

**DECISION  
of the Fifth Board of Appeal  
of 18 January 2017**

In Case R 860/2016-5

**PEAR TECHNOLOGIES LIMITED**

Xian Xing Hai Avenue,  
Building Jardim Nam Ngon,  
Loja BA, r/c  
Macao Special Administrative Region of  
the Peoples Republic of China

Applicant / Appellant

represented by LANE IP Ltd., 2 Throgmorton Avenue, EC2N 2DG London, United Kingdom

v

**Apple Inc.**

1 Infinite Loop  
Cupertino  
California 95014-2084  
United States of America

Opponent / Respondent

represented by LOCKE LORD LLP, 201 Bishopsgate, EC2M 3AB London, United Kingdom

APPEAL relating to Opposition Proceedings No B 2 465 071 (European Union trade mark application No 13 115 076)

**THE FIFTH BOARD OF APPEAL**

composed of G. Humphreys (Chairperson), V. Melgar (Rapporteur) and A. Pohlmann (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 25 July 2014, PEAR TECHNOLOGIES LIMITED ('the applicant') sought to register the figurative as amended



for the following list of goods and services:

Class 9 – Personal computers; laptop computers; handset and tablet mobile digital electronic devices for the sending and receiving of telephone calls and/or any digital data and for use as a handheld computer; apparatus for recording, transmission or reproduction of sound or images; videophones, video-tablets, pre-recorded computer programs for personal information management, database management software, electronic mail and messaging software, paging software, computer hardware, software and firmware, namely operating system programs, application development computer software programs for personal and handheld computers or handheld mobile digital electronic devices; computer, handheld and mobile handset device peripherals products; parts, fittings and accessories for all the aforesaid goods;

Class 35 – Providing consultancy on digital marketing; providing CRM solution and business solution design services;

Class 42 – Maintenance and updating of computer software; providing information concerning computer software via the internet and other computer and electronic communication networks; computer network services; providing consultancy on networking, webpage design; providing server hosting services; providing domain management services; provision of software applications for handheld, tablets, personal computer and laptop computer devices and data centre management; technical consultancy; all aforesaid services also as business to business and all aforesaid services also as business to consumer or consumers.

- 2 The application was published on 15 October 2014.
- 3 On 15 January 2015, Apple Inc. ('the opponent') filed an opposition against the registration of the published trade mark application for as amended goods and services.

- 4 The grounds of opposition were those laid down in Articles 8(1)(b), 8(4) and 8(5) EUTMR.
- 5 With respect to the following earlier right the grounds of opposition were those laid down in Articles 8(1)(b) and 8(5) EUTMR:
  - EUTM No 9 784 299, filed on 3 March 2011 and registered on 30 March 2012, for the figurative mark



for goods and services (as amended on 26 September 2016 in accordance with Article 28(8) EUTMR) in Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 14, 15, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45. Reputation was claimed for part of the goods and services in Classes 9, 16, 28, 35, 37, 38, 41 and 42:

Class 9 – Scientific, photographic, cinematographic, optical, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission and/or reproduction of sound or images or other data; magnetic data carriers; recording discs; calculating machines, data processing equipment; apparatus, instruments and materials for transmitting and/or receiving and/or recording sound and/or images; downloadable audio and video recordings featuring music; comedy, drama, action, adventure and/or animation; computers, tablet computers, computer terminals, computer peripheral devices; computer hardware; computer networks; facsimile machines, answering machines, telephone-based information retrieval software and hardware; adapters, adapter cards, connectors and drivers; blank computer storage media; fonts, typefaces, type designs and symbols in the form of recorded data; chips, discs and tapes bearing or for recording computer programs and software; random access memory, read only memory; solid state memory apparatus; electronic communication equipment and instruments; telecommunications apparatus and instruments; telecommunications equipment, apparatus and instruments; computer and electronic games; computer software and computer hardware apparatus with multimedia and interactive functions; computer gaming machines; microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers, videophones, disk drives; central processing units; circuit boards; integrated circuits; magnetic, optical, and electronic data storage devices; user manuals in electronically readable, machines readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; apparatus for data storage; hard drives; miniature hard disk drive storage units; pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes for sale with booklets; sound, video and data recordings; CD-ROMS; digital versatile discs; mouse pads; batteries; rechargeable batteries; chargers; chargers for electric batteries; headphones; stereo headphones; in-ear headphones; stereo speakers; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; radio receivers, amplifiers, sound recording and

reproducing apparatus, electric phonographs, record players, high fidelity stereo apparatus, tape recorders and reproducing apparatus, loudspeakers, multiple speaker units, microphones; digital audio and video players with multimedia and interactive functions; accessories, parts, fittings, and testing apparatus for all the aforementioned goods; digital audio and video devices; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; radios; audio, video, and digital mixers; radio transmitters; car audio apparatus; global positioning systems; navigation apparatus for vehicles (on board computers); cameras; video cameras; bags and cases adapted or shaped to contain cameras and/or video cameras; telephones; cordless telephones; mobile telephones; parts and accessories for mobile telephones; mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitations of leather; mobile telephone covers made of cloth or textile materials; portable digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers, and software related thereto; handheld digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers, and software related thereto; digital music and/or video players; MP3 and other digital format audio players; hand held computers, personal digital assistants, electronic organizers, electronic notepads; handheld and mobile digital electronic devices for the sending and receiving telephone calls, faxes, electronic mail, and other digital media; bags and cases adapted or shaped to contain digital music and/or video players, hand held computers, personal digital assistants, electronic organizers and electronic notepads; holders, straps, armbands, lanyards and clips for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image and video files; computer software; computer programs; pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multi-media content, software featuring musical sound recordings, entertainment-related audio, video, text and multi-media content, computer software and firmware for operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; downloadable electronic publications in the nature of books, plays, pamphlets, brochures, newsletters, journals, magazines, and periodicals on a wide range of topics of general interest; computer hardware and software for providing integrated telephone communication with computerised global information networks; electronic handheld devices for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; sound effect apparatus and instruments (computer software); electronic tone generators (computer software); computer desktop utility software; screen saver software; software for detecting, eradicating and preventing computer viruses; software for data encryption; software for analysing and recovering data; software for computer system backup, data processing, data storage, file management and database management; software for telecommunication and communication via local or global communications networks, including the Internet, intranets, extranets, television, mobile communication, cellular and satellite networks; software for creating and delivering electronic greeting cards, messages and electronic mail; software for web design, creation, publishing and hosting; software for access to communications networks including the Internet; instructional material relating to the foregoing; computer disk holders; computer equipment for use with all of the aforesaid goods; electronic apparatus with multimedia functions for use with all of the aforesaid goods; accessories, parts, fittings, and testing apparatus for all of the aforesaid goods;

covers, bags and cases adapted or shaped to contain all of the aforesaid goods, made of leather, imitations of leather, cloth, or textile materials;

Class 16 – Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; stickers and adhesives for stationery or household purposes; artists’ materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers’ type; printing blocks; printed matter in the field of computers; printed matter in the field of tablet computers; printed matter in the field of multi-media products, interactive products and online services; printed publications; books; magazines; newsletters; periodicals; brochures; booklets; pamphlets; manuals; journals; leaflets; greeting cards; advertising and promotional material; catalogues; catalogues relating to computer software; computer brochures; computer handbooks; computer hardware publications; computer hardware reference manuals; computer hardware users guide; computer instruction manuals; computer manuals; publications relating to technology, digital technology and gadgets; catalogues relating to musical apparatus and instruments; catalogues relating to telecommunications apparatus, mobile phones, handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, video, instant messaging, music, audio-visual and other multimedia works, and other digital data; music books; music instruction manuals; music magazines; desk accessories; telephone and address books, agendas, diaries, calendars, posters, mounted and un-mounted photographs, printed patterns for T-shirts and sweatshirts, display materials, decals and bumper stickers; booklets for sale with audio tapes; parts and fittings for the aforesaid goods;

Class 28 – Games and playthings; gymnastic and sporting articles not included in other classes; toys; playing cards; electronic hand-held game units; musical toys, games and playthings; toy audio apparatus; toy musical boxes; toy musical instruments; toy record players for playing tunes and cassettes; musical games; battery operated toys; electronic toys; electric computer games, other than those adapted for use with television receivers; electrical and electronic amusement apparatus (automatic, coin/counter freed); electronic games being automatic, coin-freed or counted-freed (other than those adapted for use with television receivers); hand-held electronic games and apparatus (other than those adapted for use with television receiver only); video games other than those adapted for use with television receivers only; automatic and coin-operated amusement machines; computer game apparatus other than coin operated or those adapted for use with television receivers; video output toys and games; electronically operated toys; interactive computer toys and games; musical toys and games; stand-alone video game machines incorporating a means of display; toy handheld electronic devices; toy computers (not working); toy mobile telephones (not working); parts and fittings for all the aforesaid goods;

