

**DECISION
of the First Board of Appeal
of 26 October 2022**

In case R 185/2022-1

FRASCHETTI SPA

Via Caragno 15

03026 Pofi (FR)

Italy

Applicant / Appellant

represented by SOCIETÀ ITALIANA BREVETTI S.P.A, Piazza di Pietra, 39, 00186,
Roma, Italy

v

Caterpillar Inc.

100 NE Adams Street

Peoria Illinois 61629

United States of America

Opponent / Defendant

represented by HOGAN LOVELLS, Avenida Maisonnave 22, 03003, Alicante, Spain

APPEAL relating to Opposition Proceedings No B 3 125 853 (European Union trade
mark application No 18 222 081)

THE FIRST BOARD OF APPEAL

composed of G. Humphreys (Chairperson), A. González Fernández (Rapporteur) and
M. Bra (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 7 April 2020, FRASCHETTI SPA ('the applicant') sought to register the figurative mark



('the contested sign'), as a European Union trade mark ('EUTM') for the following list of goods and services ('the contested goods and services'):

Class 7 - Power saws; Rock bits for drilling machines; Drilling machines; Cutting, drilling, abrading, sharpening and surface treatment machines and apparatus; Ground drilling apparatus [machines]; Steerable drilling machinery for earth displacement; Pulping machines; Mills and crushing machines; Waste grinders and waste presses [electric waste disposal units]; Waste crushing machines; Water pumps; Water supply machines [pumps]; Engine driven water pumps; Pumps [machines]; Compressors; Air compressors; Lawnmowers [machines]; Clearing saws [machines]; Tree branch cutters [machines]; Current generators; Diesel electric generators; Electrical generators using solar cells; Pressure washing machines; Industrial vacuum machines for cleaning; Robotic cleaning machines; Cleaning machines for ponds; Sand cleaning machines; Swimming pool cleaning machines; Steam cleaning machines; Floor cleaning machines; Robotic swimming pool cleaning machines; Soldering apparatus, electric; Blowing engines; Agricultural machine tools; Agricultural, gardening and forestry machines and apparatus; Motorized cultivators; Motor hoes [machines]; Line trimmers for garden use; Garden tilling machines; Gardening tools (Electric -); Power blowers for lawn debris; Garden tractors for mowing lawns; Garden rotavators; Harvesting machines; Blowing machines; Lawn edge trimmers [machines]; Hedge cutters [machines]; Pruning saws [electric]; Lopping shears [machines]; Pruning saws [motorised]; Gardening machines (Powered -);

Class 8 - Agricultural, gardening and landscaping tools; Sprayers for use in agriculture [hand tool]; Garden tools, hand-operated; Pruning saws [hand-operated]; Trowels [gardening]; Gardening scissors; Garden forks; Three-prong cultivators for gardening; Cutting, drilling, grinding, sharpening and surface treatment hand tools;

Class 37 - Maintenance and repair of garden tools; Repair or maintenance of machines and apparatus for lumbering; Maintenance and repair of earth moving equipment; Advisory services relating to the maintenance and repair of mechanical and electrical equipment; Rental of cleaning machines; Maintenance of cleaning machines.

- 2 The application was published on 15 April 2020.
- 3 On 13 July 2020, Caterpillar Inc. ('the opponent') filed an opposition against the registration of the published trade mark application for all the above goods and services.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) and Article 8(5) EUTMR.
- 5 The opposition was based, *inter alia*, on the following earlier right:

European trade mark registration No 15 167 711 of the figurative mark ('the earlier mark')



filed on 1 March 2016 and registered on 2 February 2017 for the following goods and services ('the earlier goods and services'):

Class 7 - Machines and engines and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); engines, machines and other installations for oil-field and gas-field exploitation and parts therefor as far as covered by class 7; agricultural instruments other than hand operated; ground engaging teeth for use on buckets for use on earth moving machinery; machinery for earth moving, earth conditioning and material handling, namely, backhoe loaders, skid steer loaders, multi terrain loaders, integrated tool carriers, wheel loaders, track excavators, wheeled excavators and structural, repair and replacement parts for all the foregoing, structural, repair and replacement parts for engines for all the foregoing; machinery for earth moving, earth conditioning and material handling, namely, front shovels, telescoping material handlers, track material handlers, wheeled material handlers, track-type tractors, pipelayers, track loaders, landfill compactors, soil compactors, wheel dozers, motor graders, industrial tractors, wheel tractor-scrapers and structural, repair and replacement parts for all the foregoing, structural, repair and replacement parts for engines for all the foregoing; machinery for earth moving, earth conditioning and material handling, namely, forest machines, track skidders, wheeled skidders, track feller bunchers, wheeled feller bunchers, forwarders, track harvesters, knuckleboom loaders, vibratory soil compactors and structural, repair

