

**DECISION  
of the Fourth Board of Appeal  
of 25 August 2022**

In case R 120/2022-4

**Blu Wireless Technology Limited**

5th Floor 1 Temple Way

Bristol BS2 0BY

United Kingdom

Applicant / Appellant

represented by John Paul Dean, JD IP Limited, Collingham House, 6-12 Gladstone Road, Wimbledon SW19 1QT, United Kingdom

v

**O2 Worldwide Limited**

C/O Stobbs Building 1 000 Cambridge

Research Park

Cambridge Cambridgeshire CB25 9PD

United Kingdom

Opponent / Defendant

represented by Lorenz Seidler Gossel Rechtsanwälte Patentanwälte Partnerschaft mbB, Widenmayerstr. 23, 80538 München, Germany

APPEAL relating to Opposition Proceedings No B 3 121 680 (European Union trade mark application No 18 190 044)

**THE FOURTH BOARD OF APPEAL**

composed of N. Korjus (Chairperson), L. Marijnissen (Rapporteur) and C. Govers (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 31 January 2020, Blu Wireless Technology Limited ('the applicant') sought to register the figurative mark



as a European Union trade mark for the following goods and services as limited on 3 June 2021:

Class 9 - Commercial telecommunications systems and devices; commercial radio frequency telecommunications systems and devices; commercial wireless telecommunications systems and devices; commercial millimetre wave wireless telecommunications systems and devices; wireless telecommunications mesh networks; modems and wireless access points all being commercial wireless communications infrastructure; Software relating to commercial wireless telecommunications infrastructure systems; none of the aforesaid goods being in the form of mobile phone devices, and all being for corporate, public body, or institutional customers;

Class 42 - Design services relating to commercial wireless telecommunications systems and devices; design services relating to commercial radio frequency telecommunications systems and devices; design services relating to commercial wireless telecommunications systems and devices; design services relating to commercial millimetre wave wireless telecommunications systems and devices; design services relating to commercial wireless telecommunications mesh networks; none of the aforesaid services relating to mobile phone devices, and all being for corporate, public body, or institutional customers;

Class 45 - Licensing of intellectual property for telecommunications systems and devices; licensing of intellectual property for radio frequency telecommunications systems and devices; licensing of intellectual property for wireless telecommunications systems and devices; licensing of intellectual property for millimetre wave wireless telecommunications systems and devices; licensing of intellectual property for wireless telecommunications mesh networks.

- 2 The application was published on 6 March 2020.
- 3 On 18 May 2020, O2 Worldwide Limited ('the opponent') filed an opposition against the registration of the published trade mark application for part of the goods and services, namely against all the goods and services in Classes 9 and 42.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) EUTMR.
- 5 The opposition was based on, *inter alia*, EUTM No 16 057 002 for the word mark

**BLUE**

filed on 18 November 2016 and registered on 22 November 2017 for, amongst others, the following goods and services:

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 or controlling electricity; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; digital telecommunication apparatus and instruments; digital tablets; computer hardware; computer application software; computer software downloadable from the Internet; recorded computer software; software applications; mobile software applications, downloadable applications for multimedia devices; computer games; computer game software; computer games programs; PDAs (Personal Digital Assistants); pocket PCs; mobile telephones; laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; televisions; headphones; global positioning system [GPS] apparatus; satellite navigation devices; computer software recorded onto CD Rom; SD-Cards (secure digital cards); glasses; spectacle glasses; sunglasses; protective glasses and cases therefor; contact lenses; cameras; camera lenses; MP3 players; audio tapes, audio cassettes; audio discs; audio-video tapes; audio-video cassettes; audio-video discs; video tapes; video cassettes; video discs; CDs, DVDs; downloadable electronic publications; downloadable image files; downloadable music files; mouse mats; magnets; mobile telephone covers; mobile telephone cases; hands free kits for phones; magnetic cards; encoded cards; mobile phone application software; software for telecommunication; software for the processing of financial transactions; electronic notice boards; electric batteries; battery chargers; security alarms; security cameras; security warning apparatus; security control apparatus; security surveillance apparatus; computer software for security purposes; computer software for insurance purposes; SIM cards; aerials; alarms; electric cables; chemistry apparatus and instruments; recorded computer operating programs; computer peripheral devices; data processing apparatus; diagnostic apparatus, not for medical purposes; distance measuring apparatus; distance recording apparatus; downloadable ring tones for mobile phones; electronic tags for goods; eyepieces; goggles for sports; magnetic identity cards; intercommunication apparatus; loudspeakers; magnetic data media; mathematical instruments; modems; electric monitoring apparatus; television apparatus; testing apparatus not for medical purposes; telecommunication transmitters; parts and fittings for all the aforesaid goods; none of the aforesaid goods being microphones or microphone cables;

