they also differ in their method of use. Since the compared groups of goods do not serve the same purpose, it is impossible for them to substitute each other, that is, they are not interchangeable. Both groups of goods are manufactured by undertakings specialised in different areas using different materials and different production technologies. The different kinds of compared products are distributed through different channels and are generally offered at different points of sale.

The opponent argues that some of the contested goods are 'in particular complementary' or 'closely related' to the opponent's goods because they may be sold by the same undertakings at the same points of sale. The opponent supports this argument by website printouts showing that toys and baby clothing are offered for sale through the same company. However, complementarity has to be distinguished from use in combination where goods are merely used together whether by choice or convenience. This means that they are not essential for each other. In such cases similarity can only be found on the basis of other factors, which, as shown above, is not the case here.

It is true that the CFI held that certain goods (goods in Classes 25 and 18) may be found similar due to 'aesthetic complementarity', where this aesthetic or subjective complementary nature has reached the stage of a true aesthetic 'necessity' in the sense that consumers would think it unusual or shocking to carry a bag which does not perfectly match their shoes (see judgment of 01/03/2005, T-169/03, 'Sissi Rossi', para. 62, judgments of 11/07/2007, T-150/04, 'Tosca Blu', para. 35-39 and T-443/05, Pirañam, para. 49-50, judgment of 20/10/2011, T-214/09 'Cor', para. 32-37). However, in the present case this argument cannot be accepted since it is very unlikely that consumers will consider *baby baths; toothbrushes; feeding cups for babies and children; cleaning towels; non-electric heaters for feeding bottles; lunch boxes* to be necessarily used together with *towels for children and babies* for reasons of aesthetical complementarity. Neither are toys indispensable or important for the use of the opponent's *clothing, sleepwear for children and babies* or any other goods in the opponent's specification of goods. The consumers will not consider it ordinary and natural to use those goods together.

Furthermore, account should be taken of the fact that the goods must be compared as they appear in the specifications of the conflicting marks, and not, as the opponent claims, by reference to their alleged actual or intended use. Therefore, the opponent's statements concerning the alleged similar fields of activities of the parties must be dismissed.

Bearing in mind the foregoing, the Opposition Division finds that the goods are clearly dissimilar.

Conclusion

Article 8(1)(b) CTMR states that ‘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’ (emphasis added).

According to Article 8(1)(b) CTMR, the similarity of the goods or services is a condition for a finding of likelihood of confusion. Since the goods are clearly dissimilar, one of the necessary conditions of Article 8(1)(b) CTMR is not fulfilled, and the opposition must be rejected.

COSTS

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

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

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



The Opposition Division

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

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