and replacement parts for all the foregoing, structural, repair and replacement parts for engines for all the foregoing; machinery for earth moving, earth conditioning and material handling, namely, soil compactors, vibratory asphalt compactors, pneumatic compactors, asphalt pavers, track asphalt pavers, screeds, cold planers, road reclaimers, windrow elevators, soil stabilizers, underground mining loaders, waste handlers and structural, repair and replacement parts for all the foregoing, structural, repair and replacement parts for engines for all the foregoing; attachments, namely, asphalt cutters, augers, backhoes, blades, block-handling tools, hydraulic booms, buckets, cold planers, compactors, vibratory compactors, couplers, crushers, cutting jaws, de-limbers, forks, pallet forks, grapples, hammers, hoppers, lift groups, all of the foregoing for use with machinery for earth moving, earth conditioning and material handling; attachments, namely, lifting hooks, material handling arms, multi-processors, plows, pulverizers, pulverizing jaws, rakes, rippers, saws, scarifiers, scoops, shears, snow blowers, snow plows, snow wings, all of the foregoing for use with machinery for earth moving, earth conditioning and material handling; attachments, namely, stump grinders, thumbs, tillers, trenchers, truss booms, all of the foregoing for use with machinery for earth moving, earth conditioning and material handling; marine engines; industrial engines; diesel engines; gas engines; natural gas engines; valves (part of machines); spark plugs; air filters (parts of machines or engines); water regulators (parts of machines); oil filters; couplings other than for land vehicles; assembly presses; starters; pumps; diggers; excavators; bulldozers; loaders; fellers; bunchers; scrapers (part of earth moving machines); pavers; agricultural machines; engines for industrial, marine and other applications, and parts therefor; engines for electric, industrial, diesel, gas and natural gas generators and generators sets, and parts therefor; cutting machines; compactors; skidders; filters (parts of machines and engines); belts (parts of machines, motors and engines); blades (parts of machines); earth moving machines; road marking machines; road making machines; lifting machines; agricultural apparatus and instruments; steam rollers; forestry machines; pipe laying machines; compacting machines; buckets for earth moving machines; hydraulic jacks; welding machines and apparatus; forestry machines for harvesting, extracting, loading and transporting timber; jet engines not for land vehicles; ground engaging machines; air cleaning filters (parts of machines or engines); pavement profilers; scarifiers to break up surfaces, in particular, topsoil and pavement; motor graders; fuel/air ratio controls; fuel nozzles; water separators; cultivating and harvesting machines, threshing machines, heading machines, reaping machines, binding machines, mowing machines; harrows; ploughs and rakes; draining machines; diggers (machines); aeronautical engines; agitators; air condensers; alternators; anti-friction bearings for machines; anti-friction pads for machines; anti-pollution devices for motors and engines; axles for machines; ball rings for bearings; bearing brackets for machines; bearings; belt conveyors; belts for machines; belts for motors and engines; blades (parts of machines); seal group assemblies (parts of machines), in particular, seal rings and elastomeric torus members; sealing joints (parts of engines); engines and motors for boats; brake linings other than for vehicles; brake segments other than for vehicles; brake shoes other than for vehicles; brushes (parts of machines); carburetors; compressed air machines; compressed air pumps; compressors (machines); condensing installations; connecting rods for machines, motors and engines; control cables for machines, engines or motors; control mechanisms for machines, engines or motors; current generators; control panels for generator sets; cutters (machines); cutting machines; cylinder heads for engines; cylinders for machines; cylinders for motors and engines; drilling bits (parts of machines); drilling heads (parts of machines); drilling machines; drilling machines; drills; dynamo belts; dynamo brushes; dynamos; engines, other than for land vehicles; fan belts for motors and engines; fans for motors and engines; fuel conversion apparatus for internal combustion engines; fuel economisers for motors and engines; gear boxes other than for land vehicles; gears, other than for land vehicles; grinding machines; guards (parts of machines); hammers (parts of machines); pneumatic hammers; mechanically operated hand held tools; handling apparatus for loading and unloading; hoists; holding devices for machine tools; mechanical discharging hoppers; jacks (machines); lawnmowers (machines); lift belts; lifting apparatus; loading ramps; lubricating pumps; lubricators (parts of machines); machine fly wheels; machine wheels; apparatus for machining; metal working machines; spray guns for paints; painting machines; pistons; pneumatic transporters; presses; pulleys; pumps (machines); rammers (machines); reduction gears other than for land vehicles; mechanical shovels; shaft couplings; bearings for transmission shafts; speed governors for machines, engines and motors; spraying machines; superchargers; tarring machines; threading machines; threshing machines; transmission chains and shafts, other than for land vehicles; transmissions for machines; turbines other than for land vehicles; turbocompressors; valves (parts of machines); vehicle washing installations; vulcanisation apparatus; washing apparatus; waste disposers (machines); watering machines; parts

and fittings for all the aforesaid goods; parts and fittings included in class 07 for land vehicles; agricultural machinery and earth moving machinery, namely, starting motors, alternators, pistons, cylinder heads, turbochargers, lubricating systems parts, air compressors and blocks not for land vehicles; silencers; air pumps; fuel economisers for motors and engines; exhausts; cranks; mufflers (parts of machines); exhaust caps; radiators and radiator caps; alternators; pistons; cylinder heads; turbochargers; lubricating systems parts; air compressors and blocks; replacement parts for earth moving machinery and diesel engines; welding apparatus; automatic vending machines; petrol pumps; cutting torches; electric welding apparatus; welding apparatus; combines, windrowers, balers, disc mowers and conditioners, sickle mowers and conditioners, bale accumulators and structural, repair and replacement parts for all of the foregoing, mufflers (parts of machines), silencers, fuel economisers, exhausts, hydraulic apparatus for land vehicles, mechanical engine parts for land vehicles, air compressors for land vehicles;

Class 8 - Hand tools and implements (hand-operated); taps and dies; hand jacks (hand tools); cable cutters (hand-operated); cutters; wrenches (hand-operated); knives; glass installation tools; crimping tools (hand operated); cutting tools (hand tools); fan blades (hand tools); reversing tools; hose cutters; drills and drill bits; grease guns; sockets; torque wrenches; cutlery; side arms; razors; vices (hand tool); parts and fittings for all the aforesaid goods; parts and fittings included in class 8 for land vehicles, agricultural machinery and earth moving machinery;

