

Alicante, 25/01/2017

de Merkplaats B.V.
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PAÍSES BAJOS

Notification of a decision to the applicant

<i>Your reference:</i>	JW/IB14110
<i>Invalidity number:</i>	000009682 C
<i>Contested trade mark:</i>	012095428
	Cariphy

Please find attached the decision terminating the proceedings referred to above. The decision was delivered on **25/01/2017**.

Please note that decisions of the Cancellation Division are not signed by the responsible officials but only indicate their full name and bear a printed seal of the Office in accordance with Rule 55(1) EUTMIR.

Vít MAHELKA



Enclosures (excluding the cover letter): 10 pages

CANCELLATION No 9682 C (INVALIDITY)

Innovatie Psychologische Psychiatrische Zorg B.V., Pythagoraslaan 101, 3584 BB Utrecht, The Netherlands (applicant), represented by **De Merkplaats B.V.**, Herengracht 227, 1016 BG Amsterdam, The Netherlands (professional representative)
a g a i n s t

Cariphy B.V., Van Coehoomstraat 5, 5916 PH Venlo, The Netherlands (EUTM proprietor), represented by **Damsté Advocaten**, Hengelosestraat 571, 7500 AC, Enschede, The Netherlands (professional representative).

On 25/01/2017, the Cancellation Division takes the following

DECISION

1. The application for a declaration of invalidity is partially upheld.
2. European Union trade mark No 12 095 428 is declared invalid for some of the contested goods and services, namely:

Class 9: *Software and Evidence-based software in the field of physiotherapy and (medical) personal trainers, downloads, mobile applications, sensors for determining distance, speed, time and pressure for the purpose of gathering, collecting, storing and communicating information about sports, and physical therapy activities and the sharing of information to other electronic devices, USB hardware, USB adapters, adapters, USB chargers, pedometers.*

Class 41: *Education, training, entertainment, education.*

Class 42: *Design and development of software, updating of software, rental of software, software maintenance, software implementation, ergonomic advice, including with regard to workplaces and optimization thereof; aforesaid services via the Internet.*

Class 44: *Medical services and advice, medical diagnosis of physical or mental disorders, therapeutic treatments including physiotherapy and ergonomic therapy treatments, as well as the preparation of reports and treatment programs thereof; aforesaid services via the Internet.*

3. The European Union trade mark remains registered for all the remaining goods and services, namely:

Class 5: *Food supplements for medical purposes, dietetic products, diet drinks and diet compositions, all for medical purposes; slimming supplements for medical use; whether dietetic foods and beverages, with or without addition of vitamins, minerals, proteins and / or carbohydrates, all for medical use, in particular for the purpose of*

sports people, including isotonic beverages and of powders and syrups for the preparation of the said drinks; vitamin preparations.

Class 25: *Clothing, footwear, headgear, slippers, socks, stockings, shirts, pants, shirts, jackets, underwear, thermal wear, swimwear, beach and swimwear, casual wear, sportswear, tracksuits, shorts, jeans, shorts, sports shorts, swimwear, shorts, bikinis, swimsuits, string, sweaters, sweatshirts, vests, raincoats, gloves (clothing), shoes, boots, training shoes, sports shoes, hats, caps.*

Class 28: *Gymnastic and sporting articles not included in other classes; fitness equipment.*

Class 32: *Mineral and aerated waters with the addition of caffeine, and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages.*

Class 41: *Sporting and cultural activities, recreation, organizing and conducting events, arranging and conducting of conferences, congresses, symposia and workshops, organization of competitions (education or entertainment); providing educational information, also in the form of information, book publishing and other media, all the aforesaid services, whether provided through the Internet, an Internet platform or through social media.*

4. Each party bears its own costs.

REASONS

The applicant filed an application for a declaration of invalidity against all the goods and services of European Union trade mark No 12 095 428. The application is based on Benelux trade mark registration No 925 311. The applicant invoked Article 53(1)(a) EUTMR in conjunction with Article 8(1)(a) and (b) EUTMR.

On 01/10/2015 the Cancellation Division rendered a decision which resulted in the rejection of the cancellation application on the grounds that the earlier Benelux trade mark was not duly substantiated.

The decision was appealed and the Board of Appeal decided in case R 2330/2015-2 on 15/07/2016. The Board's decision annulled the contested decision and remitted the case to the Cancellation Division for further prosecution. The Board considered that in the special circumstances of the case, the earlier mark had been sufficiently substantiated.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant did not submit any arguments initially.

