



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Third Chamber)

22 September 2021 *

(EU trade mark – Opposition proceedings – Applications for the EU word mark COLLIBRA and figurative mark collibra – Earlier national word mark Kolibri – Relative ground for refusal – Likelihood of confusion – Article 8(1)(b) of Regulation (EU) 2017/1001 – Right to be heard – Second sentence of Article 94(1) of Regulation 2017/1001)

In Cases T-128/20 and T-129/20,

Collibra, established in Brussels (Belgium), represented by A. Renck, I. Junkar and A. Bothe, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by H. O'Neill and V. Ruzek, acting as Agents,

defendant,

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

Hans Dietrich, residing in Starnberg (Germany), represented by T. Träger, lawyer,

ACTIONS brought against two decisions of the First Board of Appeal of EUIPO of 13 December 2019 (Cases R 737/2019-1 and R 738/2019-1), relating to opposition proceedings between Mr Dietrich and Collibra,

THE GENERAL COURT (Third Chamber),

composed of A.M. Collins, President, Z. Csehi (Rapporteur) and G. De Baere, Judges,

Registrar: A. Juhász-Tóth, Administrator,

having regard to the applications lodged at the Court Registry on 27 February 2020,

having regard to EUIPO's responses lodged at the Court Registry on 6 May 2020,

* Language of the case: English.

having regard to the intervener's responses lodged at the Court Registry on 7 May 2020,

having regard to the decision of 2 July 2020 joining Cases T-128/20 to T-129/20 for the purposes of the written part and any oral part of the procedure,

further to the hearing on 11 March 2021,

gives the following

Judgment¹

I. Background to the dispute

- 1 On 1 June 2017, Collibra, the applicant, filed two applications for registration of EU trade marks with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).
- 2 The trade marks in respect of which registration was sought are:
 - in Case T-128/20, the word sign COLLIBRA;
 - in Case T-129/20, the figurative sign represented below:



- 3 The goods and services in respect of which registration was sought are, in Case T-128/20, in Classes 9 and 42, and in Case T-129/20, in Class 9 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:
 - Class 9: 'Data governance software for the purpose of organisation and management of internal data';
 - Class 42: 'Design and development of computer software; computer software consultancy; installation and maintenance of computer software; scientific and technological services and research and design relating to the design and development of computer software; industrial analysis and research services in the field of computer software; all of the above in relation to the data governance and catalogue software for the purpose of organisation and management of internal data'.

...

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

- 5 On 31 August 2017, Mr Hans Dietrich, the intervener, filed two notices of opposition pursuant to Article 41 of Regulation No 207/2009 (now Article 46 of Regulation 2017/1001) to registration of the mark applied for in respect of all the goods and services referred to in paragraph 3 above.
- 6 The two oppositions were based, inter alia, on the earlier German word mark Kolibri, filed on 1 July 1999 and registered on 17 October 1999 under No 39938675, covering goods and services in Classes 9, 16, 36, 38, 41 and 42 of the Nice Agreement and corresponding, for each of those classes, to the following goods and services:
- Class 9: ‘Programs saved on data carriers (software) for data processing and word processing; programs for data and word processing regarding real estate information systems, Geographic Information Systems (GIS), real property management, building management, facility management and ancillary services, house and/or real estate administration, provision of car parks and underground car parks including the disposition of parking lots; data and word processing programs for public or municipal administration, data and word processing programs for public or municipal administration regarding real estate information systems, building and development charges, real property management, building application procedure, urban land-use planning, building permit procedure, stock data regarding channel and water pipelines, treasury budget accounting, residence registration, civil registry office, cemetery administration, organisation, preparation and conducting of elections, providing of car parks and underground car parks including the disposition of parking lots’;
 - Class 42: ‘Rental of data and word processing programs; installation and provision of hotlines and help desks for data and word processing in the public and municipal administration; installation and provision of municipal information systems’.
- ...
- 17 The Board of Appeal upheld the Opposition Division’s finding that, for the relevant public, consisting of professionals in business and public organisations, there was a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation 2017/1001, as regards the marks at issue, in spite of the high level of attention of that public.

II. Procedure and forms of order sought

- 18 The applicant claims that the Court should:
- annul the contested decisions;
 - order EUIPO and the intervener to pay the costs.
- 19 EUIPO and the intervener contend that the Court should:
- dismiss the actions;
 - order the applicant to pay the costs.

III. Law

...

- 23 In support of its action, the applicant essentially raises two pleas in law, the first alleging infringement of Article 8(1)(b) of Regulation 2017/1001, and the second infringement of the rights of defence laid down in Article 94(1) of Regulation 2017/1001.

...

B. The first plea in law, alleging infringement of Article 8(1)(b) of Regulation 2017/1001

...

1. The comparison of the signs

...

