



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Opposition Division

DECISION No 123/2000

of 28/01/2000

RULING ON OPPOSITION No B 30348

Opponent: **Actel S.C.L.**
Ctra. Valle de Aran, Km. 3
25196 Lleida
Spain

Representative: **Mr Angel Pons Ariño**
Avenida Oscar Esplá, 24 bajo
03003 Alicante
Spain

Trade Mark:



a g a i n s t

Applicant: **Actel Corporation**
955 E. Arques Avenue
Sunnyvale, CA 94086
United States of America

Representative: **J A Kemp & Co**
14 South Square
Gray's Inn
London WC1R 5LX
United Kingdom

Contested application:

ACTEL (word mark)

THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

I. FACTS AND PROCEDURE

On 04/11/1996 Actel Corporation, “the applicant”, filed application No 394866 to register the word ACTEL as a trade mark in class 9. The applicant was represented by the association of representatives J A Kemp & Co, authorised to represent others before the Office.

The application was published in Community Trade Marks Bulletin No 01/98 of 05/01/1998.

On 03/04/1998 Actel S.C.L., “the opponent”, filed a notice of opposition to the application. The opponent was represented by Mr Angel Pons Ariño, authorised to represent others before the Office.

The opposition is based on the following earlier rights:

- Community trade mark registration No 370981 of the figurative mark ACTEL. It was filed on 13/09/1996 and registered on 30/10/1998 for a range of goods and services in classes 31 and 42.
- Spanish trade mark registration No 1794804/5 of the figurative mark ACTEL. It was filed on 16/12/1993 and registered on 20/04/1994 for a range of services in class 42.
- Spanish trade mark registration No 1794803/7 of the figurative mark ACTEL. It was filed on 16/12/1993 and registered on 22/05/1996 for a range of goods in class 31.
- International trade mark registration No 667110 of the figurative mark ACTEL with effect in Germany, the Benelux countries, France, Italy and Portugal. It was registered on 16/12/1996 for a range of goods and services in classes 31 and 42.

The opponent has proved he is the current owner of the registered marks by filing copies of the registration certificates.

The opponent bases his opposition on all the goods and services which are covered by his registrations namely:

- *“Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.”* (class 31);
- *“Services of a group to its own members”* (class 42).

The opponent directs his opposition against all the goods of the application:

- *“Integrated circuits; integrated circuits being field programmable gate arrays and system programmable gate arrays, and software for programming field programmable gate arrays and system programmable gate arrays” (class 9).*

The grounds of the opposition are those of Article 8(1)(a) and (b) of the CTMR (Council Regulation 40/94).

On 27/07/1998 the applicant was notified of the opposition which was assigned number B 30348.

English was established as the language of the proceedings.

The adversarial part of the proceedings began on 08/10/1998.

On 14/10/1998 the applicant submitted his preliminary observations in reply to the notice of opposition.

On 22/10/1998 the Office invited the opponent to submit facts, evidence and arguments, not yet provided, that he considered necessary for the support of his opposition. He was given a deadline which expired on 22/12/1998.

On 04/11/1998 the opponent submitted facts, evidence and arguments that he considered necessary for the support of his opposition.

On 11/01/1999 the Office forwarded these facts, evidence and arguments to the applicant. The applicant was given until 11/03/1999 to submit his observations in reply.

On 25/01/1999 the applicant submitted his observations in reply. In these observations the applicant enclosed a copy of the observations he had already submitted on 14/10/1999 and informed the Office that he did not wish to file any further observations on this matter.

The applicant's observations were forwarded to the opponent on 02/02/1999. The opponent was given until 02/04/1999 to submit his observations in reply.

On 18/03/1999 the opponent submitted his observations in reply.

On 19/05/1999 the opponent's observations were forwarded to the applicant.

On 01/07/1999 the Office informed the parties that the “additional documentation”, which the opponent had submitted to the Office on 18/03/1999 would not be taken into consideration by the Office as the time limit for the opponent to furnish, evidence and arguments in support of the opposition already expired on 22/12/1998.

The Office considers that it has sufficient information and now gives a ruling on the opposition.

II. ARGUMENTS OF THE PARTIES

The opponent claims that there is a likelihood of confusion because the dominant component of the opponent's marks, the word ACTEL, is identical to the mark covered by the CTM application and because the trading fields of the goods and services covered by the respective marks are related. He goes on to say that the likelihood of confusion is strengthened by the reputation of the figurative mark ACTEL on the marketplace, not only in Spain but out of Spain as well. The opponent also submits evidence of use of his mark.