Class 35 – Advertising; business management; business administration; office functions; providing office functions; business consulting services; advertising agency services; advertising and marketing services; promotion services; advertising and marketing consultation; sales promotion services; promoting the goods and services of others; conducting marketing research; market surveys; analysis of advertising response and market research; creation, preparation, production, and dissemination of advertisements and advertising material for others; media planning services; administration of consumer loyalty programs; arranging and conducting incentive rewards programs to promote the sale of goods and services; arranging and conducting incentive rewards programs to promote the sale of goods and services; arranging and conducting of commercial, trade and business conferences, shows, and exhibitions; creating indexes of online information, sites and other resources available on global computer networks for others; providing an online searchable database of text, data, image, audio, video, and multimedia content in the field of entertainment featuring music, video, film, books, periodicals, television, games, and sports; providing an online searchable database of text, data, image, audio, video and multimedia content in the fields of computer hardware, computer software, consumer electronics, telecommunications and multimedia goods, mobile phones, handheld mobile digital electronic devices, and other consumer electronics and accessories, peripherals, and carrying cases for such products; providing business and commercial information over computer networks and global communication networks;

business services, namely, providing computer databases regarding the purchase and sale of a wide variety of products and services of others; business services, namely, dissemination of advertising for others via computer networks and global communication networks; compilations of directories for publishing on the Internet and other electronic, computer and communications networks; computerised database and file management; data processing services; retail store featuring computer, electronic and entertainment products; retail store and online store services featuring computer, electronic and entertainment products provided via the Internet and other computer, electronic and communications networks; retail store and online store services in the field of computers, tablet computers, computer hardware, computer software, computer peripherals, consumer electronics, telecommunications and multimedia goods and accessories, peripherals, and carrying cases for such products, and demonstration of products relating thereto; retail store services in the field of computers, tablet computers, computer hardware, computer software, computer peripherals, consumer electronics, telecommunications and multimedia goods and accessories, mobile phone, handheld mobile digital electronic devices, and other consumer electronics and accessories, peripherals, and carrying cases for such products, and demonstration of products relating thereto, provided via the Internet and other computer, electronic and communications networks; retail store services in the field of entertainment featuring music, video, film, books, magazines, periodicals, newsletters, journals and other publications on a wide range of topics of general interest, television, games, sports, movies, television programs, sporting events, musical works, pre-recorded audio and audio-visual works and related merchandise, and music related electronic products; retail store and online store services in the field of entertainment featuring music, video, film, books, magazines, periodicals, newsletters, journals and other publications on a wide range of topics of general interest, television, games, sports, movies, television programs, sporting events, musical works, pre-recorded audio and audio-visual works and related merchandise, and music related electronic products, via the Internet and other computer, electronic and communications networks; retail store services featuring telecommunications apparatus, mobile phones, handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, video, instant messaging, music, audio-visual and other multimedia works, and other digital data, accessories, peripherals, and carrying cases for such devices; retail store services featuring computer, electronic and entertainment products, telecommunications apparatus, mobile phones, handheld mobile digital electronic devices, tablet computers, music related electronic products, and other consumer electronics, computer software, and accessories, peripherals, and carrying cases for such products, provided via the Internet and other computer, electronic and communications networks; product demonstrations provided in-store and via communications networks and other electronic and communications networks; the bringing together, for the benefit of others, of a variety of service providers, in the fields of on-line services, online education and entertainment, communications, information technology, and publishing services, allowing third parties to conveniently select the service providers; computerised data storage and retrieval services; computerised data storage and retrieval services for digital text, data, image, audio, video and multimedia content; and video works; data storage of electronic mail; online music and video subscription services; subscription services, namely, providing subscriptions to text, data, image, audio, video, and multimedia content, provided via the Internet and other electronic and communications networks; subscription services, namely, providing downloadable pre-recorded text, data, image, audio, video, and multimedia content in the fields of entertainment featuring music, video, film, books, periodicals, television, games, sports and computer software for a fee or pre-paid subscription, provided via the Internet and other computer, electronic and communications networks; internet services, namely, creating indexes of information, sites and other resources available on global computer networks and other electronic and communications networks for others; searching, browsing and retrieving information, sites, and other resources available on global computer networks and other electronic and communications networks for others; organizing content of information provided over a global computer network and other electronic and communications networks according to user preferences; online music subscription services; creating indexes of information, sites and other resources available on global computer networks for others; information, advisory and consultancy services relating to all the aforesaid;

Class 37 – Repair; installation services, maintenance, installation and repair of computers, tablet computers, computer hardware, computer peripherals and consumer electronic devices; maintenance and repair of digital music or video players, hand held computers, personal digital assistants, electronic organizers and electronic notepads; maintenance and repair of electronically operated musical apparatus; information, advisory and consultancy services relating to all the aforesaid;

Class 38 – Telecommunications; communication and telecommunication services; telecommunication access services; communications by computer; communications by tablet computer; communication between computers; electronic sending of data and documentation via the Internet or other databases; supply of data and news by electronic transmission; providing access to websites and electronic news services online allowing the download of information and data; providing access to web sites on the Internet, serving and transmitting audio, video, multimedia, and advertising content to computers, mobile telephones, media players, and other mobile digital devices; delivery of digital music by telecommunications; providing temporary internet access to use online non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; communication by computer, computer intercommunication; telex, telegram and telephone services; broadcasting or transmission of radio and television programmes; time sharing services for communication apparatus; provision of telecommunications access and links to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; webcasting services (transmission); delivery of messages by electronic transmission; provision of connectivity services and access to electronic communications networks, for transmission or reception of audio, video or multimedia content; provision of telecommunications connections to electronic communication networks, for transmission or reception of audio, video or multimedia content; providing access to digital music web sites on the Internet; providing access to MP3 web sites on the Internet; delivery of digital music by telecommunications; provision of telecommunications connections to the Internet or computer databases; providing user access to the Internet (service providers); electronic mail services; telecommunication of information (including web pages), computer programs and any other data; video broadcasting, broadcasting pre-recorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via a global computer network, computer and other communications networks; streaming of video content via a global computer network; subscription audio broadcasting via a global computer network; audio broadcasting; audio broadcasting of spoken word, music, concerts, and radio programmes; streaming of audio content via a global computer network; electronic transmission of audio and video files via communications networks; communication services, namely, matching users for the transfer of music, video and audio recordings via communication networks; electronic bulletin board services; providing computer bulletin board in the fields of music, video, film, books, television, games and sports; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment, music, concerts, videos, radio, television, film, news, sports, games and cultural events; rental and hire and leasing of communication apparatus and electronic mail-boxes; electronic news services; electronic communications consultancy; facsimile, message consultation and transmission services; transmission of data and of information by electronic means, computer, cable, radio, teleprinter, teletype, electronic mail, telecopier, television, microwave, laser beam, communications satellite or electronic communication means; transmission of data by audio-visual apparatus controlled by data processing apparatus or computers; provision of access time to web-sites featuring multimedia materials; providing access to databases and directories via communications networks for obtaining data in the fields of music, video, film, books, television, games and sports; providing users with access time to electronic communications networks with means of identifying, locating, grouping, distributing, and managing data and links to third-party computer servers, computer processors and computer users; organizing and conducting video conferences; provision of

access time to web-sites featuring multimedia materials; providing users with access time to electronic communications networks with means of identifying, locating, grouping, distributing, and managing data and links to third-party computer servers, computer processors and computer users; providing computer data bases in the nature of a bulletin board in the fields of music, video, film, books, television, games and sports; providing an online searchable database of text, data, image, audio, video and multimedia content in the fields of telecommunications and mobile phones; providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; information, advisory and consultancy services relating to all the aforesaid;

Class 41 – Education; providing of training; entertainment; sporting and cultural activities; educational and entertainment services; entertainment and educational services, namely, providing text, video, audio, and multimedia materials; entertainment services, namely, providing computer games; entertainment and educational services, namely, providing electronic books, magazines, newspapers, journals, periodicals, and other publications; entertainment and educational services, namely, providing information, databases, directories, and podcasts in the fields of entertainment, news, current events, history, sports, games, the media, cultural events and activities, hobbies, publications; entertainment and educational services, namely, live performances, sporting events, cultural events, and lectures; provision of electronic publications (not downloadable); providing on-line electronic publications; publication of electronic books and journals on-line; providing publications from a global computer network or the Internet which may be browsed; computer-based and computer-assisted educational, teaching, and training services; computer assisted education services; computer assisted teaching services; computer assisted training services; computer based educations services; tablet computer assisted teaching services; tablet computer assisted training services; tablet computer based educational services; education services, providing of training, instruction and entertainment relating to computers, tablet computers, computer software, multimedia products, interactive products and online services, telecommunications apparatus, mobile phones, handheld and mobile digital electronic devices for the sending and receiving or telephone calls, faxes, electronic music, video, instant messaging, music, audio-visual and other multimedia works, and other digital data, and distributing course materials therewith; education and training services, namely, conducting classes, workshops, and seminars in the field of computers, tablet computers, computer software, online services, information technology, internet website design, music, photography and video products and consumer electronics; arranging professional workshop and training course; computer education training services; training in the use and operation of computers, tablet computers, computer software and consumer electronics; education services relating to online exhibitions and displays and interactive; exhibits in the fields of computers, computer software, computer peripherals, portable and/or electronic devices, online services, high technology, communications, information technology, information services, music, entertainment and publishing; production of radio, television and internet broadcasts of exhibitions; editing of audio-tapes; editing of cine films; editing of videotapes; editing of written text; film editing (photographic); videotape editing; digital imaging services; providing digital music (not downloadable) from MP3 web sites on the internet; providing digital music (not downloadable) from the Internet; arranging and conducting of commercial, trade and business conferences; organising and conducting exhibitions, workshops, seminars, training and conferences; publication of printed matter and of instructional and teaching materials; entertainment in relation to contests, competitions, quizzes and lotteries; gaming and gambling services; organisation and presentation of contests, competitions, games, quizzes and lotteries; electronic contests, competitions, games, quizzes and lotteries provided by means of the internet or on-line from a computer database or network; electronic publishing services; providing downloadable pre-recorded music and video for a fee or pre-paid subscription via the Internet or pre-bundled with computing devices; electronic games services provided by means of the Internet; providing computer databases in the fields of music, video, films, books, television, games and sports; entertainment services in the nature of musical, video, audio-video, and textual materials, namely books, plays, pamphlets, brochures, newsletters, journals, and magazines, on the subjects of sporting and cultural activities and a wide range of topics of general interest offered in-person and distributed over computer

