

DECISION
of the Fourth Board of Appeal
of 21 December 2017

In Case R 283/2017-4

Ruby Decor B.V.

Vreekesweid 30-32
1721 PR Broek Op Langedijk
The Netherlands

IR holder / Appellant

represented by DLA PIPER NEDERLAND N.V., Amstelveenseweg 638, 1081 JJ
Amsterdam, The Netherlands

v

ESSEGE S.A.

Chaussée de Waterloo 1589 D
1180 Brussels
Belgium

Cancellation Applicant / Respondent

represented by GEVERS, Brussels Airport Business Park, Holidaystraat, 5,
1831 Diegem, Belgium

APPEAL relating to Cancellation Proceedings No 9 936 C (International registration
No 982 775 designating the European Union)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairperson), R. Ocquet (Rapporteur) and C. Bartos
(Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 On 20 July 2008, the IR holder obtained the International registration No 982 775 designating the European Union ('the IR') of the word sign

RUBY FIRES

for, as far as relevant in the present proceedings, the following goods:

Class 6 - Coverings and materials of metal for fireplaces, (style) fireplaces and fireplace housings; fireplace surrounds and fireplace coverings; furnace fire screens, furnace fireguards; floor surrounds of metal; hearth-plates of metal; fire back of metal; chimney cowls of metal; chimney shafts of metal; chimney pots of metal; chimneys of metal;

Class 11 - Building-in fireplaces; secondary fireplaces and unobstructed fireplaces and stoves; chimney flues; flues; ceramic burners amongst others active on bio-ethanol; gas flues and pipes; ash pans; gas blocks and ghost fires of fireplaces;

Class 19 - Building materials not of metal, amongst others (style)fireplaces, ornaments of plaster cast, decorative frames not of metal, for building purposes; building materials for chimneys, flues, chimney pots, mantle pieces, not of metal; chimneys not of metal.

- 2 On 10 October 2014, the cancellation applicant filed a request for a declaration of invalidity of the IR for all the goods. The grounds for the request were those laid down in Article 60(1)(a) [ex-Article 53(1)(a)] EUTMR in conjunction with Article 8(1)(b) EUTMR and it was based on the following earlier rights:

- Benelux trade mark No 540 912

RUBY

registered on 1 August 1994 and renewed until 17 January 2024 for the following goods:

Class 11 – Heating apparatus.

- Polish trade mark No 96 713 '**RUBY**' and IR No 620 319 '**RUBY**' designating the United Kingdom, France, Germany, Italy, Portugal and Spain and also covering 'heating apparatus' in Class 11.
- 3 On 17 August 2015, upon request of the IR holder, the cancellation applicant filed the following proof of use of the earlier marks, which was analysed by the Cancellation Division:
 - Annex 2: Extract from the 'RUBY FIRES' website which shows a list of Belgian dealers. Extracts from www.chemineesliegeois.be, www.pobra.be, www.devos-sierschouwen.be, www.emex.be, www.kachelsvandenberge.be and www.enervro.be, respectively, showing pictures and information of decorative fireplaces and heating apparatus.

