

OPPOSITION No B 2 566 290

Disney Enterprises, Inc., 500 South Buena Vista Street, Burbank, California 91521, United States of America (opponent), represented by **Mitscherlich, Patent- Und Rechtsanwälte, PartmbB**, Sonnenstraße 33, 80331 Munich, Germany (professional representative)

a g a i n s t

Disnomur S.L., C/ Salto De Usero S/N, 30180 Bullas, Spain (applicant), represented by **Luis Salomón Ela Ayacaba**, avda. General Primo de Rivera, 9 entlo. C 30008 Murcia, Spain (professional representative).

On 31/01/2018, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 566 290 is partially upheld, namely for the following contested goods and services:

Class 16: *Face cloths made of paper, Hygienic paper, Paper towels, Table napkins of paper, Kitchen rolls [paper].*

Class 35: *Advertising, business management, business administration, office functions, import-export, trade fairs for commercial purposes.*

Class 39: *Transport, distribution, packaging and storage of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper.*

2. European Union trade mark application No 13 904 032 is rejected for all the above goods and services. It may proceed for the remaining services.
3. Each party bears its own costs.

As from 01/10/2017, Regulation (EC) No 207/2009 and Regulation (EC) No 2868/95 have been repealed and replaced by Regulation (EU) 2017/1001 (codification), Delegated Regulation (EU) 2017/1430 and Implementing Regulation (EU) 2017/1431, subject to certain transitional provisions. All the references in this decision to the EUTMR, EUTMDR and EUTMIR shall be understood as references to the Regulations currently in force, except where expressly indicated otherwise.

REASONS

The opponent filed an opposition against all the goods and services of European Union trade mark application No 13 904 032. The opposition is based on the following earlier rights:

- European Union trade mark registration No 186 569 'DISNEY' (word mark)

- European Union Trade Mark Registration No 872 721 'EURO DISNEY' (word mark)
- European Union Trade Mark Registration No 953 356 'DISNEY STUDIOS' (word mark)
- European Union Trade Mark Registration No 6 183 991 'DISNEY CRUISE LINE' (word mark)

The opponent invoked Articles 8(1)(a), 8(1)(b) and 8(5) EUTMR.

LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods and services

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

European Union Trade Mark Registration No 186 569 'DISNEY' (word mark)

Class 3: *Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.*

Class 6: *Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal, locksmith's work; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.*

Class 8: *Hand tools and implements (hand operated); cutlery, forks and spoons; side arms, razors.*

Class 9: *Scientific, nautical, surveying, electric (not included in other classes), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculation machines and data processing equipment; fire-extinguishing apparatus.*

Class 11: *Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.*

Class 12: *Vehicles; apparatus for locomotion by land, air or water.*

Class 14: *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments*

Class 15: *Musical instruments.*

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material, photographs; stationery; 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 on other classes); playing cards; printers' type; printing blocks.*

Class 18: *Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.*

Class 20: *Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.*

Class 21: *Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.*

Class 24: *Textiles and textile goods, not included in other classes; bed and table covers.*

Class 25: *Clothing, footwear, headgear.*

Class 26: *Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.*

Class 27: *Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).*

Class 28: *Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.*

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard, vinegar, sauces (condiments); spices, ice.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

Class 35: *Advertising and business.*

Class 38: *Communication.*

Class 41: *Education and entertainment.*

Class 42: *Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; drawing up of plans and consultation for construction; services of hotels, restaurants and cafés; vocational guidance; undertaking and cremation; care of graves; camping, public baths, swimming pools and sauna services; protection and supervision of persons and buildings; services of gardeners, landscape decorators, architects, chemists, physicists, doctors, engineers, opticians, interpreters, translators and land surveyors; services of holiday camps, sanatoria, hospitals, medical, bacteriological or chemical laboratories; services of hairdressing salons and beauty parlours; dating services and marriage bureaux; computer programming; surveying by engineers or in laboratories; costume and dress rental; investigations after persons and concerning legal affairs; photography and photographic reporting; technical consultation, animal breeding; rental of data processing equipment; rental of automatic vending machines; consulting concerning industrial property; technical and legal research concerning the protection of industrial property; copyright management; material testing; weather forecasting; reservation (rental) of rooms.*