Class 12 - Vehicles for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; locomotives; railcars; engines and air intake and exhaust assemblies for land vehicles; and parts and fittings for all of the foregoing goods; apparatus for locomotion by land, air or water; tractors and tractor engines; haulage trucks and trailer wagons; vehicles for mining, paving, agriculture, forestry, earth conditioning and material handling, namely, articulated trucks, off highway trucks, underground mining trucks, off highway tractors; internal combustion fork lift trucks; electric fork lift trucks; electric pallet movers, manual pallet movers; locomotives; agricultural tractors; structural, repair and replacement parts for engines for the foregoing vehicles; vehicle chassis; tires for vehicle wheels; wheels; tracks for vehicles; trucks; dump trucks; land vehicles incorporating loading, compacting, pipe laying and grading apparatus; tire valves; exhaust caps; radiators and radiator caps; hydraulic circuits and hydraulic adapters; couplings for land vehicles; air pumps (vehicle accessories); horns for vehicles; mirrors for vehicles; mudguards, mud flaps, spray guards, spray flaps; seats and seat belts; windscreen wipers and windscreen wiper blades, anti-skid apparatus; anti-skid chains; brakes for vehicles; brake linings for vehicles; vehicle covers; parts and fittings for all the aforesaid goods; parts and fittings included in class 12 for land vehicles, agricultural machinery and earth moving machinery, namely, gaskets, cranks, camshafts, engines, bearings, rods, liners, transmissions for land vehicles and structural, repair and replacement parts therefore; starting motors, alternators, pistons, cylinder heads, turbochargers, lubricating system parts, brake blocks for land vehicles; connecting hoses for vehicle radiators;

Class 37 - Building construction; engineering construction; repair and installation services relating to vehicles, equipment, machines, engines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; installation and maintenance of apparatus for oil-field and gas-field exploitation, and for energy production; service, maintenance, and repair of land vehicles, earth moving, earth conditioning, material handling, construction, mining, paving, agricultural, and forestry vehicles, equipment, and machinery, engines, and power generation equipment, and control units for the aforementioned; machinery installation, maintenance, and repair; rental and leasing of engineering, earth moving, earth conditioning, farming, material handling, construction, mining, paving, agricultural, and forestry vehicles, equipment, and machinery, as well as engines, generators and power generation equipment; remanufacturing of engines, transmissions, power train components, power generation units, land vehicles, earth moving and conditioning machinery, material handling

machinery, agricultural machinery, paving and construction equipment, electronic components of the foregoing, and consumer electronics; repair, servicing, and maintenance of vehicles, engines, equipment, machines, machine tools, and control units and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; repair, servicing, and maintenance of vehicles, engines, equipment, machines, machine tools, and control units and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring and vegetation management; machinery installation; rental of equipment, machines, and machine tools for use in compaction, construction, demolition, earth conditioning, earth contouring, earth moving, lifting, marine propulsion, material handling, mining, paving, pipelaying, and road building and repair, site preparation and remediation, and tunnel boring; remanufacturing of vehicles, engines, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; remanufacturing of vehicles, engines, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; providing searchable computer databases, websites, and online information services relating to renting of equipment, machines, machine tools and parts therefor for use in compaction, construction, demolition, earth conditioning, earth contouring, earth moving, lifting, mining; providing searchable computer databases, websites, and online information services relating to repair and maintenance of vehicles, equipment, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; providing searchable computer databases, websites, and online information services relating to renting of equipment, machines, machine tools, and parts therefor, for use in paving, pipelaying, road building and repair, site preparation and remediation, tunnel boring; providing searchable computer databases, websites, and online information services relating to repair and maintenance of engines and power generation equipment; providing searchable computer databases, websites, and online information services relating to repair and maintenance of vehicles, equipment, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring and vegetation management; rental store services in relation to earthmoving, construction, oil and gas extraction and mining machines and equipment, motors and engines, machine tools, machine coupling and transmission components and parts, fittings and components for the aforesaid.

- 6 By decision of 30 November 2021 ('the contested decision'), the Opposition Division refused the trade mark applied for, for all of the contested goods and services on the grounds that a likelihood of confusion existed. It gave, in particular, the following grounds for its decision, on the basis of the opponent's EUTM registration No 15 167 711:
- All conflicting goods and services are identical or similar to high degree.
 - The Opposition Division finds it appropriate to focus the comparison of the signs on the English-speaking part of the public such as in Ireland and Malta.
 - The goods are directed at the public at large as well as at business customers with specific professional knowledge or expertise. The degree of attention may vary from average to high, depending on the specialised nature of the goods, the frequency or purchase and their price.
 - The signs are similar. The earlier mark is a figurative sign consisting of the stylised verbal element 'CAT' in upper-case letters placed atop a yellow

triangle device. Despite said stylisation, the relevant public will have no difficulty in immediately perceiving the presence in the sign of the term ‘CAT’, being the normal word used in English for small felines usually kept as pets. This word is meaningful for the English-speaking part of the relevant public and, as it bears no direct reference to the goods or services in question, it has a normal degree of distinctive character.

- The figurative device of the earlier mark is a simple geometric shape and it will be perceived as being essentially decorative in nature.
- In any event, account is taken of the fact that when signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component.
- As far as the contested sign is concerned, it features the verbal element ‘GreenCat’. The public under analysis will have no difficulty in dissecting the said verbal element into the components ‘Green’ and ‘Cat’ not least given the irregular capitalisation. While the component ‘Green’ will be regarded as referring to the fact that at least some of the contested goods/services are intended for use in the areas of agriculture, gardening or landscaping – in which fields the use of the colour green is quite common – it is at best distinctive to a weak degree, in any event this word will be perceived as informing the consumer that the relevant goods/services will not harm the environment.. Meanwhile, the component ‘Cat’ has a normal degree of distinctive character.
- While the device of the cat is distinctive to a normal degree for the relevant goods/services for the reason given above, it will be regarded as being primarily a reference to the said verbal component ‘Cat’. In any event, the verbal element will enjoy greater weight within the contested sign. The slight stylisation of the verbal elements of the contested sign as well as the overall rectangular framing thereof will be perceived as being primarily decorative and so not play a substantial role in the trade mark appreciation of the contested sign. Taking into account the silhouette-type depiction of the cat’s face in the contested sign as well as the fact that the verbal elements thereof are in the colour yellow, which has the effect of drawing the eye thereto, the Opposition Division considers that none of the elements of the signs at issue is clearly dominant in the sense of being visually outstanding. Therefore, the applicant’s assertion that the device of the cat’s face is the dominant element of the contested sign must be set aside as not well founded.
- Conceptually, as both signs at issue coincide in the concept of a cat for the public under analysis, the concept of which is reinforced by the device of a cat in the contested sign, they are conceptually highly similar, and this is so despite the fact that the contested sign features the meaningful component ‘Green’, which is distinctive to a weak degree.
- Visually and aurally, the signs coincide in the word/component/sound ‘CAT’ differing in the additional verbal component/sound ‘Green’ of the contested

sign, which has a weak degree of distinctive character, and – visually speaking – in the figurative/stylised elements of both signs, all of which have less impact than the verbal elements as explained above.

