



OPPOSITION No B 2 009 309

Pinterest, Inc., 808 Brannan Street, San Francisco, California 94103, United States of America (opponent), represented by **Baker & McKenzie LLP**, 100 New Bridge Street, London EC4V 6JA, United Kingdom (professional representative)

a g a i n s t

Premium Interest Ltd, Studio 17 101 Clerkenwell Road, London EC1R 5BX, United Kingdom (applicant), represented by **Mishcon De Reya Solicitors**, Summit House, 12 Red Lion Square, London WC1R 4QD, United Kingdom (professional representative)

On 05/11/2013, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 009 309 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against all the services of Community trade mark application No 10 605 749 'Pinterest'. The opposition is based on the non-registered trade marks for the word mark 'PINTEREST' used in the European Union as a whole and in the Netherlands, Estonia, the Czech Republic, Denmark, Poland, the United Kingdom, Hungary, Cyprus, Italy, Bulgaria, Spain, France, Slovakia, Austria, Belgium, Germany, Latvia, Portugal, Finland, Slovenia, Lithuania, Greece, Malta, Romania, Sweden, Luxembourg and Ireland. The opponent invoked Article 8(4) CTMR.

NON-REGISTERED MARK OR ANOTHER SIGN USED IN THE COURSE OF TRADE – ARTICLE 8(4) CTMR

According to Article 8(4) CTMR, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Therefore, the grounds of refusal of Article 8(4) CTMR are subject to the following requirements:

- the earlier sign must have been used in the course of trade of more than local significance prior to the filing of the contested trade mark;
- pursuant to the law governing it, prior to the filing of the contested trade mark, the opponent acquired rights to the sign on which the opposition is based, including the right to prohibit the use of a subsequent trade mark;
- the conditions under which the use of a subsequent trade mark may be prohibited are fulfilled in respect of the contested trade mark.

These conditions are cumulative. Therefore, where a sign does not satisfy one of those conditions, the opposition based on a non-registered trade mark or other signs used in the course of trade within the meaning of Article 8(4) CTMR cannot succeed.

I. Non-registered marks used in the European Union as a whole, the Netherlands, Estonia, the Czech Republic, Denmark, Poland, Hungary, Cyprus, Italy, Bulgaria, Spain, France, Slovakia, Austria, Belgium, Germany, Latvia, Portugal, Finland, Slovenia, Lithuania, Greece, Malta, Romania, Sweden, Luxembourg and Ireland

a) The rights under the applicable law

According to Article 76(1) CTMR, in proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

According to Rule 19(2)(d) CTMR, if the opposition is based on an earlier right within the meaning of Article 8(4) CTMR, the opposing party shall provide evidence of the acquisition, continued existence and scope of protection of that right.

Therefore, the onus is on the opponent to submit all the information necessary for the decision, including identifying the applicable law and providing all the necessary information for its sound application. According to case-law, it is up to the opponent '... to provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application ... but also particulars establishing the content of that law' (judgment of 05/07/2011, C-263/09 P, 'Elio Fiorucci', paragraph 50). The evidence to be submitted must allow the Opposition Division to safely determine that a particular right is provided for under the law in question as well as the conditions for acquisition of that right. The evidence must further clarify whether the holder of the right is entitled to prohibit the use of a subsequent trade mark as well as the conditions under which the right may prevail and be enforced vis-à-vis a subsequent trade mark.

In the present case, the opponent did not submit information on the legal protection granted to the type of trade sign invoked by the opponent, namely non-registered marks. The opponent did not submit any information on the possible content of the rights invoked or the conditions to be fulfilled for the opponent to be able to prohibit the use of the contested trade mark under the laws in each of the Member States mentioned by the opponent. It merely states that it relies on unfair competition and/or comparable causes of action as basis of its opposition in the territories of the

European Union as a whole, the Netherlands, Estonia, the Czech Republic, Denmark, Poland, Hungary, Cyprus, Italy, Bulgaria, Spain, France, Slovakia, Austria, Belgium, Germany, Latvia, Portugal, Finland, Slovenia, Lithuania, Greece, Malta, Romania, Sweden, Luxembourg and Ireland (see the opponent's observations dated 04/12/2012, page 2). However, the abovementioned statement does not constitute a concrete legal argumentation to prove its claim.

