

Alicante, 19/12/2016

GEVERS  
Brussels Airport Business Park  
Holidaystraat, 5  
B-1831 Diegem  
BÉLGICA

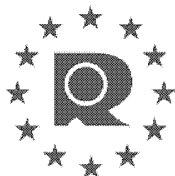
**Notification of a decision to the applicant**

*Your reference:* **2114345-TOP2500602EU00-MOKA-MO**  
*Invalidity number:* **000009936 C**  
*Contested trade mark:* **000982775**  
**IR CANCELLATIONS (Not application)**

Please find attached the decision terminating the proceedings referred to above. The decision was delivered on **19/12/2016**.

**Please note that decisions of the Cancellation Division are not signed by the responsible officials but only indicate their full name and bear a printed seal of the Office in accordance with Rule 55(1) EUTMIR.**

**Carmen SÁNCHEZ PALOMARES**



Enclosures (excluding the cover letter): 16 pages

**CANCELLATION No 9936 C (INVALIDITY)**

**Essege S.A.**, Chaussée de Waterloo 1589 D, 1180 Brussels, Belgium (applicant), represented by **Gevers**, Brussels Airport Business Park, Holidaystraat, 5, 1831 Diegem, Belgium (professional representative)

a g a i n s t

**Ruby Décor B.V.**, Vrekesweid 30-32, 1721 PR Broek OP Langedijk, The Netherlands (IR holder), represented by **DLA Piper Nederland N.V.**, Amstelveenseweg 638, 1081 JJ, Amsterdam, The Netherlands (professional representative).

On 19/12/2016, the Cancellation Division takes the following

**DECISION**

1. The application for a declaration of invalidity is partially upheld.
2. International trade mark registration No 982 775 is declared invalid for the European Union for some of the contested goods, namely:
  - Class 6: *Coverings and materials of metal for fireplaces, (style) fireplaces and fireplace housings; fireplace surrounds and fireplace coverings; furnace fire screens, furnace fireguards; floor surrounds of metal; hearth-plates of metal; fire back of metal; chimney cowls of metal; chimney shafts of metal; chimney pots of metal; chimneys of metal.*
  - Class 11: *Building-in fireplaces; secondary fireplaces and unobstructed fireplaces and stoves; chimney flues; flues; ceramic burners amongst others active on bio-ethanol; gas flues and pipes; ash pans; gas blocks and ghost fires of fireplaces.*
  - Class 19: *Building materials not of metal, amongst others (style)fireplaces, ornaments of plaster cast, decorative frames not of metal, for building purposes; building materials for chimneys, flues, chimney pots, mantle pieces, not of metal; chimneys not of metal.*
3. The international registration remains valid in the European Union for all the remaining goods, namely:
  - Class 19: *Non-metallic transportable buildings; stone.*
4. Each party bears its own costs.

## REASONS

The applicant filed an application for a declaration of invalidity against all the goods of international registration designating the European Union No 982 775. The application is based on, inter alia, Benelux trade mark registration No 540 912. The applicant invoked Article 53(1)(a) EUTMR in connection with Article 8(1)(b) EUTMR.

### SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argues that there is a likelihood of confusion due to the similarity between the signs and the identity and/or similarity between the goods. It adds that the earlier marks 'RUBY' enjoy a high distinctive character.

The IR holder contests the applicant's assertions as regards the similarities of the signs and of the goods under comparison. It argues that it established its business in 1994 in the Dutch market and it has grown to be a player on the European market. It points out that the District Court Noord-Holland stated that the applicant has not used its Benelux trade mark for fireplaces and that it tolerated coexistence between the contested mark 'RUBY FIRES' and the earlier 'RUBY'. The IR holder states that the conflicting marks have coexisted in the market and that there is no likelihood of confusion or association between the signs. Finally, it claims that the earlier marks have a low degree of distinctive character.

Moreover, the IR holder requests the applicant to submit proof of use of the earlier marks on which the applications is based.

