OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)
The Boards of Appeal

DECISION
of the Second Board of Appeal
of 18 July 2011

In Case R 1004/2009-2

Pink Ribbon Inc.
3000 Marcus Avenue, Suite 3w4
Lake Success, NY 11042
United States of America
Applicant / Appellant

represented by Walter Scheffrahn, Herengracht 23, NL-1015 BA, Amsterdam, The Netherlands

Stichting Pink Ribbon
Bergseweg 28-E
NL-3633 AK Vreeland
The Netherlands
Opponent / Respondent

represented by HOYNG MONÉGLER LLP, Marlou L.J. Van de Braak, Rembrandt Tower, 31st Floor Amstelplein 1, NL-1090 CJ Amsterdam, The Netherlands

APPEAL relating to Opposition Proceedings No B 1 302 746 (Community trade mark application No 6 013 411)

THE SECOND BOARD OF APPEAL

composed of T. de las Heras (Chairperson), H. Salmi (Rapporteur) and G. Humphreys (Member)

Registrar: P. López Fernández de Corres

gives the following

Language of the case: English

Decision

Summary of the facts

1. By an application filed on 18 June 2007, Brandconcern BV (the application subsequently being transferred to Pink Ribbon Inc. hereinafter ‘the applicant’) sought to register the figurative mark:

   ![Pink Ribbon Mark]

   for the following list of goods and services:

   Class 16 – Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks;

   Class 25 – Clothing, footwear, headgear;

   Class 36 – Insurance; financial affairs; monetary affairs; real estate affairs.


3. On 29 April 2008, Stichting Pink Ribbon (hereinafter ‘the opponent’) filed a notice of opposition against the mark applied for based on the following earlier rights:

   - Benelux trade mark registration No 792 329 of the figurative trade mark

     ![Pink Ribbon Mark]

     filed on 28 September 2005 and registered on 7 February 2006 for, among others, goods and services in Classes 16, 25 and 36 on which the opponent bases its opposition, namely:

   Class 16 – Paper, cardboard and goods made from these materials, not included in other classes; printed matter; stationery; instructional and teaching material (except apparatus);

   Class 25 – Clothing, headgear;

   Class 36 – Fundraising services; insurance; financial affairs; monetary affairs, real estate affairs.

Benelux trade mark application No 742 123 of the figurative trade mark

filed on 4 December 2003 and registered on 1 March 2004 for, among others, goods and services in Classes 16, 25 and 36, on which the opposition is based, namely:

Class 16 – Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists’ materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging, not included in other classes; printers type; printing blocks;

Class 25 – Clothing, footwear, headgear;

Class 36 – Fundraising services to support breast cancer awareness-raising campaign.

The opposition is also based on two other Benelux trade mark registrations, one trade name and one well-known mark.

The opponent directed the opposition against all the goods and services of the mark applied for.

The opponent invoked Article 8(1)(a) and (b) and 8(5) CTMR.

In an Office letter of 23 October 2008, the applicant was given until 4 January 2009 to submit its observations in reply to the notice of opposition and to the opponent’s facts, evidence and arguments. This letter was sent by mail.

On 23 October 2008, but in another letter as mentioned in the previous paragraph, the Office notified the applicant that its suspension request was rejected. This letter was sent by fax.

On 26 January 2009, subsequent to a telephone conversation with the Office, the applicant informed the Office that it had not received the Office letter of 23 October 2008. The Office was requested to accept for the present proceedings the applicant’s arguments in other opposition proceedings. If the applicant’s arguments were not acceptable, the applicant requests a ‘continuation of the proceedings’ in accordance with Article 78a CTMR (Article 82(1) CTMR codified version).

On 4 February 2009, the Office rejected the applicant’s request for a continuation of the proceedings. The Office considered, by referring to the communication No 06/05 of the President of the Office of 16 September 2005 concerning the restoration of missed time-limits, that the time-limit laid down for the applicant’s reply to the opposition was excluded from the benefit of the provision of Article 78a CTMR (Article 82(2) CTMR codified version). At the end of the notification the applicant was informed that it has the right to appeal against this decision.
Furthermore, the applicant was informed about the appeal time-limits and the payment of the appeal fee.

10 The opponent did not file a notice of appeal or pay the appeal fee within two months of receipt of the notification of 4 February 2009.