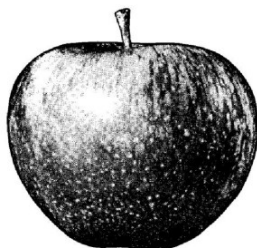


networks; providing electronic publications for browsing and downloading over computer networks, namely books, pamphlets, brochures, newsletters, journals, and magazines, on the subjects or computer hardware and software applications, telecommunications apparatus, mobile phones, handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, video, instant, messaging, music, audio-visual and other multimedia works, and other digital data, and a wide range of topics of general interest; providing databases and directories via communications networks for obtaining data in the fields of music, video, film, books, television, games and sports; providing on line facilities, via a global computer network, to enable users to program the scheduling of audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs as they will be aired; providing an online searchable database of text, data, image, audio, video, and multimedia content in the field of entertainment featuring music, video, film, books, periodicals, television, games, and sports; providing an online searchable database of text, data, image, audio, video and multimedia content in the fields of consumer electronics; information, advisory and consultancy services relating to all the aforesaid;

Class 42 – Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer hardware and software consulting services; technical support services, namely, troubleshooting computer hardware, computer peripheral, computer software and consumer electronic devices; installation, updating, maintenance and repair of computer software; technical consulting in the field of computers, tablet computers and consumer electronics; computer, tablet computer and consumer electronic diagnostic services; consulting services in the field of selection, implementation and use of computer hardware, computer software and consumer electronic systems for others; computer data recovery; consulting services in the field of selection, implementation and use of computer hardware and computer software for the operation of consumer electronic systems for others in the nature of audio, audio-visual and home and portable entertainment systems and devices; technical consulting in the field or consumer electronics, namely, audio, audio-visual and home and portable entertainment systems and devices; consulting services in the field of selection, implementation and use of computer hardware, computer software and consumer electronic systems for others, namely audio, audio-visual and home and portable entertainment systems and devices; rental of computer hardware and software apparatus and equipment; multimedia and audio-visual software consulting services; computer programming; support and consultation services for developing computer systems, databases and applications; graphic design for the compilation of web pages on the internet; information relating to computer hardware or software provided on-line, from a global computer network or the internet; creating and maintaining web-sites; development of multimedia websites; hosting the web-sites of others; providing search engines for obtaining data via communications networks; application service provider (ASP) Services featuring computer Software; application service provider (ASP) services featuring software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; application service provider (ASP) services featuring software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multimedia content, and software featuring musical sound recordings, entertainment-related audio, video, text and multimedia content; providing temporary internet access to use on-line non-downloadable software to enable users to program, audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing search engines for obtaining data on a global computer network; operating search engines; computer consulting and support services for scanning information into computer discs, creating indexes of online information, sites and other resources available on global computer networks for others; design of advertisements and advertising material for others; providing an online searchable database of text, data, image, audio, video and multimedia content in the fields of computer hardware, computer software, and multimedia goods; providing information, databases, directories, and podcasts in the field of technology; information, advisory and consultancy services relating to all the aforesaid.

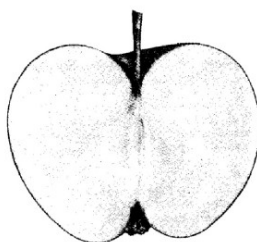
6 With respect to the following earlier rights, the grounds of opposition were those laid down in Article 8(1)(b) EUTMR:

- EUTM No 9 805 631 filed on 11 March 2011 and registered on 5 March 2012, for the figurative mark



for the goods and services in Classes 9, 14, 15, 16, 18, 25, 28, 35, 37, 38, 40, 41, 42, 45;

- EUTM No 9 805 763 filed on 11 March 2011 and registered on 28 March 2012, for the figurative mark



for the goods and services in Classes: 9, 14, 15, 16, 18, 25, 28, 35, 37, 38, 40, 41, 42, 45.

7 With respect to the following earlier rights, the grounds of opposition were those laid down in Article 8(2) EUTMR:

- Well-known trade mark in all the EU Member States



for the goods and services in Classes: 9, 16, 28, 35, 37, 38, 41, 42

8 With respect to the following earlier right the grounds of opposition were those laid down in Articles 8(4) EUTMR:

- Non-registered mark or sign used in the course of trade in all the EU Member States:



for the goods and services in Classes: 9, 16, 28, 35, 37, 38, 41, 42.

9 By decision of 16 March 2016 (‘the contested decision’), the Opposition Division upheld the as amended as amended the contested goods and services on the basis of Article 8(5) EUTMR. It gave, in particular, the following grounds for its decision:

- The Opposition Division first examined the opponent’s claims invoked under Article 8(5) EUTMR.
- The relevant territory is the European Union.
- The signs under comparison are similar to the extent that the figurative element of the pear in the contested sign has graphical features which are similar to those of the earlier mark, and that it will be associated with the concept of a pear, which is related to the concept of an apple.

#### *Reputation of the earlier EUTM*

- The opponent claimed that the earlier trade mark enjoys reputation in the European Union. As the contested trade mark was filed on 25 July 2014, the opponent was required to prove that its earlier right had acquired a reputation in the European Union prior to that date and for part of goods and services in Classes 9, 16, 28, 35, 37, 38, 41 and 42.
- The evidence was structured according to the facts presented in the Witness Statement dated 21 May 2015, signed by Thomas R. La Perle, acting as Director in the opponent’s Legal Department. The Witness Statement and the accompanying exhibits (indexed from TLP-1 to TLP-50) provide information on the background of Apple’s history; the fame and value of the Apple logo; judicial recognition of the Apple’s trade marks; the use of the Apple logo in the EU; advertising and brand building initiatives and Apple’s worldwide sales and marketing expenditures.
- An evaluation of evidence submitted leaves no doubt that the trade mark at issue is generally known in the relevant market, where it enjoys a consolidated position among the leading brands, as has been attested by diverse independent sources. Used by the opponent for decades, the Apple logo is featured prominently on its iPod, iPad and iPhone devices and in

connection with hardware and software products as well as with other services (as set out in the list of the evidence). The brand studies, the sales figures, the marketing expenditure and the international rankings (which place the trade mark among the most valuable global brands), the impressive and constantly increasing number of customers, the various references in the press to its success, all unequivocally show that the earlier mark enjoys a huge recognition among the relevant public, however only in connection with part of the goods and services:

Class 9 – Computers, tablet computers, computer terminals, computer peripheral devices; computer hardware; computer software and computer hardware apparatus with multimedia and interactive functions; digital audio and video players with multimedia and interactive functions; mobile telephones; digital music and/or video players; MP3 and other digital format audio players; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, [...], electronic mail, video, instant messaging, music, audiovisual and other multimedia works, and other digital data; computer software; computer programs; mobile telephone software; computer software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multi-media content, software featuring musical sound recordings, entertainment-related audio, video, text and multimedia content, computer software and firmware for operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer hardware and software for providing integrated telephone communication with computerised global information networks; electronic handheld devices for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; online store services in the field of entertainment featuring music, video, [...] musical works, pre-recorded audio and audiovisual works [...], and music related electronic products, provided via the Internet and other computer, electronic and communications networks;

Class 35 – Online store services in the field of entertainment featuring music, video, [...] musical works, pre-recorded audio and audiovisual works [...] and music related electronic products, via the Internet and other computer, electronic and communications networks; the bringing together, for the benefit of others, of a variety of service providers, in the field of on-line entertainment, allowing third parties to conveniently select the service providers;

Class 42 – Application service provider (ASP) services featuring computer software; application service provider (ASP) services featuring software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multimedia content, and software featuring musical sound recordings, entertainment-related audio, video, text and multimedia content; providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs.

- The evidence mainly relates to the above mentioned goods and services in Classes 9, 35 and 42, whereas there is little or no reference to the remaining goods and services.

#### *Comparison of the signs*

- The signs are visually similar insofar as the figurative element representing the pear in the contested sign has graphical features which are similar to

those of the earlier mark, essentially in terms of the abstract stylisations and the sleek, rounded silhouettes of the fruits represented in each sign, with the oblong shapes leaning to the right on top of the main objects.

- The contested sign contains graphical elements which are readily perceptible and will not pass unnoticed by the average consumer. Furthermore, it comprises a verbal element ‘PEAR’, which, where understood, merely reinforces the same concept as the one attributed to the sign’s figurative element thus creating a semantic unit.
- The image of the pear is clearly the dominant element in the contested sign, by virtue of its large size and contrasting black-and-white representation, whereas the verbal element, ‘PEAR’, is depicted in the lower part of the sign and in thin, faded lettering.
- Purely figurative signs are not subject to a phonetic assessment. As one of the signs is purely figurative, it is not possible to compare them aurally. However, considering the foregoing deliberations from a visual perspective, the overall image arising from the graphical features of the pear in the contested sign would recall in the minds of the relevant consumers the earlier reputed trade mark.
- There is no aural similarity between the signs.
- Conceptually, the earlier mark will convey to the relevant public the concept of the element it evidently represents an apple. According to the *Collins English Dictionary*, an apple is, inter alia, the firm, rounded edible fruit of a rosaceous tree, having red, yellow, or green skin and crisp white flesh.
- The fact that apples and pears are undoubtedly two distinguishable types of fruit, there is nevertheless relatedness between them, as already explained. Furthermore, pears are a common alternative to apples.
- As regards the distinctiveness of the earlier mark, the Apple logo is inherently distinctive for the goods and services for which a reputation has been found. The concept of an apple, being an edible fruit, is entirely arbitrary and striking in the context of the goods and services at issue. In addition, as already shown above, the earlier mark has been found to enjoy an enormous reputation in the European Union.