In reply the applicant argues that

- although the word ACTEL is common to both marks, the applicant's mark is not identical to the opponent's mark because the opponent's mark incorporates a fanciful logo which prevents any likelihood of confusion between the marks in dispute.
- the goods (and services) covered by both marks are totally different and are sold through different trade channels.
- the opponent has not furnished any evidence to prove that his mark has a distinctive character and repute in the European Union or any member state where the opponent's marks are registered. Thus the applicant denies that the opponent's trade mark has a distinctive character and repute and that the registration of the applicant's mark would take unfair advantage of or be detrimental to the distinctive character and repute of the opponent's mark.
- the fact that the applicant's German trade mark registration No 2042935 ACTEL has co-existed with the opponent's earlier marks since 20/08/1995 shows that the claim of likelihood of confusion between the opponent's mark and the applicant's marks is without foundation.

In reply the opponent argues that

- the fact that the opponent's mark also incorporates a device is not enough to differentiate the marks, since the average consumer normally perceives a mark as a whole and does not proceed to analyse the various details.
- a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and that the public could believe that the respective goods or services come from the same undertaking.
- that his mark does have a distinctive character and reputation in the European Market and that this is proved by both the submitted evidence of use and his international registration which covers Germany, the Benelux countries, France, Italy, and Portugal.
- no evidence has been provided with regard to the coexistence of the applicant's mark with a previous German trade mark. Moreover, according to recent jurisprudence of the Opposition Division, the Office will make its own assessment in each case.

III. DECISION

A. ON THE ADMISSIBILITY OF THE OPPOSITION

The opposition fee has been paid in accordance with the Regulation.

The opposition has been entered within the time limit, form and conditions prescribed.

Consequently, the opposition is admissible.

B. ON THE SUBSTANCE**1. Earlier national right invoked by the applicant**

The task of the Office is to assess whether or not the applicant's mark is confusingly similar to the earlier registrations on which the opposition is based. The circumstance that the applicant is the owner of a national registration is not relevant to the judgment on the two marks. The two marks can be considered similar even though the applicant owns rights which predate the CTM application in a Member State.

2. Identity of goods and signs

According to Article 8(1)(a) of the CTM Regulation (Council Regulation No 40/94), upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected.

Whether or not Article 8(1)(a) of the CTM Regulation is applicable is subject to two requirements being satisfied: both marks must be identical and the goods or services covered by both marks must be identical as well.

In this case the opponent's goods and services are not identical to the applicant's goods.

Article 8(1)(a) CTMR is not applicable as one of the requirements is not satisfied, i.e. the goods and services are not identical.

3. Likelihood of confusion

According to Article 8(1)(b) of the CTM Regulation (Council Regulation No 40/94), upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall 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. Comparison of goods and services

According to the case law of the Court of Justice, “*in assessing the similarity of the goods and services, all relevant factors relating to those goods themselves should be taken into account. Those factors include, inter alia, their nature, end users and method of use, and whether they are in competition with each other or are complementary*” (cf. Judgment of the Court of Justice of 29 September 1998 in the Canon Case C-39/97, Official Journal of the Office for Harmonization in the Internal Market, hereinafter OJ OHIM, No 12/1998, p. 1419, paragraph 23).

The opposition is directed against all the goods of the CTM application, namely against “*Integrated circuits; integrated circuits being field programmable gate arrays and system programmable gate arrays, and software for programming field programmable gate arrays and system programmable gate arrays*” (class 9)

The opponent’s marks cover “*agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt*” in class 31 and “*services of a group to its own members*” in class 42.

“*Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt*” are clearly dissimilar to “*integrated circuits; integrated circuits being field programmable gate arrays and system programmable gate arrays, and software for programming field programmable gate arrays and system programmable gate arrays*” as the nature, the end users and the method of use are different. Moreover, the goods in dispute are neither in competition with each other nor complementary to each other.

As “*services of a group to its own members*” is a vague description which could incorporate a great number of services, it is unclear whether these services are related to the applicant’s “*integrated circuits; integrated circuits being field programmable gate arrays and system programmable gate arrays, and software for programming field programmable gate arrays and system programmable gate arrays*”. Taking this into consideration it is reasonable to conclude that there is no similarity between the opponent’s goods and the applicant’s services.

b. Comparison of signs

According to the case law of the Court of Justice, “*in determining the existence of likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, phonetic and conceptual similarities between the marks. The comparison must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components*” (cf. Judgment of the Court of Justice of 11 November 1997 in the *Sabèl-Puma* Case C-251/95, OJ OHIM No 1/1998, p. 91 paragraph 23).