11 On 4 February 2009, in another letter, the applicant was informed by the Office that the other arguments in its letter of 26 January 2009 were also rejected.

12 Finally on 4 February 2009, in a third letter, the Office informed the applicant that in the absence of any observations in reply to the opposition within the prescribed term, the Office would give a ruling on the basis of the evidence before it.

13 On 30 June 2009, the Opposition Division issued a decision ruling on Opposition No B 1 302 746 (hereinafter ‘the contested decision’). The Opposition Division upheld the opposition for all the contested goods and services and ordered the applicant to bear the costs of the proceedings. The reasoning underlying the contested decision was, in essence, the following:

*Likelihood of confusion  Article 8(1)(b) CTMR*

- The contested goods in Classes 16 and 25 are identical to those protected by the earlier Benelux trade mark registration No 742 123, as they appear with exactly the same wording. As for the services in Class 36, the earlier Benelux trade mark registration No 792 329 covers, among others, exactly the same services, and consequently the services are identical.

- From a visual point of view the marks in dispute are similar in as much as the contested application also contains the denominations ‘PINK’ (represented in a pink colour) and, should the consumers infer a ‘O’ vowel in the place of the graphic figure, the denomination ‘RIBBON’, represented in a grey colour. This graphic figure in the shape of a ribbon is quite similar to the one contained in Benelux trade mark registration No 742 123.

- Phonetically, the signs are either similar to a high degree or identical.

- Conceptually, the expression contained in the opponent’s marks refers, in English, to an international symbol of breast cancer awareness. Even if the relevant consumers do not know this, many of them will be aware that ribbons have been used to express solidarity on the part of the wearer with a given cause. The consumers who do not know this fact will understand the expression literally, that is to say, a ‘ribbon’ that is ‘pink’. Lastly, for a small part of the consumers the expression will be completely meaningless. As for the contested CTM application, taking into account the presence of the graphic figure of the ‘pink ribbon’ in the place of the ‘O’ vowel, the two first groups mentioned above will also be able to understand that a) the mark conceptually reflects the symbol of breast cancer awareness or b) it represents solidarity with some cause. The third group of consumers will also most probably understand the reference to ‘pink ribbon’, though as said they will
interpret it only literally. Finally, the consumers who do not understand English will see the mark as invented.

Conclusion

- As to the distinctive character of the earlier marks, the opponent claimed that they are particularly distinctive by virtue of intensive use or reputation. This argument will not be dealt with by the Office because as it will be seen, even with a normal degree of distinctiveness that the earlier marks can prevent the registration of the later mark. It is only therefore necessary to state that the expression ‘PINK RIBBON’ does not have a meaning in relation to the goods and services at hand and is, consequently, perfectly distinctive.

- The goods and services have been found to be identical and target the average consumers as well as the professionals in the fields of ‘publicity’, etc. The level of attention will vary depending on the goods, and it will be low as regards ‘printed matter’, for example, and high in relation to services like ‘insurances’ and alike.

- As for the signs, it has been explained that Benelux trade mark registration No 792 329, which covers identical services in Class 36, is similar to the contested application in as much as they contain the same denomination (or a very similar one should the consumers not infer a letter ‘O’ from the ribbon of the application), and which will be understood by a large part of the relevant consumers either in its symbolic meaning or in the literal English concept. On the other hand, they are clearly dissimilar in the figure of the ‘pink ribbon’, which is, however, nothing else than the graphic representation of the denomination. Consequently, as regards the services in Class 36 the opposition filed under Article 8(1)(b) CTMR must be upheld based on the earlier trade mark mentioned above.

- The earlier trade mark registration No 742 123 covers identical goods in Classes 16 and 25. In the comparison of the signs it has been pointed out that, vis-à-vis the contested application, it is similar to it in a denomination which is either identical or very alike (depending how consumers perceive it), and in the graphic figure, which is also very close to the ribbon shown in the application. Consequently, as regards these goods, the opposition filed under Article 8(1)(b) CTMR is upheld.

- As the earlier rights mentioned above lead to the success of the opposition and to the rejection of the contested Community trade mark application for all the goods and services against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent.

- Also, since the opposition is fully successful on the basis of the ground of Article 8(1)(b) CTMR there is no need to further examine the other grounds of the opposition, namely Article 8(1)(a) and Article 8(5) CTMR.