The EUTM proprietor argues that it uses the contested mark for software containing a database with fitness exercises that can be combined to create a training scheme. The product is focused on fitness centres, personal trainers or physiotherapists. On the other hand, the applicant uses its earlier mark for a patient-relation management

software targeting healthcare professionals (e.g. hospitals). The EUTM proprietor's company was created before the applicant's company. Neither the marks nor the goods and services are similar. The degree of attentiveness of the public will be high. Consequently, there is no likelihood of confusion. Both marks are used on the market in the form of logos and these logos are different. The parties effectively produce different goods focusing on a different public.

In support of its observations, the EUTM proprietor filed the following evidence:

- Appendix 1: database printouts for the trade mark registrations 'Cariphy' and 'karify';
- Appendix 2: excerpts from the database of the Chamber of Commerce.

In reply, the applicant argues that the marks are visually highly similar, aurally identical and there is also a conceptual similarity in that the beginnings of the marks 'kar-'/'car-' refer to 'care'. The contested goods and services in Classes 9, 42 and 44 are identical and the remaining contested goods and services are similar because they are in competition with the applicant's goods and services or are complementary to them. Consequently, there is a likelihood of confusion.

LIKELIHOOD OF CONFUSION — ARTICLE 53(1)(a) EUTMR IN CONNECTION WITH 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 goods and services

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

The goods and services on which the application is based are the following:

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment, computers; software; Fire-extinguishing apparatus.*

- Class 38: *Telecommunications.*
- Class 42: *Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software.*
- Class 44: *Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.*

The contested goods and services are the following:

- Class 5: *Food supplements for medical purposes, dietetic products, diet drinks and diet compositions, all for medical purposes; slimming supplements for medical use; whether dietetic foods and beverages, with or without addition of vitamins, minerals, proteins and / or carbohydrates, all for medical use, in particular for the purpose of sports people, including isotonic beverages and of powders and syrups for the preparation of the said drinks; vitamin preparations.*
- Class 9: *Software and Evidence-based software in the field of physiotherapy and (medical) personal trainers, downloads, mobile applications, sensors for determining distance, speed, time and pressure for the purpose of gathering, collecting, storing and communicating information about sports, and physical therapy activities and the sharing of information to other electronic devices, USB hardware, USB adapters, adapters, USB chargers, pedometers.*
- Class 25: *Clothing, footwear, headgear, slippers, socks, stockings, shirts, pants, shirts, jackets, underwear, thermal wear, swimwear, beach and swimwear, casual wear, sportswear, tracksuits, shorts, jeans, shorts, sports shorts, swimwear, shorts, bikinis, swimsuits, string, sweaters, sweatshirts, vests, raincoats, gloves (clothing), shoes, boots, training shoes, sports shoes, hats, caps.*
- Class 28: *Gymnastic and sporting articles not included in other classes; fitness equipment.*
- Class 32: *Mineral and aerated waters with the addition of caffeine, and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages.*
- Class 41: *Education, training, entertainment, sporting and cultural activities, recreation and education, organizing and conducting events, arranging and conducting of conferences, congresses, symposia and workshops, organization of competitions (education or entertainment); providing educational information, also in the form of information, book publishing and other media, all the aforesaid services, whether provided through the Internet, an Internet platform or through social media.*
- Class 42: *Design and development of software, updating of software, rental of software, software maintenance, software implementation, ergonomic advice, including with regard to workplaces and optimization thereof; aforesaid services via the Internet.*

Class 44: *Medical services and advice, medical diagnosis of physical or mental disorders, therapeutic treatments including physiotherapy and ergonomic therapy treatments, as well as the preparation of reports and treatment programs thereof; aforesaid services via the Internet.*

The terms *in particular* and *including*, used in the EUTM proprietor's list of goods and services, indicates that the specific goods and services are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (on the use of *in particular* see reference in judgment of 09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107).

Contested goods in Class 5

The contested goods in this class are, in essence, food supplements, dietetic products, slimming products and vitamin preparations.

The applicant's list covers a wide range of goods and services in Classes 9, 38, 42 and 44, including for example software, telecommunications, scientific and technological services or medical services.