(c) The conceptual comparison

- 60 The applicant claims that the Board of Appeal erred in finding that there was a high degree of conceptual similarity between the marks at issue and maintains, on the contrary, that they are different.
- ...
- 67 In the present case, first, the Board of Appeal found that the earlier mark could, in German, refer to a hummingbird, which is not disputed.
- 68 Second, the Board of Appeal noted that, given the proximity in pronunciation of the word ‘collibra’ to the word ‘kolibri’, it cannot be ruled out that a significant part of the German public will perceive an allusion to the concept of a hummingbird in the mark applied for. It therefore concluded that the marks at issue could be regarded as conceptually highly similar for a non-negligible part of the relevant public in Germany.
- 69 That reasoning appears correct in the light of the case-law to the effect that even if the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details, the fact remains that, when perceiving a word sign, he or she will recognise word elements which, for him or her, suggest a concrete meaning or which resemble words known to him or her (see, to that effect, judgments of 6 October 2004, *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)*, T-356/02, EU:T:2004:292, paragraph 51; of 13 February 2007, *RESPICUR*, T-256/04, EU:T:2007:46, paragraph 57; and of 19 September 2012, *TeamBank v OHIM – Fercredit Servizi Finanziari (f@ir Credit)*, T-220/11, not published, EU:T:2012:444, paragraph 38). The fact that the concept of a hummingbird bears no relation to the goods and services covered by the marks applied for is irrelevant in view of the fact that those marks resemble the German word ‘kolibri’, which is known by a non-negligible part of the German public.

70 None of the applicant's arguments is capable of invalidating that reasoning.

71 As regards the case-law relied on, according to which there can be no conceptual similarity between a mark which conveys no discernible meaning in any of the languages of the European Union and another mark which carries actual meaning for the relevant public (see judgments of 16 January 2008, *Inter-Ikea v OHIM – Waibel (idea)*, T-112/06, not published, EU:T:2008:10, paragraph 70 and the case-law cited, and of 21 January 2016, *Laboratorios Ern v OHIM – michelle menard (Lenah.C)*, T-802/14, not published, EU:T:2016:25, paragraph 45 and the case-law cited), it suffices to note that it is not applicable in the present case since the Board of Appeal was entitled to find that the marks applied for evoked the concept of a hummingbird, as did the earlier mark.

...

74 Therefore, the Board of Appeal did not err in law in finding that there was a high degree of conceptual similarity between the signs at issue.

2. The comparison of the goods and services

(a) The goods in Class 9

75 As regards the comparison of the software products at issue, the applicant criticises the Board of Appeal's finding that the software products for which the earlier mark was used are similar to an average degree to the software products covered by the marks applied for.

76 In the present case, it must be borne in mind that the software products under comparison are:

- 'data governance software for the purpose of organisation and management of internal data' covered by the marks applied for, and
- 'programs for data and word processing regarding real estate information systems, Geographic Information Systems (GIS), real property management, building management, facility management and ancillary services, house and/or real estate administration; data and word processing programs for public or municipal administration, data and word processing programs for public or municipal administration regarding real estate information systems, building and development charges, real property management, building application procedure, urban land-use planning, building permit procedure, stock data regarding channel and water pipelines, treasury budget accounting' for which the earlier mark was used.

...

(1) The nature of the software products

80 The applicant criticises the Board of Appeal for automatically reaching the conclusion that the goods are similar while relying solely on the fact that all the goods related to software, in breach of EUIPO's Trade Marks and Designs Guidelines.

81 However, it is apparent from the Board of Appeal’s reasoning that it did not confine itself to the nature of the goods since it stated, in paragraph 41 of the contested decisions, that the relevant public for the goods at issue and the nature and intended purpose of the software products at issue could coincide, as could the undertakings involved in the design and development of the software products at issue. Therefore, that argument must be rejected.

(2) The intended use of the software products

82 The applicant submits that the intended purpose of the software products at issue is very different, as the Opposition Division itself stated. The intended purpose of the software covered by the marks applied for is to ensure internal data governance, the main objective of which is to allow persons within an organisation to search for, locate and verify the reliability of internal data while ensuring regulatory compliance. Although the software products covered by the earlier mark, according to the proof of use, may allow data to be consulted, which, according to the applicant, is a common feature of most software products, their intended purpose is to automate and assist real estate transactions, in particular the drafting of real estate documents, the management of building permits and facilities management.

...

88 Primarily, it is necessary to examine the merits of the arguments relating to the comparison of the intended purpose of the software.

89 In the first place, it is necessary to reject the applicant’s assertion that the software products covered by the earlier mark are used only to draft documents and to automate tasks, since it is apparent from the analysis of the proof of use, which, moreover, is not disputed, that the purpose of those software products is not only ‘text processing’ but also ‘data processing’, which may cover a wider range of activities than the mere drafting of documents or the automation of tasks.