- Annex 3: Three invoices (attached the bill of lading/packing list) issued from entities in Japan and South Korea to the cancellation applicant in 2008 and 2010, respectively. In the description of the goods, the signs ‘Ruby 255’/‘Ruby 240’/‘Ruby KSP 270’ refer to Kerosene Heaters. They also include the quantity and the unit prices.
- Annex 4: Thirty-eight invoices issued from Essege S.A. and addressed to places in France, the United Kingdom, Belgium, the Netherlands, Italy, Finland and Germany in 2003, 2005, 2006, 2007, 2008, 2009 and 2010. They include the sign ‘RUBY’, the quantity, the unit price and the total amounts in Euros. In some invoices and next to ‘RUBY’, the words ‘HEAT’ and ‘DRY’ appear and in some others, ‘KSP 225’.
- Annex 5: Delivery voucher issued by Essege S.A. and addressed at a customer in the United Kingdom in 2008. It shows the reference of the articles, the quantity and the sign ‘RUBY’.
- Annex 6: Advertising brochures in Dutch, French and Italian showing pictures of kerosene heaters, oil and kerosene stoves, tower dryer, radial panels and dehumidifiers bearing the sign ‘RUBY’. They show the characteristics of the products and the price of the items. Some brochures are undated and some are dated in 1997, 2006, 2007, 2008, 2009, 2010, 2011 and 2012.
- Annex 7: Promotional leaflets in French and Dutch and some parts translated into English which show ‘RUBY’ products (heaters, dehumidifiers, radiating panels, air conditioners). Next to the sign ‘RUBY’ there are codes, such as ‘KSP 124’ and ‘KSP 127’, which refer to the products. It includes a technical description of the products. These leaflets are not dated.
- Annex 8: Sales figures (1993-2009) of Ruby products.
- Annex 9: Sales report of the ‘RUBY’ products from 2007 to 2013 in the Benelux countries.
- Annex 10: Internet archives of the websites Tecno Air system, Essege and Ligne showing ‘RUBY’ products (heaters).
- Annex 11: Extracts from the website www.rubyfires.com dated 17 August 2015 explaining the products such as electric inserts, fireplaces and the user’s manual of the products.
- Annex 12: Google search on the word ‘RUBY’ showing pictures of precious stones.
- Annex 13: Extract from www.unigro.be which offers ‘RUBY’ items, namely, bioethanol heaters.

- Annex 14: Organisation chart of Tolefi group (to which the cancellation applicant belongs).
 - Annex 15: Extracts from dictionaries showing the definition of ‘RUBY’.
- 4 By decision of 19 December 2016 (‘the contested decision’), the Cancellation Division declared the contested IR partially invalid for the goods listed in paragraph 1 on the basis of the earlier Benelux mark, ordering each party to bear its own costs.
 - 5 The Cancellation Division found that the documents proved the genuine use of the earlier mark for the goods ‘heating apparatus’ in Class 11 in the relevant period and territory. These goods were found to be similar to various degrees to the contested goods in Classes 6, 11 and 19 listed in paragraph 1. Comparing the conflicting signs, the Cancellation Division assessed them as being visually, aurally and conceptual highly similar. On the ground of Article 60(1)(a) EUTMR, in conjunction with Article 8(1)(b) EUTMR the contested IR was declared invalid for the European Union for the aforementioned contested goods.

Submissions and arguments of the parties

- 6 On 8 February 2017, IR holder filed an appeal against the contested decision, requesting that the decision be annulled. In the statement of grounds received on 19 April 2017, the IR holder argues that the proof of use is not sufficient as some of the documents do not show where, when and how many of the ‘heating apparatus’ were sold. Furthermore, they do not prove the use of the mark in the registered form. In addition, the IR holder asserts that the conflicting goods are not similar, since the contested fireplaces do not serve to release heat but have purely a decorative purpose. The term ‘fireplace’ describes only the outer side of the fireplace (i.e. the decorative material surrounding the fire), and not the inner side (i.e. the fire). Compared to the cancellation applicant’s ‘heating apparatus’ the IR holder’s ‘fireplaces’ are different in nature, intended purpose, method of use and manufacturers. Finally, the IR holder claims that the conflicting signs are to be considered dissimilar, or at the most similar to a low degree. The Cancellation Division has erred in considering the term ‘FIRES’ as descriptive.
- 7 In its observations in reply, the cancellation applicant endorses the Cancellation Division’s analysis, requesting that the appeal be dismissed and that the IR holder be ordered to bear the costs.

Reasons

- 8 Article 60(1)(a) [ex-Article 53(1)(a)] EUTMR provides that an EUTM shall be declared invalid where there is an earlier right as referred to in Article 8(2) EUTMR and the conditions set out in paragraph 1 or 5 of that Article are fulfilled. According to Article 198 [ex-Article 158] EUTMR, this also applies to IRs designating the European Union.