European Union Trade Mark Registration No 872 721 'EURO DISNEY' (word mark)

Class 9: *Recording discs, tape and film cassettes, sound tapes; exposed and recorded films, in particular feature films, television films, sound films, picture-and-sound films, video films; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, CD's, cassettes; recorded and unrecorded video cassettes.*

Class 14: *Jewelry, including charms, necklaces, bracelets, pins, earrings and rings, watches and watch bracelets.*

Class 16: *Stationery, stationery for writing and painting, printed matter, books, including comic books, journals.*

Class 24: *Household linen, table and bed linen, bedspreads, comforters, curtains and drapes, draperies, towels, tablecloths, napkins and placemats.*

Class 25: *Clothing, footwear, headgear.*

Class 28: *Games and playthings, including plush toys and dolls; sports equipment.*

Class 39: *Arranging of tours, travel agencies, agencies for the transport of persons, organization of sightseeing tours, escorting of travelers.*

Class 41: *Services provided by a leisure and amusement park in the field of education and entertainment; publication and issuing of books and journals; supplying subscriptions to newspapers; rental of books; training of animals, popular entertainment; broadcast and/or television entertainment; production of records, sound tapes, tape cassettes and films; rental of films, records, projectors and*

accessories as well as show scenery; film projection; distribution of magazines; organization of competitions of instructive and entertaining contents.

European Union Trade Mark Registration No 953 356 'DISNEY STUDIOS' (word mark)

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; toothpaste.

Class 4: Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks (lighting).

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes and for personal hygiene; dietetic substances adapted for medical use; food for babies; plasters, materials for dressings (except instruments); material for stopping teeth, dental wax; disinfectants for medical or sanitary purposes (other than soaps); preparations for destroying vermin; fungicides; herbicides.

Class 8: Hand tools and implements (hand operated); knives, non-electric; table forks; spoons other than for fishing and for administering medicine; side arms; razors.

Class 9: Scientific (other than for medical purposes), nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic recording media; gramophone records; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines; data-processing equipment and computers; fire-extinguishing apparatus.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, lamps.

Class 12: Vehicles; apparatus for locomotion by land, air or water.

Class 14: Precious metals and their alloys other than for dental purposes; jewellery; jewellery; precious stones; clock and watch-making; chronometric instruments.

Class 15: Musical instruments.

Class 16: Paper and cardboard (unprocessed, semi-finished or for stationery); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); playing cards, printers' type; printing blocks.

Class 18: Leather and imitations of leather; animal skins; trunks and travelling bags; umbrellas; parasols and walking sticks; whips, harness and saddlery.

Class 20: Furniture; mirrors (looking glasses), frames (except for building); works of art or decorative items of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21: *Non-electric household or kitchen utensils and containers (not of precious metals or coated therewith); combs and sponges, brushes (excluding paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); tableware of glass, porcelain and earthenware.*

Class 24: *Fabrics for textile use; bed and table covers.*

Class 25: *Clothing (apparel), footwear (except orthopaedic footwear); headgear.*

Class 26: *Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.*

Class 27: *Carpets, door mats, mats, linoleum, floor coverings (except tile floorings and floor paints); wall hangings (non-textile).*

Class 28: *Games and playthings; gymnastic and sporting articles (except clothing, footwear and mats); decorations for Christmas trees.*

Class 29: *Meat and meat extracts, fish, poultry and game, preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.*

Class 30: *Coffee, artificial coffee, tea, cocoa, sugar; rice, tapioca, sago; flour; preparations made from cereals, bread, pastry, yeast, baking-powder; confectionery, ices; honey, treacle; salt; mustard; vinegar; sauces (condiments); spices; ice.*

Class 31: *Agricultural, horticultural and forestry products (neither prepared, nor processed); seeds; fresh fruits and vegetables; foodstuffs for animals; live animals; natural plants and flowers.*

Class 32: *Non-alcoholic drinks and preparations for making beverages (except coffee, tea or cocoa-based beverages and milk beverages); beers; mineral and aerated waters; fruit drinks and fruit juices; syrups.*

Class 35: *Advertising; business management; business administration; office functions.*

Class 36: *Insurance underwriting; financial affairs; monetary affairs; real-estate affairs.*