14 On 27 August 2009, the applicant filed a notice of appeal against the decision. A statement of grounds of appeal was received on 3 November 2009.
The appeal was forwarded to the Opposition Division for consideration pursuant to Article 62 CTMR and was remitted to the Boards of Appeal on 11 November 2009.

On 18 March 2010, after an extension of time-limit, the opponent submitted its observations. Together with these observations, the opponent submitted a decision of the President of the District Court of The Hague of 24 September 2008 in an interlocutory proceeding, allegedly rejecting a claim that the trade marks were invalid under Benelux law. The opponent also alleged in these observations that it had initiated proceedings on the merits.

The appeal proceedings were suspended until 1 June 2010 at the request of the applicant, who also referred to the proceedings on the merits as mentioned in the previous paragraph.

On 21 April 2011, the parties were informed that it had come to the Board’s attention that on 20 April 2011 the District Court had rendered a judgement on the merits. Since the Board considered that this judgment could be relevant to the present proceedings, both parties were given until 21 June 2011 to submit their comments.

On 15 June 2011, the opponent submitted a full copy of the judgment of the District Court in the original language Dutch and a translation thereof in the language of the proceedings as well its comments on this judgment.

The applicant did not submit any observations within the set time-limit.

Submissions and arguments of the parties

The applicant requests the Board to register the trade mark 'PINK RIBBON' in the name of the applicant in its entirety and to order the opponent to bear the costs of the proceedings.

The applicant’s extensive arguments are summarized as follows:

- The Office failed to exercise its discretion to allow a continuation of the opposition proceedings.

- The applicant accepts the findings of the Opposition Division in relation to the identity of the respective goods and services. Furthermore, it concedes that the respective marks share similarities insofar as they share the elements of a ribbon device and the words PINK RIBBON. However, this is not sufficient for there to be a likelihood of confusion in accordance with Article 8(1)(b) CTMR.

- One of the principal arguments which needs to be considered in deciding the likelihood of confusion is the distinctiveness of the mark, either inherently or as a result of the use made of it.
Once the Opposition Division had found that elements of the earlier mark had a meaning which would be taken as a generic indicator rather than as a trade mark, this should have played a part in the consideration of the likelihood of confusion contained within the section ‘Global Assessment’. However, this seems to have been ignored, and indeed the Opposition Division stated that the words PINK RIBBON do not have a meaning in relation to the goods at hand. This seems completely contrary to the findings stated in the section regarding Conceptual Similarity and underlines the flaws in the Opposition Division’s reasoning.

The mere fact that the opponent may have alleged widespread use and widespread awareness of their activities does not mean that consumers would necessarily think that the use of a similar mark indicated the same or an economically-linked company. If a party chooses a poor mark (from the point of view of distinctiveness) then it must accept as a consequence that its ability to prevent the use of similar marks will be substantially curtailed.

The mark PINK RIBBON is descriptive; it stands for breast cancer awareness and funding. It should not have been accepted by the Benelux Intellectual Property Office. The descriptive character is confirmed, amongst others, by the German ‘Markenamt’. Moreover, no one in America has ever been able to register the term ‘PINK RIBBON’ as a trade mark.

It is the applicant, not the opponent, who has earlier rights in the Benelux. Therefore, the opponent has acted in bad faith towards the applicant.

Although several parties had used the word combination PINK RIBBON as well as the different variations of a logo in the Benelux, the opponent filed an application to register the PINK RIBBON trade mark, monopolizing both the word mark as well as the figurative mark in the Benelux.

During a Benelux court case (provisionary injunction) between Dutch Stitching PINK RIBBON and Walter Scheffrahn cs, predecessor and founder of PINK RIBBON Inc, the judge did not make any provisional nor final decision on the validity of the applicant’s trade mark application. The judge referred to OHIM to decide in this respect. As to the Court case on the merits, this still has to be started.

The opponent did not prove acquired distinctiveness of the earlier marks on the filing date of the trade mark application.

23 The opponent requests the Board to dismiss the appeal, uphold the decision and order the applicant to bear the opponent’s fees and costs in the opposition and appeal proceedings. Its arguments are summarized as follows.

The Office has no discretion to allow continuation of proceedings.