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; calibration [measuring]; cloud seeding; computer programming; computer rental; computer software consultancy; computer software design; updating of computer software; computer system analysis; computer system design; construction drafting; consultancy in the design and development of computer hardware; consultancy in the field of energy-saving; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; data conversion of computer programs and data [not physical conversion]; digitization of documents [scanning]; duplication of computer programs; engineering; hosting computer sites [web sites]; industrial design; installation of computer software; scientific laboratory services; land surveying; maintenance of computer software; material testing; mechanical research; monitoring of computer systems by remote access; packaging design; technical project studies; providing search engines for the internet; provision of scientific information, advice and consultancy in relation to carbon offsetting; quality control; recovery of computer data; rental of computer software; rental of web servers; research and development for others; surveying; technical research; it services; computer programming services; programming of data processing equipment; recovery of computer data; consultancy in the field of computer hardware; rental of computer hardware; application service provider (ASP); consultancy in the field of computer software; creating

and maintaining blogs for others; expert advice and expert opinion relating to technology; rental of data processing apparatus and computers; technical services relating to projection and planning of equipment for telecommunications; product research services; weather forecasting; research in the field of telecommunication technology; monitoring of network systems in the field of telecommunications; technical support services relating to telecommunications and apparatus; data security services; data security services [firewalls]; research relating to security; computer security system monitoring services; maintenance of computer software relating to computer security and prevention of computer risks; updating of computer software relating to computer security and prevention of computer risks; computer virus protection services; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

6 By decision of 25 November 2021 ('the contested decision'), the Opposition Division upheld the opposition and rejected the trade mark applied for, for all of the contested goods and services and ordered the applicant to pay costs. The Opposition Division gave, in particular, the following reasons for its decision:

- The contested goods in Class 9 are included in, or overlap with, the earlier goods 'telecommunications apparatus; telecommunications network apparatus; telecommunication transmitters; none of the aforesaid goods being microphones or microphone cables; software for telecommunication; none of the aforesaid goods being microphones or microphone cables' in the same class and are, therefore, identical.
- The contested services in Class 42 are included in, or overlap with, the earlier services 'design related thereto (scientific and technological services)' in the same class and are, therefore, identical.
- The goods and services of the earlier mark target the general and professional public, whereas the contested goods and services target business customers with specific professional knowledge or expertise. Therefore, professionals constitute the relevant public since they are likely to be the only consumers who encounter both marks.
- The public's degree of attentiveness may vary from average to higher than average, depending on the price, specialised nature, or terms and conditions of the goods and services purchased.
- The relevant territory is the European Union.
- The earlier mark 'BLUE' will be perceived as 'the colour of the sky on a sunny day' (*Collins English Dictionary*). It has no direct relation to the relevant goods and services, and therefore has a normal degree of inherent distinctiveness. The opponent did not explicitly claim that the earlier mark is particularly distinctive by virtue of intensive use or reputation.
- The contested sign's verbal element 'Blu' is not a dictionary word. However, it will be understood by the relevant public as the word 'blue' as it is a common spelling variation of this word, that is pronounced the same. The above findings regarding the distinctiveness of the word 'blue' equally apply

to the contested sign's verbal element 'Blu' in relation to the contested goods and services, therefore, it has a normal degree of distinctiveness.

