**OPPOSITION Nо B 3 139 751**

**Youth S.R.L.**, Via Morimondo, 26, 20143 Milano, Italy (opponent), represented by **Spheriens**, Piazza della Libertà 13 - Viale Don Minzoni 1, 50129 Firenze, Italy (professional representative)

a g a i n s t

**Octopus International Inc.**, 2973 Harbor Blvd. #366, CA92626 Costa Mesa, United States (applicant), represented by **Sasse, Bachelin & Lichtenhahn Rechtsanwälte Partnerschaft mbB** Alexanderstr. 9, 10178 Berlin, Germany (professional representative).

On 05/05/2023, the Opposition Division takes the following

**DECISION:**

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|  **1.** | Opposition No B 3 139 751 is upheld for all the contested goods. |

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| **2.** | European Union trade mark application No 18 298 004 is rejected in its entirety. |

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| **3.** | The applicant bears the costs, fixed at EUR 620. |

**REASONS**

On 29/01/2021, the opponent filed an opposition against all the goods of European Union trade mark application No 18 298 004  (figurative mark). The opposition is based on:

 international trade mark registration No 1 465 369  (figurative mark) designating the European Union; and

 European Union trade mark registration No 13 342 647  (figurative mark).

The opponent invoked Article 8(1)(b) EUTMR.

**LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR**

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.

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the opponent’s international trade mark registration No 1 465 369  (figurative mark) designating the European Union.

**a) The goods**

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

Class 18: *Umbrellas and parasols; suitcases; bags; clutch bags (hand bags); vanity cases, not fitted; key cases; cosmetic cases not fitted; hip bags; haversacks; rucksacks; pocket wallets; card cases; coin holders in the nature of wallets.*

Class 25: *Clothing; footwear; headgear; rain suits for motorcyclists; waterproof jackets and trousers.*

Class 28: *Sports equipment; skateboards; games; video game apparatus.*

Class 35: *Retail and wholesale services relating to cosmetics, perfumery, deodorants for humans, ethereal oils, apparatus for recording, transmission or reproduction of sound or images, computer hardware, computer software products, eyeglasses cases, cases especially made for photographic apparatus and instruments, smartwatches, mouse pads, USB flash drives, headsets, covers for tablet computers, covers for smartphones, cases for smartphones, covers for laptops, bags adapted for laptops, computer peripherals and accessories, eyewear, sunglasses, goggles for sports, goggles for motorcyclists, protective helmets for sports, helmets for motorcyclists, articles of protective clothing for wear by motorcyclists for protection against accident or injury, jewellery, precious stones, horological articles, key rings with charms of metal, split key rings with trinket or decorative fob, charms for key rings, cuff links, ornamental pins, jewellery boxes, statues of precious metal, works of art of precious metal, umbrellas and parasols, suitcases, bags, clutch bags (hand bags), vanity cases, not fitted, key cases, cosmetic cases not fitted, hip bags, haversacks, rucksacks, pocket wallets, card cases, coin holders in the nature of wallets, clothing, footwear, headgear, rain suits for motorcyclists, waterproof jackets and trousers, sports equipment, skateboards, games, video game apparatus; online retail services relating to cosmetics, perfumery, deodorants for humans, ethereal oils, apparatus for recording, transmission or reproduction of sound or images, computer hardware, computer software products, eyeglasses cases, cases especially made for photographic apparatus and instruments, smartwatches, mouse pads, USB flash drives, headsets, covers for tablet computers, covers for smartphones, cases for smartphones, covers for laptops, bags adapted for laptops, computer peripherals and accessories, eyewear, sunglasses, goggles for sports, goggles for motorcyclists, protective helmets for sports, helmets for motorcyclists, articles of protective clothing for wear by motorcyclists for protection against accident or injury, jewellery, precious stones, horological articles, key rings with charms of metal, split key rings with trinket or decorative fob, charms for key rings, cuff links, ornamental pins, jewellery boxes, statues of precious metal, works of art of precious metal, umbrellas and parasols, suitcases, bags, clutch bags (hand bags), vanity cases, not fitted, key cases, cosmetic cases not fitted, hip bags, haversacks, rucksacks, pocket wallets, card cases, coin holders in the nature of wallets, clothing, footwear, headgear, rain suits for motorcyclists, waterproof jackets and trousers, sports equipment, skateboards, games, video game apparatus.*