Therefore, the opposition is not well founded under Article 8(4) CTMR in so far as it is based on non-registered marks in the abovementioned territories.

II. Non-registered mark used in the United Kingdom

a) Use in the course of trade of more than local significance

The condition requiring use in the course of trade is a fundamental requirement, without which the sign in question cannot enjoy any protection against the registration of a Community trade mark, irrespective of the requirements to be met under national law in order to acquire exclusive rights. Furthermore, such use must indicate that the sign in question is of more than mere local significance.

It must be recalled that the object of the condition laid down in Article 8(4) CTMR relating to use in the course of trade of a sign of more than mere local significance is to limit conflicts between signs by preventing an earlier right which is not sufficiently definite – that is to say, important and significant in the course of trade – from preventing registration of a new Community trade mark. A right of opposition of that kind must be reserved to signs with a real and actual presence on their relevant market. To be capable of preventing registration of a new sign, the sign relied on in opposition must actually be used in a sufficiently significant manner in the course of trade and its geographical extent must not be merely local, which implies, where the territory in which that sign is protected may be regarded as other than local, that the sign must be used in a substantial part of that territory. In order to ascertain whether that is the case, account must be taken of the duration and intensity of the use of the sign as a distinctive element for its addressees, namely purchasers and consumers as well as suppliers and competitors. In that regard, the use made of the sign in advertising and commercial correspondence is of particular relevance. In addition, the condition relating to use in the course of trade must be assessed separately for each of the territories in which the right relied on in support of the opposition is protected. Finally, use of the sign in the course of trade must be shown to have occurred before the date of the application for registration of the Community trade mark (judgment of 29/03/2011, C-96/09 P, 'Bud', paragraphs 157, 159, 160, 163 and 166).

In the present case, the contested trade mark was filed on 31/01/2012. Therefore, the opponent was required to prove that the sign on which the opposition is based was used in the course of trade of more than local significance in the United Kingdom prior to that date. The evidence must also show that the opponent's sign has been used in the course of trade for:

Computer software; downloadable publications; downloadable software to facilitate online advertising, business promotion, connecting social network users with businesses and for tracking users and advertising of others to provide strategy, insight, marketing, and predicting consumer behaviour; providing a web site featuring technology that enables internet users to create, bookmark, annotate, and publicly share data; providing temporary use of non-downloadable software, computer

services; design and development of computer software; hosting an interactive website and online non-downloadable software for uploading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, photos, pictures, images, text, information, and other user-generated content; scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer software; education; providing of training; entertainment; sporting and cultural activities; internet-based social networking services; personal and social services rendered by others to meet the needs of individuals; providing a social networking website for entertainment purposes and general interest purposes.

On 30/11/2012, the opponent filed the following evidence, the exact content of which will not be fully disclosed for reasons of confidentiality:

- An affidavit by Mr Anthony Falzone, the opponent's Deputy General Counsel, dated 29/11/2012. Mr Falzone states that 'Pinterest is well known as a provider of online services through its website and applications designed for Apple and Android mobile devices' and explains how the word 'Pinterest' was 'invented', the story of the relevant website and applications and the functions thereof. Mr Falzone also refers to the annexes listed below. A table included in the affidavit mentions the estimated number of visitors and account sign-ups from March 2010 to January 2012 and from February 2012 to mid-November 2012 in the United Kingdom and in the European Union as a whole. The source of these statistical estimates is not mentioned.
- An extract from <http://techcrunch.com/> dated 07/02/2012 and entitled 'Pinterest hits 10 million US monthly uniques faster than any standalone site ever – comScore', showing statistics on traffic and the number of US visitors to the website 'Pinterest'. It is mentioned, inter alia, that this article is based on comScore's data in the United States alone.
- Two extracts from the website <http://go.experian.com/>. The first extract, which is undated and printed on 19/11/2012, contains an article with the title 'Download the 2012 Digital Marketer: Benchmark and trend report' and names 'Pinterest' as the third most popular networking site behind 'Facebook' and 'Twitter'. The second extract from the same website is dated 22/08/2012. It refers, inter alia, to 'Pinterest' as a new global star of social media and contains a table showing its growth in, inter alia, the United Kingdom from July 2011 to July 2012.
- An extract from the 'Los Angeles Times', dated 21/11/2012, analysing the history and functions of 'Pinterest' and reporting estimated figures from comScore, according to which 'Pinterest' had nearly 27 million visitors in October 2012.
- An extract from <https://blog.compete.com/> dated 10/10/2012 and stating that 'Pinterest' surpasses 'Tumblr' in unique visitors. It includes statistics on traffic and demographic data for the website from August 2010 to August 2012.
- Printouts from the opponent's websites, from which it is apparent that several educational institutions, banking and financial undertakings, IT enterprises, etc., have a registered account for the social network 'Pinterest'. The opponent, in its further observations dated 22/08/2013 and 27/08/2013, mentions the dates