- The contested sign's verbal element 'Blu' is placed inside a triangle with rounded corners, filled with rainbow colours. This figurative element is commonly used in trade to highlight the information contained within; consumers do not usually attribute any trade mark significance to such shapes. Therefore, it is non-distinctive.
- The contested sign's verbal element 'Wireless' means 'communicating without connecting wires or other material contacts' (*Collins English Dictionary*). It merely indicates wireless connectivity of the relevant goods and the goods subject of the relevant services. It is, therefore, non-distinctive.
- The contested sign is merely a sum of its parts, rather than a conceptual unit.
- The contested sign is depicted in a slightly stylised font and colours, which are not especially striking and will not distract consumers from the verbal elements. They will be perceived as purely decorative and therefore play only a secondary role in the overall impression of the sign.
- Visually, the signs coincide in the letters 'BLU', which constitute the earlier mark's first three out of four letters and the contested sign's first and most distinctive element. However, the signs differ in the earlier mark's last letter 'E' and the contested sign's verbal element 'Wireless'. The latter is non-distinctive and is placed at the end of the sign. Furthermore, the signs differ in the contested sign's slight stylisation, colours and non-distinctive figurative element. Consumers tend to focus on the beginning of a sign and the verbal component of a sign has a stronger impact on the consumer than the figurative component. The signs are visually similar at least to an average degree.
- Aurally, the earlier mark and the contested sign's verbal element 'Blu' are identical. The marks differ in the pronunciation of the contested sign's verbal element 'Wireless', which is, however, non-distinctive and the relevant public may not pronounce it at all. The signs are aurally similar at least to an average degree.
- Conceptually, since both signs will be associated with the colour blue and taking into account that the contested sign's differing verbal element 'Wireless' is non-distinctive and cannot indicate the commercial origin, as well as the fact that the contested sign is a sum of its parts, the signs are conceptually similar at least to an average degree.
- It is highly conceivable that the relevant public, even those who will pay a higher degree of attention (who will also have to rely on their imperfect recollection of the signs), will confuse the trade marks or believe that the goods and services in question come from the same or economically linked undertakings.

- In its observations, the applicant argues that it has long and consistent prior use of trade marks based on the elements ‘BLU WIRELESS’ predating the earlier mark and there has been no confusion between them. In support of its arguments, the applicant submitted a witness statement by the applicant’s Chief Marketing Officer. Statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by its personal interests in the matter. In the present case, the applicant’s witness statement is not supported by other items of evidence originating from independent sources.
  - As regards the coexistence of other marks, the formal coexistence in national or Union registries is not per se particularly relevant. It should be proved that they coexist in the market, which could actually indicate that consumers are used to seeing the marks without confusing them.
  - In the absence of convincing arguments and evidence thereof, the coexistence argument of the applicant must be rejected as unfounded.
  - Considering all the above, there is a likelihood of confusion on the part of the English-speaking part of the public based on EUTM No 16 057 002. The opposition succeeds on the basis of this earlier right for all the contested goods and services. There is no need to assess the other earlier rights invoked by the opponent.
- 7 On 19 January 2022, the applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 28 March 2022.
- 8 In its response received by the Office on 24 May 2022, the opponent requested that the appeal be dismissed.
- 9 On 13 June 2022, the applicant filed a request to supplement the statement of grounds with a reply pursuant to Article 26 EUTMDR. On 10 August 2022, the Registry of the Boards of Appeal informed the applicant that this request had been rejected since the Board considered that it already was in the possession of all the relevant arguments and facts in order to decide on the case.

### **Submissions and arguments of the parties**

- 10 The arguments raised by the applicant in the statement of grounds may be summarised as follows:
- The striking figurative element of the contested sign is the dominant and distinctive element. The visual impression is important in the telecommunications infrastructure and systems sector. The contested decision erred in disregarding its impact globally, and in repeating only the opponent’s submissions without reasoning those of the applicant, contrary to fair procedures and other established principles.

