

OPPOSITION No B 3 133 137

Edex - Educational Excellence Corporation Limited, Makedonitissas, 46, Makedonitissas, Nicosia, Cyprus (opponent), represented by **Michaelidou & Constantinou L.L.C**, Kallipoleos 17, Office 303, 1055 Nicosia, Cyprus (professional representative)

a g a i n s t

Guerbet (Société Anonyme), 15, Rue Des Vanesses, 93420 Villepinte, France (holder), represented by **Regimbeau**, 87, Rue De Sèze, 69451 Lyon Cedex 06, France (professional representative).

On 30/11/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 133 137 is upheld for all the contested services, namely:

Class 42: Scientific studies and research relating to medical imaging; chemical studies and research in relation to diagnostic contrast media for use in medical imaging; consultancy, studies and research relating to pharmacy, medicine, biology, chemistry, radiology, magnetic resonance imaging; design and development of computer software intended for the medical imaging field; installation of software, maintenance of software, software updating, rental of software for use exclusively in the field of medical imaging; chemical analysis services in relation to diagnostic contrast media for use in medical imaging; biological research services in relation to diagnostic contrast media for use in medical imaging.

2. International registration No 1 536 177 is refused protection in respect of the European Union for all of the contested services. It may proceed for the remaining non-contested goods and services.
3. The holder bears the costs, fixed at EUR 620.

REASONS

On 22/10/2020, the opponent filed an opposition against some of the services of international registration designating the European Union No 1 536 177



UNIK
Tailored interconnected solutions
driving your journey to excellence

(figurative mark), namely against all the services in Class 42. The opposition is based on, inter alia, European Union trade mark registration No 16 468 068 'UNIC' (word mark). The opponent invoked Article 8(1)(b) EUTMR.

LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR

Pursuant to Article 8(1)(b) EUTMR, a likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The services

The services on which the opposition is based are the following:

Class 42: Testing, authentication and quality control; science and technology services; design services; IT services.

Following the limitation of the international registration, the contested services are the following:

Class 42: Scientific studies and research relating to medical imaging; chemical studies and research in relation to diagnostic contrast media for use in medical imaging; consultancy, studies and research relating to pharmacy, medicine, biology, chemistry, radiology, magnetic resonance imaging; design and development of computer software intended for the medical imaging field; installation of software, maintenance of software, software updating, rental of software for use exclusively in the field of medical imaging; chemical analysis services in relation to diagnostic contrast media for use in medical imaging; biological research services in relation to diagnostic contrast media for use in medical imaging.

The contested *design and development of computer software intended for the medical imaging field; installation of software, maintenance of software, software updating, rental of software for use exclusively in the field of medical imaging*, are, by nature, services belonging to the IT sector and concerning medical imaging. As such they are encompassed within the broad category of the opponent's *IT services*, which may include services in the medical field or for medical purposes (and, more specifically, IT services concerning medical imaging). Since the Office cannot dissect ex officio the broad category of the opponent's services, they are considered identical to the contested services.

The contested *scientific studies and research relating to medical imaging; chemical studies and research in relation to diagnostic contrast media for use in medical imaging; consultancy, studies and research relating to pharmacy, medicine, biology, chemistry, radiology, magnetic resonance imaging; chemical analysis services in relation to diagnostic contrast media for use in medical imaging; biological research services in relation to diagnostic contrast media for use in medical imaging*, are, in essence, different types of services provided in the scientific, healthcare and medical diagnostic sector. As such they are encompassed within the broad category of the opponent's *science and technology services*, which include, for instance, scientific services related to medical imaging or comparable diagnostic methods. Since the Office cannot dissect ex officio the broad category of the opponent's services, they are considered identical to the contested services.

b) Relevant public — degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the services found to be identical target the public at large as well as business customers with specific professional knowledge or expertise.

The public's degree of attentiveness may vary from average to high, depending on the price, sophistication, or terms and conditions of the services purchased.

c) The signs



The relevant territory is the European Union.

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

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 57). This applies by analogy to international registrations designating the European Union. Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

The marks' word elements 'UNIC' and 'UNIK' may be associated by part of the relevant public (e.g. Spanish, Italian and Portuguese-speaking part) with the term 'UNIQUE', which would be understood as a reference to the exclusivity or uniqueness of the services and hence would be weakly distinctive. Therefore, in order to take into account the most favorable scenario for the opponent, the Opposition Division considers it appropriate to focus the comparison of signs on another part of the public, namely the part who would not attribute any meaning to the terms in question, such as the English-speaking public in Ireland and Malta. For this part of the public the elements 'UNIC' and 'UNIK' have a normal degree of distinctiveness.