In support of its observations, the IR holder filed the following evidence:

- Annex A: Extract from the web page [www.rubyfires.com](http://www.rubyfires.com) on 27/02/2015 which shows pictures of fire places.
- Annex B: Judgement of 11/02/2015 C/15/211097 from the Noord-Holland District Court between the parties.
- Annex C: A report from Carratu International Plc in 2007 about "The trade mark validation of 'RUBY'".
- Annex D: Copy of a request of limitation of the list of the goods and services of the contested IR 982 775 before WIPO. The limitation concerns goods in Class 11.
- Annex E: An extract showing the definition of Ruby.

In reply, the applicant files evidence of use of its earlier marks. It rebuts the IR holder arguments and reiterates its previous observations. It states that it never tolerated the use of the contested mark.

The IR holder argues that the evidence of use filed by the applicant is either insufficient or irrelevant. It adds that some documents are dated outside the relevant period and the relevant area. The IR holder states that if use was proved, it would be for a specific set of products and not for the entire category *heating apparatus*. Finally, it reiterates its previous arguments.

In reply, the applicant points out that the evidence provided is sufficient to prove use of its marks 'Ruby'. It argues that the additions to the term 'Ruby' do not alter the distinctive character of the marks. Finally, it reiterates its previous arguments.

In its final observations, the IR holder insists on the fact that the earlier marks 'RUBY' were not used at all in connection with heating apparatus and challenges the authenticity of the evidence provided by the applicant.

## PROOF OF USE

The application is based on more than one earlier trade mark. The Cancellation Division finds it appropriate to first examine the application in relation to the applicant's Benelux trade mark registration No 540 912.

According to Article 57(2) and (3) EUTMR (as in force at the time of filing of the invalidity application), if the EUTM proprietor so requests, the applicant must submit proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trade mark has been genuinely used in the territories in which it is protected and for the goods or services for which it is registered and which it cites as justification for its application, or that there are proper reasons for non-use. If, at the date on which the contested EUTM application was published, the earlier mark had been registered for not less than five years, the applicant must submit proof that, in addition, the conditions contained in Article 42(2) EUTMR were satisfied at that date.

According to the same provision, in the absence of such proof the application for a declaration of invalidity will be rejected.

For international registrations designating the European Union, the 'date of publication' of the contested mark within the meaning of Article 42(2) EUTMR for the purposes of establishing if proof of use has to be submitted for an additional five-year period is considered to be six months after the first republication of the international registration, that is, the beginning of the opposition period (Article 156 EUTMR in conjunction with Article 152 EUTMR). The applicant has to submit proof of an additional five-year period, in accordance with the second sentence of Article 57(2) EUTMR, if at the beginning of the opposition period, namely six months after the date of the first republication of the contested IR, the earlier mark had been registered for more than five years.

The IR holder requested the applicant to submit proof of use of the trade mark on which the application is, inter alia, based, namely, Benelux trade mark registration No 540 912.

The request has been filed in due time and is admissible given that the earlier trade mark was registered more than five years prior to the date of the application for a declaration of invalidity.

On 07/05/2015 the applicant was given three months to submit proof of use.

The application for a declaration of invalidity was filed on 10/10/2014. The relevant date (first republication of the contested IR + six months) is 13/10/2009. The earlier Benelux trade mark was registered on 17/01/1994. The applicant was, therefore, required to prove that the trade mark on which the application is based was genuinely used in the Benelux countries from 10/10/2009 to 09/10/2014 inclusive, as well as from 13/10/2004 to 12/10/2009 inclusive.

Furthermore, the evidence must show use of the trade mark for the goods on which the application is based, namely:

Class 11: *Heating apparatus.*

According to Rule 40(6) EUTMIR in conjunction with Rule 22(3) EUTMIR, the evidence of use must indicate the place, time, extent and nature of use of the earlier mark for the goods and services for which it is registered and on which the application is based.