Class 37: *Construction; repair; installation services.*

Class 38: *Telecommunications.*

Class 39: *Transport; packaging and storage of goods; travel arrangement.*

Class 41: *Education; training; entertainment; sporting and cultural activities.*

Class 42: *Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming.*

European Union Trade Mark Registration No 6 183 991 'DISNEY CRUISE LINE'
(word mark)

Class 39: *Transport; packaging and storage of goods; travel arrangement.*

Class 41: *Education; providing of training; entertainment; sporting and cultural activities.*

Class 43: *Services for providing food and drink; temporary accommodation.*

The contested goods are the following:

Class 16: *Face cloths made of paper, Hygienic paper, Paper towels, Table napkins of paper, Kitchen rolls [paper].*

Class 35: *Advertising, business management, business administration, office functions, import-export, trade fairs for commercial purposes, retailing, wholesaling, sale via global computer networks of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper.*

Class 39: *Transport, distribution, packaging and storage of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper.*

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

Contested goods in Class 16:

According to the Guidelines on Classification and the Common Communication on the Common Practice on the General Indications of the Nice Class Headings (28/10/2015), '*goods made from these materials [paper]*, not included in other classes' in Class 16 covered by European Union Trade Mark Registration No 186 569 'DISNEY' lack the clarity and precision to specify the scope of protection that they give as they do not provide a clear indication of which paper goods are covered. Paper goods can have different characteristics or different purposes, they may require very different levels of technical capabilities and know-how to be produced and/or used, could target different consumers, be sold through different sales channels, and therefore relate to different market sectors.

Nevertheless, the opponent's '*goods made from these materials [paper]*, not included in other classes' and the contested *face cloths made of paper, hygienic paper, paper towels, table napkins of paper, kitchen rolls [paper]* coincide in their nature. Their purpose, in the broadest sense, may also be the same in that they are easily disposable products for use around the household. To that extent these goods are similar to a low degree. However, in the absence of an express limitation by the opponent in order to clarify its goods, it cannot be assumed that they coincide in other criteria.

Contested services in Class 35:

Advertising, business management, business administration, office functions identically appear on the applicant's list as well as on the list of the opponent covered by European Union Trade Mark Registration No 953 356 'DISNEY STUDIOS'. Consequently, the services are identical.

The contested *trade fairs for commercial purposes* consist of the organisation of events for commercial and promotional purposes. Therefore, these services are similar to a low degree to the opponent's *advertising* covered by European Union Trade Mark Registration No 953 356 'DISNEY STUDIOS', as they have the same promotional purpose and the same end users, namely companies that wish to acquire a competitive advantage or reinforce their position in the market through publicity.

Retail services allow consumers to satisfy different shopping needs in one place and are usually directed at the general consumer. They can take place in a fixed location, such as a department store, supermarket, boutique or kiosk, or in the form of non-shop retailing, such as through the internet, by catalogue or mail order.

To this extent, the contested *retailing, wholesaling, sale via global computer networks of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper* have no point of connection with any of the services of the opponent in Classes 35, 36, 37, 38, 39, 41, 42 and 43 given that they concern services provided by different companies, and to different consumers. As for Class 35, none of the opponent's earlier marks cover retail services and the business administration, office functions, advertising services are provided by distinct undertakings with a distinct purpose. They are not complementary or in competition. The other services of the opponent are even further apart in terms of the Canon criteria.

As for the goods covered by the earlier marks, apart from being different in nature, given that services are intangible whereas goods are tangible, they serve different needs. Furthermore, the method of use of those goods and services is different. They are neither in competition with, nor necessarily complementary to, each other.

Retail services concerning the sale of particular goods are similar (to a low degree) to these particular goods only (judgment of 05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 33). However, none of the earlier marks have protection for *paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper*. As seen above, the closest link found between the opponent's and the applicant's goods in Class 16 is a low degree of similarity, and this link cannot be extrapolated to also apply to the sale of these products, where similarity only exists in the case of identical products.

As regards the rest of the goods covered by the opponent's earlier marks, retail services relating to the sale of particular goods and other goods are not similar. It should be remembered that in principle goods are not similar to services. Too broad a protection would be given to retail services if similarity were found even where the goods sold at retail were highly similar to the goods covered by the other mark.

