



**OPPOSITION No B 1 577 850**

**JCDecaux SA**, 17, rue Soyer, Neuilly sur Seine, France (opponent), represented by **Isabelle Vincent**, ZI Ste. Apolline, Plaisir, France

a g a i n s t

**Hotwire, Inc.**, 655 Montgomery Street, Suite 600, San Francisco, United States of America (applicant), represented by **Maqs Law Firm Advokataktieselskab**, Pilestræde 58, Copenhagen K, Denmark.

On 03/02/2011, the Opposition Division takes the following

**DECISION:**

1. Opposition number B 1 577 850 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

**REASONS:**

The opponent filed an opposition against all the services in class 35 of Community trade mark application No 8 213 837, based on Community trade mark registration No 4 586 392. The opponent invoked Article 8(1)(b) CTMR.

**1. 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 services**

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, sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

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

**Class 35:**

*Opinion polls and surveys in the marketing field; collection of information on consumers' opinions and behaviours in relation with marketing researches and*

*advertising surveys, and on clients' opinions and behaviours in relation with goodwill satisfaction surveys; collection of data in a data bank; market researches, market prospection, business prospection and investigation, statistical work, transcription of communications; renting out of advertising spaces, trading news agency; project management (business management assistance), sales promotion, public relations, advertising; production and interpretation of information, namely service of information collected on consumers' opinions and behaviours in relation with media surveys; processing of results of surveys and opinion polls; service of compilation of technical information in relation with development and use of data banks, with data processing, with data transmission.*

The contested services are the following:

**Class 35:**

*Advertising; customer loyalty services and customer club services, for commercial, promotional and/or advertising purposes; conducting customer loyalty and incentive programs for commercial promotion and for advertising purposes.*

**Contested services in class 35:**

*Advertising is identically reproduced in the lists of the conflicting services.*

The remaining contested services “*customer loyalty services and customer club services, for commercial, promotional and/or advertising purposes; conducting customer loyalty and incentive programs for commercial promotion and for advertising purposes*” are similar to the earlier services “*opinion polls and surveys in the marketing field; collection of information on consumers' opinions and behaviours in relation with marketing researches and advertising surveys, and on clients' opinions and behaviours in relation with goodwill satisfaction surveys; collection of data in a data bank; market researches, market prospection*”.

It must be stated that the core business of the services in class 35 is to provide services to other businesses. Further, planning, working out customer loyalty services and conducting customer loyalty programs must be based on the results of market research, especially on the client's opinions and behaviour. Thus, the contested services should include one or more of the earlier services. Further, both the earlier and the contested services are generally offered by the same undertaking providing different marketing and marketing research services.

**b) The signs**

Earlier trade mark



Contested sign

The relevant territory is the European Union.

**Visually**, both marks are figurative. The earlier mark consists of a black arc as part of a circle resembling a letter “C”, and a black aeroplane between the endpoints of that arc.

The contested mark consists of a white aeroplane on a red circular background. The aeroplane is placed asymmetrically in the upper part of the circle, directed slightly upwards.

The marks are similar to the extent that both contain an aeroplane of almost identical shape. On the other hand, they differ in the size (the aeroplane in the earlier mark is much smaller than the one in the contested mark), colour and position of the aeroplanes, in the background and in the additional figurative element of the earlier mark.

**Aurally**, the earlier sign may be pronounced as letter “C” according to different pronunciation rules in different parts of the relevant territory, provided that the arc will be identified as such. The contested sign - as a purely figurative mark - cannot be pronounced and is not subject to a phonetic assessment. Consequently, it is not possible to make an aural comparison of the signs at hand.

**Conceptually**, a simple letter has no concept, even if letter “C” of the earlier mark would be identified. On the other hand as regards the figurative devices, the signs will be associated with the same concept, namely with that of an aeroplane. To that extent, the signs are conceptually similar.

**c) Distinctive and dominant elements of the signs**

In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

The marks under comparison have no elements which could be considered clearly more distinctive or dominant (visually eye-catching) in comparison to other elements.

**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.

The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.

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 as a whole has no meaning in relation to the services at hand from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

#### **e) Relevant public – level 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 level of attention is likely to vary according to the category of goods or services in question.

The services at issue are specialised services directed at business customers with specific professional knowledge or expertise in field of advertising, marketing and marketing research.

#### **f) Global assessment, other arguments and conclusion**

The services were found to be partly identical and partly similar. The earlier mark enjoys a normal degree of inherent distinctiveness for the services at issue.

The signs are visually and conceptually similar to the extent that they include an aeroplane of highly similar shape.

However, the Opposition Division is inclined to minimise the significance of this factor in the present case, since the overall visual impression created by the marks is different. The contested mark consists solely of an aeroplane, which is enhanced by its size, position, and by its red background, whereas the visual impression made by the earlier mark is the result of a combination of two figurative elements, only one of which is similar to the contested mark (the aeroplane). Moreover, in that combination the role of the aeroplane is clearly not decisive due to its size and position. Furthermore, difference in the colours of the signs underlines the visual differences. Consequently, the visual differences counteract the visual and conceptual similarities.

Additionally, as far as the arc may be interpreted as letter "C", there are aural and conceptual differences between the signs (besides the conceptual similarity).

Another factor which should be considered is that the targeted public consists of business customers and, therefore, must be deemed to be rather attentive and observant and to readily notice the significant differences between the marks at issue.

The opponent refers to what it considers analogous decisions of the Office to support its arguments. However, it must be noted that the Office is not bound by its previous decisions as each case has to be dealt with separately and with regard to its particularities.

This practice has been fully supported by the General Court which stated that it is settled case-law that the Community trade mark system is autonomous and, second, that the legality of decisions is to be assessed purely by reference to the CTMR, and not the Office's practice in earlier decisions. Accordingly, the Office is bound neither by national registrations nor by its own previous decisions (judgment of 30/06/2004, T-281/02, 'Mehr für Ihr Geld').

Additionally, it is considered that the cases mentioned bear no resemblance to this case and therefore are not relevant to the present proceedings.

Considering all the above, the Opposition Division finds that there is no likelihood of confusion on the part of the public even in the presence of identical or similar goods. Therefore, the opposition must be rejected.

## **2. COSTS AND FIXING OF 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**

Szabolcs Kiss

András Szász

Ioana Moiescu

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. 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. Under 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.