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General Court: computer repair services and data obliteration services are similar

European Union - MAQS Law Firm

**Examination/opposition
International procedures**

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In *Gigabyte Technology Co Ltd v Office for Harmonisation in the Internal Market* (OHIM), the General Court has upheld a decision of the Second Board of Appeal of OHIM finding that computer repair and design services in Classes 37 and 42 were similar to data obliteration services in Class 42 of the [Nice Classification](#).

Applicant Gigabyte Technology Co Ltd filed an application for the registration of the word mark GIGABYTE for a broad list of goods and services in Classes 9, 35, 37 and 42. In particular, the list of services included the following:

- “Installation of computer and network systems; repair services for computers and computer peripherals, computer networks and associated peripheral devices; computer installation and maintenance services; repair and maintenance of motherboards, VGA cards, servers, personal computers and internet hardware equipment” in Class 37; and
- “OEM (Original Equipment Manufacturer) for motherboard software design; system tests and OEM for motherboards, VGA cards, servers, personal computers and internet hardware equipment; computer services, namely, designing, creating, implementing computer equipment and (global) networks for others; operational and technical support services relating to computers and computer peripherals, computer systems and computer network analysis, consulting and management services, computer information technology management and consulting” in Class 42.

The opponent lodged an opposition based on the earlier Community word mark GIGABITER in respect of, among others, services in Class 42 corresponding to the following description: “Obliterating electronically stored data to render such data unreadable and irretrievable from electronic equipment and components on which such data has been stored”.

The Opposition Division found that there was no likelihood of confusion with regard to the applicant’s goods and services in Classes 9 and 35, but that there was a likelihood of confusion with regard to the applicant’s services in Classes 37 and 42.

The applicant appealed, but the Second Board of Appeal of OHIM affirmed the ruling of the Opposition Division. As regards the services in Class 37, the applicant argued that its computer repair services could require access to confidential data stored on a computer, while the opponent’s services consisted exclusively of the obliteration of data. As regards Class 42, the applicant claimed that its services involved the manufacturing of computers, while the opponent’s services involved the destruction of computers. The board disagreed, holding that the repair of computers may include the destruction of undesirable data (viruses), and that manufacturing services in Class 42 may be provided by IT experts who also specialise in obliterating electronic data. It noted that such services could be performed by the same undertakings. The board also confirmed that the marks were confusingly similar, finding that the contested services were addressed not only to IT professionals, but also to the public at large.

The applicant appealed to the General Court, claiming, in essence, that the Board of Appeal had wrongly compared the services in Classes 37 and 42 covered by the mark applied for with the services in Class 42 covered by the earlier mark.

With regard to the relevant public, the General Court first noted that the Board of Appeal’s finding that the applicant’s services in Classes 37 and 42 were addressed to the general public, as well as IT specialists, was not contested by the parties.

The court then made a detailed analysis of the board’s findings with regard to the similarity of the services.

With regard to the services in Class 37, the court found that both the applicant’s and the opponent’s services were, “by their nature, IT specialist services, and have a similar purpose in that they are designed, ultimately, to enable and to facilitate the use of computers and to deal with various aspects of that use”. The court noted that even the applicant itself acknowledged in its application that there are situations in which the repairing of computers involved the destruction of data (ie, the destruction of viruses). The applicant challenged the board’s finding that the distribution channels of the parties’ services were the same, as well as the finding that the services covered by the marks may be provided by the same undertakings. The court held that:

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“the Board of Appeal was entitled, without erring, to base its decision on the finding that it is common practice for providers of installation, maintenance and repair services in respect of computer equipment also to destroy data electronically stored on computers in order to repair them.”

With regard to the services in Class 42, the court noted that both parties' services “belong to the same area, namely computing, are addressed to the same public, are made available using the same channels and are provided by the same type of undertaking”. The applicant argued that its services in Class 42 involved the creation of computers, while the opponent's services involved the destruction of computers. The court was not convinced, holding that “the possibility that an undertaking specialising in the creation of new computer products may also have expertise in the area of obliterating and destroying data cannot be excluded”.

The court thus agreed that the marks were similar and affirmed the decision of the Board of Appeal.

This case shows that the Community trademark system is still opponent-friendly and that the EU institutions are not very tech-savvy when it comes to the similarity of IT services. All three instances were content to find that the party's services were computer-related and therefore similar. Interestingly, while the Board of Appeal dispensed with the similarity of the services in a single 12-line paragraph, the General Court dealt with the issue across 36 paragraphs on five pages. It is also interesting to note that the opponent did not intervene and that the court chastised the applicant for the lack of evidence (eg, that the channels of trade were different).

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