The contested goods are the following:

Class 18: *Bags for sports; athletic bags; beach bags; belt bags and hip bags; casual bags; courier bags; cross-body bags; diaper bags; duffel bags; evening bags; gym bags; hiking bags; leather bags; messenger bags; overnight bags; school bags; shoulder bags; tote bags; travelling bags; waterproof bags; weekend bags; rucksacks; backpacks; suitcases; wallets.*

Class 25: *Clothing; headwear; footwear; beachwear; beach clothes; beach footwear; beach hats; waist belts; dresses; gloves; gowns; headbands; sweatshirts; hooded sweatshirts; sweaters; jackets; jumpers; pants; parkas; singlets; socks; slacks; trousers; shorts; skirts; sports shirts; surfwear; swimsuits; swimwear; t-shirts; wetsuits for surface watersports.*

Class 28: *Surfboards; surfboard covers; bags especially designed for surfboards; bags adapted to carry surfboards; surfboard carrier worn on the body; surfboard fins; surfboard holder worn on the body; surfboard leashes; surfboard traction pads; swim fins; scuba fins; surf fins; fins for windsurfing boards; grips for sporting articles; pads for use in sports; floating recreational pads.*

The applicant claims that its goods are specifically designed and created in connection with surfing for the surfing community while the opponent offers products designed for streetwear fashion, and that the parties and the trade marks do not compete in any business, therefore, they will not be subject to any confusion by the public. It is reminded that during the 5-year grace period for proof of use of the earlier mark, as it is the case here, the comparison of the goods required by Article 8(1)(b) EUTMR must relate to the description of the goods covered by the earlier mark relied on in opposition or those of the contested application and not the goods for which the trade mark is actually used (22/03/2007, T-364/05, Pam Pluvial, EU:T:2007:96, § 85 and of 07/09/2006, T-133/05, Pam-Pim’s Baby-Prop, EU:T:2006:247, § 30). The particular circumstances in which the goods covered by the marks are actually marketed have, as a matter of principle, no impact on the assessment of the likelihood of confusion because they may vary in time depending on the wishes of the proprietors of the trade marks (15/03/2007, C‑171/06 P, Quantum, EU:C:2007:171, § 59; 22/03/2012, C‑354/11 P, G, EU:C:2012:167, § 73; 21/06/2012, T‑276/09, Yakut, EU:T:2012:313, § 58). Consequently, the applicant’s claim must be dismissed as it has no impact for the purposes of the present assessment.

**Contested goods in Class 18**

*Suitcases; rucksacks* are identically contained in both lists of goods.

The contested *casual bags;* *gym bags; travelling bags; beach bags; school bags; shoulder bags; athletic bags; bags for sports; backpacks;* *tote bags; weekend bags; waterproof bags; overnight bags; messenger bags; leather bags; hiking bags; evening bags; duffel bags; diaper bags; cross-body bags; courier bags; belt bags and hip bags* are included in the opponent's *bags*. Therefore, they are identical.

The contested *wallets* include, as a broader category the opponent's *pocket wallets*. Since the Office cannot dissect *ex officio* the broad category of the contested goods, they are considered identical to the opponent’s goods.

**Contested goods in Class 25**

*Footwear; clothing* are identically contained in both lists of goods.

The contested *beach hats;* *headbands; headwear* are included in, or overlap with, the opponent's *headgear*. Therefore, they are identical.

The contested *t-shirts;* *parkas; gloves; beach clothes; dresses; singlets; pants; hooded sweatshirts; sweatshirts; gowns; waist belts; jumpers; jackets; sweaters; beachwear; swimsuits; slacks; socks; shorts; swimwear; skirts; sports shirts; trousers; surfwear; wetsuits for surface watersports* are included in the opponent's *clothing*. Therefore, they are identical.

The contested *beach footwear* is included in the opponent's *footwear*. Therefore, they are identical.

