

DECISION
of the Second Board of Appeal
of 7 May 2021

In case R 983/2020-2

Super Brains B.V.

Van Oldenbarneveltplaats 390

3012 AN Rotterdam

Netherlands

Applicant / Appellant

represented by CASUS.nl, att.of: Abi Reddoub, Weena 505, 3013 AL Rotterdam,
Netherlands

v

DC Comics (partnership)

2900 West Alameda Avenue

Burbank, California 91505

United States of America

Opponent / Defendant

represented by Hofhuis Alkema Groen Advocaten, Keizersgracht 212,
1016 DX Amsterdam, Netherlands

APPEAL relating to Opposition Proceedings No B 3 069 325 (European Union trade
mark application No 17 941 033)

THE SECOND BOARD OF APPEAL

composed of S. Stürmann (Chairperson), A. Szanyi Felkl (Rapporteur) and S. Martin
(Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 10 August 2018, Super Brains B.V. ('the applicant') sought to register the figurative mark



for the following list of goods and services:

Class 9 - Software; Computer software platforms; Application software; Software suites; Data communications software; Interactive computer software; Data management software; Content access software; Multimedia software; Interactive software; Downloadable software; Computer operating system software; Computer programmes for data processing; Computer programs for network management; System support software; Development environment software; Document automation software; Collaboration management software platforms; Computer software for database management; Science software; Website development software; Computer software downloadable from global computer information networks; Computer software for use in medical decision support systems; Internet access software; Computer software to enable the searching of data; Computer software to automate data warehousing; Document management software; Computer software for application and database integration; File sharing software; Database synchronization software; Computer software for authorising access to data bases; Computer software for use in providing multiple user access to a global computer information network.

Class 42 - Design of computer databases; Development of data bases; Maintenance of data bases; Installation of database software; Database design and development; Scientific research conducted using databases; Development, updating and maintenance of software and database systems; Platform as a service [PaaS]; Hosting of multimedia applications; Server hosting; Hosting of interactive applications; Hosting multimedia educational content; Hosting the computer sites (web sites) of others; Hosting on-line web facilities for others; Hosting of mobile applications; Hosting platforms on the Internet; Hosting of computerized data, files, applications and information; Design, creation, hosting and maintenance of websites for others; Maintenance of websites and hosting on-line web facilities for others; Hosting the web sites of others on a computer server for a global computer network.

- 2 The application was published on 22 August 2018.
- 3 On 22 November 2018, DC Comics (partnership) ('the opponent') filed an opposition against the registration of the published trade mark application for all the above goods and services.

- 4 The grounds of opposition were those laid down in Article 8(1)(b), 8(4) and 8(5) EUTMR.
- 5 The opposition was based on the earlier EUTM registration No 3 429 354 for the figurative mark



filed on 22 October 2003 and registered on 29 March 2005 for the following goods and services:

- a range of goods in Classes 3 and 5;

Class 9 - Photographic, cinematographic and optical apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computers, computer hardware and computer software, parts and fittings for all the aforesaid goods; electronic publications (downloadable); interactive computer software; apparatus for searching electronic information from a global computer network or the Internet; computer programs, namely, software linking digitised video and audio media to a global computer information network; arcade games adapted for use with television receivers only; CD-ROM games; video and computer game programs; video game discs, cartridges and cassettes; digital music (downloadable) provided from the Internet; digital music (downloadable) provided from MP3 Internet web sites; MP3 players; motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes (all being sold together with booklets); digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; stereo headphones; batteries; cordless telephones; mobile telephones; parts and accessories for mobile telephones; mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitation of leather; mobile telephone covers made of cloth or textile materials; telephone and/or radio pagers; hand-held calculators; hand-held karaoke players; short motion picture film cassettes featuring comedy, drama, action, adventure and/or animation to be used with hand-held viewers or projectors; audio cassette recorders and players; video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players, electronic diaries; radios; mouse pads; eyeglasses, sunglasses and cases therefore; encoded magnetic cards, phone cards, credit cards, cash cards, debit cards and magnetic key cards; decorative magnets; swimming floats; kickboard flotation devices; swim boards; global positioning systems; navigation apparatus for vehicles (on-board computers); parts and fittings for all of the aforementioned goods;

- a range of goods in Classes 14;

Class 16 - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; 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; printed matter and paper goods, namely, books featuring characters from animated, action, adventure, comedy and/or drama features, comic books, children's books, magazines featuring characters from animated, action adventure, comedy and/or drama features, colouring books, children's activity books; booklets (all being sold together with audio tapes); stationery, writing paper, envelopes, notebooks, diaries, note cards; greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, coloured pencils, painting sets, chalk and chalkboards, decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper, paper party decorations, namely, paper napkins, paper doilies, paper place mats, crepe paper, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliqué; printed patterns for costumes, pyjamas, sweatshirts and t-shirts; adhesive tapes for stationery or household purposes; aquaria (indoor-); aquarium hoods; architects' models; babies' diapers of paper and cellulose, disposable; babies' napkin-pants [diaper-pants]; bags (garbage-) of paper or of plastics; bags for microwave cooking; balls for ball-point pens; chaplets; checkbooks [cheque books] (holders for-); composing frames [printing]; composing sticks; diaper-pants (babies'-); engraving plates; galley racks [printing]; garbage bags of paper or of plastics; graining combs; hand labelling appliances; holders (passport-); holders for checkbooks , [cheque books]; house painters' rollers; indoor aquaria; indoor terrariums [vivariums]; marking chalk; microwave cooking (bags for -); models (architects' -); mounting photographs (apparatus for-); napkin-pants (babies' -); packaging material made of starches; passport holders; photograph stands; photographs (apparatus for mounting -); printers' blankets, not of textile; printers' reglets; rollers (house painters' -); rosaries; sheets of reclaimed cellulose for wrapping; starches (packaging material made of-); steatite [tailor's chalk]; tailors' chalk; tanks [indoor aquaria]; terrariums (indoor-) [vivariums]; trays for sorting and counting money; vignetting apparatus; wristbands for the retention of writing instruments; chalk (marking -); selfadhesive tapes for stationery or household purposes.

