



**OPPOSITION No B 1 938 458**

**J.M.-E.V. E Hijos, S.R.L.**, Corró 199, 08401 Granollers (Provincia de Barcelona), Spain (opponent), represented by **Curell Suñol S.L.P.**, Passeig de Gràcia, 65 bis, 08008 Barcelona, Spain (professional representative)

a g a i n s t

**Lionel Andres Messi Cuccittini**, Gran Vía Carlos III, 53, 08028 Barcelona, Spain (applicant), represented by **J.M. Toro, S.L.**, Viriato, 56 - 1º izda, 28010 Madrid, Spain (professional representative).

On 12/06/2013, the Opposition Division takes the following

**DECISION:**

1. Opposition No B 1 938 458 is upheld for all the contested goods, namely  
Class 9: *Life-saving apparatus and instruments.*  
Class 25: *Clothing, footwear, headgear.*  
Class 28: *Gymnastic and sporting articles not included in other classes.*
2. Community trade mark application No 10 181 154 is rejected for all the contested goods. It may proceed for the remaining goods.
3. The applicant bears the costs, fixed at EUR 650.

**REASONS:**

The opponent filed an opposition against some of the goods of Community trade mark application No 10 181 154, namely against some of the goods in Classes 9 and 28 and all the goods in Class 25. The opposition is based on Community trade mark registrations No 3 436 607 and No 414 086. The opponent invoked Article 8(1)(b) CTMR.

**PRELIMINARY REMARK**

The applicant has argued that the earlier marks are not substantiated, because the holder of the earlier rights is not the same as the opponent. In this regard, the Opposition Division notes that at the time the notice of opposition was submitted, namely on 23/11/2011, the opponent and holder of earlier Community trade mark registrations No 3 436 607 and No 414 086 was Mr **Jaime Masferrer Coma**. The marks were subsequently, on 18/05/2012, transferred to **J.M.-E.V. E Hijos, S.r.l.**, the current holder and, therefore, opponent.

Therefore, the earlier marks are considered substantiated, and the argument of the applicant has to be set aside.

## PROOF OF USE

According to Article 42(2) and (3) CTMR, if the applicant so requests, the opponent shall furnish proof that, during the period of five years preceding the date of publication of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use.

According to the same provision, in the absence of such proof the opposition must be rejected.

The applicant requested that the opponent submit proof of use of Community trade mark No 414 086.

The request was filed in due time and it is admissible given that the earlier trade mark was registered more than five years prior to the publication of the contested application.

On 08/06/2012, the opponent was given two months, namely until 13/08/2012, to file the requested proof of use.

The contested application was published on 23/08/2011. The opponent was, therefore, required to prove that the trade mark on which the opposition is based was put to genuine use in the European Union during the period of 23/08/2006 to 22/08/2011 inclusive. Furthermore, the evidence must show use of the trade mark for the goods on which the opposition is based, namely the following:

Class 9: *Helmets for cyclists; protective clothing against accidents; protection devices for personal use against accidents.*

Class 28: *Gloves, accident protective shoulder, elbow and knee guards.*

According to Rule 22(3) CTMIR, the evidence of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based.

On 09/08/2012, the opponent submitted evidence as proof of use. The evidence consists of the following documents:

- Over 200 invoices dated from 2006 to 2011 and issued to addresses in France, Spain, the United Kingdom, Portugal, Belgium, Italy, Andorra and the Netherlands. They refer to the mark 'MASSI' and to a variety of goods, including helmets and gloves.
- Price lists for the years 2006 to 2010 (one for each year). The cover page is quintilingual (Spanish, French, English, German and Dutch); the list itself is in English and shows prices in GBP.
- Product catalogues for the years 2005 to 2010 (one for each year). The contents are listed in English, French, Spanish, Portuguese, Dutch and German and each country's flag (as well as the flag of Belgium) is depicted. The material shows cycling helmets, sunglasses and cycling gloves.

### Use made not by opponent but by another company

The applicant contests the evidence of use filed by the opponent on the grounds that it does not originate from the opponent itself but from another company.

According to Article 15(2) CTMR, use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor. Although this provision covers CTMs, it can be applied by analogy to earlier marks registered in Member States.

The fact that the opponent submitted evidence of use of his marks made by a third party implicitly shows that it consented to this use (see judgment of 08/07/2004, T-203/02, 'VITAFRUIT').