On 17/08/2015 the applicant submitted evidence as proof of use. As the applicant requested to keep certain commercial data contained in the evidence confidential vis-à-vis third parties, the Cancellation Division will describe the evidence only in the most general terms without divulging any such data.

The evidence to be taken into account is the following:

Annex 1: Copy of the registration certificates of the earlier marks No 540 912, No 96 713 and No 620 319 respectively.

Annex 2: Extract from the RUBY FIRES website which shows a list of Belgian dealers. Extracts from [www.chemineesliegeois.be](http://www.chemineesliegeois.be), [www.pobra.de](http://www.pobra.de), [www.devos-sierschouwen.be](http://www.devos-sierschouwen.be), [www.emex.de](http://www.emex.de), [www.kachelsvandenberge.be](http://www.kachelsvandenberge.be) and [www.enervro.be](http://www.enervro.be) respectively showing pictures and information of decorative fireplaces and heating apparatus. The extracts are not dated.

Annex 3: Three invoices (attached the bill of lading/packing list) issued from Japan and South Korea to the applicant in 2008 and 2010 respectively. In the description of the goods, the signs Ruby 255/Ruby 240/Ruby KSP 270 refer to Kerosene Heaters. They also include the quantity and the unit prices.

Annex 4: Thirty-eight invoices issued from Essege S.A. and addressed at places in France, the U.K, Belgium, The Netherlands, Italy, Finland and Germany in 2003, 2005, 2006, 2007, 2008, 2009 and 2010. They include the sign 'RUBY', the quantity, the unit price and the total amounts in Euros. In some invoices and next to 'RUBY', the words HEAT and DRY appear and in some others, KSP 225.

Annex 5: Delivery voucher issued by Essege S.A. and addressed at a customer in the UK in 2008. It shows the reference of the articles, the quantity and the sign 'RUBY'.

Annex 6: Advertising brochures in Dutch, in French and in Italian showing pictures of kerosene heaters, oil and kerosene stoves, tower dryer, radial panels and dehumidifiers bearing the sign 'Ruby'. They show the characteristics of the products and the price of the items. Some brochures are undated and some are dated in 1997, 2006, 2007, 2008, 2009, 2010, 2011 and 2012. It shows Gent (Belgium).

Annex 7: Promotional leaflets in French and in Dutch and some parts translated into English which show Ruby products (heaters, dehumidifiers, radiating panels, air conditioners). Next to the sign 'Ruby' there are codes, such as KSP 124 and KSP 127, which refer to the products. It includes a technical description of the products. These leaflets are not dated.

Annex 8: Sales figures (1993-2009) of Ruby products. The source is not identified.

Annex 9: Sales report of the Ruby products from 2007 to 2013 in the Benelux countries (Belgium, Luxembourg and the Netherlands).

Annex 10: Internet archives of the websites Tecno Air system, Essege and Ligne showing Ruby products (heaters).

Annex 11: Extracts from the website www.rubyfires.com dated 17/08/2015 explaining the products such as electric inserts, fireplaces and the user's manual of the products.

Annex 12: Google search on the word 'RUBY' showing pictures of precious stones.

Annex 13: Extract from www.unigro.be which offers RUBY items, namely, bioethanol heaters.

Annex 14: Organisation chart of Tolefi group.

Annex 15: Extracts from dictionaries showing the definition of Ruby.

*Preliminary remark: Use by a person other than the applicant*

Some of the evidence of use filed by the applicant does not originate from, or relate to, the applicant itself but another company, namely, Tecno Air Systems srl.

According to Article 15(2) EUTMR, use of the European Union trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor. Although this provision covers EUTMs, it can be applied by analogy to earlier marks registered in Member States.

In its observations, the applicant points out that Tecno Air Systems srl is a subsidiary company of Essegé. To this extent, and in accordance with Article 15(2) EUTMR, the Cancellation Division considers that the use made by this other company was made with the applicant's consent and thus is equivalent to use made by the applicant.