**Contested goods in Class 28**

The contested *surfboards; bags especially designed for surfboards; bags adapted to carry surfboards; surfboard fins; surfboard leashes; scuba fins; surf fins; fins for windsurfing boards; grips for sporting articles; pads for use in sports; swim fins; floating recreational pads; surfboard covers; surfboard carrier worn on the body; surfboard holder worn on the body; surfboard traction pads* are included in, or overlap with, the opponent's *sports equipment*. Therefore, they are identical.

**b) Relevant public — degree of attention**

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer’s degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods found to be identical target the public at large. The degree of attention is average (09/07/2021, R-1755/2020-4 & R-1900/2020-4, OCTOPUS (fig.) / OCTOPUS (fig.) § 24).

**c) The signs**

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|  Earlier trade mark |  Contested sign |

The relevant territory is the European Union.

The global appreciation of 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 (11/11/1997, C‑251/95, Sabèl, EU:C:1997:528, § 23).

Both signs consist of a circle containing a stylised illustration of eight tentacles which will be associated with an octopus at least by part of the public. This perception is acknowledged by the parties, including the applicant who notes in its observations that the figurative element of eight tentacles is intrinsic of an octopus. Moreover, this scenario is in line with the recent decisions from the Board of Appeal (09/07/2021, R-1755/2020-4 & R-1900/2020-4, OCTOPUS (fig.) / OCTOPUS (fig.), § 43 and 46), which involve the same parties and similar signs containing the figurative elements at stake. Since it is not necessary to establish that there is a likelihood of confusion for the whole of the relevant public (20/07/2017, T-521/15, Diesel v EUIPO, EU:T:2017:536, § 69), the following comparison will be carried out in relation to this non-negligible part of the consumers that will perceive both signs as including an octopus.

Give that the image of an octopus bears no descriptive or allusive meaning in relation to the goods in question, the signs have a normal degree of inherent distinctiveness.

**Visually**, both signs depict black and white images consisting of eight tentacles viewed from above, forming a symmetric and rotating shape of similar proportions. Moreover, they are depicted within a circle.

As far as the differences between them, the representation of the contested sign is more detailed and realistic, for instance, the tentacles contain the suckers typical of an octopus whereas in the earlier mark the representation is more fanciful. They also differ in the direction of their tentacle’ ends, clockwise versus contraclockwise. Another element of dissimilarity is the fact that the tentacles are depicted in black on a white background in the contested sign, as opposed to the white silhouette on a black background in the earlier mark.

The outcome of a visual comparison must be based on a ‘balance’ between similar and dissimilar elements. The former (similar) elements outweigh the latter in the present case. The average consumer will retain a very similar overall impression and proportion of the octopus and will not necessarily identify or remember the dissimilarities between the signs (30/01/2018, T-113/16, Device of a panther / Device of a panther, EU:T:2018:43, § 38), which are less striking or can easily go unnoticed.

The applicant contends that ‘the figurative element of eight tentacles is intrinsic of an octopus and that the respective logo are not unique because an octopus will always be portrayed in a similar way due to the particular features of the animal’. However, in the Opposition Division’s opinion the particular depiction of the signs in question, and in particular the bird’s-eye view, it is not the most common way in which octopus are normally represented. This, together with the circular background, produce an overall impression which is ‘very’ similar as concluded in the aforementioned case from the Board (paragraphs 43 and 46), in relation to signs including the figurative element at stake.

In light of the foregoing, the signs are visually similar, at least, to a low degree.

**Aurally**, purely figurative marks with no verbal elements are not subject to a phonetic assessment. Therefore, an aural comparison is not possible.

**Conceptually**, reference is made to the previous assertions concerning the visual comparison, which are valid *mutatis mutandi* since images, like words, may translate into concepts. The concept conveyed by the signs is that of an octopus viewed from above. Consequently, the signs are conceptually identical.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

**d) Distinctiveness of the earlier mark**

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in ‘Global assessment’).

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark has no meaning for any of the goods in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

**e) Global assessment, other arguments and conclusion**

The appreciation of likelihood of confusion on the part of the public depends, inter alia*,* on the recognition of the earlier mark on the market, the association that can be made with the registered mark, and the degree of similarity between the marks and between the goods or services identified. It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C‑342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18; 11/11/1997, C‑251/95, Sabèl, EU:C:1997:528, § 22).