On the proof of use

- 9 Article 64(2) and (3) [ex-Article 57(2) and (3)] EUTMR provides that the proprietor of a EUTM (or the holder of an IR) may request proof that the earlier mark has been put to genuine use, in the territory in which it is protected, during the five years preceding the date of the application for a declaration of invalidity. Furthermore, if, at the date on which the EUTM or IR application was published, the earlier mark had been registered for not less than five years, the proprietor of the earlier mark is to furnish proof that it was put to genuine use in that territory during the five years preceding that publication, i.e. that the conditions contained in Article 47(2) [ex-Article 42(2)] were satisfied at that date.
- 10 During the course of the cancellation proceedings, within the period stipulated by Rule 40(1) CTMIR, the EUTM holder requested evidence of use of, inter alia, the earlier Benelux mark pursuant to Article 62(3) EUTMR.
- 11 The application for a declaration of invalidity was filed on 10 October 2014. The relevant date (first publication of the contested IR) is 13 April 2009. The earlier Benelux mark was registered on 17 January 1994. The cancellation applicant was therefore required to prove that the mark was genuinely used in the Benelux from 10 October 2009 to 9 October 2014 inclusive, as well as from 13 April 2004 to 12 April 2009 inclusive.
- 12 There is ‘genuine use’ of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 43). Moreover, the condition relating to genuine use of the trade mark requires that the mark, as protected in the relevant territory, is used publicly and outwardly (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37; 30/04/2008, Sonia Rykiel, EU:T:2008:135, § 38; 18/01/2011, T-82/08, Vogue, EU:T:2011:9, § 27; 08/05/2014, T-38/13, Pedro, EU:T:2014:241, § 15).
- 13 In order to examine whether use of an earlier mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies a certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under that trade mark may be compensated for by a high intensity or a certain constancy in time of the use of that trade mark or vice versa. Moreover, the turnover achieved and quantity of product sales under the earlier mark cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking exploiting the mark, and the characteristics of the products or services on the market in question. For that reason, use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (08/07/2004, T-334/01, Hipoviton, EU:T:2004:233, § 36; 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 39).

- 14 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43; 11/05/2006, C-416/04 P, *Vitafruit*, EU:C:2006:310, § 40; 30/11/2009, T-353/07, *Coloris*, EU:T:2009:475, § 22).
- 15 According to Rule 22(3) in conjunction with Rule 40(6) CTMIR, evidence of use of a trade mark must concern the place, time, extent and nature of use of the trade mark (10/12/2015, T-690/14, *Vieta*, EU:T:2015:950, § 33; 08/07/2004, T-203/02, *Vitafruit*, EU:T:2004:225, § 37; 10/09/2008, T-325/06, *Capio*, EU:T:2008:338, § 27).
- 16 Furthermore, pursuant to Rule 22(4) CTMIR, the evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspapers, advertisements, and statements in writing as referred to in Article 97(1)(f) [ex-Article 78(1)(f)] EUTMR.

Assessment of the evidence

- 17 Bearing in mind the above considerations, the Board of Appeal will assess the proof of use filed by the cancellation applicant.

Time and place

- 18 The cancellation applicant submitted a large quantity of invoices before the Cancellation Division (Annex 4) issued within the relevant periods. There are invoices for each of the years 2005 through 2010.
- 19 Apart from invoices covering territories of the other earlier rights on which the application for cancellation was based, a significant number of these invoices relate to the Benelux. They are issued in French and English to multiple Belgian cities located in many distinct geographical parts of the country (the name of the customers was removed), namely Louvain-la-Neuve, Brussels, Orcq, Wavre, Niewkerken, Wommelgem, Tubize, Ciney, Anderlecht. Also an invoice was submitted relating to the Netherlands, addressed to an address in Steenbergem.
- 20 In addition, the advertising brochures (Annex 6) bear a date between 2007 and 2012 and are in Dutch or French, several of them indicating that they relate to Belgium or Luxembourg.
- 21 As a consequence, the cancellation applicant has provided sufficient indications regarding the time (for both relevant periods) and place of use of the earlier mark.