The following signs have to be compared:



Earlier trade mark

ACTEL

CTM application

As the earlier marks cover the entire European Union, the territory of the European Union needs to be taken into consideration.

The CTM application consists of the word mark ACTEL.

The earlier mark consists of the word ACTEL in upper case and in a slightly fancy typeface. It also incorporates a fanciful representation of an apple encircled by a device with two pointing arrows.

In both marks the word ACTEL is the dominant and distinctive component.

The main visual difference between the marks is the device part of the opponent's mark. The word ACTEL is visually similar in both marks.

As both marks will be orally referred to as ACTEL, they are phonetically identical.

The word ACTEL is an invented word without any meaning in any of the eleven official languages of the European Union. Therefore the visual and phonetic perception of the marks will not be affected by any conceptual similarity or dissimilarity.

Taking into account the visual, phonetic and conceptual comparisons, the overall impression is that the marks are indeed similar.

c) **Distinctive character and reputation of the earlier marks**

Together with the notice of opposition and together with the facts, evidence and arguments the opponent presented evidence of use his mark which consisted of:

- Leaflets in Spanish which show the figurative mark ACTEL in connection with manure (fertiliser);
- Photographs which show boxes and packaging which all bear the figurative mark ACTEL;

- An advertisement in a Spanish publication which bears the figurative mark ACTEL and translates into English: “all kinds of fruit... all days of the year”;
- A sheet of stickers which serve to identify the origin of the products, the category of the products, the products themselves, the variety of the products, the number of fruits etc. All stickers bear the figurative mark ACTEL;
- Blank invoices and delivery notes which all bear the figurative mark ACTEL;
- Copies of packaging material which all bear the figurative mark ACTEL;

On 18/03/1999, together with his observations in reply to the applicant’s observations, the opponent submitted copies of invoices and letters from his distributors in Germany, France and Italy, in which they confirm the time of introduction of the opponent’s products under the mark ACTEL into the respective markets. On 01/07/1999 the Office informed the parties that this added documentation would not be taken into consideration by the Office as the deadline for the opponent to submit facts, evidence and arguments in support of the opposition had expired on 22/12/1998.

This evidence was presumably submitted in order to corroborate the opponent’s allegation that the likelihood of confusion is strengthened by the reputation of the figurative mark ACTEL on the marketplace, not only in Spain but out of Spain as well.

The submitted evidence which will be taken into consideration shows the figurative mark ACTEL in connection with a number of products. However, as the evidence does not show to which extent the mark has been used and during which period of time the mark has been used it is not possible to ascertain whether the figurative mark ACTEL has acquired any reputation which would broaden its scope of protection.

Moreover, neither in the notice of opposition nor in the explanation of grounds did the opponent claim protection under Article 8(5) of the CTMR which deals with “taking unfair advantage of/being detrimental to the distinctive character or the repute”.

d) Conclusion

According to the seventh recital of the CTMR the appreciation of the likelihood of confusion

“ ... depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified...”.

A lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks, and vice versa (see Judgement of the Court of 29 September 1998 in Case C-39/97, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, paragraph 17, published in the OJ OHIM No. 12/98, page 1407 *et seq.*).

In judging likelihood of confusion the Office must take account of the interrelationship between the similarity of the goods and services and the similarity of the marks.

In this case both marks contain the word ACTEL, but since there is no similarity between the goods and services of the two parties, it follows that there is no likelihood of confusion between

the mark of the CTM application used on the applicant's goods and the earlier trade mark used on the opponent's goods and services in the territory in which the earlier trade mark is protected.

C. COSTS

According to the provisions of Article 81(1) of the CTMR, the losing party in opposition proceedings must bear the fees incurred by the other party, as well as all costs.

According to Rule 94(1) of the Implementing Regulation (Commission Regulation EC No. 2868/95), the apportionment of costs is dealt with in the decision on the opposition.

Since the opponent is the losing party in the opposition proceedings, he must bear all costs incurred by the other party in the course of these proceedings.

ON THESE GROUNDS, THE OFFICE DECIDES:

1. Opposition number B 30348 is rejected in its entirety.
2. The costs are to be borne by the opponent.

Alicante, 28/01/2000

Unit 7 of the Opposition Division

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