- Although it is true that consumers tend to focus more attention on the beginning of a sign, given the Western practice of reading from left-to-right, this general rule is counteracted somewhat in this case both due to the fact that the non-coinciding word ‘Green’ has a weak degree of distinctive character as well as the fact that, visually speaking, the device of the cat’s face reinforces the coinciding verbal element ‘Cat’.
- The Opposition Division considers that the signs at issue are visually similar to a low degree and aurally similar to an above-average degree.
- For reasons of procedural economy, the evidence filed by the opponent to prove its claim of enhanced distinctiveness does not have to be assessed in the present case. Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se, which in the present case must be seen as normal.
- The differences between the signs, pertaining to the additional component ‘Green’ of the contested sign, which has a weak degree of distinctive character, as well as the figurative/stylised elements of both signs, having weaker impact than the verbal elements, are not enough to counteract the similarities, especially the aural and conceptual similarities, due to the coinciding distinctive word/component ‘CAT’. Moreover, the device of a cat’s face in the contested sign tends to reinforce the similarity due to the said coinciding word/component ‘CAT’. In addition, the interdependence principle means that both the identity of the goods/services (where applicable) and the above-average or high degree of aural/conceptual similarity can compensate for the lesser degree of visual similarity between the signs at issue. In particular, a risk of confusion cannot safely be excluded in this case, where the coinciding word ‘CAT’ constitutes the only verbal component of the contested sign having a normal degree of distinctive character. Indeed, it is quite conceivable that the relevant consumer will perceive the contested mark as a sub-brand of the earlier mark, configured in a different way according to the type of goods/services that it designates.
- There is a likelihood of confusion on the part of the English-speaking part of the public such as in Ireland or Malta, which is sufficient to reject the contested application. Therefore, the opposition is well founded in its entirety on the basis of the opponent’s European Union trade mark registration No 15 167 711, despite the fact that the degree of attention exercised upon purchase may be higher than average for some of the goods/services.
- As the earlier mark leads to the success of the opposition and to the rejection of the contested trade mark application for all the goods and services against which the opposition was directed, there is no need to examine the other earlier right or grounds invoked by the opponent.

- 7 On 28 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 30 March 2022.
- 8 In its response received on 6 June 2022, the opponent requested that the appeal be dismissed.

Submissions and arguments of the parties

- 9 The arguments raised in the statement of grounds may be summarised as follows:
 - the Opposition Division erroneously considered the conflicting marks similar and reached the conclusion that there exists likelihood of confusion.
 - The element ‘GreenCat’ in the contested sign will be perceived by the relevant public as a single word.
 - The figurative element of the contested sign, namely the image of the cat’s face, is the dominant element which due to its size and position is more eye-catching than the verbal element and will have a greater impact on the relevant public.
 - The fact that the compared signs share the word ‘CAT’ is of little relevance as the marks differ in their overall structures, their number of letters and syllables. These differences render the marks visually and aurally different.
 - The element ‘GREEN’ in the contested sign is at the beginning of the mark and according to the settled case-law, generally the first element is the one that catches the consumer’s attention and therefore, will be remembered more clearly than the rest of the sign.
 - Conceptually, the marks are different because the initial verbal element of the contested sign confers it a different meaning. The combination of the terms ‘GREEN’ and ‘CAT’ is unusual as there are no green cats in nature.
 - The applicant finds some of the compared goods and services dissimilar.
 - Differences between the marks outweigh their similarities, with the consequence that there is no likelihood of confusion for the relevant public. The applicant supports its claim by quoting several Boards of Appeal and Opposition Division decisions.
- 10 The arguments raised in response may be summarised as follows:
 - The opponent requests that the Board dismisses the appeal and orders the applicant to bear the costs of the opposition and appeal proceedings.
 - The coinciding word ‘CAT’ constitutes the only verbal component of the contested sign having a normal degree of distinctive character and the

differences between the signs, pretraining to the additional component ‘GREEN’ of the contested sign, which has a weak degree of distinctive character, as well as the figurative/stylised elements of both signs, having a weaker impact than the verbal elements, are not enough to counteract the similarities, especially the aural and conceptual similarities, due to the coinciding distinctive word component ‘CAT’.

- The opponent refers to its previous submissions in front of the Opposition Division and replies to applicant’s arguments.

Reasons

- 11 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.
- 12 However, the appeal is not well founded for the reasons given below.

Confidentiality

- 13 The opponent marked its submissions during opposition proceedings as ‘confidential’.
- 14 In accordance with Article 114(4) EUTMR, files may contain certain documents which are excluded from public inspection, e.g. parts of the file which the party concerned showed a special interest in keeping confidential.
- 15 Article 114(4) EUTMR provides that files may contain certain documents which are withheld from inspection, in particular if the party concerned showed a special interest in keeping them confidential.
- 16 In the event that a special interest in keeping a document confidential is invoked in accordance with Article 114(4) EUTMR, the Office must check whether that interest is sufficiently shown. Such a special interest must exist because of the confidential nature of the document or its status as a trade or business secret.
- 17 In this case, the opponent requested that some commercial data be kept confidential. Despite the fact that detailed reasoning was not given to demonstrate why Article 114(4) EUTMR would be applicable, the Board will nonetheless follow the approach of the Opposition Division and refer to evidence on reputation in general terms without divulging any data of a sensitive commercial nature.