Consequently, since it can be presumed that the evidence filed by the opponent is an implicit indication that use has been made with its consent, the applicant's claim is unfounded.

To this extent, and in accordance with Article 15(2) CTMR, the Opposition Division considers that the use made by those other companies was made with the opponent's consent and thus is equivalent to use made by the opponent.

### Place of use

The evidence shows that the place of use is Spain, France, Portugal, Italy, the United Kingdom, the Netherlands, Germany and Belgium. This can be inferred from the languages of the documents, namely English, French, Spanish, Portuguese, Dutch and German, the currency mentioned (EUR and GBP) and some addresses, which are in France, Spain, the United Kingdom, Portugal, Belgium, Italy and the Netherlands. Consequently, the evidence of use filed by the opponent contains sufficient indications concerning the place of use.

### Time of use

Apart from the product catalogue from 2005, all the evidence is dated within the relevant period. Therefore, the evidence of use filed by the opponent contains sufficient indications concerning the time of use.

### Extent of use

The Court of Justice has held that 'use of the mark need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market' (see judgment of 11/03/2003, C-40/01, 'Ansul').

As far as this indication is concerned the General Court has stated that 'account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use' (see judgment of 08/07/2004, T-334/01, 'HIPOVITON').

The assessment of genuine use 'entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa' (judgment of 08/07/2004, T-203/02, 'Vitafruit').

The documents filed, namely the invoices, provide the Opposition Division with sufficient information concerning the commercial volume, the duration, and the frequency of use.

Therefore, the Opposition Division considers that the opponent has provided sufficient indications concerning the extent of the use of the earlier mark.

#### Nature of use

In the context of Rule 22(3) CTMIR, the expression 'nature of use' includes evidence of the use of the sign as a trade mark in the course of trade, of the use of the mark as registered, or of a variation thereof according to Article 15(1), second subparagraph, point (a) CTMR, and of its use for the goods and services for which it is registered.

According to Article 15(1), second subparagraph, point (a) CTMR, the following shall also constitute use within the meaning of paragraph 1: use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. When examining the use of an earlier registration for the purposes of Article 42(2) and (3) CTMR, Article 15 may be applied by analogy to assess whether or not the use of the sign constitutes genuine use of the earlier mark as far as its nature is concerned.

In the present case, the sign is used as the registered word mark and in a stylised form, which does, however, not alter the distinctive character of the mark, as the word 'MASSI' is still clearly legible.

In view of the above, the Opposition Division considers that the evidence does show use of the sign as registered within the meaning of Article 15(1), second subparagraph, point (a) CTMR.

The earlier mark is registered for *helmets for cyclists; protective clothing against accidents; protection devices for personal use against accidents* in Class 9 and *gloves and accident protective shoulder, elbow and knee guards* in Class 28. However, the evidence filed by the opponent does not show genuine use of the trade mark for all the goods covered by the earlier trade mark.

According to Article 42(2) CTMR, if the earlier trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

In the present case the evidence shows genuine use of the trade mark for the following goods it covers:

Class 9: *Helmets for cyclists.*

*Gloves for cyclists*, which appear in many of the opponent's evidence, are classified in Class 25. Class 28 covers only those gloves which are essentially needed to carry out a sporting activity, such as *baseball gloves* or *boxing gloves*. The material submitted does not prove use of the earlier mark in relation to gloves classified in Class 28.

*Cycling shorts*, being cyclist's clothes, are classified in Class 25 as well. They do not serve life-saving purposes and cannot, therefore, prove the use of the earlier mark in connection with *protective clothing against accidents* in Class 9.

*Sunglasses*, for which the earlier mark also appears to have been used, are *optical apparatus and instruments* in Class 9. These are not covered by the earlier mark.

The remaining goods, such as *brake shoes, water bottles, grease, handlebars, ribbon, saddles*, do not fall within the goods covered by the mark either.

The evidence submitted does not demonstrate the use of the earlier mark in relation to *protective clothing against accidents; protection devices for personal use against accidents* (other than helmets for cyclists) and *accident protective shoulder, elbow and knee guards*.

Therefore, the Opposition Division will only consider the abovementioned *helmets for cyclists* in its further examination of the opposition insofar it is based on earlier Community trade mark No 414 086.