*Assessment of evidence*

As regards **place of use**, trade marks must be used in the territory where they are protected. In the present case, some of the invoices (annex 4), the sales reports (annex 9) and the advertising brochures (annex 6) are addressed at places in the Netherlands, Belgium and Luxembourg.

Trade marks must be used in the territory where they are protected (European Union for EUTMs, the territory of the Member State for national marks or Benelux for Benelux marks and the territories of the relevant countries for international registrations). It has to be noted that the Benelux is considered as one single territory, therefore, use shown in Belgium and the Netherlands is sufficient to consider that the earlier mark was used in the Benelux.

In the case at hand, the information contained in the invoices which is supported by additional evidence (advertising brochures and sales figures) is sufficient to demonstrate the place of use of the earlier mark.

As far as the **time of use** is concerned, the IR holder contends that some of the documents are not dated therefore they should not be taken into account.

In the present case, the Cancellation Division points out that some documents are not dated and others are dated beyond the relevant period. However, from the invoices, the sales reports and the brochures, it is clearly shown that the evidence relates to the relevant periods and that the requirement of use of the earlier trade mark in the relevant periods, namely, from 10/10/2009 to 09/10/2014 inclusive, as well as from 13/10/2004 to 12/10/2009 inclusive was met.

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 assessment of genuine use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. Likewise, the territorial scope of the use is only one of several factors to be taken into account, so that a limited territorial scope of use can be counteracted by a more significant volume or duration of use.

The invoices show the amounts corresponding to the mark 'Ruby' within the relevant periods. The amounts are expressed in Euros being regular during the relevant periods and targeting several places within the relevant territories, although the names of the addresses are blacked out. The sign 'Ruby' appears with some figures (for instance KSP 225) which can be cross-referenced with the type of products as shown in the brochures. They allow the Cancellation Division to identify the earlier mark 'RUBY' with the goods.



All this information, supported by the remaining documents (sales figures and sales reports), provides the Cancellation Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use of the earlier mark.

In the context of Rule 22(3) EUTMR, the expression '**nature of use**' includes evidence of the use of the sign as a trade mark in the course of trade, of the use of the mark as registered, or of a variation thereof according to Article 15(1), second subparagraph, point (a) EUTMR, and of its use for the goods and services for which it is registered.

Nature of use requires, inter alia, that the earlier trade marks are used as trade marks that are for identifying origin, thus making it possible for the relevant public to distinguish between goods and services of different providers.

In the present case, the majority of the documents show that the earlier sign 'RUBY' or its graphical representations  are used, publicly and outwardly, in connection with the goods and therefore it is used as a trade mark.

'Nature of use' in the context of Rule 22(3) EUTMR further requires evidence of use of the mark as registered, or of a variation thereof which, pursuant to Article 15(1)(a) EUTMR, does not alter the distinctive character of the trade mark.

In the present case, the majority of the evidence provided, namely, the invoices, the brochures show the word mark 'RUBY' or the figurative signs  and . The signs used do constitute use of the earlier trade mark because the figurative features as shown above do not alter the distinctive character of the earlier trade mark. The IR holder argues that the additions next to 'Ruby' such as KSP 240 2200 w or kerosene heat are as distinctive as the element 'Ruby' which therefore alter the distinctive character of the earlier mark. However, as seen in the brochures, these additions refer to the specific type of product and to the power of the heater or are merely descriptive elements. In the Cancellation Division's view, the mere addition of the terms such as heat or classic, which are descriptive or laudatory of the relevant goods, or the figures 240 or 2200 w which are indications of the codes or the power of the items do not alter the distinctive character of the earlier mark 'RUBY'. Therefore, the applicant's claim is dismissed.

In the present case, the majority of the evidence shows use of the sign as a trade mark with a clear reference to specific goods. In its observations, the IR holder states that the earlier mark 'RUBY' is not used as a trade mark but merely as a type description for certain products. However, the evidence shows use of the sign as a trade mark with a clear reference to specific goods. The Cancellation Division considers that the evidence does show use of the sign as a trade mark and, consequently, that the applicant has provided sufficient indications concerning the nature of use of the earlier mark. The IR holder's claim is therefore dismissed.

