



**OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)**

OPERATIONS DEPARTMENT

B206b

Notification to the applicant/holder of a decision

Alicante, 29/06/2012

Carlo Rossi
B.go Ronchini, 3
I-43100 Parma
ITALIA

Your reference:
Number of the opposition: **B 001812554**
Contested trade mark number: **009494634**
Name of the applicant/holder: **VISLAB S.R.L.**

Please see the attached decision which ends the opposition proceedings referred to above. It was delivered on **29/06/2012**.

Victoria DAFAUCE MENÉNDEZ

Enclosures (excluding the cover letter): 07 pages.

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office according to Rule 55(1) CTMIR.

Dear Recipient of this Opposition Decision,

It is one of OHIM's major objectives to collect information on the quality of the services it delivers as perceived by its users. One of the Key Initiatives of the Strategic Plan relates to conduct a regular and systematic analysis of the quality of its services, and to explicitly solicit feed-back from its users on services of particular interest. First, OHIM will focus on the quality of the Opposition proceedings and decisions.

In this context, we inform you that you will receive in the next few days an email from Quota Research, our consultant in this exercise, at the address you have indicated in our database, inviting you to access the survey.

Should you not have an email address registered with us, we cordially invite you to update your personal records by sending an email to information@oami.europa.eu indicating your email address to be included indicating your ID number and the number of the opposition in question so as to be able to participate in this survey.

We would appreciate if you could answer a few questions about your experience. This survey can be completed within two to three minutes.

Thank you for your collaboration.



OPPOSITION No B 1 812 554

Visionlab, S.A., Calle Francisco Sancha, 20, 28034 Madrid, Spain (opponent),
represented by **Propi, S.L.**, Jorge Juan, 19, 3^a planta, 28001 Madrid, Spain

a g a i n s t

Vislab S.R.L., Via G.P. Usberti, 181/a, 43124 Parma, Italy (applicant), represented by
Carlo Rossi, B.go Ronchino, 3, 43100 Parma, Italy.

On 29/06/2012, the Opposition Division takes the following

DECISION:

1. Opposition number B 1 812 554 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 and services in classes 9, 12 and 42 of Community trade mark application No 9 494 634, based on Community trade mark registration No 3 768 215. The opponent invoked Article 8(1)(b) CTMR.

LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR

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

a) The goods and services

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, sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

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

Class 9: *Scientific, nautical, surveying, electrical, photographic, cinematographic, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus for recording, transmission, reproduction of*

sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus and in particular optical glasses, spectacle glasses, graduated glassware, eyeglass cases, mirrors (optical), spectacles (optical), sunglasses, instruments for spectacles, spectacle frames, correcting lenses (optical), optical lenses, magnifiers (optical), lamps (optical), micrometer screws for optical instruments, sun visors and optical apparatus in general.

Class 35: *Advertising and business included in this class, business management assistance, commercial retailing of spectacles, spectacle frames, sunglasses, correcting lenses, graduated glassware, telescopes, contact lenses, dissemination of advertising matter, direct mail advertising, retailing of products by computer networks, organisation of exhibitions for commercial and/or advertising purposes, franchise-issuing in relation to commercial management assistance.*

Class 44: *Optical, medical services, clinics and ophthalmological clinics*

The contested goods and services are the following:

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating and controlling electricity; 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, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.*

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

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.*

A grammatical interpretation of the wording of the list is required to determine the scope of the goods and services of the two lists that must be compared.

This is especially true where terms such as *in particular, namely*, or their equivalents are used to show the relationship of an individual product with a broader category.

The term *in particular* of the opponent's list (or *for example, such as*, or other equivalents) indicates that the specific goods and services are only examples of items included in the category, and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (on the use of *in particular* see a reference in judgment of 09/04/2003, T-224/01, 'NU-TRIDE').

Contested goods in class 9

The contested *scientific, nautical, surveying, 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, calculating machines, data processing equipment and computers; fire-extinguishing apparatus are equally listed in the earlier mark. Therefore, they are identical.

The contested *apparatus and instruments for conducting, switching, transforming, accumulating, regulating and controlling electricity* are included in the opponent's *electrical apparatus and instruments*. Therefore, they are considered to be identical.

Contested goods in class 12

The contested *vehicles; apparatus for locomotion by land, air or water* have no point of contact with the opponent's goods in class 9. They are all goods of a different nature and with a different purpose. Furthermore they do not share the same end-users or distribution channels. They are neither in competition nor have a complementary character. Therefore, these goods are dissimilar.

Neither do these contested goods have any point of contact with opponent's services in classes 35 and 44. Goods and services can be seen as similar if the relevant consumer would think that they come from the same or economically linked undertakings. The intended purpose of the contested goods and the opponent's services is different. The nature is different, as well as the distribution channels and the prospective purchasers. None of the goods and services fulfils a similar function from the consumer's standpoint. They are neither substitutes for one another nor are they in competition with one another. The relevant consumer will not regard the opponent's services and the contested goods as originating from the same undertaking. Therefore, they are considered to be dissimilar.

Contested services in class 42

The contested *design and development of computer hardware and software* are considered to be similar to the *data processing equipment and computers* covered by the earlier trade mark in class 9. This is because in the field of computer science producers of computers and/or software will also commonly render computer and/or software related services such as the design, development and updating of such goods. Consequently, although the nature of the goods and services is not the same, both the end-users and purpose of the goods and services coincide. Furthermore, they are complementary goods and services.