### **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 (taking into account both earlier Community trade mark registrations No 3 436 607 and No 414 086) are the following:

Class 9: *Helmets for cyclists.*

Class 25: *Clothing, footwear, headgear.*

The contested goods are the following:

Class 9: *Life-saving apparatus and instruments.*

Class 25: *Clothing, footwear, headgear.*

Class 28: *Gymnastic and sporting articles not included in other classes.*

The contested CTM application seeks protection for the entire class heading of Class 25 of the Nice Classification. It was filed on 08/08/2011. According to Communication No 2/12 of the President of the Office of 20/06/2012, as regards Community trade mark applications filed before 21/06/2012, the Office considers that the intention of the applicant was to cover all the goods or services included in the alphabetical list of the classes concerned in the edition of the Nice Classification in force at the time when the filing was made, in this case the 9th edition.

Consequently, in order to take account of the entire alphabetical list in Class 25 of the contested CTM application, the Opposition Division will compare the goods of the earlier marks with both (i) the general indications specified and (ii) any items in the alphabetical list that do not fall within the natural and usual meaning of these general indications.

In the case of Class 25, the Opposition Division has identified the following items in the alphabetical list covered by the contested CTM application that do not fall within the natural and usual meaning of these general indications:

*Boot uppers; cuffs; fittings of metal for shoes and boots; footwear uppers; hat frames [skeletons]; heelpieces for boots and shoes; heelpieces for stockings; heels; inner soles; non-slipping devices for boots and shoes; ready-made linings [parts of clothing]; shirt yokes; soles for footwear; studs for football boots [shoes]; tips for footwear; welts for boots and shoes.*

These can be grouped, for the purposes of comparison, into the following categories:

*Parts and accessories for footwear, parts and accessories for clothing, hat frames [skeletons].*

Therefore, as regards this class, both the general indications specified and the items listed above will be compared.

The earlier Community trade mark No 3 436 607 is registered for the entire class heading of Class 25 of the Nice Classification. It was filed on 31/10/2003. According to Communication No 2/12 of the President of the Office of 20/06/2012, as regards Community trade marks registered before 21/06/2012, the Office considers that the intention of the applicant was to cover all the goods or services included in the alphabetical list of the classes concerned in the edition of the Nice Classification in force at the time when the filing was made, in this case the 8th edition.

### **Contested goods in Class 9**

The contested *life-saving apparatus and instruments* include, as a broader category, the opponent's *helmets for cyclists*. It is impossible for the Opposition Division to filter these goods from the abovementioned category. Since the Opposition Division cannot dissect *ex officio* the broad category of the applicant's goods, they are considered identical.

### **Contested goods in Class 25**

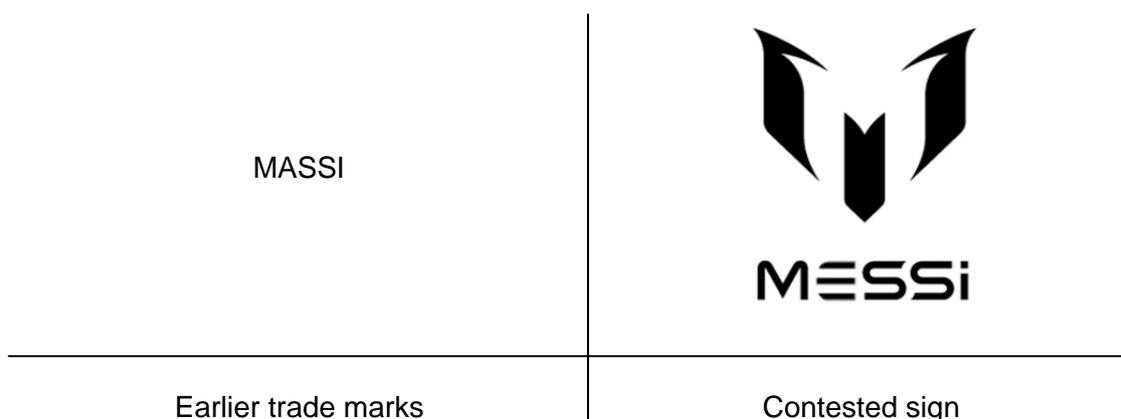
As regards the contested *clothing, footwear, headgear*, both the contested mark and earlier Community mark No 3 436 607 cover the entire class heading of Class 25 and the same items that do not fall within the natural and usual meaning of these general

indications, although in different editions of the Nice Classification. The goods are identical.