The contested goods are identical to the opponent’s goods. They target the public at large, whose degree of attention is average. The inherent distinctiveness of the earlier mark is normal.

The similarities between the signs arise from the similar depiction of the eight tentacles of an octopus seen from above on a circular background which leads, as concluded above, to a low degree of visual similarity, at least, and conceptual identity. Given that the average consumer retains only an imperfect image of the mark in his or her mind, it cannot be considered that he or she would be able to recall all figurative details of the signs in question, such as the more or less realistic style of the tentacles or whether they are depicted in black or white. The key point is how the signs at issue are normally perceived overall and not how the stylistic differences between the signs may be perceived in the event that a particularly meticulous consumer is in a position to examine the graphic stylisations and draw comparisons between them (07/10/2014, T-531/12, T (fig. mark), EU:T:2014:855, § 65). Both signs contain a bird’s-eye view image of the same animal (an octopus) with almost identical proportions and position. In the Opposition Division’s view, the signs do present similarities (in particular the aerial perspective, forming a symmetric and rotating shape, which is not the common way to represent an octopus) that may visually strike an average consumer of the relevant goods

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C‑39/97, Canon, EU:C:1998:442, § 17). If there is identity between the goods, as it is the case, the degree of difference between the marks at issue must be high in order to exclude likelihood of confusion (13/11/2012, T-555/11, tesa TACK, EU:T:2012:594, § 53 and the case-law cited therein). The visual differences between the signs are further offset by the identity between the goods concerned, and by the average level of visual and conceptual identity between the signs (01/09/2021, R-67/2021-4, LES BORDES (fig.) / DEVICE OF A STAG’S HEAD (fig.) et al., § 48; 14/12/2006, T-81/03, T-82/03 & T-103/03, Venado, EU:T:2006:397, § 103, 108, 111).

Additionally, although the relevant public may detect some differences between the signs, it is likely that consumers will perceive the differing elements as different versions of the marks, given the common and particular features of the respective representations. It is common practice in the relevant market for manufacturers to make variations in their trade marks, and the mark could be perceived as a restyling. Therefore, the likelihood that the public may associate the signs with each other is also very real.

The applicant refers to the decision of the Fourth Board of Appeal (09/07/2021, R-1755/2020-4 & R-1900/2020-4, OCTOPUS (fig.) / OCTOPUS (fig.)) involving the parties of this proceeding, to support the lack of likelihood of confusion. However, that case corroborated the likelihood of confusion in respect to the goods (confirmed) to be similar. Moreover, as indicated above, it rather confirms the similarity between the signs of the present proceeding since the disputed marks  and(which include the corresponding figurative elements assessed in this case), were considered to be ‘very similar’ (paragraphs 43 and 46).

It also argues that its EUTM has a reputation in the USA, Australia, Japan and the EU within the surfing community and filed various items of evidence to substantiate this claim. The right to an EUTM begins on the date when the EUTM is filed and not before, and from that date on the EUTM has to be examined with regard to opposition proceedings. Therefore, when considering whether or not the EUTM falls under any of the relative grounds for refusal, events or facts that happened before the filing date of the EUTM are irrelevant because the rights of the opponent, insofar as they predate the EUTM, are earlier than the applicant’s EUTM.

Taking all the above into account, the Opposition Division considers that the differences between the signs are insufficient to outweigh the similarities between them. Consequently, the relevant public, when encountering the signs in relation to identical goods, is likely to think that they come from the same undertaking or from economically linked undertakings.

Considering all the above, there is a likelihood of confusion on the part of the public, perceiving both signs as octopus’ representations.

Therefore, the opposition is well founded on the basis of the opponent’s international trade mark registration No 1 465 369 designating the European Union. It follows that the contested trade mark must be rejected for all the contested goods.

Since the opposition is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the opponent’s marks due to their extensive use as claimed by the opponent. The result would be the same even if the earlier marks enjoyed an enhanced degree of distinctiveness.

As the earlier mark analysed leads to the success of the opposition and to the rejection of the contested trade mark for all the goods against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268).

**COSTS**

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

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

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the opponent are the opposition fee and 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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| Alina LARA SOLAR | Félix ORTUÑO LÓPEZ | Chiara BORACE |

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.