The earlier mark is registered for *heating apparatus* in class 11 and the evidence does show genuine use of the trade mark for a variety of goods, among others, *heaters, radiating panels, tower dryers, kerosene or oil stoves*.

According to Article 57(2) EUTMR, if the earlier trade mark has been used for only some of the goods or services for which it is registered it will, for the purposes of the examination of the application for a declaration of invalidity, be deemed to be registered only for those goods or services.

According to case-law, when applying the abovementioned provision the following should be considered:

... if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or



services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.'

(14/07/2005, T-126/03, Aladin, EU:T:2005:288)

In the present case, the evidence proves use for, among other goods, heaters, radiating panels, tower dryers, oil and kerosene stoves, all belonging to the following category in the specification: *heating apparatus*.

The IR holder pointed out that in case genuine use were proved, it would be for a particular set of goods and not for the whole category *heating apparatus* for which the earlier mark is protected.

In the Cancellation Division's view, the majority of the goods shown in the evidence are all small appliances for heating. As the applicant is not required to prove use of all the conceivable variations of the category of goods for which the earlier mark is registered and as the goods for which use has been proved do not constitute a coherent subcategory within the broad category in the specification to which they belong, the Cancellation Division considers that the evidence shows genuine use of the trade mark for the whole category *heating apparatus* in Class 11.

The IR holder argues that the items of evidence do not indicate genuine use in terms of time, place, extent, nature and use of the goods for which the earlier mark is registered either because they fall outside the relevant period or because they lack probative value. The holder's argument is based on an individual assessment of each item of evidence regarding all the relevant factors. However, when assessing genuine use, the Cancellation Division must consider the evidence in its entirety. Even if some relevant factors are lacking in some items of evidence, the combination of all the relevant factors in all the items of evidence may still indicate genuine use.

Taking into account the evidence in its entirety, the evidence submitted by the applicant is sufficient to prove genuine use of the earlier trade mark, during the relevant period in the relevant territories for all the goods in Class 11, namely: *heating apparatus*.

**LIKELIHOOD OF CONFUSION — ARTICLE 53(1)(a) EUTMR IN CONNECTION WITH 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**

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.

The goods on which the application is based are, after the assessment of proof of use, the following:

Class 11: *Heating apparatus.*

The contested goods are the following:

Class 6: *Coverings and materials of metal for fireplaces, (style) fireplaces and fireplace housings; fireplace surrounds and fireplace coverings; furnace fire screens, furnace fireguards; floor surrounds of metal; hearth-plates of metal; fire back of metal; chimney cowls of metal; chimney shafts of metal; chimney pots of metal; chimneys of metal.*

Class 11: *Building-in fireplaces; secondary fireplaces and unobstructed fireplaces and stoves; chimney flues; flues; ceramic burners amongst others active on bio-ethanol; gas flues and pipes; ash pans; gas blocks and ghost fires of fireplaces.*

Class 19: *Building materials not of metal, amongst others (style)fireplaces, ornaments of plaster cast, decorative frames not of metal, for building purposes; building materials for chimneys, flues, chimney pots, mantle pieces, not of metal; chimneys not of metal; non-metallic transportable buildings; stone.*

**Contested goods in Class 6**

The earlier *heating apparatus* is a broad category of machines having the specific function of warming or adding temperature to a room or an item.

The contested *coverings and materials of metal for fireplaces, (style) fireplaces and fireplace housings; fireplace surrounds and fireplace coverings; furnace fire screens, furnace fireguards; floor surrounds of metal; hearth-plates of metal; fire back of metal; chimney cowls of metal; chimney shafts of metal; chimney pots of metal; chimneys of metal* are all those goods used for fireplaces or chimneys which can target the same

end public and be distributed through the same channels as the earlier *heating apparatus*. Therefore, the goods are similar to a low degree.