The Office complied with the requirements of Article 8(1)(b) CTMR. The signs are highly similar. The goods and services are identical. In itself this is already sufficient to determine the existence of a likelihood of confusion.
Furthermore, it should be taken into account that a consumer rarely has the opportunity to directly compare a trade mark and a sign with each other, but will often rely on the imperfect recollection of the trade mark. This means that a small imperfection in memory could already cause the relevant consumer to confuse marks at issue, or assume that the goods sold under these marks come from economically-linked undertakings.

The Office was thus correct in concluding that a normal degree of distinctiveness of defendant’s marks can (and does) already prevent the registration of the contested mark, as the earlier marks ‘PINK RIBBON’ do not have a meaning in relation to the goods and services at hand and they are therefore perfectly distinctive.

As was set out in the opponent’s observations and the numerous exhibits submitted to support this, the earlier trade marks and the earlier trade names invoked have an enhanced distinctive character through the intensive use made of them for years, and should therefore be awarded a broad scope of protection. Nevertheless, the outcome of the assessment of the Opposition Division is correct: namely that a likelihood of confusion exists.

In the event that the Board of Appeal were to decide that the opposition based on Article 8(1)(b) could not be fully upheld based on these two earlier trade marks alone, the opponent refers to the other earlier rights (both trade marks and trade names) that have been invoked to substantiate the opposition and refers to its earlier submissions in this regard and to the other grounds on which the opposition was based.

Insofar as the applicant argues that the earlier marks are invalid, this fails. In support of its assertion the opponent refers to the Judgment of the President of the District Court of The Hague of 24 September 2008 (interlocutory proceedings).

Insofar as the applicant raises various procedural issues (the extent to which opponent must demonstrate use made of its trade marks, the language of the exhibits; the dates of the exhibits submitted by the opponent), they fail.

Reasons

24 The appeal complies with Articles 58, 59 and 60 CTMR and Rule 48 CTMIR. It is therefore admissible.

No observations in reply by the applicant within set time-limit by the Office

25 In the statement of grounds, the applicant argues that the actual notification of the Opposition Division containing the time-limit to file observations in reply was put between the huge pile of observations filed by opponent. Unfortunately, the applicant argues, the notification had not been sent separately thus not attracting the attention of the applicant’s predecessor. The applicant therefore believes that the failure to respond before the deadline or to request a further period of time to
file submissions in reply, was attributable at least in part to the actions of the Office. Therefore, the applicant requests the Board to remit the case to the Opposition Division.

26 It is not clear to the Board if the applicant claims that the mistake was made due to the fact that the Office put the cover letter, which included the time limit to file observations, somewhere between the opponent’s facts, evidence and arguments, or that it was done correctly, but it got misplaced, by the applicant itself.

27 Insofar as the applicant argues that the Office put the cover letter between other documents, it cannot be excluded that the Office might make such a mistake. However if such were the case, taking into account that this letter is sent by mail and that the cover letter bears the information necessary for delivery, it would result in an undeliverable mail. Since in the present case the same page that contains the information necessary for delivery also contains the time-limit for the applicant to comply with, the applicant’s argument cannot succeed in this respect.

28 Insofar as the applicant argues that its predecessor misplaced the documents, this is tantamount to admitting an, in principle, inexcusable error on the side of the applicant in its organization of processing incoming mail.

29 In light of the foregoing, the applicant’s request to remit the case to the Opposition Division fails.

30 Nonetheless, the Board will take into full account the applicant’s extensive allegations made in the statement of grounds.

The validity of the earlier marks

31 In the present case the Board’s competence is limited to assessing if the Opposition Division erred in rejecting the trade mark applied for on the basis of Article 8(1)(b) CTMR and in case of the affirmative, if any of the other relative grounds of refusal invoked within the relevant opposition period are applicable.

32 As long as the earlier Benelux trade marks are protected, the applicant’s allegation on the one hand that by obtaining the Benelux registration for ‘PINK RIBBON’ the opponent acted in bad faith, as well as that the earlier marks are devoid of distinctive character, and the applicant’s claim on the other hand that it has prior rights, are irrelevant in the context of opposition to a Community trade mark application (see also judgment of 1 March 2005, T-185/03, ‘Enzo Fusco’, para. 63 and case-law cited).

33 Moreover, in a proceedings on the merits, initiated by the opponent against, amongst others, the predecessor of the applicant BRANDCONCERN B.V. as well as Mr. Scheffrahn who is representing the applicant in the case at hand, the District Court of The Hague rendered a judgement on 20 April 2011 in which the counterclaim requesting the invalidity of the opponent’s earlier marks (allegedly devoid of distinctive character, descriptive and customary, as well as filed in bad faith) was rejected in its entirety by the Court.
34 In the light of the foregoing, the Board cannot but consider for the purpose of the present proceedings that the earlier marks are valid.