- a range of goods in Classes 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 32;
- and a range of services in Class 41.

The opponent claimed reputation, pursuant to Article 8(5) EUTMR, as regards all the aforementioned goods and services, in the territory of the whole of the European Union.

Finally, the opponent based its opposition on the earlier non-registered trade mark, used in the course of trade of more than mere local significance in all the 27 Member States of the European Union, pursuant to Article 8(4) EUTMR:




The goods for which the non-registered mark was claimed are: film, television, media, computer games, computer software, clothing, printed matter, comic books, graphic novels, glassware, textiles and textile goods, model cars, toys, toy vehicles and playsets, and merchandise associated with film and television and other media.

- 6 By letter of 14 August 2019 the applicant requested proof of use of the earlier EUTM. The opponent chose not to submit additional evidence of proof of use, since it has already submitted voluminous evidence to prove reputation of its earlier mark, and asked the Office to take it into account.
- 7 By decision of 18 May 2020 ('the contested decision'), the Opposition Division upheld the opposition for all the contested goods and services. It gave, in particular, the following grounds for its decision:
- The opponent's evidence to be taken into account is, in particular, the following:

- Exhibit 1: information on 'Superman' and his 'S-Shield', such as an excerpt from *DC Comics: Sixty Years of the World's Favorite Comic Book Heroes* by Les Daniels (1995), titled 'The Creation and Impact of Superman', showing the earlier mark throughout on the 'Superman'

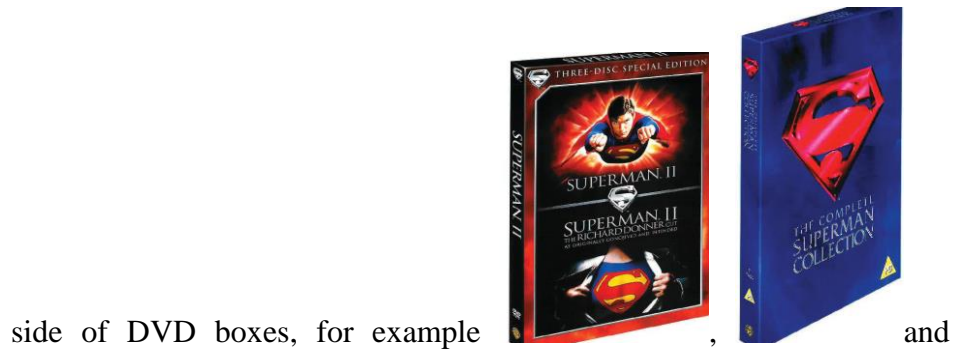


character, for example on the cover of the first issue



of *The Man of Steel* (June 1986) and on the cover of *Time* of 14/03/1988. Another extract regarding 'Superman' from the *DC Universe Online Encyclopedia* refers to the first appearance of the 'Superman' character in comics in 1938, displays the earlier mark on the chest of the 'Superman' character in every portrayal and states: 'From his blue uniform to his flowing red cap to the 'S' shield on his chest, the Man of Steel is one of the most immediately recognisable and beloved DC Super Heroes of all time.'

- Exhibit 2: EU motion picture and television series art work in the Benelux, Croatia, Czech Republic, Denmark, Finland, France, Germany, Hungary, Italy, Poland, Romania, Slovenia, Spain, Sweden and the UK, showing the earlier mark in various positions, not only on the chest of the main 'Superman' character but also independently on the top or the



or on outdoor publicity, for example



- Exhibit 3: information on the promotion in the EU of the motion picture *Man of Steel* (2013), examples of film posters used in the EU, examples of the campaign *in situ*: paid media highlights, promotion examples.
- Exhibit 4: information on the promotion in the EU of the motion picture *Batman v Superman: Dawn of Justice* (2016), examples of film posters used in the EU, examples of the campaign *in situ*: international campaign snapshots, promotion examples.
- Exhibit 5: an overview of the Facebook pages for 'Superman' (7 163 416 likes, 7 029 262 followers), *Man of Steel* (3 767 916 likes, 3 734 979 followers), *Batman v Superman: Dawn of Justice* (4 690 583 likes, 4 676 830 followers) and *Superman: The Movie* (1 384 176 likes, 1 364 650 followers), showing the earlier mark in many situations, for



- Exhibit 6: 'The Box Office Mojo' results for the motion pictures *Man of Steel* (2013) and *Batman v Superman: Dawn of Justice* (2016). Very substantial total gross numbers are indicated for many European countries. For example, '*Man of Steel* (2013) had a total gross of USD 9 806 671 in Germany, USD 20 914 412 in France,

USD 10 029 587 in Spain and USD 46 198 857 in the United Kingdom.



Batman v Superman: Dawn of Justice (2016) had a total gross of USD 18 918 262 in Germany, USD 21 319 616 in France, USD 11 357 442 in Spain and USD 53 128 158 in the United Kingdom. Furthermore, the evidence includes a broadcast sales history report of ‘Superman’-related titles in the EU (2013-present) and an overview of the first telecast of ‘Superman’-related titles by title and country in the EU.