Nature

- 22 In the context of Rule 22(3) CTMIR, the expression ‘nature of use’ includes evidence of the use of the sign as a trade mark in the course of trade, of the use of the mark as registered, or of a variation thereof according to Article 18(1), second subparagraph, point (a) [ex-Article 15] EUTMR, and of its use for the goods or services for which it is registered.

Use as a trade mark

- 23 The proof of use must establish a clear link between the use of the mark and the relevant goods and services, as clearly indicated in Rule 22(3) CTMIR. Genuine use requires that use is made as a trade mark in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43; 14/04/2016, T-20/15, *PICCOLOMINI / PICCOLO*, EU:T:2016:218, § 42).
- 24 The Board notes that the mark ‘RUBY’ is referred to in invoices (Annex 4) and is depicted in advertising and promotional leaflets (Annexes 6 and 7) and on the websites (Annexes 10 and 11) where the earlier mark is presented as an indicator for the goods provided by cancellation applicant. Therefore, the Board concludes that the evidence shows that the cancellation applicant has used the earlier mark as a trade mark and in accordance with its essential function.

Use as registered

- 25 Regarding the use of the mark as registered, it should be noted that Article 18 EUTMR mentions that use of the mark in a form different from that registered still constitutes use of the trade mark as long as it does not alter the distinctive character of the trade mark.
- 26 In such situations, where the sign used in trade differs from the form in which it was registered only in insignificant respects, and the two signs can therefore be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark which was registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade (27/02/2014, T-226/12, *LIDL*, EU:T:2014:98, referring to 23/02/2006, T-194/03, *Bainbridge*, EU:T:2006:65, § 50).
- 27 The earlier mark is a word mark, consisting of the verbal element ‘RUBY’. It is, as is logical, mentioned and referred to as such in the invoices (Annex 4) and in the advertising either in capitals or as ‘Ruby’.
- 28 For the protection of word marks it is irrelevant whether they are written in upper or lower-case letters (25/11/2015, T-763/14, *SOPRAPUR*, EU:T:2015:883, § 56).
- 29 Furthermore, contrary to the IR holder’s arguments, the Board finds that the addition of other verbal/numerical elements such as ‘KSP’ and ‘255’ does not change the distinctive character of the sign as it is obvious for the relevant public that these additional elements are not part of the sign but indicate specific models of the ‘RUBY’ heaters.

- 30 The use of the word ‘RUBY’ as a sign in connection of the products constitutes a use of the earlier mark as registered.

Use for the registered goods

- 31 The invoices relate to the sales of ‘RUBY’ heaters, including, inter alia, the models ‘RUBY KSP 225’ and ‘RUBY 255’.
- 32 The advertising brochures (Annex 6) and the leaflets (Annex 7) also depict heaters. A leaflet of the Belgium retailer HUBO dated December 2011 depicts the petroleum or kerosene heater ‘RUBY KSP 225’. The ‘RUBY 255’ petroleum heater is depicted on the websites of the companies Tecno Air system, Essege and Ligne (internet archives Annex 10). Evidence that does not relate to the Benelux territory also show electric heaters and bioethanol heaters. In any event, following Article 16(5)(b) of the Trade Mark Directive, affixing the mark to goods in the Benelux solely for export purposes also constitutes use.
- 33 The purpose and intended use of the petroleum or kerosene heaters concerned, for which use is proven in the Benelux, is to heat a room or place.
- 34 Therefore, the Board finds that the earlier mark has been used for ‘heating apparatus’ in Class 11, as it is not possible to make any significant sub-divisions within the category concerned.