Therefore, the contested *retailing, wholesaling, sale via global computer networks of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper* are dissimilar to all the goods and services covered by the earlier marks.

Contested services in Class 39:

Transport, distribution of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper fall into the broad categories of the opponent, covered by the earlier European Union Trade Mark No 953 356 'DISNEY STUDIOS', *transport of goods*. Therefore, the services are identical.

Packaging and storage of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper fall into the broad categories of the opponent, covered by the earlier European Union Trade Mark No 953 356, *packaging and storage of goods*. Therefore, the services are identical.

The Opposition Division finds it appropriate to proceed with the comparison of the signs taking into consideration only European Union Trade Mark Registrations Nos 186 569 'DISNEY' and 953 356 'DISNEY STUDIOS' since similarity of the goods and services have been established for goods and services covered by these marks.

b) Relevant public — degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods and services found to be identical or similar to a low degree are directed at the public at large (goods in Class 16) as well as an expert professional public (services in Class 35 and 39).

The degree of attention is considered to vary from average to high depending on the expertise of the relevant public and the cost of the services.

c) The signs

(1) EUTM No 186 569

DISNEY

(2) EUTM No 953 356

DISNEY STUDIOS

Earlier trade marks

Contested sign

The relevant territory is the European Union.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in

mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C 514/06 P, Armafoam, EU:C:2008:511, § 57). Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

'DISNEY' and 'DISNI' are pronounced identically in English. Therefore, the Opposition Division finds it appropriate to focus the comparison of the signs on the English-speaking relevant public.

The earlier marks are word marks 'DISNEY' and 'DISNEY STUDIOS' respectively. The contested mark consists of the word element 'Disni' written in standard blue lower case letters in front of the drawing of a yellow building. 'DISNEY' will be understood by the relevant public as the surname of *'Walt(er Elias) 1901–66, US film producer, who pioneered animated cartoons: noted esp for his creations Mickey Mouse and Donald Duck and films such as Fantasia.'* (Online Collins Dictionary). 'Disni' is a meaningless term which may nevertheless be associated with the above concept by part of the relevant public, given that it is pronounced identically. 'STUDIOS' refers to *'a room used to record television or radio programmes, make films, etc or the premises of a radio, television, or film company'*. None of these terms have a relation to the goods and services in conflict and therefore their distinctiveness is normal. The same applies to the drawing of the building.

Visually, the signs coincide in 'DISN' and differ in 'EY'/'i' and 'STUDIOS' as for the earlier mark (2).

Consumers generally tend to focus on the beginning of a sign when they encounter a trade mark. This is because the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader. Therefore it is relevant that the coincidence concerns the first four letters of the signs.

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T 312/03, Selenium-Ace, EU:T:2005:289, § 37). Therefore, the image of the building will attract consumers' attention less.

Therefore, the signs are visually similar to an average degree.

Aurally, as explained above, there is identity as far as the earlier mark (1) is concerned. In relation to the earlier mark (2) there is a medium degree of aural similarity because the signs coincide in 'DISNEY'/'DISNI' and differ in 'STUDIOS'

Conceptually, as explained above, part of the public might perceive a conceptual link between 'DISNEY' and 'DISNI', while the signs in any event will differ in the concept of the building in the contested mark, and as for the earlier mark (2) also in the concept of 'STUDIOS'. For this part of the relevant public there is a low degree of conceptual

similarity. The rest of the relevant public will not grasp the conceptual link between the signs and thus the signs will be conceptually not similar.

Taking into account that the signs have been found similar in at least one aspect of the comparison, the examination will proceed.

d) Distinctiveness of the earlier marks

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier marks have been extensively used and enjoy an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed at this point (see below in 'Global assessment').

Consequently, the assessment of the distinctiveness of the earlier marks will rest on their distinctiveness per se. In the present case, the earlier trade marks as a whole have no meaning for any of the goods and services in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier marks must be seen as normal.

e) Global assessment, other arguments and conclusion

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings.

The goods in Class 16 are similar to a low degree to the goods of the earlier mark 'DISNI'. In light of the aural identity, consumers with an average degree of attentiveness will readily assume that the goods come from the same or economically linked undertakings.