- Exhibit 7: examples of motion pictures, television serials and e-books readily available for purchase on the European Union market, such as on amazon.co.uk, showing, for example, DVD and Blu-ray items displaying



the earlier mark: fnac.com (a site targeting Belgium and France); amazon.de (a site targeting Germany) and bol.com (a site targeting the Netherlands).

- Exhibit 9: examples of comics available for purchase on the European Union market: Titan Comics and forbiddenplanet.com (UK); paninishop.de (Germany) and Rwedizioni.it (Italy), showing the earlier

Plus save 25% off the cover price when you subscribe. That's just \$2.25 an issue!

The great offer includes:

- Save up to 25% off the cover price!
- Pay £2.00 every 3 issues or direct debit
- Or get 13 issues for only £30, saving 13%!*
- FREE UK* delivery to your door!
- Get the very first issue!

Order now to be the first to get your copy of the very first issue!

mark as follows:



and

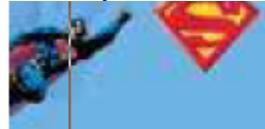
- Exhibit 10: articles from the site licenseglobal.com about the scale of licensing of the ‘SUPERMAN’ marks, including the ‘S-shield’ (2012-2016) and examples of merchandising that is readily available for



purchase on the European Union market, such as



, and . An article entitled ‘Warner Bros. Consumer Products doesn’t need X-ray vision to know Superman is a



well recognized superhero icon’, dated 01/05/2005, gives some ‘global superman perceptions’, namely that ‘in London, kids connect with the shield more than the hero’ and the following:

‘Of Superman’s many brand strengths, the S-shield logo and icon is deemed cool by many age groups. In particular, according to research, boys separate the man from the shield, explains Globe. The shield – already on a variety of merchandise from Ts to backpacks – makes a statement about your personality, says the same research. But the S-shield is not only iconic for boys. Globe believes, and the research concurs, that with trend-right product, the S-shield appeals to girls and juniors, as well.’

This article also references worldwide research, via focus groups with 9- to 11-year-old boys in different cities, including Milan and London, concluding that ‘the S-shield is really aesthetic ... and it’s an icon with momentum’.

Another article, dated 12/03/2013, on the film *Man of Steel* states that ‘[t]raditionally the Superman program for WBCP has been anchored in apparel, with the iconic S-Shield graphic leading the charge’. An article dated 01/03/2016 states that ‘[t]he Puma x Superman collection features Puma’s classic styles in kids’ size versions and incorporating Superman’s suit colors and iconic S-shield’. Furthermore, a ‘Brand Assurance Report’ generated from the DC Comics internal consumer products database shows products licensed for distribution in the EU between 2013 and 2018. Examples are given from amazon.co.uk, with goods displaying the earlier mark, for example, and; other outlets are LIDL and logoshirt-shop.de, amazon.it, bol.com and zazzle.nl.

- The evidence shows that the place of use is the European Union. This can be inferred from the evidence of the websites in different countries that offer goods under the earlier mark (exhibits 7 and 9) and from the sales numbers of the motion pictures and TV broadcasts (exhibit 6), which refer to various countries in the European Union of the time, such as Austria, Belgium, Bulgaria, Croatia, Czech Republic, Denmark, Finland, France, Germany, Greece, Hungary, Italy, Netherlands, Poland, Portugal, Slovakia, Slovenia, Spain, Sweden and the United Kingdom.
- The documents filed, mainly the evidence relating to the history and sale of comics in the EU (exhibits 1 and 9) and promotion and results of the two major motion pictures released in 2013 and 2016 (exhibits 2, 3, 4, 6 and 7), provide the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use.
- The earlier mark is registered in black and white, while it is mainly used in colour. Contrary to the applicant's arguments, the use in colour does not affect the distinctive character of the earlier mark. The specific letter 'S' and the diamond shape in which it is depicted are the main distinctive elements, and they are present with the same relative shades in the earlier mark as registered and as used, since the letter 'S' and the diamond shape in each case contrast against a lighter background. The colours used, mainly yellow and red, but also others such as white and blue, have as such no particular inherent distinctive character and are more of a decorative nature. The colours are not the main contributors to the overall distinctiveness of the sign.
- The fact that the earlier mark is associated with a comic book or film character does not prevent it from also functioning as a trade mark, as long as it fulfils the essential function of a trade mark, namely as an indicator of the origin of the goods in question. The evidence demonstrates that the sign performs this function for the goods in Classes 9 and 16.
- Taking into account the evidence in its entirety, the evidence submitted by the opponent is sufficient to prove genuine use of the earlier trade mark during the relevant period in the relevant territory for:

Class 9 – Motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation.

Class 16 – Comic books.

- The applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.
- The contested trade mark was filed on 10/08/2018. Therefore, the opponent was required to prove that the trade mark on which the opposition is based

had acquired a reputation in the European Union prior to that date. The evidence must also show that the reputation was acquired for the goods and services for which the opponent has claimed reputation.