- The figurative element is far more complex than described in the contested decision, with three curved sides and apexes having relatively different radii. The blurred spectrum of colours adds to the sophistication, giving movement and various meanings. It is not common in the trade. The verbal element of the contested sign is wholly contained within the device.
- Visually and aurally, the contested sign and the earlier trade marks as a whole are very different in length, composition and number of letters, words and syllables.
- Since ‘Blu’ is followed by a word beginning with the letter ‘w’, its ‘ew’ sound is more pronounced, as opposed to the ‘oo’ of ‘Blue’. The contested sign’s four syllables are aurally different to the opponent’s marks.
- The reductive assessment artificially dissected the examined signs which the sophisticated consumer will not do. In this regard, reference is made to the witness statement of Ms Caroline Gabriel, Research Director, Rethink Technology Research, which reinforces the applicant’s Chief Marketing Officer witness statement submitted at first instance with regard to the very different sectors in play (Annexes 1 and 2).
- Conceptually, the word element ‘Blue’ represents the colour blue, widely used in telecommunications (*Newton’s Telecom Dictionary*, 19th Edition, Ed H Newton, 2003, pages 115-117). The word element ‘Blu’ in the contested mark is an invented word which has no meaning and is not a dictionary word.
- Consumers refer to the applicant as ‘Blu Wireless’. The goodwill associated with the trading name, or ‘house mark’ will reinforce the applicant’s name. Therefore, the words in combination are indicative of commercial origin.
- The earlier German marks are all dissimilar to the contested sign too, their differing verbal elements creating different meanings.
- The earlier marks are not reproduced within the contested sign since ‘blu’ is an invented word in a creative device. The word ‘wireless’ is a key part of the established, well-known, award-winning trade mark applied for. It was ascribed just one of several meanings which should have been analysed, and as a unit. The combination is fanciful akin to many prior registrations which feature one or part of one of the contested sign’s elements with other elements.
- The house mark ‘Blue Wireless’ at play reinforces the trading name thereby conveying a double message in terms of brand identity unlike the earlier marks, and is inherently distinctive.
- The statement that the ‘contested sign is merely a sum of its parts, rather than a conceptual unit’ is not appropriate to relative grounds, and the sign is in any event not descriptive.
- The examiner further erred in comparing the distinctive figurative device to a simple geometric, commonplace shape or label, by analogy. Furthermore, a

coinciding element does not automatically result in a finding of likelihood of confusion and verbal elements do not always constitute the most distinctive element. Each case turns on its facts. Significantly, in this case, the figurative device of the contested sign fully contains the first verbal element which is short. The prominent second word of the contested sign is the longest and therefore may still dominate even if weak. Unlike the consumer targeted by the earlier marks, the corporate consumer will appreciate such considerations when selecting with discernment (by further reference to the annexed witness statements). The overall impression was not duly regarded in the assessment, leading to an unlawful disregard for components of the complex sign which were not considered dominant, and an incorrect result.

- The contested goods and services are clearly defined and specific, as required. The earlier goods and services cover a wide range of unrelated goods, which renders the scope questionable and clutters up the Register.
  - The examiner has not properly considered the average consumer of the respective marks. The telecommunications sector covers an extremely broad spectrum, and includes distinct customer bases such as the applicant's Business to Business ('B2B') customers of high value telecoms infrastructure and mmWave technology, attested by the contents of the earlier witness statement, and the mobile telecommunications services and tariffs offered under the earlier marks to Business to Consumers ('B2C') customers.
  - The average consumer of the contested goods and services does not select them from a physical store or online. A network infrastructure system is bespoke, costs millions and takes up to two years, as further attested. The average consumer is e.g. a corporate entity, often involved in a particular sector, government department, local administration or city, and will often be a body of technical experts as opposed to one individual, not a 'professional'.
  - As such, the assertion that the goods and services are identical and targeted at the same consumer is incorrect and misleading.
  - As the respective consumer bases are very different, any risk of confusion is highly unlikely.
- 11 The arguments raised by the opponent in response may be summarised as follows:
- The Office correctly assessed the level of attention of the relevant public, made up of consumers of both parties, which includes a sophisticated public of business customers with specific professional knowledge or expertise and correctly differentiated the degree of attention paid. The marketing conditions and actual or intended use of the goods and services are irrelevant as found. In any event, the opponent provides not just telecommunications services but also the infrastructure services required by them in Germany and the UK. Furthermore, even a high level of attention could not prevent the existence of a likelihood of confusion in the present case; even experts are not immune to confusing similar trade marks.