*Likelihood of confusion*

35 Article 8 CTMR provides:

'1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

...

(b) If because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods and 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.

...

36 A likelihood of confusion lies in the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings (see judgment of 29 September 1998, C-39/97, 'Canon', para. 29 and judgment of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 17).

37 A likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see judgment of 11 November 1997, C-251/95, 'Sabé', para. 22, judgment of 29 September 1998, C-39/97, 'Canon', para. 16 and judgment of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 18).

38 That assessment entails certain interdependence between the factors taken into account and, in particular, the similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa (see judgments of 29 September 1998, C-39/97, 'Canon', para. 17 and of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 19).

39 Furthermore, marks with a highly distinctive character, either *per se* or because of the recognition they possess on the market, enjoy broader protection (see judgment of 29 September 1998, C-39/97, 'Canon', para. 18). The likelihood of confusion is therefore deemed to be greater when the earlier mark is highly distinctive or lower when the earlier mark has a very low degree of distinctive character.
Relevant public / territory

40 The perception of the marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (see judgment of 26 April 2007, C-412/05 P, 'Travatan', para. 59).

41 Since the earlier marks are registered in the Benelux, the relevant public has to be found in these Member States. A possible perception of the public outside the Benelux is irrelevant for the purposes of the present proceedings. Therefore, the applicant's allegation that the German trade mark authorities have confirmed the descriptive character of 'PINK RIBBON' as well as the allegation that no one in America has ever been able to register the term 'PINK RIBBON' as a trade mark are, even if they were true, irrelevant for the purpose of the present proceedings.

42 The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, for example, judgment of 28 June 2005, T-301/03, 'Canal Jean', para. 50).

43 Account should also be taken of the fact that the average consumer has only rarely the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind (see judgment of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 26).

44 Where the goods or services with which the registration application is concerned are intended for all consumers, as in the case at issue, the relevant public must be deemed to be composed of the average consumer, reasonably well informed and reasonably observant and circumspect.

45 It should be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see judgment of 7 October 2010, T-244/09, 'ascensa', para. 18 and case-law cited therein).

46 The average consumer's level of attention with respect to the contested goods is in principle not particularly high or low. Bearing in mind the essential financial and relatively technical nature of the services at issue, as well as that the commitments taken on by consumers in relation to these services can be relatively significant, the level of attention of the average consumer is relatively high for the services (see judgment of 15 September 2005, T-320/03 'Live richly', paras 70 and 73).

Comparison of the goods and services

47 The Board agrees with the Opposition Division's finding that the goods and services at issue are identical. This is also explicitly confirmed by the applicant.
Comparison of the signs

48 The signs to be compared are:

<table>
<thead>
<tr>
<th>PINK RIBBON</th>
<th>Pink Ribbon</th>
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</thead>
<tbody>
<tr>
<td>Contested mark</td>
<td>Earlier Benelux marks No 792 329 and No 742 123</td>
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</table>

49 The applicant does not dispute the comparison of the signs as made by the Opposition Division which is as follows:

'The earlier rights contain both the expression ‘pink ribbon’, which appears in standard upper case letters in the case of Benelux trade mark registration No 792 329, and in a mixture of upper and low case letters in blue colour in the case of Benelux trade mark registration No 742 123. This latter mark is accompanied by a ribbon in pink, and both, the expression and the ribbon are contained in a square of a light blue colour. Consequently, from a visual point of view the marks in dispute are similar in as much as the contested application also contains the denominations 'PINK' (which has been represented in a pink colour) and, if the consumers infer a vowel 'O' in the place of the graphic figure, the denomination 'RIBBON', represented in a grey colour. This graphic figure in the shape of a ribbon is quite similar to the one contained in Benelux trade mark registration No 742 123.

Phonetically, the English expression ‘PINK RIBBON’ of the opponent’s marks will be pronounced according to the knowledge the relevant consumers have of this language. At any rate, what matters is that, if the consumers do not infer a vowel 'O' in the place of the graphic figure that appears in the contested application, the pronunciation of the signs will be similar to a high degree, as they share all the sounds, but one. If, on the other hand, they are able to infer this vowel 'O', the pronunciation of the marks is completely identical.