Extent

- 35 As to the extent of use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310, § 41; 08/07/2004, T-334/01, Hipoviton, EU:T:2004:233, § 35).
- 36 The invoices (Annex 4) amount to the sales of several hundreds of ‘RUBY’ heaters. For instance, with respect to sales in Belgium, invoice No 2895/V10 dated 31 October 2008 concerns the sale of 400 pieces of ‘RUBY 255’. Invoice No 3114/V10 dated 22 October 2010 shows the sale of 8 pieces of ‘RUBY KSP 225’. Invoice No 6694/V10 dated 31 December 2010 shows the sale of 20 pieces ‘RUBY. With respect to the Netherlands, invoice No 1147/V10 shows the sale of 36 pieces of ‘RUBY KSP 225’. Prices vary from 24,00 to 249,00 euros per item.
- 37 The cancellation applicant also submitted sales figures for ‘RUBY’ products for the period of 1994-2011 (Annex 8) and a sales report for ‘RUBY’ products in the Benelux for the period of 2007-2013 (Annex 9), which documents were marked as confidential. The IR holder objects to these documents, but the Board considers that in any event the submitted invoices give sufficient indications as to the extent of use.
- 38 The Board emphasises that the requirement for the extent of use does not mean that the cancellation applicant has to reveal the entire volume of sales or turn-over figures. It is sufficient to submit evidence which proves that the minimum threshold for a finding of genuine use has been passed (11/05/2006, C-416/04 P,

Vitafruit, EU:C:2006:310, § 72). It follows that it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the Office or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 25).

- 39 The quantity and frequency of ‘RUBY’ products supplied to customers in particular in Belgium shows that these products have been sold continuously during the relevant period of time and that a significant turnover has been generated. The invoices for the sale of the products amount to a sufficient extent within the relevant period.
- 40 The word ‘RUBY’ appears in the product description on the invoices and advertisement and leaflets. The sales add up to quantities which leave no doubt that the mark was genuinely used. It also follows from the invoices, which are numbered, that these are mere examples. As a consequence, the extent of use has been without any doubt significant.

Conclusion

- 41 The Board considers that the IR holder’s arguments that the evidence submitted by the cancellation applicant would not prove genuine use of the earlier Benelux mark, cannot be followed.
- 42 In the context of a global assessment it is not required that an item of evidence contains an indication regarding all relevant aspects, as the items of evidence, taken together, may prove the requisite facts (see, by analogy, 17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 33). Although such items alone cannot support a conclusion of genuine use, the fact remains that they must be evaluated with the other evidence in the context of the assessment of the genuine nature of use of the earlier mark (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310, § 53). An accumulation of evidence may then allow the necessary facts to be established, even though each of those pieces of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (17/04/2008, C-108/07 P, Ferro, EU:C:2008:234, §§ 36 and 37; 19/04/2013, T-454/11, Al bustan, EU:T:2013:206, § 36; 30/09/2014, T-132/12, Lambretta, EU:T:2014:843, § 25).
- 43 The Board therefore concurs with the Cancellation Division that the submitted documents considered as a whole, provide sufficient and conclusive evidence about the time, place, extent and nature of the use of the earlier Benelux mark during the relevant periods in the relevant territory, for the goods for which it is registered, namely:

Class 11 – heating apparatus.

Article 60(1)(a) in conjunction with Article 8(1)(b) EUTMR

- 44 According to Article 8(1)(b) EUTMR, 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; likelihood of confusion includes a likelihood of association with the earlier trade mark.

Comparison of the goods

- 45 In assessing the similarity of the goods and services, all the relevant factors relating to those goods and services should be taken into account, including, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are 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 and services concerned (11/07/2007, T-443/05, Pirañam, EU:T:2007:219, § 37).
- 46 It follows from Article 33(7) [ex-Article 28(7)] EUTMR that the Nice Classification does not provide in itself a basis for drawing conclusions as to the similarity or dissimilarity of the goods and services.
- 47 The reference point is whether the relevant public will perceive the goods concerned as having a common commercial origin (04/11/2003, T-85/02, Castillo, EU:T:2003:288, § 38) and whether the consumers consider it normal that the goods 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).
- 48 The goods to be compared are (emphasis added):