of the abovementioned screenshots; however, the documents per se are undated and the date on which the accounts were created cannot be verified.

- A printout from the website <http://www.webbyawards.com/> showing that 'Pinterest' won the 'People's Voice Best Visual Design – Function Award' and the 'Social Media Webby Award' for 2012. The opponent states that a Webby Award is one of the most prestigious awards a website can win and that 'the 2012 awards attracted some 10 000 entrants from over 60 countries'. However, no relevant documents confirming the abovementioned information have been provided.
- Several extracts and articles from American and United Kingdom magazines, newspapers, blogs and websites in English, dated from 07/05/2011 to 09/08/2012.
- An extract from <http://www.theguardian.com/uk> dated 10/02/2012, showing the circulation figures of national daily newspapers for January 2012, including some of the newspapers from which the opponent had taken the extracts mentioned above.

The opponent also provided, on 22/08/2013 and 27/08/2013, evidence which relates to the substantiation of its earlier non-registered mark. However, these were submitted after the expiry of the relevant time limit for substantiation set by the Office, that is 04/12/2012. Non-compliance with a given deadline leads to the rejection of submissions made after its expiry, meaning that belated evidence is not to be taken into account, with all the adverse consequences that this might entail for the party concerned.

According to Rule 19(4) CTMIR, 'the Office shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time limit set by the Office'.

Therefore, the evidence submitted by the opponent on 22/08/2013 and 27/08/2013 will not be taken into consideration.

The majority of the evidence that relates to the relevant period prior to the filing of the contested CTMA, that is prior to 31/01/2012, merely mentions the name of 'Pinterest' as a social network or explains its functionality, without showing any indication of use or knowledge of it by the relevant public in the United Kingdom. Mere references to the website 'Pinterest' by, inter alia, United Kingdom newspapers and media do not mean that the public at large, to whom the services of the mark are addressed, are aware of 'Pinterest' to a sufficient extent to conclude that the non-registered mark is used in the course of trade of more than local significance.

Parts of the evidence describe 'Pinterest' as a 'sudden craze', 'a great new platform', 'the buzzy new social service of the moment' and 'the next big thing'. However, even the abovementioned documents contain comments such as 'despite launching in March 2010, Pinterest has only started making waves recently (see <http://www.contentandmotion.co.uk>, dated 18/01/2012), '[Pinterest is] very American at the moment. Let's elbow our way in?' (see 'The Guardian Weekend', dated 28/01/2012) and 'Pinterest, already in the top ten social networks in the U.S., is an online noticeboard...' (see <http://www.bbc.co.uk/>, dated 30/01/2012). The documents furnished contain no indications regarding the relevant territory of the United Kingdom and the awareness of the relevant public in respect of the non-registered

mark 'Pinterest'. The site seems to be based in the United States of America, and it has enjoyed great success with the public in the United States, which has visited the website so often that it has been ranked as one of the top 10 websites in that country. However, there is no reference to an equivalent impact on consumers in the United Kingdom.