Conceptually, the expression contained in the opponent’s marks refers, in English, to an international symbol of breast cancer awareness. Even if the relevant consumers do not know this, many of them will be aware that ribbons have been used to express solidarity on the part of the wearer with a given cause. The consumers who do not know this fact will understand the expression literally, that is to say, a ‘ribbon’ that is ‘pink’. Lastly, for a small part of the consumers the expression will be completely meaningless. As for the contested CTM, taking into account the presence of the graphic figure of the ‘pink ribbon’ in the place of the vowel 'O', the two first groups mentioned above will also be able to understand that a) the mark conceptually reflects the symbol of breast cancer awareness or b) it represents solidarity with some cause. The
third group of consumers will also very probably understand the reference to ‘pink ribbon’, though as said they will interpret it only literally. Finally, the consumers who do not understand English will see the mark as invented.’

50 The Board agrees with the above considerations which lead to a finding that the signs are visually highly similar, either phonetically highly similar or identical and either conceptually identical or meaningless.

51 Overall, the signs are, at least, highly similar.

Distinctive character of the earlier mark

52 The Opposition Division considered that the question of the alleged descriptiveness (and hence total non-distinctiveness) of the mark is outside the scope of the present proceedings because under the CTMR, the Opposition Division does not have any competence as to the validity of earlier national or Benelux trade marks. Insofar as the Opposition Division considered that it has no competence as to the validity of the earlier national marks, this is correct and this also applies to the Board. However, this does not imply that the Office cannot make a proper assessment of the distinctive character of the earlier mark for the purposes of the present proceedings.

53 In its judgment of 20 April 2011 the District Court of The Hague considered amongst others:

‘4.3. Scheffrahn et al.’s argument that the Foundation’s trademarks solely comprise signs that are customary in everyday language in the sense of Article 2.28 (1) d BCIP is unfounded. Most of the facts that Scheffrahn et al. contended in this connection regard the use of signs outside the Benelux. The fact that those signs are customary in the Benelux cannot be based on this, since it has not been contended or shown that the relevant public in the Benelux was aware of that use. The only use in the Benelux that Scheffrahn et al. contended regards the Pink Ribbon Gala of the American Women’s Club in 2002 and the Pink Ribbon Day that Estée Lauder organizes each year as of 2002. Those two activities are insufficient to conclude that the term PINK RIBBON or the image of a pink ribbon was customary in the Benelux as a symbol of the fight against breast cancer at the time the Foundation’s trademarks were registered, let alone that the Foundation’s trademarks were a customary indication of the goods and services for which the Foundation registered those trademarks at that time.

4.4. In addition, the Foundation contended unchallenged that from the registration of its trademarks, it has made a very intensive use of those trademarks in the scope of various activities and publications. As a result of that use, the trademarks acquired (additional) distinctive character. For this reason, as well, the Foundation’s trademarks cannot be nullified as usual signs (Article 2.28 (2) BCIP).

(…)

4.7. To the extent that Scheffrahn et al. also wanted to invoke the grounds for nullity of Article 2.28 (1) b (devoid of distinctive character) and c (descriptive signs) BCIP (in counterclaim Scheffrahn et al. appears to limit itself to the claim of customary names and bad faith), this cannot lead to a different opinion regarding the validity of the
Although the Community trade mark regime is an autonomous system with its own set of rules and objectives peculiar to it and applies independently of any national system (see judgment of 7 December 2010, T-59/08 ‘Nimei La Perla Modern Classic’, para. 66), the Board may very well take into consideration judgments of the national authorities.

The applicant stresses that given the conceptual comparison in the contested decision the Opposition Division should have taken the lack of distinctive character of the earlier mark into account in the global assessment. Instead, the applicant alleges, the Opposition Division stated in the global assessment that the words ‘PINK RIBBON’ do not have a meaning in relation to the goods at hand and have a normal distinctive character.

However the Board does not share the applicant’s view that there is a contradiction in the conceptual comparison and the global assessment of the contested decision.

Firstly, from the conceptual comparison as made by the Opposition Division it follows that the relevant public can be divided into three groups. A first group aware that ribbons have been used to express solidarity on the part of the wearer with a given cause, a second group who will understand the expression ‘PINK RIBBON’ literally, that is to say, a ‘ribbon’ that is ‘pink’ and a third, small part of the consumers, who will not understand the expression at all. In the Board’s view, even if the first group were to be considered to be the largest group, the second and third group combined will still form a significant part of the relevant public.