- The similarity of the signs was also correctly reasoned by the Opposition Division. The figurative element is no more than a simple triangle-like geometric shape in rainbow colours, as held in the contested decision. Indeed, there are many well-known trade marks which use non-distinctive coloured and multi-coloured geometric shapes as a background to highlight their distinctive verbal element. Such examples are distinguishable from those cases where the figurative element is itself distinctive, and determinative in the overall impression. It is the clearly separated element ‘Blu’ here which visually dominates, as correctly assessed and which is unconnected to the purely descriptive element ‘wireless’, regardless of the length of the respective words, in accordance with the findings made and citations relied upon in the contested decision. Furthermore, the overall impression is of course often dominated by one of the trade mark elements. The assessment of certain elements of the mark as less distinctive and therefore less important, cannot be equated with a disregard of these elements. Contrary to the applicant’s representation, it is not the figurative element of the contested mark that ‘stands out against the earlier marks’, but the element ‘Blu’ which is nearly identical to the earlier marks.
- The question whether an e.g. descriptive element can acquire distinctiveness and case-law pertaining to that question are not relevant here. The contested sign will be broken down into meaningful parts by the relevant public as reflected in case-law; not artificially and not perceived as a conceptual unit as correctly held. Furthermore, the registrability of the contested sign says nothing about the distinctiveness of the individual trade mark elements, and the allegations of renown of the contested mark are neither sufficient nor relevant. The mere presence of the word ‘wireless’ in the contested sign or as a (descriptive) element in other prior registrations is of no consequence since it are the other elements which confer distinctiveness or give weight overall. The same applies to the laudatory additions ‘1’, ‘One’, ‘Deals’, ‘Insider’ and ‘All-in’ in the earlier German marks relied upon.
- The applicant has not annexed the dictionary reference cited regarding the prevalence of the word ‘blue’ in telecommunications, which therefore falls to be disregarded, and it is clear from an enclosed online article excerpt that the colour as such, and not the word, is used by tech companies solely because of positive associations with that specific colour which are intended to be attributed to the relevant company (Enclosure LSG 8). In terms of the word for the colour, the absence of the letter ‘e’ in ‘blu’ makes no difference to its perception and pronunciation.
- The fact that the applicant considers the contested sign to be its house mark does not alter the perception of the relevant public with regard to the distinctive and descriptive elements of the contested sign as a composite mark.
- The goods and services are identical as found and unaffected by the limitation. Moreover, the opponent is perfectly entitled to a broad trade mark protection in law and as recognised by a recent cancellation decision which further acknowledged that the opponent is also known for its infrastructure

services, currently in the 5G rollout, which includes mmWave technology, and that the provision of a mobile network and telecommunication services encompasses the provision of infrastructure systems (Enclosure LSG 7). Such broad protection is neither contrary to competition nor does it constitute cluttering of the Register.

- Numerous recent decisions of the Office in similar cases confirm that the findings in this case are correct. All these decisions are applicable in the case at hand (Enclosures LSG 9-14).

### **Reasons**

- 12 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 13 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible. However, the appeal is not well founded as will be reasoned by the Board below.

#### *Article 8(1)(b) EUTMR*

- 14 According to Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must not be registered if, because of its identity with or similarity to the earlier trade mark and, cumulatively, the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.
- 15 As the Opposition Division did, the Board will start its examination on the basis of earlier EUTM No 16 057 002 for the word mark ‘BLUE’.