- It is clear from that evidence that the earlier trade mark has been subject to long-standing and intensive use before the filing date of the EUTM application in several Member States, where it enjoyed a consolidated position among the leading brands in the comics and film sector.
- ‘Superman’ is a name that has distinguished a world-renowned line of comic books since 1938 and that the character with its blue uniform, flowing red cap and the ‘S-shield’ on its chest has become one of the most immediately recognisable and beloved superheroes.
- From the very beginning the earlier mark played a significant role and became one of the most important symbols associated with the ‘Superman’ comics, and later with the films and TV series. Notably, throughout the evidence, the ‘Superman’ character always appears in the comics and in the films/series with the earlier mark, the ‘S-shield’, on its chest.
- The comics were very soon transposed into very popular film and TV series. They made their first appearance on the big screen in a series of 17 animated cartoons between 1941 and 1943 and have subsequently appeared in numerous other motion pictures and television series such as: *Superman* (1948), *Atom Man vs. Superman* (1950), *Superman and the Mole Men* (1951), *Superman* (1978), *Superman II* (1981), *Superman III* (1983), *Superman IV: The Quest for Peace* (1987), and, more recently, *Superman Returns* (2006), *Man of Steel* (2013), *Batman v Superman: Dawn of Justice* (2016).
- The films released in cinemas and films and series sold as DVDs/Blu-ray throughout the European Union are numerous (exhibits 2, 3, 4 and 7). Many of them, in particular the most recent ones, reached high positions in the charts of various EU countries (exhibit 6) and were intensively promoted and covered by the European press.
- The millions of followers and likes on social media show the recognition of the earlier mark in relation to the ‘Superman’ comics and films. In the extracts from Facebook, the earlier mark appears either on the chest of the main ‘Superman’ character or is used individually
- The fame of the earlier mark is also apparent from its proven attractiveness to being used under licence on many different goods by third parties in different Member States of the European Union (exhibit 10). The long and consistent use of the earlier mark in relation to successful and popular comics and films made it a sign desired by companies to make their products more attractive to customers. This is also apparent from the many references on the LicenseGlobal website, which apart from giving more information on the licence agreements of the earlier mark, refer several times to the earlier mark,

the ‘S-shield’, as ‘iconic’. In one of the articles it is even said that ‘in London, kids connect with the shield more than the hero’ and ‘[o]f Superman’s many brand strengths, the S-shield logo and icon is deemed cool by many age groups’.

- The earlier trade mark is known in a substantial part of the European Union by a significant part of the public concerned, and has, therefore, obtained a reputation in relation to ‘motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation’ in Class 9 and ‘comic books’ in Class 16.
- Although the earlier mark is registered in black and white, while the mark has been used in colour, the relevant public will still recognise the earlier mark as originating from the opponent and as being used to distinguish its comics and films.
- Visually, the signs coincide in the diamond shape of their figurative elements and in the ‘S’ shape inside of them, although differently shaped. However, they differ in the specific stylisation of the letter ‘S’ in each sign, in their colours and in the additional verbal element ‘SUPERBRAINS’ in the contested sign, which has a low degree of distinctiveness, at least for part of the relevant public. Therefore, the signs are visually similar to a low degree.
- Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the signs coincides, at least for part of the public, in the sound of the single letter ‘S’, present identically in both signs and having a normal degree of distinctiveness. The pronunciation differs in the additional verbal element ‘SUPERBRAINS’ in the contested sign, which has a low degree of distinctiveness, at least for part of the relevant public. Furthermore, it cannot be excluded that part of the relevant public will not pronounce the single letter ‘S’ in the contested sign and will only pronounce the verbal element underneath, ‘SUPERBRAINS’. Therefore, the signs are aurally similar at least to a low degree for the part of the relevant public that will pronounce the single letter ‘S’ in the contested sign, while the signs are aurally not similar for the part of the relevant public that will only pronounce the verbal element ‘SUPERBRAINS’ in the contested sign.
- Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. As the signs will be associated with a similar meaning on account of the diamond shaped figurative element containing a single letter ‘S’, while the contested sign has an additional concept ‘SUPERBRAINS’, which is less distinctive for part of the public as mentioned above, the signs are conceptually similar to an average degree.
- The signs are visually similar to a low degree, aurally similar at least to a low degree and conceptually similar to an average degree. Although the earlier mark contains only the letter ‘S’, it is clear from the evidence that it is

associated with the ‘Superman’ comics and films. The fact that the contested sign, which uses the same diamond-shaped figurative element incorporating an ‘S’ shape, also has the verbal element ‘SUPERBRAINS’ will, despite the low degree of distinctiveness of its constituent elements for part of the relevant public, contribute to making a link with the earlier mark as the public will see it together with the other elements as an allusion to ‘Superman’.

- The earlier mark, which has an inherent normal degree of distinctiveness, obtained a reputation for ‘motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation’ (Class 9) and ‘comic books’ (Class 16).
- The contested goods and services have a certain connection with the opponent’s reputed goods as the making of comics and films/TV series is nowadays highly computerised, requiring specific software and IT skills.
- When encountering the contested sign, the relevant consumers will be likely to associate it with the earlier mark, that is to say, establish a mental ‘link’ between the signs. However, although a ‘link’ between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 96).
- The opponent must establish that detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that purpose, the opponent should file evidence, or at least put forward a coherent line of argument demonstrating what the detriment or unfair advantage would consist of and how it would occur, that could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.
- The opponent claims that use of the contested trade mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark.
- Unfair advantage taken by the contested mark must be assessed by reference to both the general public (some of the goods in Class 9) and the professional public (some of the goods in Class 9 and the services in Class 42). The level of attention will vary from average to higher than average depending on the specific nature and price of the goods and services.
- The earlier mark has obtained a reputation and has become an attractive and powerful brand in the European Union. As a consequence, it has gained strong licensing power, as demonstrated by the evidence (exhibit 10). Furthermore, the earlier mark is recognised in relation to the ‘Superman’

comics and films and has gained, on account of their content, a positive image that stands inter alia for speed, strength and superpower.