#### *The ‘link’ between the signs*

- The opposition is directed against the goods and services in Classes 9, 35 and 42.
- The contested goods in Class 9 mainly cover computer hardware and peripherals, hand-held mobile digital devices, and computer programs. The contested services in Class 35 are business services related to marketing and customer relationship management. The contested services in Class 42 mainly refer to IT services rendered in connection with computer software, websites and networks.

- There is an obvious connection between all of the contested goods in Class 9 and the contested services in Class 42 with the opponent's goods and services in the same classes, since the former are either identical or similar to the opponent's goods and services for which the earlier mark enjoys a reputation.
- With regard to the contested services in Class 35, there is a close connection to the reputed goods and services, in that business services in the field of marketing and CRM are increasingly based on information technology solutions. Moreover, not only the opponent's goods and services enable the provision of the contested services in Class 35, but they also act as drivers for innovation in the CRM field. Consequently, consumers will be exposed to the contested sign in the same market segment as that in which the opponent's earlier mark is used for advanced electronic devices and IT services, as well as business solutions for data processing, communication and digital marketing.
- Part of the relevant consumers will be likely to associate it with the earlier mark in that the earlier mark represents the striking, inherently distinctive and highly reputed 'Apple' logo whilst the contested sign features a pear which not only is yet another type of fruit, but also imitates the earlier mark by conjuring related semantic content and suggesting an alternative choice for the consumer. Admittedly, there are some mental steps involved in the perception of the consumer. However, the Opposition Division considers that precisely because of the uniqueness and enormous reputation of the earlier mark the contested sign's allusive, somewhat mocking image of the pear will trigger and establish a mental 'link' with the earlier Apple logo.

*Risk of injury (unfair advantage)*

- The opponent claims that a transfer of the positive images associated with the Apple logo will occur which would result in a free-riding on the coat-tails of the opponent's highly reputed earlier trade mark. That is supported by a cogent line of arguments in relation to the overlapping or connected goods and services for which the conflicting marks will be used and references to the substantial investments that the opponent has made for building its world-famous 'lifestyle' brand.
- Therefore, the Opposition Division concludes that the opponent has shown, in a satisfactory manner, that the risk of, inter alia, unfair advantage is serious and not merely hypothetical, and the applicant's arguments in that regard are dismissed.
- In the context of the relevant goods and services, all of which imply technological sophistication and innovation, the Opposition Division agrees with the opponent that it is almost certain that at least a substantial part of the relevant public would treat the contested sign as being allusive to the opponent's Apple logo which enjoys exceptional fame and recognition. An iconic landmark in the field of consumer electronics and related computer software and IT services for the public at large and businesses, the opponent's Apple logo is instantly recognised by consumers everywhere as a defining signature of the opponent's company, 'a pioneer and leader in the

field of technology'. With a market presence of more than 35 years and ranked several times as the number one most valuable global brand, the famous Apple logo conveys an image of innovation, creativity, imagination, design, user-friendliness and functionality that will be immediately transferred to the contested goods and services in Classes 9, 35 and 42.

- The 'good' and 'special' reputation of the earlier mark, in that it conveys a positive message or brand images as set out above, could positively influence the choice of consumers as regard the goods and services of other providers.
- Clearly, a pear is not an apple. However, the pear logo, particularly on account of its abstract stylisation, sleek silhouette and the oblong stem leaning to one side, connotes to the reputed Apple logo. It is as if the message conveyed by the contested sign imitated and at the same time mocked and defied the reputed Apple logo. Obviously, neither the logo is the Apple logo, nor the contested goods and services originated from Apple. Yet, the goods and services marketed under the pear logo present a comparable alternative to those bearing the Apple logo, for instance in the sense of analogous design, functionalities, etc. In other words, a pear is as good as an apple.
- The Apple-branded products have 'legions of adoring fans'; over the course of more than 35 years of operation, Apple 'has earned a fiercely loyal customer base and its goods and services have become some of the most recognized and highly sought after in the world'. Such strong, fanatic sentiment for a brand can cause antagonism on the part of some consumers who wish to express their alternative views and life-style ideas by standing out from the mainstream. This is where the contested sign can appeal to the consumers.
- Use of the contested sign in relation to technologically advanced electronic devices and IT services, as well as business solutions for data processing, communication and digital marketing which either overlap or are closely connected to those marketed under the reputed Apple logo can lead to a situation where consumers prefer the applicant's goods and services to those of other competitors in the market precisely because the pear logo imitates and simultaneously challenges the Apple logo. Thus, the special brand image, attractive powers and advertising value of the opponent's earlier mark can be misappropriated. That may stimulate the sales of the applicant's goods and services to an extent which may be disproportionately high in comparison with the size of its own promotional investment and thus lead to the unacceptable situation where the applicant is allowed to take a 'free-ride' on the investment of the opponent in promoting and building-up the value of its mark.
- On the basis of the above, the Opposition Division concludes that, in view of the substantial exposure of the public to the opponent's earlier reputed mark, in relation to the goods and services for which a reputation has been found and taking into account the somewhat low, yet existing similarity between the signs, there exists a probability that the use without due cause of the contested sign in respect of the contested goods and services in

Classes 9, 35 and 42 may acquire some unearned benefit and lead to free-riding, that is to say, it would take unfair advantage of the distinctive character and the repute of the earlier trade mark.

- Considering all the above, the opposition is well founded under Article 8(5) EUTMR. Therefore, the contested mark must be rejected for all the goods and services.
- 10 On 10 May 2016, the applicant filed an appeal against the contested decision, requesting that the decision be as amended set aside as amended accepted. The statement of grounds of the appeal was received on 6 July 2016.
- 11 In its observations in reply received on 7 September 2016, the opponent requests that the appeal be dismissed.
- 12 On 26 September 2016, the opponent filed a declaration under Article 28(8) EUTMR with respect to the list of goods and services of its EUTM No 9 784 299.

### **Submissions and arguments of the parties**

- 13 The arguments raised in the statement of grounds may be summarised as follows:
- The Office erred in its assessment of the respective marks in terms of visual, aural and conceptual similarities.

#### *Visual comparison*

- There is no visual similarity between the marks.
- The graphic element in the contested sign is a pear with no ‘bite’ or a part missing from it, unlike the clear ‘bite’ shape in the opponent’s sign. Neither is there any bold outline to denote the shape of the pear around the edges unlike the bold black in the depiction of the opponent’s ‘Apple’ logo.
- Furthermore, the Office failed to note the fact that the applicant has a EUTM No 14 452 023 registered for the word ‘PEAR’ for the same goods and services.
- Great emphasis is placed on the fact that both marks contain a stalk element that is leaning to the right. However, there are clear differences in the shape and size of the stalk; being oval/egg shaped and more pronounced in the apple of the opponent’s mark and rectangular and smaller in prominence in the contested sign to fit with the square and rectangles making up the patterns in the pear device.
- The word ‘PEAR’ is a clear and obvious point of difference between the respective marks and the graphic elements are utterly distinct, given the ‘highly stylised image’ of the contested sign. The Office stated, ‘clearly a pear is not an apple.’



- The Office itself recognises that the differences in the respective marks will not go unnoticed by the average consumer.
- The location of the word ‘PEAR’ below the logo does not lead to the conclusion that the word will be ignored and not spoken. Furthermore, the lettering cannot be classified as faded, but merely in a light shade. The word has at least equal prominence in the composite sign and cannot be ignored.
- The Office wrongly qualified the contested sign as containing an ‘imitating figurative element’. The contested sign contains squares of different sizes that have no ‘bite’ element and the word ‘PEAR’ in addition.

#### *Conceptual comparison*

- The word element of the contested sign will not be ignored, even if not understood by non-English-speaking consumers, as the word element is the inherent part of the trade mark.
- Contrary to the contested decision, apples and pears are in fact conceptually distinguishable.
- The Office wrongly assessed that ‘apples and pears are comparable fruit that are often seen as being in competition with each other’ and that ‘pears are alternatives to apples’, which in the applicant’s view is a broad sweeping statement not supported by any facts or evidence.
- The marks are, contrary to the Office’s view, visually not similar given the clear presence of the word ‘PEAR’ and the highly stylised, different nature of the graphic element in the contested mark with the variety of squares in different shapes and sizes and a different stalk on top of the pear logo.
- Furthermore, there is a clear and unequivocal phonetic difference with the presence of the word ‘PEAR’ which will be pronounced and not ignored.
- The marks are conceptually distinct as consumers recognise the difference between a pear and an apple and in fact, many EU consumers and countries use an idiom to refer to the fact that when two things cannot be compared, it is like comparing apples with pears. As English-speaking consumers will understand the concept of a pear, they will clearly know and understand it to be completely different to an apple and for non-English-speaking consumers, the word PEAR has even greater distinctiveness and is more memorable and unusual and therefore, provides a further conceptual difference to the opponent’s marks.

#### *The link*

- The Office erred in finding a link between the signs.
- The marks differ in appearance, sound, concept, given the size of the squares in the contested sign, the word element, the element of the ‘bite’, the shape and size of the device and the stem, making them dissimilar overall.