All the contested goods in Class 5 are dissimilar to all the applicant's goods and services in Classes 9, 38, 42 and 44. They have in principle a different nature, purpose and method of use. They are neither in competition nor clearly complementary. Moreover, the usual commercial origin of the goods/services, their distribution channels and sales outlets are normally different.

In particular, the contested goods in Class 5 are dissimilar to the applicant's *medical services* in Class 44. Even though a certain link cannot be denied due to the fact that both are related to health, the differences in nature and especially in the usual origin clearly outweigh any similarities. The relevant public does not expect a doctor to develop and market food supplements, for example.

Contested goods in Class 9

The contested *software and evidence-based software in the field of physiotherapy and (medical) personal trainers; mobile applications* are included in the broad category of the applicant's *software*. Therefore, they are identical.

The contested *downloads* overlap with the applicant's *software*. Therefore, they are identical.

The contested *sensors for determining distance, speed, time and pressure for the purpose of gathering, collecting, storing and communicating information about sports, and physical therapy activities and the sharing of information to other electronic devices* are included in the broad categories of, or overlap with, the applicant's *measuring apparatus and instruments or data processing equipment*. Therefore, they are identical.

The contested *USB hardware, USB adapters, adapters, USB chargers* are included in the broad category of, or overlap with, the applicant's *data processing equipment*. Therefore, they are identical.

The contested *pedometers* are included in the broad category of the applicant's *measuring apparatus and instruments*. Therefore, they are identical.

Contested goods in Class 25

All the contested goods in Class 25 (in essence clothing, footwear and headgear articles) are dissimilar to all the applicant's goods and services in Classes 9, 38, 42 and 44. They have a different nature, purpose and method of use. They are neither in competition nor complementary. Moreover, the usual commercial origin of the goods/services, their distribution channels and sales outlets are normally different.

Contested goods in Class 28

The contested *gymnastic and sporting articles not included in other classes; fitness equipment* are dissimilar to all the applicant's goods and services in Classes 9, 38, 42 and 44. They have a different nature, purpose and method of use. They are neither in competition nor clearly complementary. Moreover, the usual commercial origin of the goods/services, their distribution channels and sales outlets are normally different.

Contested goods in Class 32

The contested *mineral and aerated waters with the addition of caffeine, and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages* are dissimilar to all the applicant's goods and services in Classes 9, 38, 42 and 44. They have a different nature, purpose and method of use. They are neither in competition nor clearly complementary. Moreover, the usual commercial origin of the goods/services, their distribution channels and sales outlets are normally different.

Contested services in Class 41

The contested *education* (mentioned twice in the list of services) and *training* are similar to the applicant's *scientific ... services and research ... relating thereto* in Class 42 as they can coincide in provider and distribution channels. Furthermore they are complementary.

The contested *entertainment* is similar to a low degree to the applicant's *software* in Class 9 (covering *computer game software*) as they can coincide in provider/producer and relevant consumer. Furthermore they are complementary.

All the remaining contested services, namely *sporting and cultural activities, recreation, organizing and conducting events, arranging and conducting of conferences, congresses, symposia and workshops, organization of competitions (education or entertainment); providing educational information, also in the form of information, book publishing and other media, all the aforesaid services, whether provided through the Internet, an Internet platform or through social media*, are considered dissimilar to all the applicant's goods and services in Classes 9, 38, 42 and 44. They have a different nature, purpose and method of use. They are neither in competition nor clearly complementary. Moreover, the usual commercial origin of the goods/services, their distribution channels and sales outlets are normally different.

Contested services in Class 42

The contested *design and development of software; aforesaid services via the Internet* are included in the broad category of the applicant's *design and development of computer ... software* in Class 42. Therefore, they are identical.

The contested *updating of software, rental of software, software maintenance, software implementation; aforesaid services via the Internet* are similar to the applicant's *design and development of computer ... software* in Class 42 as they can coincide in provider, relevant consumer and distribution channels.

The contested *ergonomic advice, including with regard to workplaces and optimization thereof; aforesaid services via the Internet* are included in the broad categories of, or overlap with, the applicant's *scientific and technological services* in Class 42. Therefore, they are identical.

