

OPPOSITION No B 3 160 252

Volvo Trademark Holding AB, c/o AB Volvo, 405 08 Göteborg, Sweden (opponent), represented by **Noerr Alicante IP, S.L.**, Avenida México 20, 03008 Alicante, Spain (professional representative)

a g a i n s t

Shenzhen Liansen Technology Co., Ltd., 5th Floor, Building A1, Dehe Industrial Zone, Huangpu Community, Xinqiao Street, Baoan District, 518000 Shenzhen, China (applicant), represented by **KBZ Żuradzki Barczyk & Wspólnicy Adwokaci i Radcy Prawni Sp.k.**, ul. PCK 6/7, 40-057 Katowice, Poland (professional representative).

On 20/02/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 160 252 is upheld for all the contested goods.
2. European Union trade mark application No 18 552 312 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 14/12/2021, the opponent filed an opposition against all the goods of European Union trade mark (EUTM) application No 18 552 312 'Volto' (word mark). The opposition is based on, inter alia, EUTM registration No 2 361 087 'VOLVO' (word mark). The opponent invoked Article 8(1)(b) EUTMR and Article 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.

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 EUTM registration No 2 361 087.

a) The goods

The opposition is based on, inter alia, the following goods:

Class 2: *Paints, varnishes, diluents and lacquers, also in spray or pen form; putty; preservatives against rust, anti-corrosive agents; coating compositions and preservatives, metal and lacquer conservation agents; preservatives against deterioration of wood; colorants, dyes; mordants, including metal mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.*

The contested goods are the following:

Class 2: *Ink for printers and photocopiers; toner cartridges, filled, for printers and photocopiers; edible inks; edible ink cartridges, filled, for printers; toner for printers and photocopiers; ink cartridges, filled, for printers and photocopiers; printing ink; engraving ink; dyes; pigments.*

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 or complementary.

Dyes are identically included in both lists of goods.

The contested *pigments* are, inter alia, ‘any substances used to impart colour’ as well as ‘powders that are mixed with a liquid to give a paint, ink, etc’ (<https://www.collinsdictionary.com/dictionary/english/pigment>).

The remaining contested goods are different kinds of ink (‘a fluid or paste used for printing, writing, and drawing’; <https://www.collinsdictionary.com/dictionary/english/ink>) and toners (‘powdered chemicals used in photocopying machines and laser printers, which is transferred onto paper to form the printed image’; <https://www.collinsdictionary.com/dictionary/english/toner>), as well as cartridges filled with these substances.

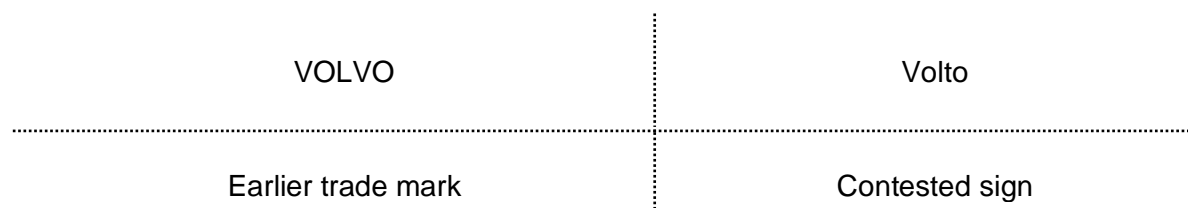
The opponent’s *colorants* are ‘any substances that impart colour, such as a pigment, dye, or ink’ (<https://www.collinsdictionary.com/dictionary/english/colorant>; all the above dictionary content retrieved on 15/02/2023).

Insofar as the contested goods are not identical to the opponent’s, because they overlap with *colorants* and/or *metals in foil and powder form for painters, decorators, printers and artists*, they are at least highly similar to the opponent’s *colorants*, since they can have the same purpose of imparting colour, as well as the same producers, distribution channels and end users.

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 identical or at least highly similar target both the public at large and business customers with specific professional knowledge or expertise, whose degree of attention is expected to be average overall.

c) The signs and the distinctiveness of the earlier mark

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.

Neither of the marks has any meaning in certain languages, for example in English, French or German. Consequently, the Opposition Division finds it appropriate to focus the comparison of the signs on the part of the public speaking those languages.

According to the opponent, the earlier mark has been extensively used and enjoys 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 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 as a whole has no meaning for any of the goods in question from the perspective of the public under assessment. Therefore, the distinctiveness of the earlier mark must be seen as normal.

Both marks are word marks. In the case of word marks, it is the word as such which is protected and not its written form. Consequently, the use of upper or lower case letters is, in principle, immaterial.

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.

Visually and aurally, the signs coincide in 'VOL*O' and differ in (the sound of) their second last letters, that is, 'V' in the earlier mark and 'T' in the contested sign. Therefore, the signs are visually and aurally similar to an above average degree.

Conceptually, neither of the signs has a meaning for the public under assessment. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs.

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

d) Global assessment, other arguments and conclusion

The Court has stated that likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case; this appreciation depends on numerous elements and, in particular, on the degree of recognition of the mark on the market, the association that the public might make between the two marks and the degree of similarity between the signs and the goods and services (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

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 and 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).

The earlier mark has been found to have at least a normal degree of distinctiveness. The goods at issue are identical or at least highly similar, and the signs are visually and aurally similar to an above average degree. They coincide, inter alia, in their beginnings, on which consumers tend to focus when encountering a trade mark. The discrepancies between the signs are confined to one letter out of five, 'V' and 'T', respectively, placed in the second last position, where they are more likely to go unnoticed by consumers.

In this regard, account is also taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks, but must trust in their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).

Moreover, for the part of the relevant public under assessment, both signs are meaningless, fanciful terms and, therefore, they do not have any meaning which could help consumers to safely distinguish between them.

Consequently, the relevant public with an average degree of attention may be mistaken about the origin of the goods found to be identical or at least highly similar.

Considering all the above, there is a likelihood of confusion on the part of the English-, French- and German-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 well founded on the basis of the opponent's EUTM registration No 2 361 087. It follows that the contested trade mark must be rejected for all the contested goods.

As this earlier right leads to the success of the opposition and to the rejection of the contested trade mark for all the goods 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).

Since the opposition is fully successful on the basis of the ground of Article 8(1)(b) EUTMR, there is no need to further examine the other ground of the opposition, namely Article 8(5) EUTMR.

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

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**

Carmen SÁNCHEZ
PALOMARES

Natascha GALPERIN

María Belén IBARRA
DE DIEGO

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.