



## Reports of Cases

JUDGMENT OF THE GENERAL COURT (Third Chamber)

16 January 2018\*

(EU trade mark — Opposition proceedings — Application for EU word mark METAPORN — Earlier EU and national word marks META4 and figurative marks meta4 — Relative ground for refusal — Article 8(1)(b) of Regulation (EC) No 207/2009 (now Article 8(1)(b) of Regulation (EU) 2017/1001) — Similarity of the services — Meaning of complementary services — Similarity of the signs — Likelihood of confusion)

In Case T-273/16,

**Sun Media Ltd**, established in Hong Kong (China), represented by A. Schnider, lawyer,

applicant,

v

**European Union Intellectual Property Office (EUIPO)**, represented by S. Bonne, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

**Meta4 Spain, SA**, established in Las Rozas (Spain), represented by I. Temiño Cenicerros, lawyer,

ACTION brought against the decision of the Second Board of Appeal of EUIPO of 3 March 2016 (Joined Cases R 653/2015-2 and R 674/2015-2) relating to opposition proceedings between Meta4 Spain and Sun Media,

THE GENERAL COURT (Third Chamber),

composed of S. Frimodt Nielsen, President, I.S. Forrester (Rapporteur) and E. Perillo, Judges,

Registrar: I. Dragan, Administrator,

having regard to the application lodged at the Court Registry on 30 May 2016,

having regard to the response of EUIPO lodged at the Court Registry on 11 August 2016,

having regard to the response of the intervener lodged at the Court Registry on 11 August 2016,

further to the hearing on 4 July 2017,

\* Language of the case: English.

gives the following

### Judgment<sup>1</sup>

...

#### *Law*

...

*The first plea in law, alleging infringement of Article 8(1)(b) of Regulation No 207/2009*

...

#### *Comparison of the services*

- 32 According to settled case-law, in assessing the similarity of the goods or services at issue, all the relevant factors relating to those goods or services should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account such as the distribution channels of the goods concerned (see judgment of 11 July 2007, *El Corte Inglés v OHIM — Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)*, T-443/05, EU:T:2007:219, paragraph 37 and the case-law cited).
- 33 Complementary services are services which are closely connected in the sense that one is indispensable or important for the use of the other so that consumers may think that the same undertaking is responsible for the provision of those services (see judgment of 2 October 2013, *Cartoon Network v OHIM — Boomerang TV (BOOMERANG)*, T-285/12, not published, EU:T:2013:520, paragraph 26 and the case-law cited).
- 34 In the present case, the Board of Appeal found that the services concerned were partly identical and partly similar. In particular, it found that the services in Class 41 of the mark applied for had at least a low degree of similarity, both with the broadcasting services and the telecommunications services in Class 38 of the earlier EU marks, as a result of their complementary character.
- 35 The applicant does not dispute the Board of Appeal's findings relating to the identical or similar nature of the services in Classes 35, 38 and 42 of the mark applied for. It merely states that the Board of Appeal made an error of assessment by concluding that the adult entertainment services in Class 41 of the mark applied for had at least a low degree of similarity with the telecommunications services in Class 38 of the earlier marks.
- 36 In that regard, first, it is true that the adult entertainment services in Class 41 of the mark applied for have a different nature and different purpose from those of the services in Class 38 of the earlier EU marks. However, as the Board of Appeal rightly points out in paragraph 78 of the contested decision, that finding is not, in itself, such as to call into question any complementarity between those services (see, to that effect, judgment of 2 October 2013, *BOOMERANG*, T-285/12, not published, EU:T:2013:520, paragraphs 29 to 35).

<sup>1</sup> Only the paragraphs of the present judgment which the Court considers it appropriate to publish are reproduced here.

