



OPPOSITION No B 2 215 401

Bigben Interactive, Société Anonyme, 396/466 rue de la Voyette Crt 2, 59273 Fretin, France (opponent), represented by **Novagraaf Belgium S.A./N.V.**, Chaussée de la Hulpe 187, 1170 Brussel, Belgium (professional representative)

a g a i n s t

NHS Inc., 104 Bronson Street, Suite #9, Santa Cruz 95062, United States of America (holder), represented by **Njord Law Firm Advokatpartnerselskab**, Pilestræde 58, 1112 Copenhagen, Denmark (professional representative)

On 19/06/2015, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 215 401 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against all the goods of international registration designating the European Union No 1 130 965 for the figurative mark

CREATURE, namely:

Class 25: *Clothing, namely, tops, tank tops, t-shirts, long-sleeve shirts, sweatshirts and jackets; headwear, caps and beanies; socks.*

Class 28: *Skateboards.*

The opposition is based on all the goods in Classes 9, 16 and 28 of Community trade mark registration No 1 625 581 for the word mark 'CREATURES'. The opponent invoked Article 8(1)(b) CTMR.

PROOF OF USE

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

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

As regards international registrations designating the European Union, the 'date of publication of the contested mark' within the meaning of Article 42(2) CTMR for the purposes of establishing the five-year period of use obligation for the earlier mark is considered to be six months after the first republication of the international registration, that is, the beginning of the opposition period (Article 156 CTMR in conjunction with Article 152 CTMR). The opponent's mark is under use obligation if at the beginning of the opposition period, namely six months after the date of the first republication of the IR, it had been registered for more than five years.

The holder requested that the opponent submit proof of use of Community trade mark No 1 625 581.

The request was submitted in due time and is admissible given that the earlier trade mark was registered more than five years prior to the relevant date (first republication of the contested IR + six months).

The relevant date (first republication of the contested IR + six months) is 19/04/2013. The opponent was therefore required to prove that the trade mark on which the opposition is based was put to genuine use in the European Union from 19/04/2008 to 18/04/2013 inclusive. Furthermore, the evidence must show use of the trade mark for the goods on which the opposition is based, namely the following:

Class 9: Computer programs; computer programs for the generation of computer games; computer games; computer programs enabling real-time interaction with synthetic software agents within a simulated environment; computer programs for applying artificial life techniques and algorithms; data storage media pre-recorded with computer programs.

Class 16: Printed matter; printed publications; instructional and teaching material; books, manuals, periodicals, magazines; catalogues and directories; calendars; posters; stationery; graphic representations and reproductions; transfers; writing instruments.

Class 28: Games; toys; computer games; electronic games; video games; electronic toys; board games.

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

On 13/06/2014, in accordance with Rule 22(2) CTMIR, the Office gave the opponent until 25/08/2014 to submit evidence of use of the earlier trade mark. This time limit was subsequently extended by two months. Within the set time limit, the opponent submitted evidence of use.

The evidence to be taken into account is the following:

- Excerpts from the websites creatures-online.co.uk, creatures-online.fr and creatures-online.nl in English, French and Dutch, which, according to the opponent, were launched in 2012, as well as an excerpt from the game's Facebook page, displaying the trade mark



, all dated 22/08/2014 **(Item I)**.

- Press releases from the opponent in French and in English, dated May 2011 and May 2013, and several communications on its website www.bigben.fr and www.bigben-interactive.co.uk, dated 22/08/2014, relating to the release of the opponent's online computer game Creatures **(Item II)**.
- Search results and an article published on the blog fishingcactus.com relating to the development of the game Creatures, dated 2011-2012 **(Item III)**.
- Articles from various websites relating to the release of the game Creatures in 2011, not translated, dated 2011 **(Item IV)**.

Having examined the evidence of use submitted by the opponent, the Opposition Division finds that it does not demonstrate that the earlier Community trade mark has been used for any of the goods for which it is registered.