#### *Comparison of the goods and services*

- 16 The contested goods and services in Classes 9 and 42 were correctly considered by the Opposition Division to be identical to goods and services covered by the earlier mark. This is not in dispute between the parties, save to the extent that the applicant argues that the earlier mark covers an over broad specification, and that therefore the goods and services cannot be considered identical. However, as correctly argued in response, there is nothing unlawful about a broad scope of protection *per se*, so long as the terms covered are identified with the requisite specificity and clarity which is indeed the case at hand.
- 17 Once again, the applicant has sought to argue that the conflicting marks are used in divergent business areas i.e. the earlier mark is used essentially for mobile phone services, whereas the contested sign centres on the creation and design of commercial telecommunications infrastructure for business and public organisations using millimetre wave technology. In support of its arguments, the applicant submitted witness statements. However, the particular circumstances in

which the goods and services covered by the marks are actually marketed have, as a matter of principle, no impact on the assessment of the likelihood of confusion because they may vary in time depending on the wishes of the proprietors of the trade marks (15/03/2007, C-171/06 P, Quantum, EU:C:2007:171, § 59; 22/03/2012, C-354/11 P, G, EU:C:2012:167, § 73; 21/06/2012, T-276/09, Yakut, EU:T:2012:313, § 58).

- 18 The comparison of the goods and services must be based on the wording indicated in the respective lists of goods and services and any actual or intended use not stipulated therein is not relevant for the comparison; the conflicting marks have to be compared for the goods and services for which they are registered or applied for and not as used or intended to be used or marketed (30/06/2010, C-448/09 P, Centrixx, EU:C:2010:384, § 74; 16/06/2010, T-487/08, Kremezin, EU:T:2010:237, § 71).
- 19 Accordingly, the arguments raised by the applicant as regards the actual use of the respective marks and the respective business activities of the parties are all ineffective and so are the contents of the witness statements submitted by the applicant.


*Relevant public and territory*

- 20 In the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of products and services concerned, who is 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 (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26; 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 42).
- 21 The goods and services of the earlier mark target the general and professional public, whereas the contested goods and services as limited target e.g. corporate entities i.e. business customers, with specific professional knowledge or expertise. Therefore, professionals constitute the relevant public since they are likely to be the only consumers who encounter both marks. Their level of attention will be high.
- 22 Since the earlier mark is an EUTM, the relevant territory for analysing the likelihood of confusion is the European Union including all its Member States. For an EUTM application to be refused registration, it is sufficient that the relative ground for refusal for the purposes of Article 8(1)(b) EUTMR exists in only part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 57; 09/03/2005, T-33/03, Hai, EU:T:2005:89, § 39; 22/03/2007, T-322/05, Terranus, EU:T:2007:94, § 29; 05/02/2020, T-44/19, TC Touring Club, EU:T:2020:31, § 84).
- 23 Following the approach of the Opposition Division, the Board will examine the opposition from the perspective of the English-speaking part of the public, which concerns the public in Ireland where English is the native language, but also the public that has a good understanding of the English language which is in any

event the case in the Scandinavian countries, the Netherlands and Finland. The same applies to Malta, where English is one of the official languages, and to Cyprus (09/12/2010, T-307/09, Naturally active, EU:T:2010:509, § 26).

### *Comparison of the signs*

- 24 The assessment of the visual, phonetic 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. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (28/04/2004, C-3/03 P, Matratzen, EU:C:2004:233, § 32; 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28-29).
- 25 According to case-law, where a mark consists of both figurative and verbal elements, it does not automatically follow that it is the verbal element which must always be considered to be dominant (16/01/2008, T-112/06, Idea, EU:T:2008:10, § 45). However, where a trade mark is composed of verbal and figurative elements, the former are, in principle, more distinctive than the latter, because the average consumer will more readily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark (01/03/2016, T-61/15, 1e1 / UNOE et al., EU:T:2016:115, § 61).
- 26 The signs to be compared are the following:

<i>Contested sign</i>	<i>Earlier mark</i>
	<p style="text-align: center;"><b>BLUE</b></p>