<p>Class 6 - Coverings and materials of metal for fireplaces, (style) fireplaces and fireplace housings; fireplace surrounds and fireplace coverings; furnace fire screens, furnace fireguards; floor surrounds of metal; hearth-plates of metal; fire back of metal; chimney cowls of metal; chimney shafts of metal; chimney pots of metal; chimneys of metal.</p> <p>Class 11 - Building-in fireplaces; secondary fireplaces and unobstructed fireplaces and stoves; chimney flues; flues; ceramic burners amongst others active on bio-ethanol; gas flues and pipes; ash pans; gas blocks and ghost fires of fireplaces.</p> <p>Class 19 - Building materials not of metal, amongst others (style)fireplaces, ornaments of plaster cast, decorative frames not of metal, for building purposes; building materials for chimneys, flues, chimney pots, mantle pieces, not of metal; chimneys not of metal.</p>	<p>Class 11 - Heating apparatus.</p>
<p><i>Contested sign</i></p>	<p><i>Earlier mark</i></p>

- 49 The IR holder's arguments basically rest on the assertion that all its goods relate to 'fireplaces' and that these are dissimilar to 'heating apparatus' since the term 'fireplace' describes only the outer side of a fireplace (i.e. the decorative material surrounding the fire), and not the inner side (i.e. the fire). It is a fact that the IR holder's goods relate to 'fireplaces' or products closely related thereto, such as 'chimneys' and 'fire screens', though they also cover 'stoves' and 'burners'.
- 50 The Board can in any event not follow the IR holder's reasoning. The *Oxford English Dictionary* defines a 'fireplace' as 'a place for a domestic fire, especially a grate or hearth at the base of a chimney'. A 'fireplace' is included in the broad category of 'heating apparatus': it is a heating apparatus producing heat by fire. A 'fireplace' necessarily produces fire and therefore always releases heat and serves, as a consequence, to heat a room or place. Such a 'fireplace' does not necessarily include any decorative material surrounding the fire.
- 51 The contested goods in **Class 6** are parts of 'fireplaces' or 'heating apparatus'. They are manufactured, bought and used in close relation to the latter. The targeted consumers, manufacturers and distribution channels are the same as those of the earlier 'heating apparatus' in Class 11. These goods are, at least, similar to an average degree.
- 52 As to the contested goods in **Class 11**, 'the building-in fireplaces; secondary fireplaces and unobstructed fireplaces and stoves; ceramic burners amongst others active on bio-ethanol' all fall under the broad category of 'heating apparatus' and are, therefore, identical to the earlier goods.
- 53 The remaining contested goods in Class 11, namely 'chimney flues; flues; gas flues and pipes; ash pans; gas blocks and ghost fires of fireplaces' are parts of 'heating apparatus' and are, at least, similar to an average degree to the earlier goods.
- 54 Finally, the contested goods in **Class 19** are specifically used to build 'fireplaces' or 'heating apparatus' in general or can be used to build them. They are manufactured, bought and used in relation to the latter. The targeted consumers, manufacturers and distribution channels of are the same as those of 'heating apparatus' in Class 11. Therefore, the IR holder's arguments that the 'building materials' concerned are dissimilar cannot be followed. The contested goods in Class 19 are similar to an average degree to the earlier goods in Class 11.

Comparison of the signs

- 55 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 and 27; 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).

56 The signs to be compared are the following:

RUBY FIRES	RUBY
<i>Contested sign</i>	<i>Earlier mark</i>

57 The signs in question are both word marks and the earlier mark ‘RUBY’ is fully included in the contested IR, in which it maintains an independent and distinctive role (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594).

58 The signs differ only in the additional word ‘FIRES’ of the contested IR. This word is obviously descriptive for the contested goods in Classes 6, 11 and 19 which are, or all are closely related to, ‘fireplaces’ or ‘heaters’. Apart from the fact that it concerns a basic English word, a significant part of the relevant public in the Benelux understands English (09/12/2010, T 307/09, Naturally active, EU:T:2010:509, § 26; 22/05/2012, T-60/11, Suisse Premium, EU:T:2012:252, § 50). The IR holder’s argument that that the word ‘FIRE’ is a ‘very strong meaningful element’ and that the Cancellation Division ‘erred in law’ by taking into account that this element is ‘allegedly’ descriptive and non-distinctive, can clearly not be followed.