*Due cause*

- The applicant clearly has due cause in the adoption of the mark as its company name is ‘Pear Technologies Limited’ and it holds a registered EUTM for the word ‘PEAR’, it is therefore well within its rights to adopt a logo of a pear as part of its branding in order to match the company name and word mark in place and to have such a logo combined with the words ‘Pear Technologies’. This name is distinctive and unusual in its field of digital marketing and CRM related software goods and services.
- The mark is highly stylised and the make-up of the pear logo with the different pear shape, size and colour and the long, attached stalk is so completely different from the opponent’s mark that it has clearly been adopted with due cause and in support of the PEAR name present in the mark and company name of the applicant.

*Comparison of goods and services*

- For the sake of procedural economy, the applicant highlights the particular differences between the services of the respective parties in Classes 35 and 42, while the similarity of the goods in Class 9 is irrelevant.
- It is clear that the services in Class 35 are in no way similar to each other at all in nature, purpose, use, users and would not be in competition with each other. The opponent’s services in Class 35 relate to the sale of music and entertainment online, whereas the applicant’s services relate to digital marketing and customer relationship management for businesses. The mere fact that both services may be provided through the medium of technology and the Internet (as most businesses now are) does not lead to a conclusion that such services are similar. To reach such a conclusion is akin to saying that any services that can be provided via the Internet will be similar to each other because they provide an IT solution.
- With respect to the services in Class 42, the Office erred in its reasoning and conclusion that ‘there is an obvious connection between all of the contested services in Class 42 and the goods and services of which the earlier mark enjoys reputation.’ The opponent’s services possess reputation in respect of the service provider services and access to software specifically relating to the music and entertainment field, but not for ‘service provider services featuring computer software’. Services relating to webpage design are not music or entertainment services as can be said for domain management and the IT service of hosting a server. The nature, purpose and use of such services is completely different and they would never be in competition with the services for which the Office considers the opponent to have a reputation for. Nor would a consumer make any connection between them as a consumer would not expect a company that designs web pages and manages domain names to provide services to access and download music and entertainment. The fields are utterly distinct.

*Free riding / unfair advantage*

- Due to the clear differences between the marks, there is no possibility of imitation.
- The opponent failed to prove the related semantic content between the marks.
- It is settled case-law that consumers will not overanalyse a mark and its parts and so it cannot be said that consumers will make a link if, as the Office admits, some mental steps are involved to make any kind of link. The consumer will not undertake such mental steps, particularly given the services of interest have a different nature, purpose and use and are not in competition too.
- The opponent must adduce prima facie evidence of a future risk or a coherent line of argument. The applicant submits that the opponent has failed to do this because there is no such risk. Merely putting forward some arguments without cogent, supporting and convincing evidence is not sufficient, particularly as the services are not ‘overlapping and connected’ as contended by the Office.
- The opponent’s claims are refuted by the applicant. The adoption of the mark which is so completely visually different has a crucial aural point of difference in the registered ‘PEAR’ word mark and shares no conceptual similarity as a pear cannot be compared to an apple, and would in no way affect the ability of the opponent to distinguish its goods/services for which it has a reputation. This is particularly the case given the opponent’s services are in the field of music and entertainment whereas the applicant is a digital marketing and CRM service provider, offering web page design and domain management as well as marketing services.
- Therefore, it cannot be said that any consumer will make any assumption that the services of the applicant originate from the opponent or vice versa. The clear differences in the respective marks means that the applicant is in no way seeking to establish any connection with the opponent, false or otherwise or attempting to trade on the opponent’s reputation. The name of the applicant’s company is ‘Pear Technologies’ so it makes perfect logical sense for them to have a pear logo to promote their business and the different highly stylised nature of the mark proves that the applicant has due cause to adopt and use its mark.
- The Office states that the contested sign is ‘allusive’ to the opponent’s Apple logo. The applicant submits that the mark cannot possibly be said to be allusive given the overall visual, aural and conceptual differences submitted, the presence of the PEAR word registered in its own right that would be understood by English-speaking consumers as being a completely different fruit to an apple and would be even more distinctive, striking and unusual to all the non-English-speaking consumers across the EU.
- The statement in the contested decision that the mark imitated and mocked the opponent’s mark, appears to be a personal opinion of the examiner with no supporting evidence. Furthermore, the conclusion of the Office here that ‘a pear is as good as an apple’ is not a phrase that is used or recognised and

as submitted concerning the idiom, the opposite is in fact the case in that consumers recognise one cannot compare an apple to a pear and use this term as a phrase.

14 The arguments raised in reply to the appeal may be summarised as follows:

- The opponent has clearly demonstrated that at the filing date of the contested sign, the ‘Apple’ logo had a substantial reputation in the relevant marketplace. Due to the mentioned similarities between the marks, the contested sign takes unfair advantage of, and/or is detrimental to the distinctive character or repute of the ‘Apple’ logo, contrary to Article 8(5) EUTMR, and this ground has been properly substantiated.
- Visually the marks are similar for the following reasons: the representation of a rounded pear device with a detached stalk at an approximate 45 degree angle, as featured in the contested sign, is strikingly similar to the ‘Apple’ logo; both are stylised, solid images of a fruit. In particular, the shape, angle, position and side of the stalk are highly similar and the detachment of the stem in the contested sign is very evocative of the ‘Apple’ logo.
- The Office correctly assessed that ‘visually the signs are similar to the extent that they contain a large, sleek, rounded object, on top of which there is an oblong shape angled to the right. The abstract stylisations of the silhouettes are similar’.
- The EUTM No 14 452 023 ‘PEAR’ (word) in the name of the applicant was filed on 7 August 2015, which is over a year after the filing of the contested application and seven months after the present opposition proceedings commenced.
- The word element ‘PEAR’ in the contested sign is not highly distinctive. The dominant components of both marks are spherical, curvy shapes of the fruit device and the detached leaf/stalk element.
- The applicant has essentially attempted to align itself with the opponent by choosing a mark that will bring the opponent and its Apple logo to mind. The applicant has chosen the pear fruit as its identifier, both through using the word mark and a pear device (as applied for under the mark applied for), noting that a pear is the closest fruit possible to an apple, which the opponent has demonstrated in the opponent’s observations both in terms of biology, science and also language and likely association in the minds of consumers. Further, and which has been demonstrated above and in the opponent’s observations, the mark applied for has been filed in respect of goods and services that are identical to the goods and services provided by the opponent, which the opponent is famous and renowned for.
- The applicant has set out from the outset to draw an association with the opponent and its Apple logo. The opponent reiterates that this opposition is not the result of the opponent seeking to assert its earlier rights against a dissimilar mark that can be distinguished from its earlier rights, but rather the applicant is seeking to register and use a mark that is as close as possible to the opponent’s identity and marks, for the reason that the

opponent and its earlier rights are hugely famous and well reputed. The result of the applicant's use of the mark will be consumer confusion to the benefit of the applicant in the form of new customers and to the detriment of the opponent. Further, the applicant's use of the mark will take unfair advantage of and cause detriment to the opponent's Apple logo. The applicant merely seeks to liken and associate itself with the opponent as much as possible through using the mark applied for so as to ride off the coat tails of the opponent's goodwill in its Apple logo in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of its own in that regard, the marketing effort expended by the opponent.

- The Office correctly assessed the conceptual similarity between the signs. While apples and pears are obviously different, they are comparable fruits that are often seen as being in competition with each other and are common alternatives. In fact apples and pears are very similar fruits, potentially the most similar fruit that can be in competition with each other.
- Both marks clearly represent a piece of fruit and the detached stalk within the contested sign is almost identical to the detached leaf element within the 'Apple' logo. Furthermore, the curved black squares match the curved properties of the opponent's marks.
- The opponent further agrees with the findings of the Office in stating that there is no aural similarity between the signs. However, considering the foregoing deliberations from a visual perspective, the overall image arising from the graphical features of the pear in the contested sign would recall to the minds of the relevant consumers, the earlier reputed mark.
- The opponent reiterates that it does not deny that apples and pears are different fruits, which is an obvious fact. Instead, the opponent agrees with the findings of the Office that apples and pears are comparable fruits that are often seen as being in competition with each other and contests the applicant's claims that these findings are unsubstantiated. In particular, apples and pears are very closely similar fruits, potentially the most similar fruit, and in choosing a pear as its identity, the applicant intentionally chose the closest fruit possible to an apple, being the identifier of the, particularly in connection with the goods and services applied for under the application.
- The opponent maintains that there is clear visual and conceptual similarity between the opponent's Apple logo mark and the mark applied for.

#### *Reputation and link*

- The applicant seeks to focus on the differences between the marks but as the opponent has submitted, there are always differences between similar marks, and this is to be expected. For the purposes of Article 8(5) EUTMR, even low similarity between the marks is sufficient for a mark to be refused registration.

- The opponent submits that, while the previous decisions are not binding, they are indeed very valuable to this case as they serve to demonstrate and evidence the fame and reputation of the earlier marks including the Apple logo.
- Clearly the opponent's marks enjoy reputation and the previous decisions of EUIPO should be considered to that extent.
- The reputation of the 'Apple' logo covers, inter alia, all the goods and services applied for by the contested sign.

*Due cause*

- Further, regarding due cause, the opponent reiterates that there is no due cause for the use of the mark applied for to take advantage of and/or be detrimental to the Apple logo and recalls that it is for the applicant to prove any such cause. The opponent maintains that the applicant has failed to provide any such evidence to demonstrate that it has due cause to apply for and use the mark applied for. The applicant has no due cause to adopt the pear device, it being highly similar and almost identical to an apple, other than to sustain a false connection between the marks, in order to deliberately deceive or confuse consumers as to the origin or qualities of goods and services provided under the mark applied for.