The same applies to services which have been found identical, or even those found similar to a low degree to the earlier mark 'DISNEY STUDIOS'. The earlier sign aurally fully includes, in its beginning, the only verbal element of the contested sign, which attracts consumers' attention more than the differing figurative element or 'STUDIOS'.

Consequently, the differences are not sufficient to counteract the similarities and consumers with an average, even those with a high degree of attentiveness are likely to attribute the services to the same or economically linked undertakings.

Considering all the above, there is a likelihood of confusion on the part of the English-speaking part of the public. As stated above in section c) of this decision, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

Therefore, the opposition is partly well founded on the basis of the opponent's European Union Trade Mark Registrations Nos 186 569 'DISNEY' and 953 356 'DISNEY STUDIOS'.

It follows from the above that the contested trade mark must be rejected for the goods and services found to be identical or similar to a low degree to those of the earlier trade mark.

The rest of the contested services are dissimilar. As similarity of goods and services is a necessary condition for the application of Article 8(1) EUTMR, the opposition based on this Article and directed at these services cannot be successful.

Since the opposition is partially successful on the basis of the inherent distinctiveness of the earlier marks there is no need to assess the enhanced degree of distinctiveness of the opposing marks due to their reputation as claimed by the opponent and in relation to identical and similar goods and services. The result would be the same even if the earlier marks enjoyed an enhanced degree of distinctiveness.

Likewise, under the ground of Article 8(1)(b) EUTMR there is no need to assess the claimed enhanced degree of distinctiveness of the opposing marks in relation to dissimilar services, as the similarity of goods and services is a *sine qua non* for there to be likelihood of confusion. The result would be the same even if the earlier marks enjoyed an enhanced degree of distinctiveness.

The other earlier rights invoked by the opponent, European Union Trade Mark Registrations No 872 721 'EURO DISNEY' (word mark) and No 6 183 991 'DISNEY CRUISE LINE' (word mark) cover goods and services, which, as seen above, are clearly different to the contested *retailing, wholesaling, sale via global computer networks of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper* in Class 35. Therefore, the outcome cannot be different with respect to these contested services for which the opposition has already been rejected; no likelihood of confusion exists with respect to those services.

For the sake of completeness, it must be mentioned that the opposition must also fail insofar as based on grounds under Article 8(1)(a) EUTMR and directed against the remaining services because the signs are obviously not identical.

The examination of the opposition will proceed with the ground of Article 8(5) EUTMR also invoked by the opponent, as far as the dissimilar services are concerned.

REPUTATION — ARTICLE 8(5) EUTMR

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds for refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) Reputation of the earlier trade marks

According to the opponent, the earlier trade marks have a reputation in the European Union and its Member States.

Reputation implies a knowledge threshold that is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public. Reputation is claimed for all the goods and services on which the opposition is based, in Classes 3, 4, 5, 8, 9, 11, 12, 14, 15, 16, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 31, 32, 35, 36, 37, 38, 39, 41 and 42 and 43.

In the present case, the contested trade mark was filed on 01/04/2015. Therefore, the opponent was required to prove that the trade marks on which the opposition is based had acquired a reputation in the European Union prior to that date. The evidence must also show that the reputation was acquired for the goods and services for which the opponent has claimed reputation, namely all the goods and services on which the opposition is based in classes listed above. The opponent referred to the earlier marks' reputation, in particular, in relation to entertainment/entertainment related services in Class 41.

The remaining, dissimilar services the opposition is directed against are the following:

Class 35: *Retailing, wholesaling, sale via global computer networks of all kinds of paper face wipes, toilet paper, paper hand towels, paper serviettes, kitchen paper.*

When the opposition is based on a mark with reputation within the meaning of Article 8(5) EUTMR, the opposing party must provide evidence showing, inter alia, that the mark has a reputation, as well as evidence or arguments showing that use

without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

In order to determine the mark's level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

On 29/01/2016 the opponent submitted the following evidence:

