

General Court rebukes Board of Appeal regarding proof of use; expands "link of complementarity" **Examination/opposition International procedures**
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- **Court annulled board's decision in opposition proceedings involving ZOOM marks in Classes 9 and 15**
- **Board had incorrectly refused proof of use of earlier marks for certain goods**
- **Decision expands "link of complementarity" when determining similarity of goods**

In *Kabushiki Kaisha Zoom v European Union Intellectual Property Office* (EUIPO) (Case T-831/16, April 24 2018), the General Court has annulled a decision of the Fifth Board of Appeal of the EUIPO in which the latter had dismissed an appeal brought against a decision of the Opposition Division.

Background

The case arose when Leedsworld Inc filed an application for registration as an EU trademark (EUTM) of the word mark ZOOM for the following goods in Class 9: "Cord and cable management devices, namely, holders, wraps, brackets and clips for containing and organising audio, computer, connection, electrical, electronic, power, printer, stereo and video cables; carrying cases for electronic equipment, namely, computers, cell phones, cameras, PDAs, electronic tablets, media players and handheld devices; stands for electronic equipment, namely, computers, cell phones, cameras, PDAs, electronic tablets, media players and handheld devices; and battery chargers and power banks; none of the aforementioned products relating to music technology products."

Kabushiki Kaisha Zoom lodged an opposition based on two EUTM registrations for the mark ZOOM, both of which were more than five years old and thus subject to the use requirement. These registrations covered a large number of items primarily related to handy recorders and electronic guitar accessories.

Opposition Division decision

The Opposition Division of the EUIPO upheld the opposition for "carrying cases for electronic equipment, namely, media players and hand-held devices; stands for electronic equipment, namely, media players and hand-held devices; none of the aforementioned products relating to music technology products", but allowed the application for "cord and cable management devices, namely, holders, wraps, brackets and clips for containing and organising audio, computer, connection, electrical, electronic, power, printer, stereo and video cables; and battery chargers and power banks; none of the aforementioned products relating to music technology products".

Board of Appeal decision

Kabushiki Kaisha Zoom appealed this decision, but the Fifth Board of Appeal of the EUIPO dismissed the appeal. The Board of Appeal took the view that genuine use of the earlier marks had only been proven in relation to certain goods, namely:

- "handy recorders" - that is, hand-held audio/sound recording devices;
- "recording devices for live performance recording, interfacing, controlling and sampling"; and
- "guitar effects devices (stomps, pedals) including acoustic, bass and electric guitars".

By contrast, the Board of Appeal considered that proof of genuine use had not been established in relation to:

- "photographic machines and apparatus; cinematographic machines and apparatus";
- "portable communicating apparatus";
- "power distribution and control machines apparatus (AC adapter) and electric wire and cable"; and
- "batteries and cells".

The opponent appealed to the General Court, arguing that the Board of Appeal had erred in the following four ways:

1. The Board of Appeal had made an error of assessment with regard to the proof of genuine use of the

earlier marks in respect of several categories of goods;

2. On the basis of that error of assessment, the board had wrongly restricted the scope of protection conferred by those marks;
3. The board had incorrectly assessed the similarity of the goods in question; and
4. The overall likelihood of confusion had also been incorrectly assessed.

General Court decision

The court reviewed the proof of use and agreed that the board had incorrectly refused the proof of use of the earlier marks in respect of the opponent's marketing of AC adapters and USB, AV and HDMI cables. The Board of Appeal ought to have taken that evidence into account for the purpose of assessing the genuine use of the earlier marks for the category "power distribution apparatus", of which AC adapters constitute a subcategory, and for the category "electric cables", to which the USB, AV and HDMI cables can be assimilated.

Having expanded the opponent's rights, the court went on to hold that the opponent's "electric wires and cables" were complementary to the trademark applicant's "cord and cable management devices, namely, holders, wraps, brackets and clips for containing and organising audio, computer, connection, electrical, electronic, power, printer, stereo and video cables". Further, the court held that the opponent's AC adapters, as a subcategory of "power distribution apparatus", were similar to "battery chargers and power packs".

The court reasoned that the intended use of such goods, particularly AC adapters in respect of products marketed by the opponent, consists in supplying electricity to electronic devices either directly or through batteries. Indeed, AC adapters can also be used to supply power to rechargeable batteries, which is akin to charging a battery. The nature, intended purpose and method of use of the goods in question, if they are not completely identical, are nevertheless very close.

These findings led the court to uphold the opponent's claim that the contested decision should be annulled insofar as the Board of Appeal had upheld the opposition only in part.

Comment

This case is interesting for several reasons. Firstly, it shows that the General Court will review in detail the proof of use which had been assessed by both the Opposition Division and the Board of Appeal of the EUIPO. Secondly, it expands the "link of complementarity" when determining the similarity of goods. Finally, it demonstrates once again that the General Court is rather opponent-friendly.

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