*Comparison of goods and services*

- First, the opponent understands that the applicant appears to have accepted that the Class 9 goods applied for are all identical or similar to those covered by the earlier marks.
- The opponent is very concerned by the application, which covers goods and services in Classes 9, 35 and 42, many of which are central and/or related to the opponent's activities. In this regard, the opponent reiterates that there is a very high risk that use of the mark applied for in connection with the goods and services applied for in which the opponent has an extraordinary reputation will confuse members of the public who believe that the goods and services emanate from, or at the very least are associated with, the opponent.

*Free riding / unfair advantage*

- The opponent reiterates its submissions that in view of the similarity between the marks, noting the exceptional fame and recognition of the opponent's Apple logo and the requirement for global appreciation, it is highly likely that the public would establish a clear economic connection between the opponent and the applicant as a result of the applicant's use of the mark applied for.
- Further, the opponent maintains that the applicant has not shown due cause to use the mark applied for.

- Accordingly, the opponent demonstrated that the Apple logo enjoys a substantial reputation globally and throughout the relevant territories in the EU and is a well-known mark in the EU.
- The opponent maintains that, the applicant has chosen the ‘pear’ fruit as its identifier, both through using the word mark and a pear device, noting that a pear is the closest fruit possible to an apple, in terms of biology, science and also language and likely leads to association in the minds of consumers. Further, the application has been filed in respect of goods and services that are identical to the goods and services provided by the opponent, which the opponent is famous and renowned for and protected by the opponent’s earlier marks.
- The result of the use of the contested application will be consumer confusion to the benefit of the applicant in the form of new customers and to the detriment of the opponent. Further, the use of the mark applied for will take unfair advantage of and cause detriment to the opponent’s Apple logo. The applicant merely seeks to liken and associate itself with the opponent as much as possible through using the application so as to ride off the coat tails of the opponent’s goodwill in its Apple logo in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of its own in that regard, the marketing effort of the opponent.
- The opponent submits and has evidenced that, as a consequence of the extensive use and reputation of the opponent and its Apple logo, consumers know to associate fruit imagery, namely an apple device and the word ‘APPLE’, in connection with computer and consumer electronic goods and related services with the opponent. The apples and pears are clearly conceptually similar, especially in connection with the computer and consumer electronic goods and related services at issue. Therefore, the applicant is merely trying to take unfair advantage of Apple’s reputation and there is no other reason to adopt a fruit mark in connection with computer and consumer electronic goods and related services other than to draw an association with the opponent and its Apple logo and take unfair advantage in this way. Clearly, the adoption of a fruit device in connection with the goods and services at issue creates a real risk of confusion and detriment to the repute of the Apple mark in addition to amounting to passing off.

### **Reasons**

- 15 The appeal complies with Articles 58, 59 and 60(1) EUTMR and Rules 48 and 49 CTMIR. It is, therefore, admissible.

#### *Scope of the appeal*

- 16 For reasons of procedural economy, the Board, in keeping with the approach of the contested decision, will primarily take into account the earlier EUTM No 9 784 299, for which reputation under Article 8(5) EUTMR was claimed, as this earlier right represents the strongest case from the opponent’s perspective.

- 17 The Opposition Division carried out a detailed analysis of the reputation of the earlier EUTMR No 9 784 299 with respect to part of the goods or services (indicated in paragraphs 34-36 below), which has not been challenged. For the sake of completeness and in order to avoid unnecessary repetition, the Board refers to that analysis (pages 13-19 of the contested decision) which it confirms and endorses.
- 18 The similarity of the goods applied for in Class 9 with the goods and services of the earlier right for which reputation was proven has not been contested by the applicant. The Board considers the findings in the contested decision to that extent correct and complete and refers to that analysis (page 22 of the contested decision). The appeal is therefore limited to the contested services in Classes 35 and 42.

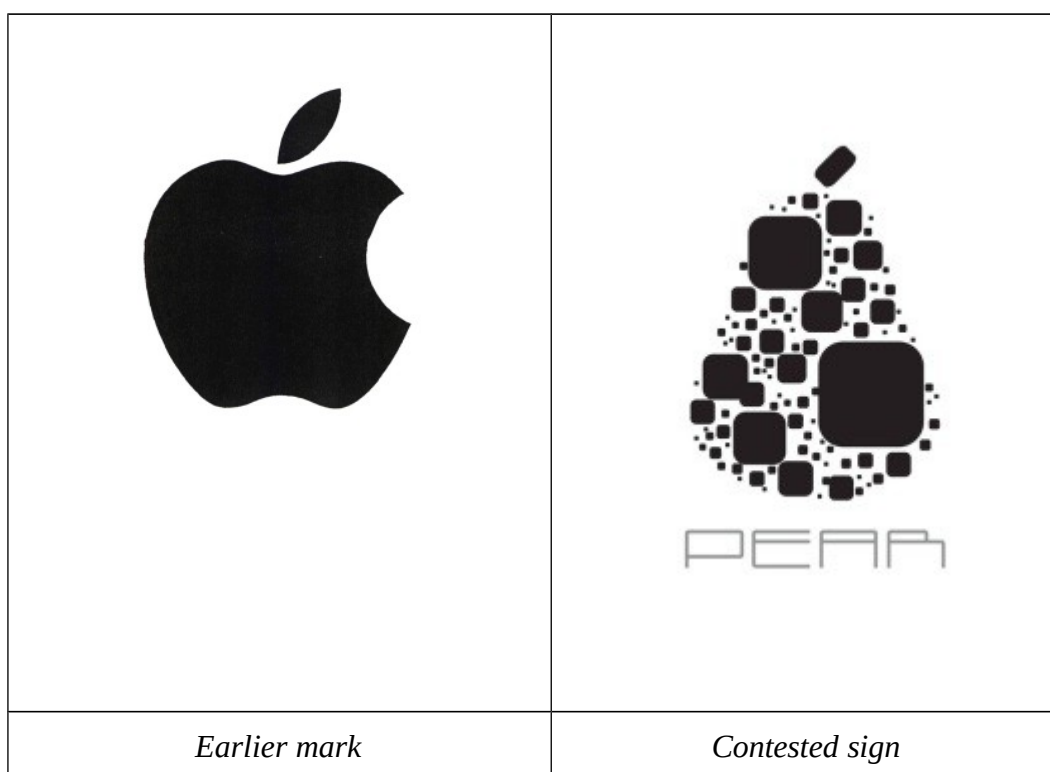
*Article 8(5) EUTMR*

- 19 For an earlier trade mark to be afforded the broader protection under Article 8(5) EUTMR, a number of conditions must, therefore, be satisfied. First, the earlier trade mark which is claimed to have a reputation must be registered. Secondly, that mark and the mark applied for must be identical or similar. Thirdly, it must have a reputation in the European Union, in the case of an earlier EU trade mark, or in the Member State concerned, in the case of an earlier national trade mark. Fourthly, the use without due cause of the mark applied for must lead to the risk that unfair advantage might be taken of the distinctive character or the repute of the earlier trade mark or that it might be detrimental to the distinctive character or the repute of the earlier trade mark. As those conditions are cumulative, failure to satisfy one of them is sufficient to render that provision inapplicable (judgment of 28/09/2016, T-362/15, HENLEY, EU:T:2016:576, § 19 and the case-law cited).
- 20 The application of Article 8(5) EUTMR requires a number of conditions to be met, cumulatively. Failure to satisfy one of them is sufficient to render that provision inapplicable (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 30; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 34; and 16/05/2007, T-137/05, Nimei La Perla Modern Classic, EU:T:2007:142, § 26).
- 21 Accordingly, an application for the Article 8(5) EUTMR requires that the following conditions be met:
  - a. The European Union trade mark applied for and the earlier trade mark must be identical or similar.
  - b. The earlier trade mark must have a reputation in the Union or in a Member State.
  - c. Unfair advantage must be being taken of the distinctive character or the reputation of the earlier trade mark or detriment must be being caused thereto.
  - d. There must be lack of due cause.



a) *Similarity of the signs*

- 22 According to the case-law, the existence of a similarity between the marks at issue is a precondition for the application both of Article 8(1)(b) and of Article 8(5) EUTMR. In the context of both those provisions, that condition relating to similarity between the marks at issue requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, to that effect, judgment of 24/03/2011, Ferrero, C-552/09 P, ECR, EU:C:2011:177, § 51, 52).
- 23 Although the global assessment of whether a link exists between the marks at issue for the purposes of Article 8(5) EUTMR implies some interdependence between the relevant factors and, accordingly, a low degree of similarity between the marks may be offset by the strong distinctiveness of the earlier mark, the fact remains that, where there is no similarity between the marks at issue, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services concerned are identical or similar are not sufficient grounds for finding that there is a likelihood of confusion between the marks at issue or that the relevant public will make a link between them (judgment of 11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 33).
- 24 The signs to be compared are:  
25



The earlier mark is a figurative sign in black, representing an apple with a 'bite' taken out of it and a stalk. The contested sign consists of a device in a form of black squares with curved edges, all together representing a pear with a stalk and additionally a word 'PEAR' in a stylised lettering placed beneath the device.