The remaining *scientific and technological services and research and design relating thereto; industrial analysis and research services* are dissimilar to the opponent's goods and services in classes 9, 35 and 44. The applicant's services are provided by engineers in the fields of science, technology and industry. They are of a specialised nature and are likely to be supplied to businesses developing technologies. In contrast, the opponent's services in class 35 relate to business and retail services which are not related to the contested services in class 42 while the opponent's services in class 44 relate to medical purposes. They have a different public and are produced and provided by different undertakings. Even though the applicant's services in class 42 may require the use of scientific apparatus covered by the opponent's specification in class 9, the link is so remote that it does not give rise to any similarity. In addition, the goods and services are different in nature. Consequently, the goods and services at issue are dissimilar.

b) The signs

VISIONLAB	VISLAB
Earlier trade mark	Contested sign

The relevant territory is the European Union.

Visually, the earlier mark is a word made up of nine letters, whereas the contested mark is word made up of six letters. Therefore, the signs are different lengths. The marks are similar to the extent that they coincide in the letters "VIS**LAB". On the other hand, they differ in the presence of the letters "ION" in the middle of the earlier mark which are not in the contested sign.

Aurally, in some languages, e.g. English and Spanish, the earlier mark will be pronounced, in three syllables as "VI"- "SION"- "LAB". In other languages, e.g. Hungarian, it will be pronounced in four syllables as "VI"- "SI"- "ON"- "LAB". The contested mark will be pronounced throughout the European Union in two syllables, as "VIS"- "LAB". Therefore, the signs are different in length and rhythm in all the relevant languages. In fact, only the last syllables of the marks coincide. Although the signs also have their first three phonemes "V" , "I" and "S" in common, the syllabic structure of the words differs, as been shown above.

Conceptually, in several languages including English, French and Spanish the first part of the earlier mark, "VISION", means the ability of seeing or the image of something. Furthermore, it can be reasonably presumed that it will be understood with the same meaning in other Member States as well as it is a widely known expression and because there are similar corresponding expressions in other languages. The first part "VIS" of the contested mark can have several meanings depending on the relevant language, such as "some" in Danish, "fish" in Dutch, "screw" in French or "dream" in Romanian. However, none of these meanings is related to vision. The last part of both signs "LAB" could be perceived by a part of the relevant public as the abbreviated form of "laboratory" provided that it is separately identified within the contested mark, in which case the signs have this concept in common. In languages where the term "LAB" will not be separately identified within the contested mark, particularly in languages where the first part "VIS" has no meaning (such as in Spanish, German, Polish or Hungarian), the contested sign will not have any meaning, and consequently the signs have no concept in common.

It follows from the above that the signs are similar to a certain degree.

c) Distinctive and dominant elements of the signs

In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

The marks under comparison have no elements which could be considered clearly more dominant (visually eye-catching) in comparison to other elements.

As regards the distinctive elements, the first part of the earlier mark "VISION" will be associated by part of the relevant public with seeing or the image of something. Thus, it is considered that this element is weak for those goods and services which are related to the field of optics or ophthalmology.

To the extent that the last three letters of the signs "LAB" will be perceived as the abbreviated version of "laboratory", this element will be considered weak for those goods and services which are related to the scientific or medical field, such as the opponent's scientific and optical apparatus and instruments and optical and medical services and the contested scientific apparatus and instruments and scientific and technological services or research and industrial analysis and research services.

The part of the relevant public who understands the meaning of these elements will not pay as much attention to these weak elements as to the other more distinctive elements of the marks. Consequently, the impact of this weak element is limited when assessing the likelihood of confusion between the marks at issue.

d) Distinctiveness of the earlier mark

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

The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness *per se*. In the present case, the earlier trade mark as a whole has no meaning in relation to any of the goods and services at hand from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal, despite the presence of some weak elements in the mark as stated above in section c) of this decision.

e) Relevant public – level of attention

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

In the case at hand, the goods and services are directed both at the public at large and a professional public.

f) Global assessment, other arguments and conclusion

The goods and services are partly identical, partly similar, and partly dissimilar.

The conflicting marks have been found only similar to a certain degree, since they coincide in the sequence of letters "V-I-S" at the beginning of the signs and in the letters "L-A-B" at the end of them, which are in the same order in both signs.

However, the additional letters "I-O-N" between these two parts in the earlier mark introduce significant differences from visual, aural and also conceptual point of view. These additional letters make the earlier mark longer than the contested sign and they also introduce other sounds which changes the pronunciation from two syllables in the contested sign to three or four syllables in the earlier mark. Finally, the addition of these three letters in the earlier sign means that it will evoke a different meaning for part of the public. In this regard, it should be noted that although the signs should not be artificially split, the part of the public who understands the meaning of the first part of the earlier sign, "VISION", will naturally divide the sign into two parts and will probably identify the last part of the sign "LAB" as "laboratory". However, in the contested sign, the lack of the meaning in most languages of the first three letters "VIS" will not bring to the mind of the public any artificial division. Rather, they will perceive the contested sign as a whole, which clearly distinguishes it from the earlier mark. This finding is also applicable to those few languages where the initial part "VIS" might evoke some meanings which are, however, completely unrelated to vision.

Hence, the differences between the signs are considered to be more than sufficient to counteract the similarities and just because the signs coincide in some letters, this is not sufficient in itself for a finding of a likelihood of confusion. Therefore, the Opposition Division considers that the relevant public will not believe that the goods and services in question originate from the same company or from economically linked undertakings.

Considering all the above, the Opposition Division finds that there is no likelihood of confusion on the part of the public even though the goods are identical and the services are similar. Therefore, the opposition must be rejected.

Given that the opposition is not successful even on the assumption that the opponent proved genuine use for all the goods and services for which the earlier mark is registered, it is unnecessary to examine the evidence of use filed by the opponent.

COSTS

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

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

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



The Opposition Division

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MENÉNDEZ

Péter SIPOS

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. 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. Under 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.