- 27 The earlier word mark is composed of the single word 'BLUE'. In the case of word marks it is irrelevant whether they are written in lower- or upper-case letters since it is the word as such that is protected and not its written form (31/01/2013, T-66/11, Babilu, EU:T:2013:48, § 57). The word 'blue' refers to a colour. As a word, it has no direct relationship to the goods and services. It is therefore distinctive to a normal degree. The Opposition Division correctly noted that some of the goods at issue may be of a blue colour, however, they are likely to be selected according to their specification and not according to their colour (17/07/2019, R 2007/2018-5, Bluesim / Blue et al., § 25). Moreover, the validity of the earlier mark cannot be called into question in opposition proceedings but only in cancellation proceedings brought against this mark (24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 38). Positive associations with colours are not strictly relevant to considerations regarding words for colours *in concreto*.
- 28 The contested sign is a figurative mark which contains the verbal elements 'Blu' and 'Wireless'. The word 'Blu' is depicted in white against a multicoloured, rounded triangular device. The word 'Wireless' is depicted in blue writing to the

right. Although striking, sizeable and prominently positioned, the triangular device is an approximation of a simple, geometric shape, with a decorative colour scheme. As such, it is not particularly distinctive. There is nothing about it which will lead the consumer to focus on it in the relevant sense i.e. for identification purposes. The Board concurs with the finding of the Opposition Division that it serves to highlight the verbal element 'Blu' contained therein.

- 29 The word 'Blu' will be understood as an obvious misspelling of the colour 'blue' by the relevant public, and distinctive as reasoned above. The Opposition Division correctly held that the element 'Wireless' of the contested sign is likely to be understood, as defined, as a reference to 'communicating without connecting wires or other material contacts'. It merely indicates the wireless connectivity of the relevant goods and the goods which are the subject of the relevant services. It is, therefore, non-distinctive in the context of telecommunications regardless of any other definitions which exist for the word.
- 30 Accordingly, the only slightly stylised font and colours will be perceived as decorative. The simple background device, will not distract consumers from the verbal elements either, playing only a secondary role in the overall impression of the sign. However, none of the elements in the contested sign are negligible, nor did the Opposition Division suggest otherwise, contrary to one of the applicant's lines of argument.
- 31 Bearing in mind that where a sign is composed of figurative and verbal elements consumers tend to focus on the latter (see paragraph 25 above), within the contested sign, the relevant public's attention will remain particularly on the distinctive verbal element 'Blu', which indicates the commercial origin of the goods and services, and which is positioned to the fore of the sign where consumers tend to focus their attention, the word 'Wireless' being a non-distinctive element, and the remaining elements playing no more than a secondary role in the overall impression of the contested sign.
- 32 Visually, the signs coincide in the distinctive letter string 'Blu', which constitute three out of the four letters which make up the sole element of the earlier mark and the first and sole distinctive verbal element of the contested sign, playing an independent and distinctive role therein. They differ in the earlier mark's last letter 'E', the contested sign's verbal element 'Wireless' which is non-distinctive and placed at the end of the sign, the figurative device of the contested sign which is secondary, and the colours used which are decorative. The signs are visually similar to a below average degree.
- 33 Aurally, the signs coincide in the identical sound 'Blu', which constitute three out of the four letters which make up the sole element of the earlier mark and the first and sole distinctive verbal element of the contested sign, playing an independent and distinctive role therein. The earlier mark's last letter 'E' in 'BLUE', makes no difference to the pronunciation by the relevant public. The signs also differ in the second verbal element of the contested sign, 'wireless', which is however not distinctive and merely plays a secondary role. Therefore, contrary to the applicant's arguments, the signs are aurally also similar to at least an average degree, as the Opposition Division held.

- 34 Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. As the signs will be associated with a similar meaning as regards the terms ‘blue’ and ‘blu’ and the additional concept ‘wireless’ conveyed by the contested sign is not distinctive, the signs are conceptually similar to at least an average degree, as found by the Opposition Division. No meaning is attributable to the figurative device. This conclusion applies irrespective of whether or not colours may convey positive associations as argued by the applicant.