- 26 Visually, both marks contain a depiction of a piece of fruit including a stalk/leaf. However, as correctly observed by the applicant, there are differences since the contested sign contains the word 'PEAR'; it does not have a 'bite' taken out of it and additionally it has various black rectangular shapes within the device.
- 27 The Board first notes that the stalk/leaf, as the applicant argues, although they are different in shape, they are placed in a similar position in both signs and in fact, as the opponent correctly states, they are at the same 45 degree angle oriented right and are clearly detached from the fruit.
- 28 Second, according to the applicant's argument that the word element 'PEAR' has at least equal prominence in the composite sign and cannot be ignored, the Board notes that the device element in the contested sign is placed at the central point of the mark and makes this element dominant (12/11/2015, T-449/13, WISENT, EU:T:2015:839 § 83). Furthermore, the word element is smaller, in a faded font and placed beneath the device, and therefore it must be considered to be only a secondary element of the sign. The Board adds that although it is generally accepted that words are more prominent in marks consisting of a word and device, the Opposition Division correctly noted that this element, where understood, merely reinforces the same concept as the one attributed to the sign's figurative element thus creating a semantic unit.
- 29 At the same time the Board identifies that the differences between the signs in fact, will not go unnoticed by the average consumer. However, it should also be noticed that there are elements of at most remote visual similarity between the signs. In particular, the contested decision rightly found that the signs share the figurative elements of sleek rounded silhouettes of fruit represented in both signs, with the oblong shape leaning to the right on top of the main object, conferring on those marks a degree of visual similarity. Both signs are stylised solid images of a fruit with the characteristic stalk. Consequently, the abstract stylisations of the silhouettes are similar.
- 30 The Opposition Division correctly decided that aurally, there is no similarity between the signs. The applicant seems to contest this finding by stating that since the earlier mark does not include any word element and that the mark applied for includes the word 'PEAR', which will be read by the consumers, there is a clear dissimilarity between the signs not just a mere dissimilarity.
- 31 The Board notes that since the earlier trade mark does not include any verbal elements (it is a purely figurative mark) it is not subject to a phonetic assessment. It has been an established practice that the possibility of a direct (pronunciation-based) phonetic comparison of the figurative elements of the signs is excluded (decision of 09/07/2015, R 863/2011-G, Malta Cross International Foundation / Maltese cross, § 49; 07/02/2012, T-424/10, Eléphants dans un rectangle, EU:T:2012:58, § 47). The Board adds that considering the foregoing deliberations from a visual perspective, the overall image arising from the graphical features of the pear in the contested sign would recall to the minds of the relevant consumers the earlier reputed mark.
- 32 A certain conceptual link between the signs cannot be denied. It is true that apples and pears are two distinguishable fruits. Nevertheless, they are both types of fruit which are closely related in a biological sense (such as the origin, size,

colours, texture) and they are associated together in many ways throughout the relevant territory and in fact, they are common alternatives to each other. Consequently, the Board finds that the signs under comparison are similar to the extent that the figurative element of the ‘pear’ in the contested sign has graphical features which are similar to those of the earlier mark. It will be therefore be associated with the concept of a ‘pear’, which is in turn is related to the concept of an ‘apple’.

- 33 It has also been found that there is at most a remote visual similarity between the signs and a low level of conceptual similarity between the marks. It follows from the case-law, that the existence of a visual and conceptual similarity, however faint, between the signs at issue is a precondition for the application of Article 8(5) EUTMR and that the degree of similarity is a relevant factor in determining whether there is a link between those signs (judgment of 11/12/2014, T-480/12, MASTER, EU:T:2014:1062, § 73).

*b) Reputation of the earlier mark*

- 34 As regards the reputation of the ‘Apple’ brand in the IT and technology sector in the EU, it is a common ground between the parties that, in view of the evidence supplied by the opponent, the Opposition Division correctly assessed that the ‘Apple’ brand had acquired a reputation before the filing date of the contested application for part of the goods and services listed below.
- 35 In particular, the Board considers that following the examination of the evidence submitted by the opponent before the Opposition Division it leaves no doubt that the trade mark at issue enjoys a consolidated position among the leading brands, as has been attested by diverse independent sources (Exhibit TLP-9). Used by the opponent for decades, the Apple logo is featured prominently on its iPod, iPad and iPhone devices and in connection with hardware and software products as well as with other services (Exhibits TLP 18 to 46). The brand studies (Exhibits TLP 12-13), the sales figures (Exhibits TLP 18 to 46), the marketing expenditure (Exhibit TLP 50) and the international rankings which place the Apple logo among the most valuable global brands (Exhibit TLP 9; 10; 11), the impressive and constantly increasing number of customers, the various references in the press to its success, all unequivocally show that the earlier mark enjoys a high reputation among the relevant public in connection with the following goods and services:

Class 9 – Computers, tablet computers, computer terminals, computer peripheral devices; computer hardware; computer software and computer hardware apparatus with multimedia and interactive functions; digital audio and video players with multimedia and interactive functions; mobile telephones; digital music and/or video players; MP3 and other digital format audio players; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, [...], electronic mail, video, instant messaging, music, audiovisual and other multimedia works, and other digital data; computer software; computer programs; mobile telephone software; computer software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multi-media content, software featuring musical sound recordings, entertainment-related audio, video, text and multi-media content, computer software and firmware for operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer hardware and software for providing integrated telephone communication with computerised global information networks; electronic handheld devices for the wireless receipt, storage and/or

transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; online store services in the field of entertainment featuring music, video, [...] musical works, pre-recorded audio and audiovisual works [...], and music related electronic products, provided via the Internet and other computer, electronic and communications networks;

Class 35 – Online store services in the field of entertainment featuring music, video, [...] musical works, pre-recorded audio and audiovisual works [...] and music related electronic products, via the Internet and other computer, electronic and communications networks; the bringing together, for the benefit of others, of a variety of service providers, in the field of on-line entertainment, allowing third parties to conveniently select the service providers;

Class 42 – Application service provider (ASP) services featuring computer software; application service provider (ASP) services featuring software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multimedia content, and software featuring musical sound recordings, entertainment-related audio, video, text and multimedia content; providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs.

- 36 Having considered the above, the Board notes that the evidence submitted by the opponent before the Opposition Division provides enough proof to determine that the earlier Apple logo had acquired a high degree of reputation for the above mentioned goods and services in the relevant territory before the filing of the contested application.

*Existence of a link between the signs*

- 37 In order to establish whether an earlier mark with a reputation may be adversely affected by the risk of one of the types of injury referred to in Article 8(5) EUTMR, one has to establish first whether the relevant public would establish a link between the marks at issue.
- 38 The stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 53-55). The existence of such a link in the mind of the public constitutes a condition which is necessary but not, in itself, sufficient to establish the existence of one of the types of injury against which Article 8(5) EUTMR ensures protection for the benefit of marks with a reputation (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 31, 32). A link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically linked undertakings (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 57).
- 39 The existence of such a link must be subject to an overall assessment, taking into account all factors relevant to the circumstances of the case, including the degree of similarity between the marks at issue; the nature of the goods or services covered by the marks at issue, including the degree of closeness or

dissimilarity between those goods or services, and the relevant section of the public; the strength of the earlier mark's reputation; the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and the existence of the likelihood of confusion on the part of the public (12/03/2009, C-320/07 P, *Nasdaq*, EU:C:2009:146, § 45; 30/04/2009, C-136/08 P, *Camelo*, EU:C:2009:282, § 26; see also, by analogy, 27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 42).

*Relevant public*

- 40 As the earlier trade mark is a EUTM, the relevant territory is the European Union.
- 41 The parties operate in related IT sectors. In particular the opponent's mark has a proven reputation for technologically advanced electronic devices and IT services, as well as for business solutions for data processing, communication and digital marketing. In parallel to this, the applicant operates in the sector of technologically advanced electronic devices and IT services and CRM business solutions in particular.
- 42 In the present case therefore, the relevant public of both, the earlier mark's goods and services and the contested mark's goods and services in Classes 9, 35 and 42 overlaps i.e. is composed of the public in general and professional consumers. With respect to the services in Class 35, those of the applicant are essentially designed for the business consumer, while those of the earlier right, are designed for both, the average consumers and business users of computers.
- 43 Since the goods and services in conflict relate to business technology and IT, the level of attention of those consumers is expected to be heightened, given that these goods and services might have particular economic importance for the consumers buying them and that they seek specific technologically advanced goods and services. In that regard, it must be noted that, according to settled case-law, professionals are likely to have specific knowledge of the services covered by the marks at issue and/or to display, in that regard, a higher level of attentiveness than the public at large (judgment of 15/01/2013, T-451/11, *Gigabyte*, EU:T:2013:13, § 38 and the case-law cited).

*Similarity of the goods and services*

- 44 The opposition is directed against the goods and services in Classes 9, 35 and 42. Whereas the identity and similarity of the respective goods in Class 9 (covering mainly computer hardware and peripherals, hand-held mobile digital devices, and computer programs) has not been contested, the applicant claims that due to different sectors in which the parties operate, the remaining services in Classes 35 and 42 cannot be considered similar to the goods and services of the earlier right. In particular, its services in Class 35 comprise business solutions, relating to digital marketing; customer relationship management (CRM) and design. And the services in Class 42 mainly refer to a range of IT services rendered in connection with computer software, websites and networks.
- 45 The Board first considers that the contested services in Class 42 are identical and similar to the services in Class 42 of the earlier right for which reputation

was proven. In the second place, the Board concludes that the contested services in Class 35 are considered similar to the opponent's goods and services, since the business services in the field of marketing and CRM are increasingly based on information technology solutions such as those provided by the opponent. Moreover, as the Opposition Division correctly indicated, the opponent's services in Class 42 enable the provision of the contested services in Class 35, but they also act as drivers for innovation in the CRM field. Consequently, the consumers will be exposed to the contested sign in the same market segment as that in which the opponent's earlier mark is used – technologically advanced electronic devices and IT services – as well as business solutions for data processing, communication and digital market.