Contested services in Class 44

Medical services and advice, medical diagnosis of physical or mental disorders, therapeutic treatments including physiotherapy and ergonomic therapy treatments, as well as the preparation of reports and treatment programs thereof; aforesaid services via the Internet are included in the broad category of, or overlap with, the applicant's *medical services* Class 44. Therefore, they are identical.

b) Relevant public — degree of attention

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

In the present case, the goods and services found to be identical, similar and similar to a low degree are directed either at the public at large or at business customers with specific professional knowledge or expertise. The degree of attention will be between average and high. It will be high for the goods or services that are expensive, are not purchased very often or are of utmost importance for the consumer, for example *design and development of software* or *medical services*.

c) The signs

karify	Cariphy
Earlier trade mark	Contested trade mark

The relevant territory is that of the Benelux countries.

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

Both marks are word marks composed of one word. Consequently, they have no elements that could be considered clearly more distinctive or more dominant (visually eye-catching) than other elements.

The fact that the earlier trade mark is depicted in lower case and the contested sign contains an upper case 'C' at its beginning has no bearing on the comparison of the marks, because both are word marks. Protection is therefore granted for the word itself, and not for the particular way in which the mark is written.

Visually, the signs coincide in '*ari*y'. They also have the same structure (one word) and a very similar length (six letters as opposed to seven letters). However, the marks differ in the letters 'k'/C' and 'f'/ph'.

Therefore, the signs are similar to an average degree.

Aurally, and irrespective of the language used by the relevant consumers in the Benelux countries, the pronunciation of the signs fully coincides because the initial 'C' in the contested mark will be pronounced as /k/ and the sound of 'f' and 'ph' will be the same, namely /f/. Consequently, the marks are aurally identical.

Conceptually, the Cancellation Division considers that neither of the signs has a meaning for the public in the relevant territory. It is unlikely that the public in the Benelux countries would readily link the marks with the English notion of 'care' because this word as such is not included in the marks. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs.

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

d) 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.

The applicant did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.

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

e) Global assessment, other arguments and conclusion

The goods and services have been found to be partially identical, partially similar, partially similar to a low degree and partially dissimilar.

The earlier trade mark's degree of distinctiveness is average. The level of attention of the public will be between average and high.

The marks are visually similar and aurally identical. There is nothing to link or differentiate the marks conceptually. The overall impression created by the marks is highly similar because they will be retained in the consumers' memory basically as the same word. This is because the letters 'k'/'C' and 'f'/'ph' are commonly used as equivalents producing the same sound. Consequently, the relevant public is likely to confuse the marks when used in respect of the goods and services that are identical, similar and also similar to a low degree.

The fact that the parties effectively produce a different type of software, target a different type of public and use different logos in the market is irrelevant because the task of the Cancellation Division is to compare the marks and the goods and services as registered.

The fact that the EUTM proprietor's company was created before the applicant's company is irrelevant because what matters in the present proceedings is only the question of which mark is earlier. In this case, the earlier Benelux trade mark No 925 311 has an earlier application date (06/09/2012) than that of the contested EUTM (28/08/2013) and is, therefore, an earlier trade mark within the meaning of Article 53(1)(a) and Article 8(1)(b) EUTMR.

The applicant argues in respect of the goods and services found dissimilar in these proceedings that they are in competition with or complementary to the applicant's goods and services and are, therefore, similar. The Cancellation Division cannot agree with this standpoint and considers that they are not in competition because they satisfy different needs. Furthermore, they are not complementary in the sense that they would be indispensable or important for the use of each other.

Considering all the above, the Cancellation Division finds that there is a likelihood of confusion on the part of the public and, therefore, the application is partly well founded on the basis of the applicant's Benelux trade mark registration.

Pursuant to the above, the contested trade mark must be declared invalid for the goods and services found to be identical, similar or similar to a low degree to those of the earlier trade mark.

The rest of the contested goods and services are dissimilar. As identity/similarity of goods and services is a necessary condition for the application of Article 8(1) EUTMR, the application based on this article and directed at these goods and services cannot be successful.

The cancellation application must also fail insofar as it is based on grounds under Article 8(1)(a) EUTMR in conjunction with Article 53(1)(a) EUTMR and directed against the remaining goods and services because the signs and the goods and services are obviously not identical.

COSTS

According to Article 85(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party. According to Article 85(2) EUTMR,

where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Cancellation Division will decide a different apportionment of costs.

Since the cancellation is successful only for part of the contested goods and services, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



The Cancellation Division

Alexandra APOSTOLAKIS

Vít MAHELKA

Lucinda CARNEY

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 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 of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.