



OPPOSITION No B 2 075 490

Cin - Corporação Industrial do Norte, S.A., Avenida Dom Mendo, 831, 4474-009 Maia, Portugal (opponent), represented by **Rui Pelayo de Sousa Henriques, Pedro Gil da Silva Pelayo de Sousa Henriques** and **Paulo Rui da Silva Pelayo de Sousa Henriques**, Rua de Sá da Bandeira, 706 – 6.º Dt.º, 4000-432 Porto, Portugal (professional representatives)

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Kirkhill-TA Co., 300 East Cypress Street, Brea, California 92821, United States of America (applicant), represented by **Njord Law Firm Advokatpartnerselskab**, Pilestræde 58, 1112 Copenhagen K, Denmark (professional representative).

On 28/01/2015, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 075 490 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 10 764 165, namely against all the goods in Classes 2 and 17. The opposition is based on Portuguese trade mark registration No 336 596. 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 goods on which the opposition is based are the following:

Class 2: *Paints, varnishes, enamels for painting, lacquers, siccatives (drying agents) for paints, mastic (natural resin), oil cement (putty) and glaziers' putty.*

Class 17: *Sealant compounds for joints, insulators, insulators, substances for insulating buildings against moisture, insulating materials, insulating paints and insulating varnish.*

The contested goods, after a limitation, are the following:

Class 2: *Paints, varnishes, lacquers; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists; coating compositions in the nature of paint; spray-on coatings; coatings for industrial use, military use, use in the building and construction industry, use on automobiles, marine vehicles and aerospace vehicles; heat-resistant coatings; paints; varnish; liquid surface applications for veneer; finishing applications in the form of paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, metals in foil and powder form for painters, decorators, printers and artists; liquid surface applications; all of the above being sealants with thermal characteristics, and none of the above being coatings for waterproofing cement or concrete.*

Class 17: *Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal; adhesives; caulking compound; synthetic rubber and synthetic rubber for industrial use, military use, building and construction industry, automobile, marine vehicles and aerospace vehicles; extruded coatings; all of the above being sealants with thermal characteristics, and none of the above being coatings for waterproofing cement or concrete.*

The contested CTM application seeks protection for the entire class headings of Classes 2 and 17 of the Nice Classification. It was filed on 28/03/2012. 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 lists 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 10th edition.

Consequently, in order to take account of the entire alphabetical lists in Classes 2 and 17 of the contested CTM application, the Opposition Division will compare the goods of the earlier mark with both (i) the general indications specified and (ii) any items in the alphabetical lists that do not fall within the natural and usual meaning of these general indications.

In the case of Class 2, 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:

Class 2: *Agglutinants for paints; Canada balsam; thickeners for paints; thinners for lacquers; thinners for paints; turpentine [thinner for paints].*

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

In the case of Class 17, the Opposition Division has not identified any items in the alphabetical list covered by the contested CTM application that fall outside of the natural and usual meaning of the general indications of the class heading.

Therefore, as regards this class, only the general indications will be taken into account.

Some of the contested goods are identical to goods on which the opposition is based. For reasons of procedural economy, the Opposition Division will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed as if all the contested goods were identical to those of the earlier mark.

b) The signs

| | |
|--------------------|----------------|
| FAST | FASTBLOCK |
| Earlier trade mark | Contested sign |

The relevant territory is Portugal.

Visually, the signs are similar to the extent that they coincide in the sequence of letters 'FAST', representing all the letters of the earlier mark and the first four, out of nine, letters of the contested sign. However, they differ in the additional and final five letters of the contested sign, namely 'BLOCK', which have no counterparts in the earlier mark.

Aurally, while the earlier mark contains one syllable, namely 'FAST', the contested sign contains two syllables, namely 'FAST-BLOCK'. The pronunciation of the signs coincides in the sound of the syllable 'FAST', present identically in both signs, and to that extent the signs are aurally similar. The pronunciation differs in the sound of the second syllable 'BLOCK' of the contested sign, which has no counterpart in the earlier mark. Consequently, the rhythm and intonation of the signs are different.

Conceptually, neither of the signs has a meaning for the public in the relevant territory. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs.

Taking into account the abovementioned visual and aural coincidences, it is considered that the signs under comparison are similar to the extent that they coincide in the sequence of letters 'FAST'.

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 assumed to be identical are directed at the public at large, but also at some professionals involved in manufacturing or other industries, such as construction, the automobile industry, the military, etc. The level of attention when choosing the relevant goods will vary from average to above average.

f) Global assessment, other arguments and conclusion

The contested goods are assumed to be identical to the opponent's goods. The public's level of attention will vary from average to above average when choosing the goods.

Although the signs coincide visually and aurally in the sequence 'FAST', forming the entire earlier mark, this is not enough to cause confusion between the marks. The contested sign is significantly longer than the earlier mark, consisting of nine letters rather than four. Furthermore, while the earlier mark is a one syllable word, the contested sign contains two syllables. Consequently, the rhythm and intonation of the signs are different. The visual and aural differences between the signs, comprising of the last five out of nine letters of the contested sign, which form a separate syllable, namely 'BLOCK', will be clearly perceived by the relevant consumers.

Although the earlier mark is included in the contested sign, the overall impressions of the signs are different and the abovementioned differences are enough to outweigh the similarities between the signs resulting from the shared sequence of letters 'FAST'. Therefore, the Opposition Division does not find it plausible to conclude that the relevant consumer, who, for the purposes of the assessment, is considered to be, at least, reasonably well informed and reasonably observant and circumspect, might believe that the goods in question come from the same undertaking or, as the case may be, from economically-linked undertakings.

The opponent refers to a previous decision of the Office, concerning the same earlier mark, to support its arguments. However, 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 legality of decisions is to be assessed purely by reference to the CTMR, and not the Office's practice in earlier decisions (judgment of 30/06/2004, T-281/02, 'Mehr für Ihr Geld').

Even though previous decisions of the Office are not binding, their reasoning and outcome should still be duly considered when deciding upon a particular case.

In the present case, the previous case referred to by the opponent is not relevant to the present proceedings. Although it concerns the same earlier right, the contested sign in this previous case is not comparable to the one at issue, as the latter is significantly longer, containing different letters and sounds.

Considering all the above, even assuming that the goods are identical, there is no likelihood of confusion on the part of the public. Therefore, the opposition must be rejected.

Given that the opposition is not well founded under Article 8(1) CTMR it is unnecessary to examine the evidence of use filed by the opponent.

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

Victoria DAFAUCE
MENÉNDEZ

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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.