

**Dell prevents registration of LEXDELL for certain goods and services  
European Union - Nestor Nestor Diculescu Kingston Petersen**

**Examination/opposition  
International procedures**

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In *Dellmeier v Office for Harmonisation in the Internal Market* (OHIM) (Case T-641/14, September 9 2015), the General Court (Third Chamber) has considered a dispute between Mrs Alexandra Dellmeier, the applicant for the word mark LEXDELL (No 008114779) for goods and services in Classes 16, 25, 41 and 45 of the [Nice Classification](#), and *Dell Inc.* The latter had opposed the registration of LEXDELL in the European Union on the basis of the rights deriving from the earlier figurative mark DELL (and device), depicted below, protected for goods and services in Classes 9, 16, 25, 35, 36, 37, 38, 40, 41 and 42:



During the opposition stage, Dell relied on the provisions of Article 8(1)(b) and Article 8(5) of the [Community Trademark Regulation](#) (2007/2009), claiming that:

- (i) there was a likelihood of confusion between the two marks; and
- (ii) use of the contested mark would take unfair advantage of, and be detrimental to, the distinctive character or repute of the earlier DELL mark.

In brief, both the Opposition Division and the Board of Appeal of OHIM ruled in favour of the opponent, rejecting the application with regard to the following goods and services:

Goods and services for which the application for LEXDELL was rejected	
Class 16	"Paper, cardboard and goods made from these materials; printed matter; instructional and teaching material (included in Class 16); printed goods, pamphlets, newspapers and periodicals (included in this class)."
Class 25	"Clothing, footwear, headgear, in particular men's and women's outer clothing, children's outer clothing; hiking, trekking, outdoor and climbing clothing; men and women's city and leisure shoes, children's shoes; hiking, trekking, outdoor and climbing footwear; clothing, footwear and headgear for football, basketball, handball and volleyball; clothing for jogging, fitness training and gymnastics; clothing, footwear and headgear for tennis, squash and badminton; clothing, footwear and headgear for in-line skating, skateboarding and roller skating, and for hockey, football, baseball and boxing; clothing, footwear and headgear for cycling; clothing, footwear and headgear for equestrian sports; golf clothing, footwear and headgear; men and women's fashion bathing clothing; underwear; lingerie; corsetry; hosiery; clothing, footwear and headgear for water sports, in particular for surfing, sailing, rowing and canoeing; clothing, footwear and headgear for alpine skiing, cross country skiing and snowboarding; clothing, footwear and headgear for ice skating and ice hockey; children's fashion clothing; babies' diapers of textile."
Class 41	"Providing of training, education and instruction, in particular organising, arranging and conducting of seminars, training courses and lectures, in

	<p>particular on legal topics; providing of training and further training, including training in the form of correspondence courses; organising, arranging and conducting of exhibitions, congresses, symposiums, forum discussions, information events and private views for cultural purposes; book rental; rental of periodicals; publication and edition of books, newspapers and periodicals."</p>
<p>Class 45</p>	<p>"Licensing of trademarks and hallmarks (legal services); licensing of patents, utility models, registered designs, copyright and artistic copyright, trademark rights, general personal rights, rights to a name and rights to a company name (legal services); legal research services; legal services; lawyer and patent lawyer services, in particular in the field of intellectual property rights; legal services from lawyers and patent lawyers; legal representation and cooperation; legal research; legal research, in particular into intellectual property matters; identity and similarity searches for trademarks, company names, patents, domain names and other protected privileges; formulation and registration of patent claims; filing and registration of intellectual property rights, trademarks, patents, registered designs, utility models, copyright, software rights, protection of plant varieties and semiconductor protection rights; preparation of contracts, in particular licence contracts; management, extension, conflict monitoring and exploitation of intellectual property rights, trademarks, patents, registered designs, utility models, copyright, software rights, protection of plant varieties and semiconductor protection rights; registration and conflict monitoring of domain names and title protection notifications; licensing of intellectual property, in particular trademarks, patents and domain names; organising and appraisal of trademarks, domain names and other intellectual property rights and copyright."</p>

The decision rendered by the Board of Appeal was further contested by Dellmeier. The General Court confirmed OHIM's findings, rejecting the pleas put forward by the applicant.

The court first confirmed that there was a certain degree of similarity between the two signs - visually, aurally and conceptually - despite the graphic representation of the letter 'E' in the earlier mark and the presence of the word 'lex' at the beginning of the contested mark.

Further, the court upheld OHIM's finding that the earlier DELL mark had a reputation with regard to goods and services in Classes 9, 37, 40 and 42, and that the contested mark was likely to take unfair advantage of the distinctive character or the reputation of the earlier mark with regard to some of the services in Classes 41 and 45. In this respect, OHIM had found that there was a link between certain services in these classes covered by the mark applied for and the goods and services protected by the opponent's mark.

Although the applicant invoked due cause for the use of the mark applied for, since she had held a registration for the same trademark for legal services in Germany since 2001, and since the mark resulted from the combination of her name and that of her father, the court noted that the mere existence of such earlier trademark registration did not allow the applicant to circumvent the provisions of Article 8(5) of the regulation.

This decision of the General Court reconfirms the strong protection conferred to trademarks with a reputation in the European Union, in that such protection also extends to signs that are similar only to a certain degree (ie, where the similarity is not evident). In addition, the decision reiterates that the conflicting rights do not necessarily need to designate identical or similar goods/services - it is sufficient to prove that there is a

certain connection between the goods/services in order to find that the use of the subsequent mark would be detrimental to the distinctive character and/or repute of the earlier mark.

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