*Distinctiveness of the earlier mark*

- 46 The Board finds no error in the contested decision as far as it decided that the earlier mark represents the striking, inherently distinctive and highly reputed 'Apple' logo, whilst the contested sign features a 'pear', which not only is just another type of fruit, but also imitates the earlier mark by conjuring related semantic content and suggesting an alternative choice for consumers. The concept of an 'apple', being an edible fruit, is entirely arbitrary and striking in the context of the goods and services at issue.
- 47 The Opposition Division further correctly stated that the 'Apple' logo acquired a high reputation in the EU market for part of the goods and services concerned (see paragraphs 34-36 *supra*).

*Global assessment under Article 8(5) EUTMR*

- 48 In the present case, the global assessment under Article 8(5) EUTMR, to determine whether the relevant public makes a link between the marks at issue, leads to the conclusion that, given the degree of similarity, however faint, between those marks, it is probable that the relevant public will make a link and thereby associate the marks. Although the signs at issue are only slightly similar, it is not altogether inconceivable that the relevant public could make a link between them and, even if there is no likelihood of confusion, be led to transfer the image and the values of the earlier marks to the goods bearing the mark applied for (judgment of 29/03/2012, T-369/10, *Beatle*, EU:T:2012:177, § 71).
- 49 In the Board's view, the signs correspond in their distinctive figurative elements, that is to say, the spherical, curvy shapes of the fruit device and the detached leaf/stalk element, and do not contain different figurative elements capable of introducing significant conceptual differences between them (12/11/2015, T-449/13, *WISSENT*, EU:T:2015:839 § 128).
- 50 The contested mark is a stylized representation of a pear fruit with a stalk, composed of black squares, while the earlier mark is a simple representation of an apple in black with a stalk and a 'bite'. The Board follows the findings in the contested decision and considers that admittedly, there are some mental steps involved in the perception of the consumer, however, because of the uniqueness and high reputation of the earlier mark the contested sign's allusive, somewhat mocking image of the 'pear' will trigger and establish a mental 'link' with the earlier 'Apple' logo.

51 The word element 'PEAR' of the contested sign due to its position and meaning in English merely reinforces the same concept as one attributes to the sign's figurative element thus creating an almost indivisible unit (12/11/2015, T-449/13, WISENT, EU:T:2015:839 § 129), which in the Board's view, might even increase the possibility that the relevant public makes a link with the earlier 'Apple' logo.

*c) Unfair advantage*

52 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of an identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation or riding on the coat-tails of the mark with a reputation. It follows that advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor (18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 41, 43).

53 The existence of unfair advantage taken of the reputation of the earlier mark may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case (29/03/2012, T-369/10, Beatle, EU:T:2012:177, § 62 and 10/05/2007, T-47/06, Nasdaq, EU:T:2007:131, § 54). Thus, Article 8(5) EUTMR must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute or, more generally, to the proprietor of that trade mark. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image (see, by analogy, 12/07/2011, C-324/09, L'Oréal-eBay, EU:C:2011:474, § 50).

54 In order to determine whether use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and degree of distinctive character, the degree of similarity between the marks at issue, and the nature and degree of proximity of the goods or services concerned.

55 It is clear from case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to it (see, to that

effect, 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 67-69 and 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 44).

- 56 The opponent claims that a transfer of the positive images associated with the 'Apple' logo will result in there being an unfair advantage. The Board is of the view that given the unquestionable high reputation that Apple has and taking into account that there is a link between the respective marks, the applicant does have an unfair advantage. The characteristics associated with the Apple brand, particularly the mark's reputation for providing high quality technology, is likely to be transferred to the applicant. Since the applicant would be benefitting from the reputation of the Apple brand, without paying any compensation to the opponent, or expending the money necessary to create a market for its products in the EU, they are effectively riding the coat-tails of the opponent which constitutes an unfair advantage.
- 57 The Board notes that the 'Apple's' established image is embodied in a piece of fruit, which is highly distinctive and unusual in the IT sector. Based on the evidence presented, the Opposition Division correctly assessed that the 'Apple' branded products have become some of the most recognized and highly sought after in the world, which are regularly followed by a number of admirers or fans.
- 58 The opponent's household 'Apple' logo is not only inherently distinctive but also has a proven high reputation for technologically advanced electronic devices and IT services, as well as for business solutions for data processing, communication and digital marketing throughout the EU; in parallel, the applicant operates in the related IT sector of technologically advanced electronic devices and IT services and CRM business solutions.
- 59 The Opposition Division was also correct when it stated that a pear is not an apple. However, the 'pear' logo, particularly on account of its abstract stylisation, sleek silhouette and the oblong stem leaning to the right, evokes the reputed 'Apple' logo. It is as if the message conveyed by the contested sign imitated and at the same time mocked and defied the reputed 'Apple' logo. Obviously, the contested logo is not the 'Apple' logo, nor do the contested goods and services originate from the 'Apple' company. Yet, the goods and services marketed under the pear logo present a comparable alternative, for instance in the sense of analogous design, functionalities, etc. In other words, a pear is as good as an apple.
- 60 In the Board's view the applicant has sought to mimic the iconic image of an apple by taking the fruit which is closest to that image namely a pear and riding on the coat tails of the customer base of the Apple brand.
- 61 In addition, as the Opposition Division correctly considered, the use of the contested sign in relation to technologically advanced goods and services which either overlap or are connected to those marketed under the reputed 'Apple' logo can lead to a situation where consumers prefer the applicant's goods and services to those of other competitors in the market precisely because the 'pear' logo imitates and simultaneously challenges the 'Apple' logo. Thus, the special brand image, attractive powers and advertising value of the opponent's earlier mark can be misappropriated. That may stimulate the sales of the applicant's



goods and services to an extent which may be disproportionately high in comparison to the size of its own promotional investment and thus lead to the unacceptable situation where the applicant is allowed to take a ‘free-ride’ on the investment of the opponent in promoting and building-up the value of its mark.

*d) Due cause*

- 62 Article 8(5) EUTMR makes an opposition by an earlier trade mark with repute subject to the lack of due cause for using the trade mark applied for. Such a reference to ‘due cause’ means that the applicant would be allowed to use the mark applied for, notwithstanding the unfair advantage which might be taken of the opponent’s mark, in circumstances where it could not reasonably be required to abstain from such use.
- 63 It must be recalled that the applicant has claimed due cause for use of the contested trade mark based on the fact that its company name is ‘PEAR TECHNOLOGIES LIMITED’, which is also original, distinctive and unusual in the field of digital marketing and customer relation management (CRM) and also because it has got a EUTM for the word ‘Pear’ registered on 7 August 2015, which in fact postdates the filing date of the contested application.
- 64 However, as the opponent correctly states, the applicant by choosing a similar fruit to indicate its undertaking is clearly attempting to align itself with the opponent by choosing a mark that will bring the opponent and its ‘Apple’ logo to mind. In particular, the applicant has chosen the pear fruit as its identifier, both through using the word mark and a pear device, noting that a pear is the closest fruit possible to an apple in terms of science, language and consumers’ perception. In addition the goods and services applied for are identical and similar with the goods and services of the earlier mark. The applicant merely intended to draw an association with the ‘Apple’ logo and to register and use the mark that is as close as possible to the opponent’s identity and its marks given its fame and reputation.
- 65 Consequently, in the absence of any indications in the evidence providing an apparent justification for the applicant’s use of the contested mark, the lack of due cause must be generally presumed (29/03/2012, T-369/10, *Beatle*, EU:T:2012:177, § 76).
- 66 The Board concludes, in line with the Opposition Division, that in view of the substantial exposure of the public to the opponent’s earlier reputed mark, in relation to the goods and services for which a reputation has been found and taking into account the somewhat low, yet existing similarity between the signs, there exists a probability that the use without due cause of the contested sign in respect of the contested goods and services in Classes 9, 35 and 42 may acquire some unearned benefit and lead to free-riding, that is to say, it would take unfair advantage of the distinctive character and the repute of the earlier trade mark.
- 67 In view of the above considerations, the Board concludes that the conditions of Article 8(5) EUTMR are fulfilled as the contested mark can be associated with the earlier mark and, in view of the identity between the goods and services, it is capable of taking unfair advantage of the well-established reputation of the

earlier trade mark and the considerable investment undertaken by the opponent to achieve that reputation.

- 68 Considering all the above, the opposition is well founded under Article 8(5) EUTMR and the contested mark must be rejected for all the goods and services. Therefore, it is not necessary to examine the remaining grounds and earlier rights on which the opposition is based.
- 69 Accordingly, the appeal is dismissed and the contested decision is confirmed.

### **Costs**

- 70 In accordance with Article 85(6) EUTMR and Rule 94(7)(d) CTMIR the Board of Appeal fixes the costs. The cost award at first instance is confirmed (where the applicant was ordered to bear the costs) and given the dismissal of the appeal, the Board fixes the amount of costs to be reimbursed by the applicant to the opponent at EUR 550 for representation costs with respect to the appeal proceedings.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to pay the opponent EUR 550.**

Signed

G. Humphreys

Signed

V. Melgar

Signed

A. Pohlmann

Registrar:

Signed

H.Dijkema