Article 8(1)(b) EUTMR

- 18 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 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. The likelihood of confusion includes the likelihood of association with

the earlier trade mark. A likelihood of confusion lies in 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 (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29;).

- 19 A likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 16; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).

Relevant Territory, Relevant public and Degree of attention

- 20 In the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of goods and services concerned. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17, 26). It should, however, be recalled that the average consumer's level of attention is likely to vary according to the category of goods or services in question (20/10/2011, T-189/09, P, EU:T:2011:611, § 26; 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 42).
- 21 In the present case, the goods and services at issue target the public at large as well as business customers with specific professional knowledge or expertise with a degree of attention varying from average to high, depending on the specialised nature goods, the frequency of purchase and their price. For the reasons of procedural economy, the Board will proceed as if the level of attention of the relevant public was high in relation to all the goods and services in question.
- 22 Since the earlier mark is a European Union trade mark, the relevant territory for the assessment of the likelihood of confusion is the European Union.
- 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.
- 24 Accordingly, the Opposition Division found it appropriate to focus its analysis on the earlier EUTMR No 15 167 711 and on the basis of the English-speaking public, such as in Ireland and Malta. The Board will follow this undisputed approach.

Comparison of the goods and services

- 25 The goods and services applied for which are at issue in the present appeal are all the goods and services as indicated in paragraph 1 above.

- 26 The assessment of the similarity of the goods and services must take into account all relevant factors, which include their nature, their purpose and method of use, and whether they are in competition with each other or complementary (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 23). Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (11/07/2007, T-443/05, Pirañam, EU:T:2007:219, § 37).
- 27 Goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking. That implies that complementary goods or services can be used together, which presupposes that they are intended for the same public (12/07/2012, T-361/11, Dolphin, EU:T:2012:377, § 48 and case-law cited therein).
- 28 The reference point is whether the relevant public will perceive the goods or services concerned as having a common commercial origin (04/11/2003, T-85/02, Castillo, EU:T:2003:288, § 38) and whether consumers consider it normal that the goods or services are marketed under the same trade mark, which normally implies that a large number of producers or providers are the same (11/07/2007, T-150/04, Tosca Blu, EU:T:2007:214, § 37).
- 29 In order for goods to be regarded as being in competition, there must be an element of interchangeability between them (04/02/2013, T-504/11, Dignitude, EU:T:2013:57, § 42).

Contested goods in Class 7

- 30 The Opposition Division correctly assessed the contested ‘power saws; rock bits for drilling machines; drilling machines; cutting, drilling, abrading, sharpening and surface treatment machines and apparatus; ground drilling apparatus [machines]; steerable drilling machinery for earth displacement; pulping machines; mills and crushing machines; waste grinders and waste presses [electric waste disposal units]; waste crushing machines; lawnmowers [machines]; clearing saws [machines]; tree branch cutters [machines]; sand cleaning machines; blowing engines; agricultural machine tools; agricultural, gardening and forestry machines and apparatus; motorized cultivators; motor hoes [machines]; line trimmers for garden use; garden tilling machines; gardening tools (electric -); power blowers for lawn debris; garden tractors for mowing lawns; garden rotavators; harvesting machines; blowing machines; lawn edge trimmers [machines]; hedge cutters [machines]; pruning saws [electric]; lopping shears [machines]; pruning saws [motorised]; gardening machines (powered -)’ are either identically included (in both lists of goods in Class 7) or otherwise included within at least one of the broader categories of the earlier ‘machines and engines and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation

management’. Therefore, they are identical to the goods in Class 7 of the earlier trade mark.

- 31 The contested ‘compressors; air compressors’ are identically contained within or are included within the broader category of the earlier ‘compressors (machines)’. Therefore, they are identical.
- 32 The contested ‘current generators; diesel electric generators; electrical generators using solar cells’ are identically contained within or are otherwise overlap with the earlier ‘current generators’. Therefore, they are identical to the goods in Class 7 of the earlier trade mark .
- 33 The contested ‘pressure washing machines’ overlap with the earlier ‘washing apparatus’. Therefore, they are identical to the goods in Class 7 of the earlier trade mark.
- 34 The contested ‘soldering apparatus, electric’ is included within the broader category of the earlier ‘metal working machines’. Therefore, they are identical to the goods in Class 7 of the earlier trade mark.
- 35 The contested goods ‘industrial vacuum machines for cleaning; robotic cleaning machines; cleaning machines for ponds; swimming pool cleaning machines; steam cleaning machines; floor cleaning machines; robotic swimming pool cleaning machines’ are highly similar to the earlier ‘washing apparatus’ as they have the same general purpose of cleaning and they may coincide in distribution channels, relevant publics and producers. Some are also complementary.
- 36 As regards the contested ‘water pumps; water supply machines [pumps]; engine driven water pumps; pumps [machines]’, these goods are included within the broader category of the earlier ‘pumps (machines)’ and they are, therefore, identical. Accordingly, the applicant’s argument that these goods are different to the earlier ‘water regulators’ must be set aside as irrelevant.

Contested goods in Class 8

- 37 The Board endorses the finding of identity between the goods in this class in the contested decision. Indeed, all of the of the contested goods – which are various hand or hand-operated tools for use in agriculture, gardening, landscaping, as well as for cutting, drilling, grinding, sharpening, and surface treatment – are included within the broader category of the earlier ‘hand tools and implements (hand-operated)’.

Contested services in Class 37

- 38 The Opposition Division rightly concluded that the contested services ‘maintenance and repair of garden tools; repair or maintenance of machines and apparatus for lumbering; maintenance and repair of earth moving equipment’ overlap with the earlier ‘repair, servicing, and maintenance of equipment, machines, machine tools, and control units and parts therefor, for use in earth conditioning, earth contouring, earth moving, forestry, landscaping’ having regard

to the fact that the earlier landscaping is broad enough to encompass landscape gardening tools. Therefore, they are identical.