- Considering the reputation of the earlier mark, the visual, aural and conceptual similarities between the signs and the fact that the goods and services at issue are connected, the relevant public will make a link between the marks. This link will create an association from which the applicant will commercially benefit as the positive image of the earlier mark will be easily transposed to the applicant's goods and services. Therefore, there is a high probability that the use of the mark applied for may lead to free-riding, that is to say, it would take unfair advantage of the reputation of the earlier mark and the considerable investments undertaken by the opponent to achieve that reputation.
- 8 On 19 May 2020, the applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 27 August 2020.
- 9 No response was filed.

Submissions and arguments of the applicant

- 10 The arguments raised in the statement of grounds may be summarised as follows:
- The facts of the case are not disputed.
 - The applicant wants nothing more than to help children suffering from ADHD (Attention Deficit or/and Hyperactivity Disorder) with an Internet App, for free, and thereby to improve their lives and the lives of their parents, family and caretakers. The applicant and his daughter also suffer from ADHD.
 - The App is to be used on personal mobile devices, available from the App store and not from the shelf of the opponent's products.
 - The idea behind the product is that ADHD patients have 'superbrains', that need to be stimulated to use their full potential in a positive and playful manner. The App is used in medical treatment courses and its medical benefits have been acknowledged.
 - Gamification (application of game design elements and game principles in a non-game context) has little to do with entertainment services and everything with medical relief.
 - The applicant believes also that the earlier mark is not similar and is not brought to mind by the contested mark, and that the Opposition Division has erred in its analysis of Article 8(5) EUTMR. The clear conceptual meaning of 'Brains' neutralises any visual similarities. The opponent does not pass the hurdle of similarity to establish a link, nor do the goods and services for

which the conflicting marks are used overlap, and the chance of the relevant public making a link between the marks is remote.

- Even the mere evidence of such a link is not adequate to establish a risk of free-riding. The opponent has not provided compelling evidence that there is a risk that the consumer of the goods protected by the earlier mark will change his behaviour as a result of the applicant's mark, or that it seems inevitable that the marketing of the App of the applicant would benefit unfairly (or at all) from the trade mark of the opponent. It has failed to set out sufficient facts to support a finding of free-riding. The general public with an average degree of attention will not be inclined to purchase the App, thinking that it will find similar qualities, owing to the transfer of positive association connected to the image of the earlier mark.
- There are no positive characteristics of the earlier mark which could be transferred to the goods of the EUTM applied for. There is also no high likelihood of such a transfer to be happening in the commercial sector concerned.
- It does not necessarily follow that the attraction, reputation or prestige attributed to the earlier mark is of any use to the applicant in marketing his goods, or will give it a marketing boost. It does not use the concept of the opponent's mark as a value provider or with any other qualities, so as to give it a leg up.
- As there is no clear exploitation and free-riding on the coat-tails of a famous earlier mark, the decision of the Opposition Division should be annulled.

Reasons

- 11 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Scope of the appeal

- 12 The applicant challenges the contested decision in its entirety. However, by its own statement, it only challenges the way Article 8(5) was applied by the Opposition Division, as it does not contest the factual assessment (assessment of proof of use and proof of reputation of the earlier mark) as regards the rest of the decision.

As regards the assessment of proof of use

- 13 It is common ground and not challenged by the parties that the evidence submitted by the opponent is sufficient to prove genuine use of the earlier trade mark during the relevant period in the relevant territory of the European Union for the following goods:

Class 9: Motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation.

Class 16: Comic books.


- 14 For reasons of procedural economy the evidence was not examined further as regards the remaining goods and services on which the opposition was based.
- 15 It is noted that where, as in the present case, the Opposition Division concludes that proof of genuine use of the earlier mark has been provided and, accordingly, upholds the opposition, the Board of Appeal can examine the question of that proof only if the applicant for the mark raises it specifically in its appeal before that Board (14/12/2011, T-504/09, Vökl, EU:T:2011:739, § 35-35; 13.09.2010, T-292/08, Often, EU:T:2010:399, §§33, 39 and 40). Since the examination of proof of use is not contested the Board must proceed by accepting the above conclusion.

Assessment based on Article 8(5) EUTMR

- 16 The applicant contends that the earlier mark is not similar and is not brought to mind by the contested mark, and that the Opposition Division has erred in its analysis of Article 8(5) EUTMR. In its opinion, the clear conceptual meaning of 'Brains' neutralises any visual similarities. The opponent does not pass the hurdle of similarity to establish a link, nor do the goods and services for which the conflicting marks are used overlap, and the chance of the relevant public making a link between the marks is remote.
- 17 According to Article 8(5) EUTMR, an opposition to an application for an EUTM may be founded, among others, on an earlier EU trade mark, which has a reputation in the European Union, even though the earlier mark is registered for goods or services which are not similar to the goods or services covered by the application for an EU trade mark, provided that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trade mark.
- 18 The application of Article 8(5) EUTMR is subject to the following cumulative conditions:
 - (i) the earlier mark claimed in the opposition must have a reputation;
 - (ii) the marks at issue must be identical or similar;
 - (iii) there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
 - (iv) there is no due cause justifying the use of the mark.

- 19 Since the above conditions are cumulative, failure to satisfy one of them is sufficient to render that provision inapplicable (25/05/2005, T-67/04, Spafinders, EU:T:2005:179, § 30).
- 20 The types of injury referred to in Article 8(5) EUTMR, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see 14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 23; of 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29 and 41, and 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 30).