*Overall assessment of the likelihood of confusion*

- 35 According to the case-law of the Court of Justice, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion. It follows from the very wording of Article 8(1)(b) EUTMR that the concept of a likelihood of association is not an alternative to that of a likelihood of confusion, but serves to define its scope (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17).
- 36 A likelihood of confusion on the part of the public must be assessed globally. That global assessment implies some interdependence between the factors taken into account and in particular similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between these 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; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 19). The more distinctive the earlier mark, the greater the risk of confusion, and marks with a highly distinctive character, either per se or because of the reputation 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, § 18).
- 37 The average consumer only rarely has the chance to make a direct comparison between the different marks but must place his or her trust in the imperfect picture of them that he or she has kept in mind (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26; 30/06/2004, T-186/02, Dieselit, EU:T:2004:197, § 38). Even a more attentive public only retains an imperfect image of the trade marks (06/12/2018, T-665/17, CCB, EU:T:2018:879, § 68).
- 38 With reference to paragraph 27 above, the earlier mark has an inherently normal degree of distinctive character in relation to the services at hand.
- 39 The applicant argued that ‘BLUE’ constitutes a prevalent feature of trade marks on the Register, and that its distinctiveness is attenuated as a consequence. The existence of registrations *per se* does not necessarily reflect the situation on the market. The mere statement by the applicant that such registrations exist does not demonstrate that consumers have been exposed to widespread use of, and have become accustomed to, trade marks that include the word ‘BLUE’ for the goods and services concerned. Indeed, the mere fact, irrespective of whether it is substantiated or not, that other similar marks appear prevalently on a trade mark

register does not permit the conclusion that the distinctiveness of the earlier mark is weakened *in concreto*.

- 40 Taking into account the below average degree of visual and the, at least, average degree of aural and conceptual similarity between the signs, as well as the identity between the goods and services, there exists a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR on the part of the English-speaking public, even taking into account a high level of attention of the relevant public. With reference to paragraph 22 above, this suffices for the opposition to succeed.
- 41 In its supported observations, the applicant argues that it has long and consistent prior use of trade marks based on the elements ‘BLU WIRELESS’ which predates the earlier mark and that there has been no confusion between them. However, the applicant has not shown that the signs peacefully coexisted on the relevant market, in which respect the Board endorses the position taken by the Opposition Division in the contested decision. Furthermore the Board notes that a highly distinctive character or reputation of the contested sign, a claim which in any event also remains unsubstantiated by reliable independent and objective evidence, is not relevant in the context of relative grounds for refusal, as in the present case in respect of whether there is a likelihood of confusion. According to the case-law, the highly distinctive character of a sign is relevant only in respect of the earlier mark and not the later mark (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20; 16/09/2009, T-400/06, zerorh+, EU:T:2009:331, § 83; 19/04/2013, T- 537/11, Snickers, EU:T:2013:207, § 55; 17/09/2015, T-323/14, Bankia, EU:T:2015:642, § 49).
- 42 The contested decision was reasoned in accordance with good practice, previous relevant decisions and well-established principles of case-law. Contrary to the applicant’s arguments, no elements were disregarded in the assessment, all elements were weighed up appropriately and the assessment was duly made on the merits.
- 43 Since the opposition succeeds in its entirety on the basis of earlier EUTM No 16 057 002 for the word mark ‘BLUE’, there is no need to examine the other earlier marks invoked.

### *Conclusion*

- 44 The opposition was correctly upheld for all the contested goods and services. The appeal shall be dismissed.

### **Costs**

- 45 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent’s costs of the opposition and appeal proceedings.

- 46 As to the appeal proceedings, these consist of the opponent's costs of professional representation of EUR 550.
- 47 As to the opposition proceedings, the Opposition Division ordered the applicant to bear the opposition fee of EUR 320 and the opponent's representation costs which were fixed at EUR 300. This decision remains unaffected.
- 48 The total amount for both proceedings is EUR 1 170.



**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to bear the opponent's costs in the appeal proceedings, which are fixed at EUR 550. The total amount to be paid by the applicant to the opponent in the opposition and appeal proceedings is EUR 1 170.**

Signed

N. Korjus

Signed

L. Marijnissen

Signed

C. Govers

Registrar:

Signed

H.Dijkema