The documents submitted by the opponent consist mostly of excerpts from its websites, advertisements and press releases. In most of them, the earlier trade mark is not even displayed in relation to the goods at stake. All the documents submitted by the opponent mention the name 'Creatures' in relation to a computer game, popular in 1996-2001, which was about to be 'reinvigorated' and delivered to the users on the license by the opponent in cooperation with Fishing Cactus and the IP rights owner, Gameware. No proof that the game was actually launched and the mark 'Creatures' used in relation to the relevant goods in the relevant period was submitted by the opponent.

Most of the materials come directly from the opponent or economically linked entities (in this case the blog fishingcactus.com). As far as the probative value of this kind of evidence is concerned, documents coming directly from the interested parties themselves or their employees are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by its personal interests in the matter.

The final outcome depends on the overall assessment of the evidence in the particular case. This is because, in general, further evidence is necessary to establish use, since such statements have to be considered as having less probative value than physical evidence (labels, packaging, etc.) or evidence originating from independent sources.

The opponent did not submit any invoices, affidavits, turnover and sales figures or samples of the products/packaging. There are no indications concerning the place, time, extent or nature of the use of the earlier mark. Furthermore, the website extracts are dated after the relevant period.

As regards the extent of use, all the relevant facts and circumstances must be taken into account, including the nature of the relevant goods or services and the characteristics of the market concerned, the territorial extent of use, its commercial volume, duration and frequency.

The documents filed by the opponent do not provide the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use.

Therefore, the Opposition Division considers that the opponent has not provided sufficient indications concerning the extent of the use of the earlier mark.

The Court of Justice has held that there is 'genuine use' of a mark where it is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Furthermore, the condition of genuine use of the mark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (judgment of 11/03/2003, C-40/01, 'Ansul' and judgment of 12/03/2003, T-174/01, 'Silk Cocoon').

The Opposition Division concludes that the evidence furnished by the opponent is insufficient to prove that the earlier trade mark was genuinely used in the relevant territory during the relevant period of time.

Therefore, the opposition must be rejected pursuant to Article 42(2) CTMR and Rule 22(2) CTMIR.

It should be noted, however, that, even had the evidence submitted been sufficient to show genuine use of the earlier mark, it would have established genuine use only in relation to one category of products, namely *computer games* in Class 28. Moreover, had genuine use been established, the outcome of the case would not have been affected, as computer games are in fact dissimilar to the contested goods, which are the following:

Class 25: *Clothing, namely, tops, tank tops, t-shirts, long-sleeve shirts, sweatshirts and jackets; headwear, caps and beanies; socks.*

Class 28: *Skateboards.*

Contested goods in Class 25

The goods of the earlier mark and the contested goods in Class 25 are clearly dissimilar. The contested goods are clothing, headgear and socks. The nature and purpose of these goods are different. These goods have different distribution channels, sales outlets, producers and method of use, and they are neither complementary nor in competition.

Contested goods in Class 28

Although the goods in question may coincide in their very broad purpose and end consumers – both are used for leisure activities and amusement purposes – they are dissimilar. Aside from being different in nature, given that computer games, as a type of software, are intangible, whereas skateboards are tangible, the goods differ in their nature and method of use, are produced by different manufacturers and do not have the same distribution channels or points of sale. Moreover, the goods are neither in competition nor complementary. Using a skateboard is akin to the practice of a sport, a physical activity, while playing computer games is a passive leisure activity.

According to Article 8(1)(b) CTMR, the similarity of the goods or services is a condition for a finding of likelihood of confusion. Since the goods are clearly

dissimilar, one of the necessary conditions of Article 8(1)(b) CTMR is not fulfilled, and the opposition would be rejected even if the opponent had shown use for the particular good to which the evidence solely refers.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the holder in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) CTMIR, the costs to be paid to the holder are the costs of representation which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Plamen IVANOV

Eamonn KELLY

Gordana TRIPKOVIĆ

According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.