As regards the assessment of proof of reputation

- 21 A trade mark has a reputation within the meaning of Article 8(5) EUTMR if it is known by a significant portion of the public concerned by the products or services covered by that trade mark (06/10/2009, C-301/07, Pago, EU:C:2009:611, § 24). In examining the reputation, all the relevant facts of the case must be taken into consideration, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it (22/03/2007, T-215/03, Vips, EU:T:2007:93, § 34-36; 13/12/2004, T-8/03, Emilio Pucci, EU:T:2004:358, § 67).
- 22 In the present case the Opposition Division found that the earlier EUTM,  is known in a substantial part of the European Union by a significant part of the public concerned, and has obtained a reputation in relation to ‘motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation’ in Class 9 and ‘comic books’ in Class 16.
- 23 The assessment of the evidence is also not contested by the applicant. Upon careful analysis/revision of the evidence (pieces of evidence summarised under paragraph 6, above), the Board hereby confirms the conclusion reached by the Opposition Division. The level of reputation of the earlier mark is of high level in the European Union, and apparent from its proven attractiveness to being used under licence on many different goods by third parties in different Member States of the European Union (exhibit 10). The long and consistent use of the earlier mark in relation to successful and popular comics and films made it a sign desired by companies to make their products more attractive to customers (e.g. agreement with PUMA). This is also apparent from the many references on the LicenseGlobal website, which apart from giving more information on the licence agreements of the earlier mark, refer several times to the earlier mark, the ‘S-shield’, as ‘iconic’
- 24 Having established the reputation of the opponent’s earlier EUTM in respect of ‘motion picture films featuring comedy, drama, action, adventure and/or

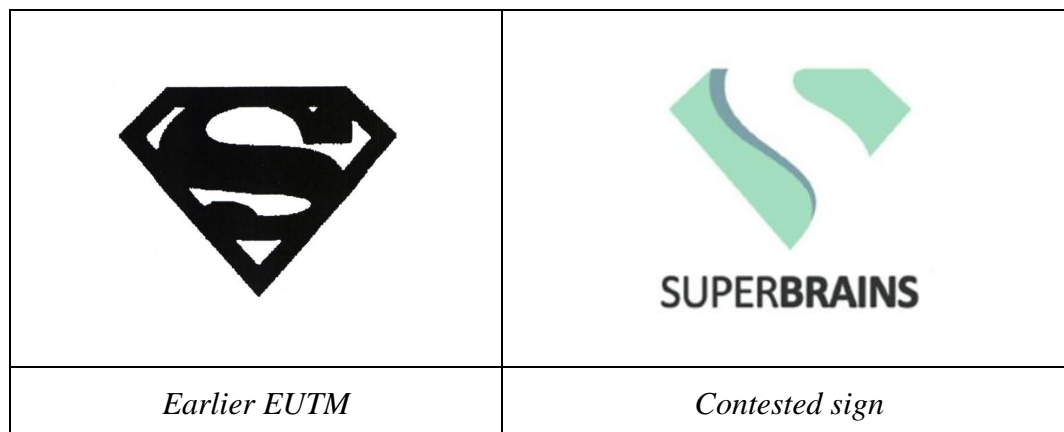
animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation' in Class 9 and 'comic books' in Class 16 the Board will now assess if use of the mark applied for in connection with the goods and services applied for in Classes 9 and 42 would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier marks. Just one of those types of injury suffices for Article 8(5) EUTMR to apply (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 28).

- 25 According to the grounds of appeal, the applicant only intends to protect an APP, a software application designed to help children suffering from ADHD (Attention Deficit or/and Hyperactivity Disorder). Said App, is also freely downloadable from the Internet, to improve the lives of ADHD patients, the lives of their parents, family and caretakers.
- 26 However, the specification of the list of goods and services applied for is much broader than that and has never been limited by the applicant. Therefore the Board can only take into account the list of goods and services as specified under paragraph 1, above. Furthermore, considering the wide list of goods and services applied for, the Board cannot base its decision on the particular circumstances according to which the goods and services covered by the mark applied for are presently marketed. These circumstances depend solely on the business strategy of the appellant which might change in time (12/01/2006, T-147/03, Quantum, EU:T:2006:10, § 107).

Existence of a link between the trade marks in dispute

- 27 According to case-law, the various infringements covered by Article 8(5) EUTMR are the consequence of a certain degree of similarity between the earlier mark and the mark applied for, by virtue of which the relevant section of the public makes a connection between them, even though it does not necessarily confuse them. The existence of a link between the mark applied for and the earlier mark, which must be appreciated globally, taking into account all factors relevant to the circumstances of the case, is therefore an essential condition for the application of that provision (see 12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146, § 28 and 53; 23/10/2003, C 408/01, Adidas, EU:C:2003:582, § 29, 30 and 38; 27/11/2008, C 252/07, Intel, EU:C:2008:655, §§ 33, 57, 58 and 66; also 24/03/2011, C 552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53). Those factors include the (1) degree of similarity between the conflicting marks; (2) the nature of the goods or services for which the conflicting marks were registered or applied for, including the degree of closeness or dissimilarity between those goods and services, and the relevant section(s) of the public; (3) the strength of the earlier mark's reputation; (4) the degree of the earlier mark's distinctive character, whether inherent or acquired through use and the (5) existence of a likelihood of confusion on the part of the public (27/11/2008, C 252/07, Intel, EU:C:2008:655, § 42) .