- Exhibit A1: Wikipedia excerpt regarding 'The Walt Disney Company,' 'commonly known as Disney', 'the world's second largest media conglomerate in terms of revenue'
- Exhibit A2: Wikipedia excerpt regarding 'The Walt Disney Studios,' 'one of Hollywood's major film studios'
- Exhibit A3: Wikipedia excerpt regarding 'Disney Cruise Line', offering a variety of destinations including Europe.
- Exhibit A4: Article from <http://variety.com> dated 21/12/2015 reporting that Disney's latest 'Star Wars' movie broke the global (worldwide) box office debut record.
- Exhibit A5: Screenshot from www.forbes.com 'FORBES The World's Most



Valuable Brands', showing as the 11th most valuable brand worldwide in the broadcasting and cable industry, operating through five business segments: media and networks, parks and resorts, studio entertainment, consumer products and interactive media

- Exhibit A6: Screenshot from www.forbes.com, listing 'Disney' as the 14th most valuable brand worldwide

The opponent filed further evidence (namely a further 'Forbes' list) during the course of the opposition proceedings, which, however, cannot be taken into account for the purposes of proving the reputation of the earlier marks on account of it having been filed after the time limit for substantiation. In any event, this evidence has similar nature to the evidence assessed below and consequently it would not change the outcome.

The opponent, essentially, submitted three 'Wikipedia' articles and two 'most valuable brands' lists compiled by 'Forbes'. The Wikipedia articles give information on 'The Walt Disney Studios', resorts, cruise lines, and on the history of the media company 'The Walt Disney Company', including its revenues in USD, however without any breakdown per territory or business activity.

The lists compiled by 'Forbes' make some references to some activities (media, entertainment, consumer products) which may be linked to the goods and services claimed. However, there is no information on any territorial breakdown which could allow for any conclusions to be made as regards the European Union. Furthermore, there is no information on the methodology applied for compiling such lists, the criteria for concluding the value of a brand, and to what extent such list may be useful

to make solid conclusions on the public's recognition of the opponent's marks for the goods and services claimed.

The article appearing in *variety.com* refers to revenues generated by the 'Star Wars' movie but contains no information on the public's recognition of the term 'Disney' or the opponent's earlier marks.

The opponent claims that the Office should be aware of the enormous reputation of 'Disney'.

According to Article 95(1) EUTMR, in proceedings before it the Office will examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office will be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

It follows that the Office cannot take into account any alleged rights for which the opponent does not submit appropriate evidence.

It furthermore follows that in assessing whether the earlier mark enjoys reputation, the Office may neither take into account facts known to it as a result of its own private knowledge of the market nor conduct an *ex-officio* investigation, but should exclusively base its findings on the information and evidence submitted by the opponent.

Exceptions to this rule apply where particular facts are so well-established that they can be considered as universally known and, thus, are also presumed to be known to the Office (e.g. the fact that a particular country has a certain number of consumers, or the fact that food products target the general public). However, whether or not a mark has passed the threshold of reputation established by the Court is not in itself a pure question of fact, since it requires the legal evaluation of several factual indications, and, as such, the reputation of the earlier mark may not be simply assumed to be a universally known fact.

The evidence submitted by the opponent does not demonstrate that the earlier trade marks have acquired a reputation through their use. The evidence provides no information on the territory, time and extent of such use. The material that has been submitted does not provide any indication as regards the degree of recognition of the trade marks among the relevant public. Furthermore, there are no indications as regards the market share of the trade marks and no indications as to the extent to which they have been promoted. As a result the evidence does not show that the trade marks are known by a significant part of the relevant public.

The Opposition Division, therefore, finds that the evidence submitted by the opponent does not demonstrate that the earlier trade marks acquired a reputation.

As seen above, it is a requirement for the opposition to be successful under Article 8(5) EUTMR that the earlier trade mark has a reputation. Since it has not been established that the earlier trade marks have a reputation, one of the necessary conditions contained in Article 8(5) EUTMR is not fulfilled.

In any case, the Opposition Division also notes that the opponent only made some general remarks about unfair advantage or detriment as the unavoidable result of the marks' reputation, high similarity of the signs and identity or high similarity of the goods and services. However, the opponent did not provide any specific facts, arguments or evidence that could support the conclusion that the use of the

contested trade mark for the conflicting services would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade marks.

Therefore, the opposition must be rejected as far as Article 8(5) EUTMR is concerned.



The Opposition Division

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Marianna KONDAS

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According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.