

OPPOSITION No B 3 173 643

Sennder Technologies GmbH, Genthiner Straße 34, 10785 Berlin, Germany (opponent), represented by **Clover Law Rechtsanwälte Gamer Siegmund Partnerschaft mbB**, Ruckerstraße 4, 10119 Berlin, Germany (professional representative)

a g a i n s t

LPE Poland sp. z o.o., ul. Partynicka 8, 53-031 Wrocław, Poland (applicant), represented by **Biuro Patentowe "iniciator" sp. z o.o.**, ul. Żółkiewskiego 7b/1, 35-203 Rzeszów, Poland (professional representative).

On 28/08/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 173 643 is upheld for all the contested goods and services.
2. European Union trade mark application No 18 675 749 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 28/06/2022, the opponent filed an opposition against all the goods and services of European Union trade mark application No 18 675 749 'OptiSender' (word mark). The opposition is based on, inter alia, European Union trade mark registration No 18 605 756 'sennder' (word mark). The opponent invoked Article 8(1)(b) EUTMR.

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

Pursuant to 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.

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the opponent's European Union trade mark registration No 18 605 756.

a) The goods and services

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

Class 9: *Mobile apps; software.*

Class 42: *Software as a service [SaaS]; IT services.*

The contested goods and services are the following:

Class 9: *Mobile apps; programs for computers; utility software; computer software for database management; mobile software and computer programs for the management of courier shipments in companies; software for optimising the process and costs of courier shipments; process controlling software.*

Class 42: *Design and development of software in the field of mobile applications; hosting of mobile applications; design and development of software for database management; development of databases for courier service providers; software as a service [SaaS]; installation, maintenance and updating of database software.*

Contested goods in Class 9

Mobile apps are identically contained in both lists of goods.

The contested *computer software for database management; utility software; programs for computers; process controlling software; mobile software and computer programs for the management of courier shipments in companies; software for optimising the process and costs of courier shipments* are included in the opponent's broad category of *software*. Therefore, they are identical.

Contested services in Class 42

Software as a service [SaaS] is identically contained in both lists of services.

The contested *design and development of software in the field of mobile applications; hosting of mobile applications; design and development of software for database management; development of databases for courier service providers; installation, maintenance and updating of database software* are included in the opponent's broad category of *IT services*. Therefore, they are identical.

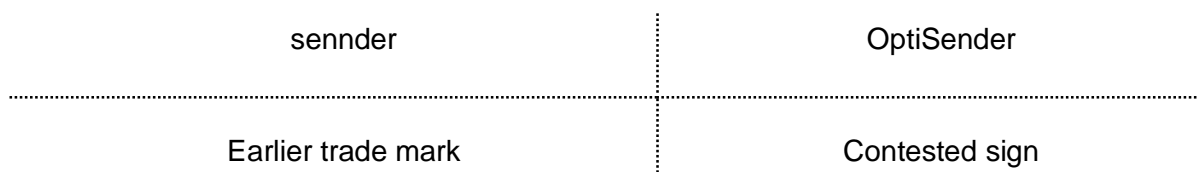
b) Relevant public — degree of attention

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 are directed at the public at large, as well as at business customers with specific professional knowledge or expertise.

The degree of attention may vary from average to high, depending on the specialised nature of the services, the frequency of purchase and their price.

c) The signs



The relevant territory is 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.

The verbal element 'sender' has a meaning for the English-speaking part of the public. However, it is meaningless and, as such, distinctive to an average degree, for other parts of the relevant public, such as for example for **significant part of Bulgarian- and Polish-speaking public**. Since this affects the public's perception of the signs, the Opposition Division finds it appropriate to focus the comparison of the signs on this part of the public.

The contested sign is comprised of a single verbal element. However, as it is depicted in irregular capitalisation, it will be dissected into the components 'Opti' and 'Sender', both meaningless and, as such, distinctive.

The earlier mark, 'sennder', will also be perceived as meaningless and thus distinctive from the perspective of the public analysed.

Visually and aurally, the earlier mark is almost fully reproduced (with the sole exception of the additional 'n' in the earlier mark) in the contested sign where, due to the irregular capitalisation, it is perceived independently. The signs differ in the verbal component 'Opti' placed at the beginning of the contested sign, which has no counterpart in the earlier mark. The signs also differ in the additional letter 'n' in the middle of the earlier mark (i.e. 'sennder' versus 'Sender'), which may be easily overlooked by the public analysed and does not give rise to significant visual or aural differences with regards to the second verbal element in the contested sign.

Although consumers generally pay greater attention to the beginning of a mark than to its end, this finding cannot apply in all cases, nor can it call into question the principle that the examination as to whether the marks are similar must take account of the overall impression created by those marks them (10/10/2006, T-172/05, Armafoam, EU:T:2006:300, § 65; 07/10/2010, T-244/09, Acsensa, EU:T:2010:430, § 23). The assertion that the beginning of the earlier mark is the part that particularly attracts the consumer's attention cannot be assessed independently of the facts of the present case, and in particular the specific characteristics of the signs at issue (13/04/2011, T-228/09, U.S. Polo Assn., EU:T:2011:170, § 37).

In view of the above, the signs are visually and aurally similar to an average degree.

Conceptually, neither of the signs has a meaning and, therefore, the conceptual aspect does not influence the assessment of the similarity of the signs. Therefore, they are conceptually neutral.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

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 claimed, in its observations filed on 19/01/2023, that the earlier mark has been extensively used and gained repute. However, the opponent did not indicate in the notice of opposition, or at any other moment within the opposition period, that Article 8(5) EUTMR was a basis of the opposition. Therefore, the opponent's assertion in this regard is treated as a claim of an enhanced distinctiveness within the application of Article 8(1)(b) EUTMR.

For reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

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 has no meaning for any of the goods and services in question from the perspective of the public on which the assessment is focused. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

The appreciation of likelihood of confusion on the part of the public depends on numerous elements and, in particular, on the recognition of the earlier mark on the market, the association which can be made with the registered mark, the degree of similarity between the marks and between the goods or services identified (eleventh recital of the EUTMR). It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18; 11/11/1997, C-251/95, Sabel, EU:C:1997:528, § 22).

The contested goods and services are identical. They target the public at large, as well as business consumers, who display an average to high degree of attention. The signs are visually and aurally similar to an average degree and conceptually neutral.

The earlier mark is almost fully reproduced in the contested sign where, due to the irregular capitalisation, it is perceived independently. The differing additional letter 'n' in the middle of the earlier mark may be easily overlooked by the public and does not give rise to significant visual or aural differences between the signs. The signs hold no meanings that could help the public to differentiate between them on that basis.

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods or services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C 39/97, Canon, EU:C:1998:442, § 17). In the present case, the coinciding goods and services are identical.

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. Indeed, it is highly conceivable that the relevant consumer, even when displaying a higher than average degree of attention, will perceive the contested mark as a sub-brand or a variation of the earlier mark, configured in a different way according to the type of goods or services that it designates (23/10/2002, T-104/01, Fifties, EU:T:2002:262, § 49).

Considering all the above, the Opposition Division finds that there is a likelihood of confusion at least on the significant part of the Bulgarian- and Polish-speaking part of the public and therefore the opposition is partly well founded on the basis of the opponent's European Union trade mark registration. 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.

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

Since the opposition is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the opponent's mark due to its enhanced distinctiveness as claimed by the opponent. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

As the earlier right No 18 605 756 leads to the success of the opposition and to the rejection of the contested trade mark for all the goods and services against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268).

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

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

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the opponent are the opposition fee and 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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Gracia TORDESILLAS
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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.