- 28 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 44).
- 29 The signs to be compared are:



- 30 In the present case, according to the contested decision, the signs are visually similar to a low degree, aurally similar at least to a low degree and conceptually similar to an average degree. In the applicant's view 'the clear conceptual meaning of 'Brains' neutralises any visual similarities'.
- 31 The Bord cannot concur with the applicant's argument.
- 32 In fact, the Board finds that the visual similarity of the signs is at least average. Both marks are dominated by a highly similar, eye catching element, a capital 'S', enclosed by the same, diamond shaped frame. The differences in the stylisation of the letter and the frame, the use of green colour in the sign applied for are secondary, and less likely to be remembered to the visual impression of the main shape, the 'S' in a diamond frame. The word 'SUPERBRAINS' in the contested mark is of secondary importance, considering its size, and contrary to the applicant's opinion, it does not distract the public's attention from the dominant figurative element. It must be mentioned that the protection of a trade mark which does not refer to any colour in particular is extended to all colour combinations as from the time when the mark is registered (16/01/2018, T-398/16, COFFEE ROCKS, EU:T:2018:4, § 53), including green, used in the contested mark.
- 33 Taking into account all the aforesaid, this Board finds that the signs display general appearances which are similar, - the unusual diamond shape (or shield) entirely filled with the 'S' sign, - given, that they have the same structure (16/01/2018, T-398/16, COFFEE ROCKS, EU:T:2018:4, § 51).
- 34 Aurally, as correctly stated by the Opposition Division, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the signs coincides in the sound of the single letter 'S', present

identically in both signs and having a normal degree of distinctiveness. The pronunciation differs in the additional verbal element ‘SUPERBRAINS’ in the contested sign. It cannot be excluded that part of the relevant public will not pronounce the single letter ‘S’ in the contested sign and will only pronounce the verbal element underneath, ‘SUPERBRAINS’. Therefore, the signs are aurally similar at least to a low degree for the part of the relevant public that will pronounce the single letter ‘S’ in the contested sign, while the signs are aurally not similar for the part of the relevant public that will only pronounce the verbal element ‘SUPERBRAINS’ in the contested sign.

- 35 Conceptually, the signs will be associated with a similar meaning on account of the dominant diamond shaped figurative elements containing a single letter ‘S’. The word ‘SUPERBRAINS’ of the contested sign will be split into the elements ‘SUPER’ and ‘BRAINS’. The element ‘SUPER’ will be perceived by the entire relevant European public as ‘[v]ery good or pleasant; excellent’ (see, Oxford Dictionaries, 06/05/2020 at <https://www.lexico.com/definition/super>). It is, therefore, laudatory and has a low degree of distinctiveness, if any. The word ‘BRAINS’ will be perceived by part of the relevant public as ‘[a]n organ of soft nervous tissue contained in the skull of vertebrates, functioning as the coordinating centre of sensation and intellectual and nervous activity’; ‘intellectual capacity’ (see Oxford Dictionaries, 06/05/2020 at <https://www.lexico.com/definition/brain>). However, for another part of the relevant public the word ‘brains’ will be meaningless. While it will have a normal degree of distinctiveness for the relevant public that perceives it as meaningless, its distinctiveness is low for the remaining part of the relevant public, as it might indicate that the goods and services target persons with a high intellectual capacity or persons who want to acquire such a capacity, or that the providers of the goods and services have a high intellectual capacity. The expression as a whole, ‘SUPERBRAINS’, will be easily understood by this part of the relevant public as ‘super intellectual capacity’, and, as a whole it has a low degree of distinctiveness for the reasons explained above. Therefore, due to the secondary visual importance and low distinctive character of the word ‘SUPERBRAINS’, the signs are conceptually similar to an average degree.
- 36 Furthermore, it cannot be ruled out that, on account of the general appearance of the marks at issue, sharing the unusual diamond/shield shape with an ‘S’ and the presence of the word ‘SUPER’ in the contested mark at issue, the relevant public will associate the earlier mark and the contested EUTM with the concept of a ‘SUPERMAN’ (16/01/2018, T-398/16, COFFEE ROCKS, EU:T:2018:4, § 64).
- 37 In the present case, the signs are visually and conceptually similar to an average degree and aurally similar at least to a low degree. Although the earlier mark contains only the letter ‘S’, it is clear from the evidence that it is associated with the ‘Superman’ comics and films. According to the Opposition Division, the fact that the contested sign, which uses the same diamond-shaped figurative element incorporating an ‘S’ shape, also has the verbal element ‘SUPERBRAINS’ will, despite the low degree of distinctiveness of its constituent elements for part of the relevant public, contribute to making a link with the earlier mark as the public

will see it together with the other elements as an allusion to ‘Superman’. The Board can only agree with the above analysis.


- 38 On the other hand, the fact that the conflicting marks are identical or similar is not sufficient for it to be concluded that there is a link between those marks. It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap and that the public targeted by each of the two marks may never be confronted with the other mark, so that they will not establish any link between those marks. It is also possible that, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered or applied for is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 45-49).
- 39 The relevant public, in the present case is the general public. The general public buys various software products (claimed by the contested mark in Class 9), e.g. to operate their computers, to support computer operation and safety, for storing/retrieving various data, for personal training and also entertainment purposes. The general public may also need to order software related services, such as installation, storage (hosting) and maintenance services, the ones offered by the applicant in Class 42. The general public also watch films in cinemas and through television broadcasting alike. They also buy DVD’s containing their favourite films. Thus, contrary to the applicant’s contention, there is an overlap between the public interested in the applicant’s goods and services and the public buying the opponent’s goods, especially those in Class 9.
- 40 Although films and software are not, under normal circumstances, being produced and released by the same companies, it is also not unusual nowadays that sophisticated software based video games (which might stem from comic books) serve as a basis for successful film products (for example Avatar) and vice versa (Harry Potter video games reached the market following the success of the films). Considering the above trends bringing the software and entertainment industries close, the ‘fans’ of the opponent’s mark would hardly be surprised by the appearance of software products and services under the opponent’s logo in the entertainment electronics market. Therefore, even if the goods and services at issue are not closely similar, they cannot be considered distant either.
- 41 It follows from the above that the similarity of the signs and the proximity of the goods and services, notwithstanding the lack of a likelihood of confusion, enables that a link would exist in the mind of the relevant public between the trade marks at stake. In those circumstances, the fact that the applicant’s goods and services in Classes 9 and 42 are not similar in the sense of Article 8(1)(b) EUTMR to the opponent’s goods and services is not sufficient to avoid such a link from arising.
- 42 However, the existence of a link between the conflicting marks in the mind of the public constitutes a condition which is necessary but not, in itself, sufficient to establish the existence of one of the types of injury against which Article 8(5)