The tagline "Tailored interconnected solution driving your journey to excellence", in the contested mark, would be perceived by the public under analysis as a promotional and laudatory expression aimed at describing and praising the quality and characteristics of the services at issue. Therefore, it has a low degree of distinctness.

The figurative element in the contested mark, consisting of three stylized figures (two drops of water, an electric plug, and a brain connected to electrodes) surrounded by circular shapes, although bearing some relation to the services at issue, is fanciful and original and displays a normal degree of distinctiveness.

The stylization of the contested sign's word elements is not particularly original and would not detract the consumers' attention from the word elements as such.

The word element 'UNIK' and the figurative element are co-dominant in the contested mark, while the tagline "Tailored interconnected solution driving your journey to excellence" has a secondary role, due to its position and size. It must be considered, however, that when signs consist of both word and figurative components, in principle, the word component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their word element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace / SELENIUM SPEZIAL A-C-E (fig.), EU:T:2005:289, § 37).

Visually, the signs coincide in the string of letters 'UNI-'. They differ in the last letters 'C' as opposed to 'K', as well as in the figurative element and the the tagline "Tailored interconnected solution driving your journey to excellence" in the contested sign. Given that the earlier mark is almost entirely reproduced in the contested sign's dominant word element, the marks are visually similar to at least an average degree.

Aurally, the pronunciation of the signs coincides in the sound of the letters 'UNIC/K', insofar as the letters 'C' and 'K' are pronounced identically in English. Consumers are unlikely to pronounce the contested sign's tagline "Tailored interconnected solution driving your journey to excellence", due to its secondary role in the sign. Therefore, the signs are aurally similar to at least a high degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the signs. As the earlier mark would not be associated with any meaning, while the contested mark would be associated with the concepts conveyed by the figurative element and the expression "Tailored interconnected solution driving your journey to excellence", the signs are conceptually not similar.

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

d) Distinctiveness of the earlier mark

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the services in question from the perspective of the public under analysis. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

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 that can be made with the registered mark and 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).

The services are identical and target the public at large and business customers, whose degree of attention may vary from average to high. The signs are visually similar to at least an average degree, aurally similar to at least a high degree and conceptually not similar. The distinctiveness of the earlier mark must be seen as normal.

Account is taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks but must trust in their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Even consumers who pay a high degree of attention need to rely on their imperfect recollection of trade marks (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 54).

The dominant word element of the contested sign reproduces the earlier mark almost in its entirety. The differences lie in the last letters 'C' and 'K', (although these are aurally identical), in the contested sign's figurative element (which has a lower impact on the consumers) and in the tagline "Tailored interconnected solution driving your journey to excellence" (which has a low degree of distinctiveness). Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17). In the present case the differences between the marks, and in particular the absence of conceptual similarity between them, is offset by the identity between the services. Therefore, considering the overall assessed similarity between the marks and the services, and even if there are some differences between the signs, consumers, irrespective of their expertise and degree of attention, may be misled and may believe that the identical services come from the same or economically linked undertakings.

The applicant's claim that some of the opponent's services, namely *science and technology services*, lack clarity and precision and, as such, could not be considered similar to the contested services, cannot be upheld. When the earlier mark was applied for, no objections concerning the clarity and precision of the designates services were raised by the Office, nor can the clarity and precision of the opponent's services be called into question in the present proceedings.

In the same vein, the applicant's claim that the English-speaking part of the public would associate the earlier mark with the English word 'unique' is also rejected. Even if 'UNIC' is aurally close to 'unique', this is not sufficient for the public under analysis to establish a connection between the two terms, insofar as 'UNIC' per se does not mean anything in English and considering, in addition, that it only shares the first three letters (out of six) with the meaningful word 'unique', while the ending parts, '-C' as opposed to '-que', have no commonalities.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the English-speaking part of the public, such as consumers in Ireland and

Malta, and therefore the opposition is well founded on the basis of the opponent's European Union trade mark registration No 16 468 068

Since the opposition is successful based on the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the earlier mark, which was claimed by the opponent. The outcome of the opposition would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

It follows from the above that the contested trade mark must be rejected for all the contested services.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the holder is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Saida CRABBE

Vito PATI

Teresa TRALLERO OCAÑA

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.