Secondly, insofar as the first group is aware that ribbons have been used to express solidarity on the part of the wearer with a given cause, this does not justify a conclusion that this part of the relevant public is incapable of seeing an indication of commercial origin in the earlier marks in relation to the contested goods and services covered by the Class 16, 25, and 36 headings of the Nice Classification.
Therefore, the applicant’s allegation that there is a contradiction in the conceptual comparison and the global assessment of the contested decision fails. In fact, if there is any contradiction to be detected it is in the applicant’s arguments about the lack of distinctive character of the earlier marks, but then on the other hand filing a trade mark application for a highly similar sign (arguably even identical from a phonetic and conceptual point of view) for identical goods and services.

As to the alleged enhanced distinctiveness of the earlier marks, the Board will first proceed to assess if the Opposition Division erred in considering that '[t]his argument will not be dealt with by the Office because as it will be seen, even with a normal degree of distinctiveness the earlier marks can prevent the registration of the later mark. It is only therefore necessary to state that the expression ‘PINK RIBBON’ does not have a meaning in relation to the goods and services at hand and is, consequently, perfectly distinctive."

Global assessment

In light of all the foregoing, it must be held that there exists, in the present case, whatever the degree of attentiveness of the relevant public, a likelihood of confusion, given that the goods and services in question are identical and given the high similarity between the opposing signs. It is more than likely that the relevant public will believe that the identical goods and services at issue bearing the conflicting signs come from the same undertaking or, as the case may be, from undertakings that are economically linked. Consequently, there is a likelihood of confusion between the marks in the Benelux.

For completeness sake the Board points out that even if it were to be considered that the earlier trade marks have a low degree of distinctive character instead of, for the purpose of the proceedings, normal distinctive character, such would not be able to affect the outcome in the case at hand. Although the distinctive character of the earlier marks must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see judgment of 13 December 2007, T-134/06, ‘Pagesjaunes.com’, para. 71 and the case-law therein cited).

In addition, the approach taken by the applicant in that respect would have the effect of disregarding the factor of the similarity of the marks in favour of one based on the distinctive character of the earlier national mark, which would then be given undue importance. The result would be that where the earlier national mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. Such a result would not, however, be consistent with the very nature of the global appreciation which the competent authorities are required to undertake by virtue of Article 8(1)(b) CTMR (see judgment of 13 December 2007, T-134/06, ‘Pagesjaunes.com’, para. 72 and the case-law therein cited).
Accordingly, the Opposition Division did not err in rejecting the applicant’s trade mark on the basis of Article 8(1)(b) CTMR because there is a likelihood of confusion between the trade mark applied for and the earlier Benelux marks Nos 792 329 and 742 123 for all the contested goods and service. Thus, there is no need to examine the other earlier rights invoked by the opponent.

Moreover, there is no need for the Board to assess the impact of the District Court ordering Scheffran et al. to refrain from applying for any Benelux or Community trade mark containing the words ‘PINK RIBBON’ or another combination of the words ‘PINK’ and ‘RIBBON’ with immediate effect after the judgment is served.

The appeal is dismissed.

Costs

Pursuant to Article 85(1) CTMR, the applicant, as the losing party, must bear the costs of the appeal proceedings. Pursuant to Article 85(6) CTMR and Rule 94(3) last sentence CTMR, the applicant is therefore ordered to reimburse the costs of professional representation for the appeal proceedings at the level laid down in Rule 94(7)(d) CTMR (EUR 550). As to the opposition proceedings, the Opposition Division ordered the applicant to bear the opponent’s representation costs in the amount of EUR 300 and the opposition fee of EUR 350.
Order

On those grounds,

THE BOARD

hereby:

1. **Dismisses the appeal;**
2. **Orders the applicant to bear the total amount of EUR 1200 in respect of the fees and costs of the opponent in the appeal and opposition proceedings.**

Signed

T. de las Heras

Signed

H. Salmi

Signed

G. Humphreys

According to Article 6 of Commission Regulation (EC) No 216/96

According to Article 6 of Commission Regulation (EC) No 216/96

Registrar:

Signed

P. López Fernández de Corres