- 39 The contested term ‘advisory services relating to the maintenance and repair of mechanical and electrical equipment’ overlaps with the earlier ‘providing information services relating to repair and maintenance of equipment, machines, machine tools, and parts therefor, for use in agriculture’. Therefore, they are identical.
- 40 As regards the contested services ‘maintenance of cleaning machines’, they are included in the broader category of the earlier ‘machinery installation, maintenance, and repair’, hence, they are identical.
- 41 As regards the contested ‘rental of cleaning machines’, these services overlap with the very broad term of the earlier services ‘rental of machines for use in construction, demolition, and road building’ as cleaning machines in Class 7 may encompass industrial sweepers, industrial vacuum cleaners or road sweepers which are used to keep construction sites clean and safe. Consequently, these services are also identical, despite the applicant’s argument to the contrary.

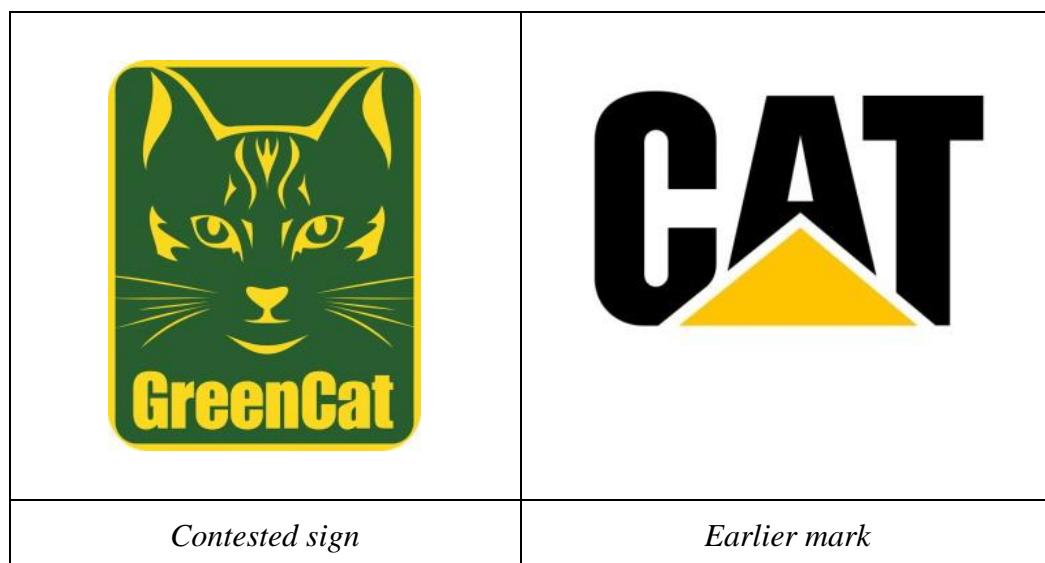
Conclusion on comparison of goods and services

- 42 To sum up, the compared goods and services are identical or similar to a high degree.

Comparison of the marks

- 43 The global appreciation of the similarity between the signs includes an examination of whether the two signs concerned are visually, aurally or conceptually similar, which must be carried out on the basis of the overall impression created by them and bearing in mind, in particular, their distinctive and dominant components (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 25, 27; 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).
- 44 Furthermore, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more visual, phonetic or conceptual aspect (02/12/2009, T-434/07, Solvo, EU:T:2009:480, § 31; 13/09/2010, T-149/08, Sorvir, EU:T:2010:398, § 29; 14/04/2011, T-466/08, Acno focus, EU:T:2011:182, § 52).
- 45 The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 41).

46 The signs to be compared are:



- 47 The earlier mark is a figurative mark consisting of the word ‘CAT’ in black upper-case letters and a yellow triangle serving as a foot support or pedestal to the mentioned verbal element.
- 48 The contested sign is a figurative mark consisting of the verbal element ‘GreenCat’ depicted in a yellow bold typeface and a figurative element resembling the silhouette profile outline of a cat’s face in yellow. These elements are depicted on a green rectangular background with a yellow frame.
- 49 In the case at hand, the word ‘CAT’ will be understood by the relevant public as a small feline usually kept as a pet and is inherently distinctive for the goods and services in question. On the other hand, the word ‘GREEN’ will be perceived as referring to the fact that at least some of the contested goods/services are intended for use in the areas of agriculture gardening or landscaping – fields in which the use of the colour green is quite common – or that relevant goods/services will not harm the environment and therefore it is of a weak distinctive character. As a result, contrary to the applicant’s assertions, that word element will be given a lesser degree of attention in the public’s perception of that sign (12/05/2021, T-70/20, MUSEUM OF ILLUSIONS (fig.) / MUSEUM OF ILLUSIONS (fig.), EU:T:2021:253, § 57)
- 50 The Board rejects the applicant’s argument that the verbal element of the contested sign ‘GreenCat’ will be perceived by the relevant consumers as a single word. This assertion contravenes long-established case-law which states that consumers, when perceiving a sign containing verbal components tend to break it down into elements, which for them, suggest a concrete meaning or which resemble known words (06/10/2004, T-356/02, Vitakraft, EU:T:2004:292, § 51; 06/09/2013, T-599/10, Eurocool, EU:T:2013:399, § 104). As rightly asserted by the Opposition Division, the public under analysis will have no difficulty in dissecting said verbal element into the components ‘Green and ‘Cat’ not least given the irregular

capitalisation, which merely emphasises its straightforward and obvious construction of two well defined word elements.