### **Contested goods in Class 11**

The contested *building-in fireplaces; secondary fireplaces and unobstructed fireplaces and stoves; ceramic burners amongst others active on bio-ethanol; gas blocks and ghost fires of fireplaces* are all those items whose purpose is to release heat and are therefore similar to the earlier goods *heating apparatus* since they have the same purpose, can be manufactured by the same companies and addressed at the same end consumers. Moreover, these goods can be distributed through the same channels.

The contested *chimney flues; flues; gas flues and pipes* are pipes or channels for conveying exhaust gases from a chimneys, oven, furnace or boiler. The contested goods and the earlier *heating apparatus* can coincide in producers and distribution channels. They target the same relevant public. Therefore, they are similar to a low degree.

Finally, the contested *ash pans* are trays fitted beneath grates in which ashes can be collected. They have a certain link with the earlier *heating apparatus* since can coincide in producers and distribution channels. They target the same relevant public. Therefore, they are similar to a low degree.

### **Contested goods in Class 19**

The contested *building materials not of metal, amongst others (style)fireplaces, ornaments of plaster cast, decorative frames not of metal, for building purposes; building materials for chimneys, flues, chimney pots, mantle pieces, not of metal* share a certain degree of similarity with the goods protected by the earlier mark since the earlier *heating apparatus* might be part of central heating systems. These goods are complementary, are distributed through the same channels and target the same relevant public. Therefore, they are similar to a low degree.

The same reasoning applies to the contested *chimneys not of metal* which can have a certain link with the applicant's goods *heating apparatus* since they can be complementary, target the same end public and be distributed through the same channels. Therefore, they are similar to a low degree.

On the other hand, *non-metallic transportable buildings; stone* have no commonalities with the earlier *heating apparatus* since they do not share the same nature and purpose, are not manufactured by the same companies and are not addressed at the same end consumers. Moreover, they are neither complementary nor in competition. The goods are therefore dissimilar.

### **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 found to be similar to various degrees are directed at the public at large and at professionals with knowledge or expertise in the relevant

field. The degree of attention may vary from average to high depending on the exact nature, price and sophistication of the goods.

**c) The signs**

RUBY	RUBY FIRES
Earlier trade mark	Contested trade mark

The relevant territory is the Benelux countries.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression, bearing in mind their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

Both marks are word signs. The earlier mark consists of one single word 'RUBY' whereas the contested mark consists of the elements 'RUBY' and 'FIRES'.

The marks share the common element 'RUBY', which has no meaning for the majority of the relevant consumers; however, for another part of the public with a sufficient level of English, this word makes reference to, among other meanings, a precious stone or an intense purplish red colour but it could also be perceived as a female name. Be that as it may, this element has no connection with the relevant goods for the relevant public therefore it has an average degree of distinctive character.

The IR holder states that the element 'RUBY' is not particularly distinctive since the colour ruby red alludes to the possible characteristics of the goods. However, the Cancellation Division considers that the argument of the IR holder is far-fetched and since there is no clear and direct meaning between the word 'RUBY' and the relevant goods, the distinctiveness of the element 'RUBY' is normal and the IR holder's claim is dismissed.

The earlier mark has no element that could be considered more distinctive than others since it consists of one single element.

On the other hand, the element 'FIRES' of the contested mark has no meaning for the majority of the relevant consumers therefore it has an average degree of distinctive character for that part of the public.

However, it cannot be denied that another part of the relevant public with a sufficient level of English will perceive it as, among other meanings, a *domestic heating appliance that uses electricity or gas as fuel*. Bearing in mind the relevant goods, this element is descriptive and non-distinctive for that part of the public since it directly refers to a characteristic of those goods.

None of the marks has elements that could be considered more dominant (visually eye-catching) than other elements.

The Cancellation Division will focus the comparison of the signs on that part of the Benelux public for which 'FIRES' is descriptive and non-distinctive.

**Visually**, the signs coincide in 'RUBY' which is the only element of the earlier mark and the first and distinctive element of the contested mark. However, they differ in the second element of the contested mark 'FIRES' which is descriptive for this part of the relevant public. Therefore, the signs are visually highly similar.