### **Contested goods in Class 28**

The contested *gymnastic and sporting articles not included in other classes* and the opponent's *helmets for cyclists* have the same purpose and nature. Moreover, they can coincide in end users and distribution channels. Therefore, they are considered similar.

#### **b) The signs**



The relevant territory is the European Union.

The earlier marks are the word marks 'MASSI'. The contested sign is a figurative mark composed of the verbal element 'MESSI' in black, highly stylised, upper case letters and, above that, a black and white, fanciful device in a V-shape.

**Visually**, the signs are similar to the extent that they coincide in the letters 'M\*SSI'. On the other hand, they differ in their second letters, 'A' in the earlier marks and 'E' in the contested sign. Moreover, they differ in the figurative elements of the contested sign.

**Aurally**, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the marks coincides in the sound of the letters 'M\*SSI', present identically in both signs, and to that extent the marks are aurally similar. The pronunciation differs in the sound of the letters 'A' of the earlier marks and 'E' of the contested mark, which have no respective counterparts.

**Conceptually**, depending on the language spoken, the earlier marks 'MASSI' will be associated with the following:

- the plural of 'masa', meaning 'table', by the Bulgarian-speaking part of the public in the relevant territory;
- the plural of 'masso', meaning 'boulder' or 'rock', or a common nickname for 'Massimo' or 'Massimiliano', by the Italian-speaking part of the public;
- a slang expression for money or a colloquial expression for a small purse or wallet by the Finnish-speaking part of the public;

- a form of 'mass' (denoting 'quantity, mass'), by the Estonian-speaking part of the public.

The verbal element 'MESSI' of the contested mark will be perceived as:

- the third person singular form of the verb 'mesia', meaning 'to knead', by the Bulgarian-speaking part of the public;
- the plural form of the past participle of the verb 'mettere', meaning, amongst others, 'to place', 'to wear', 'to put on', by the Italian-speaking part of the public;
- the kitchen/canteen of a ship by the Finnish-speaking part of the public;
- 'trade fairs', as 'messi' is a form of the noun 'mess', meaning 'trade fair', by the Estonian-speaking part of the public.

Furthermore, and independent of the language spoken, a part of the public in the relevant territory will associate the verbal element 'MESSI' of the contested sign with the surname of the famous football player 'Lionel Andres Messi' (the applicant).

For the part of the public that associates the marks with different meanings, or for which one of the marks does not have a meaning, the marks are not conceptually similar.

For the remaining part of the public, to which neither of the signs conveys a meaning, the signs have no concept in common.

Taking into account the abovementioned visual and aural coincidences, it is considered that the signs under comparison are 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) than 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 any of the goods 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.

In the present case, the goods found to be identical and similar are directed both at the public at large and at business customers with specific professional knowledge or expertise. The level of attention is considered to vary from average, for goods such as *clothing, footwear and headgear*, to above average, for goods related to the integrity of the human body, such as *helmets for cyclists*.

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

The goods under comparison are identical and similar. The distinctiveness of the earlier mark is considered to be normal and the level of attention is expected to vary from average to above average.

The signs are visually and aurally similar insofar as they coincide in four out of their five letters, 'M\*SSI'. The only differences between the marks lie in their second letters, 'A' and 'E', respectively, and in the figurative elements of the contested sign.

Where a trade mark is composed of verbal and figurative elements, the former usually has a stronger impact than the latter, because the average consumer will more readily refer to the marks in question by quoting their name than by describing the figurative elements of the trade marks.

Therefore, the abovementioned differences are not sufficient to outweigh the similarities between the marks, as account should also be taken of the fact that consumers can rarely compare both marks at the time of purchase but must rely on their imperfect recollection of them, and that consumers tend to remember similarities rather than dissimilarities.

Therefore, taking into account all the relevant factors in the present case, including the principle that a lesser degree of similarity between the signs may be offset by a greater degree of similarity between the goods and services, which applies in the present case, even if consumers display an increased level of attention in relation to some of the goods, they might believe that the conflicting goods come from the same or economically linked undertakings.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public.

Therefore, the opposition is well founded on the basis of the opponent's Community trade mark registrations. It follows that the contested trade mark must be rejected for all the contested goods.

## **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 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 Rule 94(3), (6) and (7)(d)(i) CTMIR, 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**

Ana DA FONSECA

Natascha GALPERIN

Natascha SEMJEVSKI

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.