EUTMR ensures protection for the benefit of a trade mark with a reputation (see, to that effect, 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 31-32). Therefore, it does not dispense the proprietor of the earlier mark from having to prove the serious likelihood that such an injury will occur in the future.

Taking unfair advantage of the distinctive character or the repute of the earlier mark

- 43 As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the earlier mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (18/06/2009, C-487/07, L’Oréal, EU:C:2009:378, § 41).
- 44 In other words, this concerns the risk that the image of the mark with a reputation, or the characteristics which it projects, are transferred to the goods and services covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark already having a reputation (see 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40).
- 45 The advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor (18/06/2009, C-487/07, L’Oréal, EU:C:2009:378, § 43).
- 46 It follows from the wording of Article 8(5) EUTMR that the proprietor of the earlier mark is not required to demonstrate actual and present unfair advantage of the earlier mark. It must nevertheless adduce *prima facie* evidence of a future risk, which is not hypothetical, of unfair advantage (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 40).
- 47 Defining the relevant consumer, the Court of Justice found that unfair advantage, taken by the later mark, has to be assessed by reference to average consumers of the goods or services for which the later mark is applied for (see 27/11/2008, C-252/07, Intel, EU:C:2008:655, §35-36).
- 48 Therefore, for the purpose of the present evaluation, unfair advantage taken by the contested mark must be assessed by reference to the average European Union consumer of the goods in respect of which the applicant seeks protection, i.e. various software products in Class 9 and the related IT services in Class 42. These are goods and services meant, among others, also for the general public, who is deemed to be reasonably well informed and reasonably observant and circumspect. These goods and services exist in all price ranges and, therefore, the attention level upon purchasing them will, in general, be average.



- 49 Upon encountering the sign  , used on software products and related IT services, the relevant consumer, especially one following the trends of the entertainment industry, who also coincides with the purchaser of the opponent's films (in cinemas, as a television programme or a DVD), would inevitably make a

mental connection with the opponent's sign  , and the goods it offers on account of the reputation of the opponent's mark. This would give the applicant a competitive advantage in at least those major European countries mentioned above, since its goods would benefit from the extra attractiveness they would gain from the association with the opponent's older mark. This indeed constitutes a case of taking advantage of the reputation of the opponent's sign, as it was found by the Opposition Division.

- 50 In this respect, it was not necessary for the opponent to prove the actual occurrence of the event described above, of software products and IT services bearing the sign applied for being mistaken for an item originating from the opponent. It is sufficient to show that there is a risk of 'free riding', i.e. that the applicant's mark might benefit and therefore gain an unfair advantage from the repute or distinctiveness of the older mark. The ability of a trade mark with repute to transfer a certain image from one product or service to another product or service leads third parties to wish to take advantage of the financial value of this reputation, in as much as the use of this trade mark with repute in connection with different products or services will facilitate their commercial success (see decision of 25 April 2001, R 283/1999-3 'HOLLYWOOD / HOLLYWOOD' at par. 121).
- 51 In light of the above considerations, the Board concludes that the contested mark is likely to take unfair advantage of the distinctive character or the repute of the earlier mark and that, on this basis, the opposition is well founded under Article 8(5) EUTMR. Having regard to the wording of Article 8(5) EUTMR, the existence of one of the above types of risk is indeed sufficient for that provision to apply.

Due cause

- 52 Article 8(5) EUTMR makes an opposition by an earlier trade mark with repute subject to the lack of due cause for using the trade mark applied for. Such a reference to 'due cause' means that the applicant would be allowed to use the mark applied for, notwithstanding the unfair advantage which might be taken of the opponent's mark, in circumstances where it could not reasonably be required to abstain from such use.
- 53 In the present case, the applicant did not submit any comments, thus no arguments about the existence of due cause for the use of the mark applied for either.

Conclusion

- 54 Consequently, since all the conditions listed under paragraph 20 are fulfilled, the appeal cannot succeed and shall be dismissed accordingly.

Costs

- 55 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, shall bear the costs incurred by the opponent in the appeal and opposition proceedings.
- 56 As to the appeal proceedings, these consist of the opponent's costs of professional representation of EUR 550.
- 57 As to the opposition proceedings, the Opposition Division ordered the applicant to bear the costs in the amount of EUR 620. This decision does not change. The total amount for both proceedings is EUR 1 170.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to bear the costs incurred by the opponent in the appeal and opposition proceedings to a total sum of EUR 1 170.**

Signed

S. Stürmann

Signed

A. Szanyi Felkl

Signed

S. Martin

Registrar:

Signed

H.Dijkema