**Aurally**, irrespective of the different pronunciation rules in different parts of the relevant territories, the pronunciation of the signs coincides in the sound of the letters 'ruby(i)', present identically in both signs. The pronunciation differs in the sound of the letters 'fires' of the contested mark, which forms the descriptive element of the contested mark for that part of the public. Therefore, the signs are aurally highly similar.

**Conceptually**, the public in the relevant territory will perceive the common element 'RUBY' as a precious stone or an intense purplish red colour but it could also be perceived as a female name, as explained above. The relevant public will attribute a meaning to the second element of the contested mark 'FIRES' as explained above and it is a descriptive and non-distinctive.

As the signs will be associated with a similar meaning on account of the common distinctive term 'RUBY', the signs are conceptually highly similar.

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.

According to the applicant, the earlier trade mark enjoys a high degree of distinctiveness as a result of its long-standing and intensive use in the Benelux countries for all the goods for which it is registered, namely *heating apparatus* in Class 11. This claim must be properly considered given that the distinctiveness of the earlier trade mark must be taken into account in the assessment of likelihood of confusion. Indeed, the more distinctive the earlier mark, the greater will be the likelihood of confusion (11/11/1997, C-251/95, Sabèl, EU:C:1997:528), and, therefore, marks with a highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442).

The evidence to be taken into account for the assessment of the enhanced distinctive character of the earlier mark is the same as the one listed for the assessment of the proof of use. The Cancellation Division will remit to those documents.

Having examined the material listed above, the Cancellation Division concludes that the evidence submitted by the applicant does not demonstrate that the earlier trade mark has acquired a high degree of distinctiveness through its use for its goods, namely *heating apparatus* (Class 11).

Some of these pieces of evidence are either undated. On the other hand, the brochures, the leaflets and the extracts from several internet web pages, indicate that some promotional activities were carried out. Moreover, the sale figures (annexes 8 and 9) issued by the company are indications of some activity of the earlier mark in the relevant market. The applicant also filed invoices throughout the years.

However, the evidence provided, taken as a whole, does not demonstrate that the earlier trade mark acquired a high degree of distinctiveness through its use for the goods in Class 11. The applicant did not file any other supporting document such as a survey on the mark's recognition that supports the finding of brand awareness (such as a survey on the recognition of the mark among the public, publicly audited turnover, etc.) under the earlier trade mark and that the company has led its resources to reach the threshold of enhanced distinctive character. Therefore, this claim is rejected as unfounded.

Consequently, 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 for any of the goods from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

#### **e) Global assessment, other arguments and conclusion**

According to the case-law of the Court of Justice, in determining the existence of likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, phonetic and conceptual similarities between the marks. The comparison "must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components" (see 11/11/1997, C-251/95, Sabèl, EU:C:1997:528). Likelihood of confusion must be assessed globally, taking into account all the circumstances of the case.

For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. 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 (see 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323).

The goods are partly similar to various degrees and partly dissimilar and the distinctive character of the earlier mark is normal.

Taking into account all the above, and especially the fact that the earlier mark is fully contained in the contested mark, being in the latter an independent and distinctive element, it is considered that the additional term 'FIRES' of the contested mark, which is descriptive and non-distinctive for a part of the public, cannot counteract the visual, aural and conceptual similarities between the marks so as to exclude a likelihood of confusion for those goods found similar even for the public showing a higher degree of attention.

The relevant consumers may think that the similar goods come from the same or from economically-related companies. Those consumers are likely to notice the repetition of the distinctive element 'RUBY' in the contested mark as it plays an independent role therein, when remembering the marks based on the imperfect recollection of them and might consequently not notice the difference between them, or they might associate the trade marks based on the common element 'RUBY' and therefore assume that the contested mark is a sub-brand of goods connected to the earlier mark.