59 Descriptive elements are to be accorded less importance in the overall impression and the descriptive meaning is to be taken into consideration in the comparison of the signs (13/07/2012, T-255/09, La Caixa, EU:T:2012:383, § 79; 13/09/2010, T-366/07, P&G Prestige beauté, EU:T:2010:394, § 65; 19/05/2010, T-243/08, EDUCA Memory game, EU:T:2010:210, § 33; 25/06/2008, T-224/06, L’Altra Moda, EU:T:2008:221, § 34, 40 and 46).

60 The targeted consumer does not usually consider descriptive elements forming part of a composite mark as the distinctive and dominant element of the overall impression conveyed by the sign (07/07/2005, T-385/03, Biker Miles, EU:T:2005:276, § 44; 06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 34; 03/07/2003, T-129/01, Budmen, EU:T:2003:184, § 53)

61 It follows that the word ‘RUBY’ is the dominant element of the contested IR.

62 As the dominant element of the contested IR is identical to the earlier mark, the conflicting signs are visually and aurally highly similar.

63 Conceptually, part of the public will perceive the term ‘RUBY’ as a dark red jewel or something that is dark red in colour, or as a female name (*Collins English Dictionary*), another part of the public may not associate the term with any meaning or concept. The possible conceptual difference created by the descriptive term ‘FIRES’ cannot be given any significant weight and cannot play a decisive differentiating role from a conceptual perspective (16/12/2015, T-491/13, Trident Pure, EU:T:2015:979, § 93 and 108). Therefore, the conceptual comparison is either identical or it remains neutral.

Distinctiveness of the earlier mark

- 64 The cancellation applicant did not explicitly claim that its earlier marks, including the Benelux mark, are particularly distinctive by virtue of intensive use or reputation. As a result, the assessment of the earlier Benelux mark's distinctiveness will rest on its distinctiveness *per se*.
- 65 The degree of inherent distinctive character of the earlier mark is considered normal since the term 'RUBY' does not have any apparent meaning in relation to the earlier 'heating apparatus' in Class 11.

Global assessment

- 66 A likelihood of confusion on the part of the public must be assessed globally. That global assessment implies some interdependence between the factors taken into account and in particular similarity between the marks and between the goods or services covered. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 19). The more distinctive the earlier mark, the greater the risk of confusion, and marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).
- 67 The goods at issue target both the general public and professionals and their level of attention will vary from average to high. The relevant territory is the Benelux.
- 68 In view of the partial identity and partial similarity of the conflicting goods, and the high visual and aural similarity of the signs (and the conceptual identity for part of the relevant public), a likelihood of confusion in the meaning of Article 8(1)(b) EUTMR exists between the earlier mark and the contested IR for all the contested goods in Classes 6, 11 and 19, even for the professional public in the Benelux countries, since due to the fact that the signs only differ in the descriptive element 'FIRES', the public could be lead to believe that the goods in question come from the same undertaking or economically-linked undertakings.
- 69 Since the appeal is fully successful on the basis of Article 8(1)(b) EUTMR and the earlier Benelux mark invoked, there is no need to examine the cancellation request filed on the basis of the other earlier marks.
- 70 The appeal must be dismissed.

Costs

- 71 Since the IR holder is the losing party within the meaning of Article 109(1) [ex-Article 85(1)] EUTMR, it must be ordered to bear the representation costs incurred by the cancellation applicant in the appeal proceedings. The Cancellation

Division correctly decided that the parties shall bear their own costs in the cancellation proceedings.

Fixing of Costs

- 72 In accordance with Article 109(7) [ex-Article 85(6)] EUTMR and Rules 94(3) and 94(7)(d)(vi) CTMIR, the Board fixes the amount of representation costs to be paid by the IR holder to the cancellation applicant in the appeal proceedings at EUR 550. No costs need to be fixed for the cancellation proceedings.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the IR holder to bear the costs of the appeal proceedings;**
- 3. Fixes the total amount of costs to be paid by the IR holder to the cancellation applicant at EUR 550.**

Signed

D. Schennen

Signed

R. Ocquet

Signed

C. Bartos

Registrar:

Signed

H.Dijkema