- 37 Secondly, with regard to the complementarity between the adult entertainment services in Class 41 of the mark applied for and the broadcasting services in Class 38 of the earlier EU marks, it should be noted that the Board of Appeal found that those adult entertainment services included the production of films (contested decision, paragraph 79). It also found that the telecommunications services in Class 38 of the earlier EU marks included broadcasting services, including radio and television broadcasting services, and it stated that the earlier EU figurative mark registered under number 1 669 720 expressly covered radio broadcasting services (contested decision, paragraph 76). Although the applicant disputes the conclusion reached by the Board of Appeal in relation to the complementary character of the services at issue and their similarity, it must be observed that it does not dispute the Board's assessments in paragraphs 76 and 79 of the contested decision in relation to the scope of the services covered by the signs at issue.
- 38 It has already been held that the production of films in Class 41 had a certain degree of similarity with broadcasting services in Class 38, given their complementary character (see, to that effect, judgment of 2 October 2013, *BOOMERANG*, T-285/12, not published, EU:T:2013:520, paragraph 35). This is all the more so where, as in the present case, the services in Class 41 of the mark applied for and the broadcasting services in Class 38 of the earlier EU marks have the common feature of being offered in electronic format, in some cases on the internet, to the extent that that common mode of broadcasting is liable to accentuate the similarity between those services (see, to that effect, judgment of 4 June 2014, *Free v OHIM — Conradi + Kaiser (FreeLounge)*, T-161/12, not published, EU:T:2014:350, paragraph 29).
- 39 In addition, it must be observed, as the Board of Appeal did, that radio and television programmes are currently being broadcast more and more via internet or broad band connections (contested decision, paragraph 80).
- 40 Thirdly, with regard to the complementarity between the adult entertainment services and the telecommunications services of the earlier EU marks, it must be pointed out, as the Board of Appeal rightly did in paragraph 81 of the contested decision, that the application to register the mark applied for stipulates that the adult entertainment services in Class 41 of the mark applied for are 'especially' provided in electronic and online form. Services in Class 41 which, as in the present case, are provided online have already been found to be similar to the services of 'telecommunications; communications by computer terminals, computer-aided transmission of messages and images' covered by the earlier EU marks (see, to that effect, judgment of 12 July 2012, *Wall v OHIM — Bluepod Media Worldwide (bluepod MEDIA)*, T-227/11, not published, EU:T:2012:375, paragraphs 44 and 51).
- 41 It is true that, in the same judgment, the General Court also approved the Board of Appeal's finding in the case in question that, even if some telecommunications operators provided some entertainment services in Class 41 using specialised subsidiaries, the consumer would not usually expect there to be a link between the supply of those entertainment services and services connected with the transmission of data by computer and data networks (judgment of 12 July 2012, *bluepod MEDIA*, T-227/11, not published, EU:T:2012:375, paragraph 48).
- 42 It is nevertheless appropriate to take into account, as the Board of Appeal did, the economic reality on the market as it currently exists in order to ascertain whether the finding of fact in the case which gave rise to the judgment of 12 July 2012, *bluepod MEDIA* (T-227/11, not published, EU:T:2012:375), still holds true today. It must be observed that that reality is very different from the one which prevailed even a few years ago, in particular as a result of the rapid technological developments that radically changed the manner in which audiovisual entertainment content is consumed. Moreover, whereas, in the past, traditional telecommunications service providers were only occasionally active in developing entertainment content, today they do so regularly, while entertainment companies offer services which, in the past, were the reserve of the telecommunications industries. Indeed, some companies offer packages which provide consumers with both a telecommunications connection and access to

entertainment content via that connection. Telecommunications consumers can therefore be led to believe that the entertainment content provided through their internet connection is provided by the same company (contested decision, paragraphs 83 to 86).

...

On those grounds,

THE GENERAL COURT (Third Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Sun Media Ltd to pay the costs.**

Frimodt Nielsen

Forrester

Perillo

Delivered in open court in Luxembourg on 16 January 2018.

E. Coulon  
Registrar

S. Frimodt Nielsen  
President