



DECISION

Of 23 /01/2007

RULING ON OPPOSITION No B 795 569

Opponent: **Daniel Giersch**
14 bis Rue Honoré Labande
MC- 98000 Monaco
Mónaco

Representative: **Götz Thomas**
Breitenburger Str. 31
25524 Itzehoe
Germany

Trade Mark:



against

Applicant/holder: **Google, Inc.**
Building 41, 1600 Amphitheatre Parkway
Mountain View, California 94043
United States of America

Representative: **Grünecker, Kinkeldey, Stockmair &
Schwanhäusser**
Maximilianstr. 58
80538 München
Germany

Contested trade mark: **GMAIL**

I. FACTS AND PROCEDURE

On 14/04/2004, the applicant filed application No 3 753 621 to register the word mark "GMAIL" for services in class 38, against which the opposition is directed.

The opposition is based on the earlier German trade mark registration No 30 025 697 for the figurative mark, as reproduced on the cover page, which has been registered for services in classes 38, 39 and 42. The opponent bases its opposition on all these services.

The grounds of the opposition are those laid down in Article 8(1)(b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ("CTMR").

Both parties filed observations and evidence within the time limits set by the Office.

The opponent argues that there is a likelihood of confusion because of the similarity of the signs and because the services covered by the two marks are identical or similar. The opponent claims an average scope of distinctiveness for the mark which has been supported by case-law from the Hamburg District Court. The opponent also states further that the identical element of the marks, "G-Mail", is the prominent feature in his mark therefore giving rise to a likelihood of confusion on behalf of the public.

In reply, the applicant argues that "MAIL is descriptive of the services and is therefore of very limited distinctiveness. The applicant also reasons that due to the nature of the services, the relevant consumer will be more attentive and will easily see the differences between the two marks in dispute. The applicant suggests that the targeted consumers will easily make the link between the holder of the mark, Google and the sign due to the letter "G". The applicant also includes a figurative, colour version of the "GMAIL" mark and adds that the style and colours will lead to consumers to making the link once again between the holder and the mark.

Furthermore, the applicant alleges that the opponent has deliberately set out to take advantage or a "free ride" of the German Postal Office, since the colours used in the mark are identical to those used by the German Postal Office as well as the use of the word 'post'. The applicant also states that the opponent is not using the mark for the services against which the opposition is directed, namely, class 38.

II. DECISION

Preliminary Remarks

Before proceeding, the Office points that the contested application is for the word mark "GMAIL" and not for the figurative mark as included in the observations of the applicant. Therefore, the assessment of similarity will be for the Community trade mark for which the applicant seeks protection. Further to the assertions made by the applicant regarding the letter "G" being immediately recognised by consumers as referring to the applicant, Google, there is no evidence to support this and furthermore it would appear that these comments are made when referring to the applicant's other figurative marks which are of no relevance to these proceedings.

Furthermore, as far as the Opposition proceedings are concerned, it is not up to the Office to decide whether or not the opponent is taking advantage of other marks on the market nor to investigate whether or not the opponent's mark is really being used in conjunction with the services for which it is registered. Indeed, as the applicant is well aware, the earlier right is not subject to the proof of use requirements as set out in Article 43 (2) and (3) since it is still within the five year grace period.

A. ON THE ADMISSIBILITY OF THE DECISION

The applicant argues that the opposition should be rejected on the grounds of inadmissibility due to the non-translation of the colour indications from the original German certificate. However, in this respect the Office points out that the applicant provided the Office with a colour copy of the mark in question in which the colours would be clearly appreciated. Furthermore, in the opponent's statement of grounds, the colours of the mark are clearly indicated.

Further to Rule 15 which sets out the procedure for opposition and proof of use, paragraph (e) states "if the earlier mark is in colour, the representation shall be in colour". In sending the Office a colour copy of the earlier right, the opponent complied with the requisites of this rule. Consequently, the opposition is admissible.

B. LIKELIHOOD OF CONFUSION

a) Comparison of the services

The services of the earlier mark, amongst others, are, *telecommunications, particularly services in and for electronic communication networks, like Internet or World Wide Web, electronic mail service, dissemination of information.*


The services of the contested mark are, *telecommunications; communications by computer terminals; message sending; electronic mail services.*

The contested services are identical to those of the earlier right or indeed included within the broader terms of the earlier right's specification since they are all telecommunications services.

b) Comparison of the signs

In determining the existence of likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, phonetic and conceptual similarities between the marks. The comparison must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (cf. Judgment of the Court of Justice, Case C-251/95 *Sabèl BV v Puma AG, Rudolf Dassler Sport* [1997] OJ OHIM 1/98, p. 91, paragraph 22 et seq.).

The signs to be compared are:

 <p>Earlier trade mark registration</p>	<p>GMAIL</p> <p>CTM application</p>
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The earlier figurative mark is protected in Germany. Therefore, it is the impression that the signs make on the German public and their meaning and pronunciation in the German language which are relevant for their comparison.

Likelihood of confusion in only one part of the Community is sufficient as a relative ground for the rejection of the application in issue. This follows from the unity character of the Community trade mark (See Judgment of the Court of First Instance of 9.3.2005 in case T-33/03, “Hai/Shark”, par. 39).

Dominant components

In determining the distinctive character of a mark, and, accordingly, in assessing whether it is highly distinctive, it is necessary to make a global assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus, to distinguish those goods or services from those of other undertakings. In making that assessment, account should be taken of all relevant factors, and in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered (see *Lloyd*, paragraph 28 et seq.).