In addition, the Cancellation Division notes that the likelihood of confusion includes the likelihood of association, in the sense that the public may, if not confuse the two signs directly, believe that they come from the same undertaking or from economically related ones (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 16). In the present case, the consumer may easily conclude that the goods labelled and offered under the contested mark come from the same or from an economically-linked undertaking as the earlier mark.

In its observations, the IR holder argues that the marks under dispute coexist in the relevant territories and the parties have been negotiating a coexistence agreement. In support of this argument, the IR holder filed a Judgement of 11/02/2015 from the Noord-Holland District Court of a dispute between the parties.

According to case-law,

... the possibility cannot be entirely dismissed that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion which the [Cancellation] Division and the Board of Appeal find exists as between two conflicting marks. However, that possibility can be taken into consideration only if, at the very least, during the proceedings before the EUIPO concerning relative grounds of refusal, the [proprietor of] the European Union trade mark duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the intervener's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical.

(11/05/2005, T-31/03, Grupo Sada, EU:T:2005:169, § 86)

Formal coexistence of certain marks in national or Union registries is not per se particularly relevant. It also needs to be proven that the marks coexist in the market, which could indicate that consumers are used to seeing the marks without confusing them. Last but not least, the Office will in principle be restricted in its examination to the trade marks in conflict.

Only under special circumstances may the Cancellation Division consider evidence of the coexistence of other marks in the market (and possibly in a Register) on a national/Union level as an indication of 'dilution' of the distinctive character of the applicant's mark which might be contrary to an assumption of likelihood of confusion.

This has to be assessed on a case-by-case basis and such an indicative value should be treated with caution as there may be different reasons as to why similar signs coexist, for example, different legal or factual situations in the past, or prior rights agreements between the parties involved.

In this case, the judgement filed by the applicant does not establish the coexistence of the marks in the relevant territory and the applicant has not submitted any other piece of evidence such as an agreement which shows that there has been a pacific coexistence of the trade marks under comparison in the relevant territories. Therefore, in the absence of convincing arguments and evidence thereof, this argument of the IR holder must be rejected as unfounded.

Considering all the above, the Cancellation Division finds that there is a likelihood of confusion on the part of the public and, therefore, the application is partly well founded on the basis of the applicant's Benelux trade mark registration No 540 912.

Pursuant to the above, the contested trade mark must be declared invalid for the goods found to be similar to those of the earlier trade mark.

It also has to be noted that, likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa (see 29/09/1998, C-39/97, Canon, EU:C:1998:442). In the present case and taking into account this principle, the contested trade mark must be rejected for the goods found to be similar to a low degree to the goods of the earlier trade mark as the obvious similarities between the signs offset the low degree of similarity between the goods.

The rest of the contested goods are dissimilar. As similarity of goods and services is a necessary condition for the application of Article 8(1) EUTMR, the application based on this article and directed at these goods cannot be successful as far as it based on the earlier Benelux trade mark registration No 540 912.

The applicant has also based its cancellation application on the following earlier trade marks:

- Polish trade mark registration No 96 713 for the word mark 'RUBY' protected for *apparatus for heating* in class 11.
- International trade mark registration No 620 319 for the word mark 'RUBY' designating the United Kingdom, France, Germany, Italy, Portugal and Spain protected for *heating apparatus* class 11.

Since these marks are identical to the one compared and cover the same scope of goods, the outcome cannot be different for goods for which the cancellation application has already been rejected. Therefore, there is no likelihood of confusion for those goods.

The same reasoning applies to the evidence of use. The Cancellation Division will not carry out the assessment of proof of use for those marks since these two remaining marks are identical to the earlier mark which was assessed for proof of use and it covers the same goods.

## **COSTS**

According to Article 85(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party. According to Article 85(2) EUTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Cancellation Division will decide a different apportionment of costs.

Since the cancellation is successful only for part of the contested goods, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



**The Cancellation Division**

María Belén IBARRA  
DE DIEGO

Carmen SÁNCHEZ  
PALOMARES

Michaela SIMANDLOVA

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 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 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 720 has been paid.