- 51 Where a trade mark is composed of verbal and figurative elements, the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name rather than by describing the figurative element of the trade mark (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 18/02/2016, T-364/14, B!O / BO, EU:T:2016:84, § 24).
- 52 In the earlier mark, the yellow triangle at the bottom of the letter 'A' is a simple geometrical shape. The triangle device is therefore unlikely to have any major impact on the consumer's perception of the sign as a whole, instead focusing on the distinctive word element 'CAT' contained therein.
- 53 As regards the contested sign, while the device of the cat is distinctive in relation to the goods and services at issue, it merely underlines and refers to the distinctive verbal element 'CAT'. The slight stylization of the verbal elements of the contested sign as well as the overall rectangular framing thereof will be perceived as being primarily decorative and so do not play a substantial role in the trade mark appreciation of the contested sign.
- 54 The applicant states that the figurative element of the contested sign, in particular the yellow image of cat's face placed on a green background, is given its position and size, the visually dominant element of the contested sign. This argument of the applicant was already considered by the Opposition Division which in reply found that none of the elements of the sign at issue is clearly dominant in the sense of being visually outstanding. That is due to the fact that the cat's face is a sketch with a yellow outline, not significantly larger than the verbal element, which is depicted in bold yellow typeface, equally drawing the public's attention thereto. This finding is concurred by the Board.
- 55 It is against this background that the conflicting signs have to be compared.
- 56 Visually, the signs are similar to a slightly lower-than-average degree as they coincide in the word 'CAT' and differ in the verbal element 'GREEN', which is of a weak distinctive character, and in the figurative elements of both marks, all of which have less impact than the verbal elements as explained above.
- 57 The yellow colouring of both marks is not substantially different in terms of colour code and the green of the contested mark reinforces the word element 'green' and the concept of eco-friendliness or greenness of the relevant goods and services, namely that they are a range of goods and services that are less damaging to the environment than other goods and services available in the market. As mentioned above, the graphic depiction of the 'cat', although not present in the earlier mark, reinforces the concept of a feline animal and could be perceived as a revamping of the opponent's marks in line with its eco-friendly product and service range.
- 58 Aurally, the signs are similar to an average degree due to the coincidence in the distinctive element 'CAT'. As explained above, the other verbal element in the

contested sign 'GREEN', will play a secondary role therein, due to its weak distinctive character.

- 59 Conceptually, the marks are similar to a high degree as they coincide in the concept of a cat, which is reinforced by the device of a cat in the contested sign. The element 'GREEN' of the contested sign does not significantly differentiate that concept in view of its weak degree of distinctiveness

Distinctiveness of the earlier mark

- 60 In determining the degree of distinctive character of a trade mark, an overall assessment has to be made of the greater or lesser capacity to identify the goods for which it has been registered as coming from a particular undertaking. Account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element that is descriptive of the goods for which it has been registered and other criteria; in particular, how intensive, geographically widespread and long-standing the use of the mark has been (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 22-23).
- 61 As such, the distinctive character of a trade mark can be appraised only, first by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public.
- 62 In the present case, the earlier trade mark as a whole has no meaning in relation to the goods and services at issue from the perspective of the public in the relevant territory. Therefore, the inherent distinctiveness of the earlier mark must be seen as normal.
- 63 According to the opponent, the earlier mark has been extensively used and thus enjoys reputation and an enhanced scope of protection in the EU.
- 64 The Board finds that the evidence submitted by the opponent confirms the enhanced distinctiveness and reputation of the earlier mark in relation to, at least, part of the earlier goods in Class 7.
- 65 In particular, during the opposition proceedings, the opponent submitted evidence that shows reputation, *inter alia*, in the following EU Member States:

- Germany:

According to market survey carried out in Germany in 2010 by Gesellschaft für Konsumforschung (GfK), 92.8% of the interviewees (working in companies using construction or mining vehicles, machines or engines) know the term CAT or have seen it before and that 93.5% have seen the term CAT in relation to construction machinery and engines. Moreover, 72.2% of the interviewed persons say that CAT refers only to one company and 61.8% of all respondents finally mentioned Caterpillar or Caterpillar's dealers as the name of this company. Finally, 85.2% of all respondents agree that CAT is a high quality brand, 85.8% that CAT has a long tradition.

According to a market survey carried out in Germany in 2018 by GfK Company among the general public: 77.2% of the respondents with high, some or no interest in construction machines know the name CAT spontaneously and without reference to any particular product; 81,4% of the respondents associate the sign with construction machines; 51% link the sign to one sole company, namely Caterpillar; and as many as 92,3% think the sign stands for 'high quality'.

The opponent promoted the earlier mark during the Bauma Exhibition in Munich in 2013, 2016 and 2019.

- Poland:

According to a 2011 market study carried out by GfK in Poland 96% of the respondents know the name CAT, 76% associate the name with machines used in the building industry (spontaneous response to an open question) and 85% know that the CAT machines come from one company. Of those respondents that know the name of this company, 93% name Caterpillar or Cat. Furthermore, 45% claim to know the name CAT for more than 10 years and 96% agree that CAT offers high quality services, while 90% agree that it is a brand of high quality and has long tradition.

- Finland:

According to a market survey carried out in Finland by Taloustutkimus Oy in 2011, 90% of the employees of construction and mining companies recognised the term 'CAT' without any product reference. Of those who were familiar with the term CAT, a majority associated it spontaneously with e.g. Caterpillar, earthmoving/earth movers, backhoes/diggers, large construction machines/machine brand, and wheel-mounted loaders. The awareness of the term CAT in connection with construction and mining vehicles, machines and engines was 93% of the target group. Moreover, a total of 61% of the respondents said that CAT is an indication for one specific company. Of those, 86% of the respondents name Caterpillar or Caterpillar's dealers as the name of this company.

- Other EU Member States:

The opponent invests heavily in marketing and promotion campaigns throughout the EU;

The opponent exhibits its products at relevant trade shows throughout the EU;

The reputation of the earlier mark 'CAT' in relation to some of the earlier goods in Class 7 and services in Class 37 has been confirmed by various decisions and court rulings, including:

- 23/04/2010, R 93/2009-1, RAMKAT / CAT et al., § 25 for, at least, Spain, Germany and Ireland in connection with goods in Class 7;

- Opposition Division decision 16/08/2011, B 1 069 394, V-CAT visible-light photocatalyst (fig.) / CAT (fig.), for, at least, Spain, Germany and the UK in connection with engines, motors, machinery and heavy industrial and construction vehicles, rental and leasing of these goods, covered by the earlier trade marks in Classes 7, 12, 37 and 42.