In this regard, the Office point out that both marks start with the same verbal element “GMAIL” and due to its prominent positioning and lettering within both of the marks in dispute, it can undoubtedly be called the dominant element of the verbal elements. Furthermore, since this element contains the word “MAIL” the relevant, German consumers will recognise it as being connected to “email”. Therefore, in view of the fact that the services at issue are telecommunications services in class 38, it could be deemed that this element is of a limited distinctiveness. However, bearing in mind the “G” at the beginning of this word, it has to be said that this letter endows a certain amount of distinctiveness to the word as a whole thus diminishing the effect that the more descriptive “mail” element may have.

Moving onto the visual comparison, the marks coincide in the five letters /GMAIL/ which indeed is the totality of the contested mark itself. Although the letters of the contested application are written in uppercase as opposed to the capital /G/ and lower case /MAIL/ in the earlier right, this has no relevance for the purpose of comparison, since for this mark protection is sought for the word itself and not for the specific representation thereof. The earlier right includes other wording but it is written in a

much smaller script making the “G-MAIL” predominant in the mark. Regarding the use of hyphen in the earlier right, the only visual consequence is that it separates the /G/ from the word. Indeed the use of colour and the additional elements mentioned, do little to cloud the undeniable, strong, visual identity of the verbal elements in the marks. Additionally, it should also be borne in mind that the average relevant consumer very rarely has the opportunity to compare signs side by side, thus relying on the imperfect picture retained in their memory, therefore “GMAIL” is what will be recalled from the earlier right. Thus the Office concludes a strong visual similarity between the marks in dispute.

Aurally both marks are identical as far as the “GMAIL” element is concerned. Although the earlier right has the additional “und die Post geht richtig ab” which would make the overall aural effect substantially different from that of the contested application, the Office is of the opinion that the relevant consumer would not refer to this element since it is more of a promotional slogan. Additionally, this element is positioned below “GMAIL” and since signs are read from top to bottom, then it is the GMAIL element which will receive more attention. Moreover, the beginnings of the marks are identical and since it is the beginnings of signs that have more of an impact on the public as has been established, then the remaining wording becomes less important. In view of the above, the Office finds the marks very similar aurally.

Conceptually the dominant element of the marks, “GMAIL”, has no meaning in German. However, as mentioned previously, the fact that this element contains “MAIL” will lead consumers to link the marks with electronic messaging services since the term “e-mail” is used in Germany to refer to these services as well as the fact that the relevant public is more than used to seeing these kind of services being marketed with “MAIL” suffixed terms. In the case of the “und die Post geht richtig ab” this is a typical German idiom meaning “and off the Post goes” or “the post is moving” which here is meant to highlight the speed of the service.

c) Overall assessment on the likelihood of confusion

It constitutes a likelihood of confusion within the meaning of Article 8(1)(b) CTMR 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 (see Judgment of the Court of Justice, Case C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn Mayer Inc*[1998], OJ OHIM No. 12/98, page 1407 *et seq.*, paragraph 29.)

Likelihood of confusion must be assessed globally, taking into account all the circumstances of the case. Likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa. Furthermore, the more distinctive the earlier mark, the greater the risk of confusion. 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. (See *Canon*, paragraph 17 *et seq.*)

For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. However, account should be taken of the fact that the average consumer only rarely has 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. It should also 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 (Judgment of the Court of Justice Case C-342/97, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, OJ OHIM No 12/1999, p. 1585, paragraph 26).

As to the distinctive character of the earlier mark, the opponent claims average distinctiveness, although the Office points out that the element "MAIL" is of extremely limited distinctiveness, if any, particularly bearing in mind the services in question.

Although the applicant asserts that given the nature of the services in question, the relevant public will be more attentive and thus small differences between the marks will be suffice to differentiate them. The Office is of the opinion that the high degree of similarity between the marks leaves little room for small differences to be observed by the general public. Moreover, the general public is used to companies using variations of trade marks so they will see the contested application as a simple version of the earlier right and believe they come from the same undertaking.

As has been discussed, the dominant elements of both marks are identical and furthermore they are the first words to which attention is drawn. The fact that that earlier right has additional wording is irrelevant since the relevant consumer would see this as emphasising the "GMAIL" services due to its promotional qualities which highlight the speed of the services concerned.

Therefore, when taking into account that the services in comparison are identical, the Office concludes that there is a strong likelihood of confusion given the strong visual and phonetic similarity between the marks in dispute.

Therefore, the contested CTM application is to be rejected in full due to its similarity to the earlier German trade mark registration.

C. COSTS

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

According to Rule 94(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing the CTMR (OJ OHIM 2-3/95, p. 259), the apportionment of costs must be dealt with in the decision on the opposition.

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

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

DECIDES TO:

1. Uphold opposition number B 795 569 for all the contested services.
2. Reject application number 3 753 621 in its entirety.
3. Order the applicant to bear the costs.

FIXES THE COSTS AS FOLLOWS:

The amount of the costs to be paid by the applicant to the opponent pursuant to Article 81 (6) CTMR in conjunction with Rule 94 (3) IR shall be:

Representation costs 300 euro
Opposition fee 350 euro

Total amount: 650 euro

Alicante, 23/01/2007

The Opposition Division

Patricia LOPEZ
FERNANDEZ DE CORRES

Vanessa PAGE

Alain RASSAT

Notice on the availability of an appeal:

Under Article 58 of the Community Trade Mark Regulation any party adversely affected by this decision has a right to appeal against this decision. Under Article 59 of the Regulation notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of 800 euro has been paid.

Notice on the review of the fixation of costs:

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. Under Rule 94 (4) of the Implementing Regulation such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of 100 euro (Article 2 point 30 of the Fees Regulation) has been paid.