90 In the second place, in paragraph 40 of the contested decisions, the Board of Appeal stated that ‘the need for data-related policies, maintaining data integrity and its trustworthiness, and ensuring regulatory standards are met’ was equally of relevance to the field of real estate transactions (acquisition, sale, hereditary building rights, concession contracts), as to the field of administration of buildings, such as leasing and rental of properties, building and facilities management. It considered that entities in the public sector, like any private organisation, would need to enforce ‘data related policies, maintain data integrity, and ensure that regulatory standards were met’ in relation to applications for building permits and in the administration and management of facilities.

91 In paragraph 40 of the contested decisions, the Board of Appeal did not compare the intended purposes of the software products at issue, nor did it explain how the software products covered by the earlier mark had the same objectives as data governance software, contrary to EUIPO’s assertion. By contrast, the Board of Appeal, in that paragraph implicitly defined data governance as ‘[the implementation] of data-related policies, [maintaining] data integrity and reliability [and] compliance with regulatory standards’, a definition which the parties do not dispute.

92 In the third place, it should be noted that the only comparison of the intended purposes of the software products at issue by the Board of Appeal is made in paragraph 39 of the contested decisions, which reads as follows:

‘The organisation and management of internal data which is described in the specification of the mark[s] applied for is also a feature of the [intervener’s] software. For instance the [intervener’s] building application software (OP 17) enables an organisation to create a customised map of its key data elements: file flows, specialist departments, individual tasks and allocation of tasks.’

93 It was therefore only in paragraph 39 of the contested decisions that the Board of Appeal found, in essence, that the ‘data processing’ and ‘text processing’ carried out by the software products covered by the earlier mark involved the same characteristics of ‘organisation and management of internal data’ as the ‘data governance software for the purpose of organisation and management of internal data’ covered by the marks applied for. It was in that regard, and only in paragraph 39 of the contested decisions, that the Board of Appeal found that the software products overlap, based on the existence of common characteristics of the software products at issue, namely that they all enabled internal data to be organised and managed. In that regard, it should be noted that the intervener is wrong to claim that the applicant admitted that there were overlaps between the software products under comparison during the administrative procedure. The comments to which the intervener refers, which allegedly acknowledge such overlaps, are in fact derived from that party’s own written pleadings, and not those of the applicant.

94 It must be confirmed that the ‘data processing’ concerning real estate covered by the earlier mark requires the features of organisation and management of internal data, which are also present in the software products covered by the marks applied for. In that regard, EUIPO and the intervener rightly maintain that the ‘facilities management’ or ‘house and/or real estate administration’ software products covered by the earlier mark generate a large volume of data and incorporate certain functionalities for the organisation and management of those data, functionalities which they share with the ‘data governance’ software products.

95 The existence of an overlap between the intended purposes of those software products is the reason why the Board of Appeal found only an average, rather than a high, degree of similarity in terms of intended purpose.

96 Furthermore, the applicant’s argument that the Opposition Division had stated that the intended purpose of the software products was very different must be rejected. The Opposition Division stated that, although their specific purpose of use was not the same, they were all used, in general, for data processing and, in addition, their method of use (via a computer) was the same. It is therefore also apparent from those decisions that the intended purposes of the software products overlap, in that they all enable data processing to be carried out.

...

(b) The services in Class 42

116 The applicant claims that the Board of Appeal merely states, without any reasoning, that the services covered by the word mark applied for could be offered by the same undertakings that design the types of software products for which the earlier mark is used. Furthermore, according

to the applicant, that fact, which is moreover disputed, is insufficient to conclude that those services and goods are similar. In reality, those services are different from the software products covered by the earlier mark or, at most, similar to a very low degree.

117 EUIPO and the intervener dispute those arguments.

...

121 In the second place, the Board of Appeal did not err in stating that the real-estate and facilities-management software products covered by the earlier mark and the data governance software products covered by the word mark applied for could be designed and developed by the same undertakings. It should be noted that, in the field of information technology, software manufacturers will also commonly provide software services. Furthermore, as EUIPO observes, in the present case the end users and the manufacturers of the goods and services at issue coincide. The applicant's arguments in that regard having already been rejected, the Board of Appeal was entitled to conclude that the services covered by the word mark applied for, which all concerned data governance and catalogue software products for the purpose of organisation and management of internal data, were similar to the software products covered by the earlier mark. Furthermore, that reasoning is sufficient to establish a similarity, contrary to what the applicant claims.

3. The likelihood of confusion

...

134 It follows from the foregoing that the first plea in law must be rejected in its entirety.

...

On those grounds,

THE GENERAL COURT (Third Chamber)

hereby:

- 1. Joins Cases T-128/20 and T-129/20 for the purposes of the judgment;**
- 2. Dismisses the actions;**
- 3. Orders Collibra to pay the costs.**

Collins

Csehi

De Baere

Delivered in open court in Luxembourg on 22 September 2021.

[Signatures]