66 The aforementioned evidence shows reputation and a high degree of enhanced distinctiveness of the earlier mark for, at least, machines used in the building and construction industry in Class 7.

Overall assessment of the likelihood of confusion

- 67 The appreciation of likelihood of confusion on the part of the public depends on numerous elements and, in particular, on the recognition of the earlier mark on the market, the association which can be made with the registered mark, the degree of similarity between the marks and between the goods or services identified. It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).
- 68 Such a global assessment of a likelihood of confusion implies some interdependence between the relevant factors, and in particular, the similarity between the trade marks and between the goods or services. Accordingly, a greater degree of similarity between the goods or services may be offset by a lower degree of similarity between the marks, and vice versa (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).
- 69 In the present case the conflicting goods and services have been found to be mostly identical and partly highly similar.
- 70 A complex mark and another mark which is identical to one of the components of the complex mark can be considered to be similar only if that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (see, *inter alia*, judgments of 23/10/2002, T-6/01, Matratzen + Matratzenmarkt Concord (fig.), EU:T:2002:261, § 33; of 13/04/2005, T-286/03, RIGHT GUARD XTREME SPORT (fig.) / WILKINSON SWORD XTREME III (fig.), EU:T:2005:126, § 60,73-74; and 07/07/2005, T-385/03, Biker Miles, EU:T:2005:276, § 39).
- 71 This occurs in the present case where the dominant component of the earlier mark, the word ‘CAT’, is visually, phonetically, and conceptually identically reproduced in the contested mark. Furthermore, this element is the more important of the word elements in the contested sign and it will not be disregarded in favour of the figurative elements. Indeed, the triangle of the earlier mark is simply a basic geometric figure, and the figurative element of the contested mark represents exactly the same coinciding concept; a cat. Therefore, the contested mark could be

perceived as a graphic variant of the earlier mark. The adjective ‘GREEN’ does not serve to make the marks different since it has, at best, a weak distinctive character for the goods and services at hand, as indicated above.

- 72 In applying an overall, global assessment of all relevant facts of the case, the Board finds that a risk of confusion within the meaning of Article 8(1)(b) EUTMR cannot be safely excluded in the present case, in view of the similarities between the signs at hand, in respect of the contested goods and services that have been found identical or highly similar to the earlier goods and services and even considering the inherent distinctiveness of the earlier mark, also bearing in mind the principle of imperfect recollection, regardless of the high level of attention displayed by part of the relevant public (21/11/2013, T-443/12, *ancotel*, EU:T:2013:605, § 54).
- 73 Consumers are likely to believe that the goods and services at issue come from the same undertaking or at least from economically-linked undertakings when marked with the conflicting signs. It cannot be excluded that the relevant public will perceive the contested mark as a variation or sub-brand of the earlier mark for a specific line of goods and services.
- 74 This conclusion is further underlined by the fact that the earlier mark is endowed with a strong reputation and enhanced distinctiveness – at least – insofar as machines used in the building and construction industry in Class 7 are concerned. Indeed, according to established case-law, the more distinctive the earlier mark, the greater will be the likelihood of confusion, 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, § 18).
- 75 As such the conclusions drawn above are also in line with previous case-law of the Court and the Boards themselves regarding cases concerning similar facts:
- 13/07/2012, T-251/21, *Tigercat / CAT (fig.) et al.*;
 - 09/06/2020, R 1016/2019-2, *Speedcat / CAT (fig.) et al.*;
 - 23/04/2010, R 93/2009-1, *RAMKAT / CAT et al.*;
 - 26/02/2010, R 992/2009-2, *BLACK CAT (fig.) / CAT (fig.) et al.*;
 - 24/02/2010, R 125/2009-2, *TWINCAT / CAT (fig.)*.
- 76 This conclusion cannot be refuted by the applicant’s references to previous decisions of the Opposition Division and the Boards of Appeal, which allegedly show that no likelihood of confusion was found in cases similar to the one at hand. The Board must set this argument aside as none of the examples quoted by the applicant are clearly comparable to the present case as they involve signs containing multiple verbal elements or signs in which the overlapping elements are of secondary importance.

- 77 It was for the applicant to clearly set out thorough reasoning as to why it considered those decisions cited to be relevant to the present proceedings. Nevertheless, the applicant submitted no such arguments.
- 78 In any event, the Boards of Appeal are not bound by previous decisions, as each case has to be dealt separately and with regard to its particularities. According to settled case-law, the legality of decisions is to be assessed purely with reference to the EUTMR, and not to the Office practice in earlier decisions (30/06/2004, T-281/02, *Mehr für Ihr Geld*, EU:T:2004:198, § 35). The principle of legality shall always prevail and no party can request the repetition of an incorrect decision (27/02/2002, T-106/00, *Stream-serve*, EU:T:2002:43, § 66-67).

Conclusion

- 79 Consequently, the appeal is dismissed in its entirety and the contested decision is confirmed. As the earlier EUTM No 15 167 711 leads to the success of the opposition and the rejection of the appeal, there is no need to examine the other earlier right and/or grounds invoked by the opponent (16/09/2004, T-342/02, *Moser Grupo Media, S.L.*, EU:T:2004:268, § 46, 48).

Costs

- 80 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.
- 81 As to the appeal proceedings, these consist of the opponent's costs of professional representation of EUR 550.
- 82 As to the opposition proceedings, the applicant shall bear the opposition fee of EUR 320 and the opponent's representation costs which were fixed at EUR 300.
- 83 The total amount for both proceedings is therefore EUR 1 170.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to bear the opponent's fees and costs in the opposition and appeal proceedings of EUR 1 170.**

Signed

G. Humphreys

Signed

A. González Fernández

Signed

M. Bra

Registrar:

Signed

H. Dijkema