It is true that websites are open to an extensive public that is not necessarily confined to the borders of the United States of America. People from all over the world, including the United Kingdom, can visit the website 'Pinterest' and become familiar with the abovementioned non-registered mark. Nevertheless, the Opposition Division cannot come to the conclusion, not even on the basis of probabilities or suppositions, that the alleged use of the mark is indeed proven in the United Kingdom and, in such a case, that the use is not confined to a small part of that territory. Furthermore, a significant part of the evidence provided, that includes such references in respect of the use of the mark in the relevant territory, is dated after the relevant date. The earliest concrete data provided on the traffic of the website or its recognition by the relevant public in the United Kingdom relates to a relatively short period preceding the filing of the contested CTMA, or even to after the filing date. Only on 13/02/2012 did the website <http://dailymail.co.uk/> state that 'the site hit 1.9 million visits in the UK in January', and on 24/02/2012 'The Guardian' reported that 'early figures suggest that the gender balance of the UK's 200 000 users is more even', showing the first estimates of users in the relevant territory. In any event, without further complementary evidence, figures for website users cannot be regarded as representing 'addressees among which the sign in question has become known as a distinctive element'. It is noted that most of the statistics mentioned are not even provided by an official source and are simply estimates. For example, on 02/12/2011 <http://connect.icrossing.co.uk> reported that 'Pinterest doesn't release traffic numbers, but ComScore estimates the site grew to 3.3 million users in October, from just 418,000 in May', while <http://www.telegraph.co.uk> stated on 09/01/2012 that 'Pinterest, a social bookmarking service popular with female design fans, already has over 3m active users if figures are to be believed'. Once again, the numbers appear to be mere speculations and, even if they were to be believed, it is not specified where the estimated visitors are located.

The opponent's services in respect of 'Pinterest' and the non-registered mark have been mentioned in the American and the British media. However, 'Pinterest' is described as one of the most visited sites in the United States or as a site that 'although it has been steadily gaining a foothold in the United States, [...] has just taken off in the United Kingdom' (see <http://www.theguardian.com/uk>, dated 22/02/2012). The sign does not seem to be used in the course of trade of more than local significance in the United Kingdom; rather, it seems to be used mainly in the United States. The commercial exploitation of the sign in a foreign country, such as the United States, could serve as an indication that the sign is known to a public that is not merely local. However, this would be true only if there was use proven primarily in a part of the United Kingdom, which is not the case. In the present case, the evidence, including visitor estimates and traffic statistics, shows that the sign is used in the course of trade mainly outside the United Kingdom.

The evidence does not provide a convincing picture of use of the opponent's sign at the time of the filing of the contested trade mark in the relevant territory. The Opposition Division cannot adduce the economic dimension of the mark from its mere presence on internet blogs or newspapers. The earliest data mentioning United Kingdom users appear only after the relevant date of filing of the contested sign, that is 31/01/2012, and refers to the number of visitors during January 2012, which coincides with the abovementioned date. The affidavit by Mr Falzone includes a table

with relevant figures for hits and users that date back to 2010. However, this statement, which gives concrete information, was drawn up by the interested party itself. As far as the probative value of the statement is concerned, the Opposition Division finds that statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by personal interests in the matter.

Although this does not mean that such statements are devoid of any probative value at all, they cannot serve on their own to prove the commencement of use and goodwill of a sign. The content of the written statements needs to be sufficiently supported by other evidence (judgment of 13/05/2009, T-183/08, 'Jello Schuhpark 11', paragraphs 38 to 39; judgment of 23/09/2009, T-409/07, 'acopat', paragraphs 50 and 56-57; and judgment of 07/06/2005, T-303/03, 'Salvita'). In the present case, the opponent's Deputy General Counsel's affidavit is not sufficiently supported by evidence from external and independent sources.

Considering all the above, the Opposition Division concludes that the evidence submitted by the opponent is insufficient to prove that the earlier sign was used in the course of trade of more than local significance in connection with the services on which the opposition was based before the relevant date and in the relevant territory.

As one of the necessary requirements of Article 8(4) CTMR is not met, the opposition must be rejected as unfounded.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) CTMR, the costs to be paid to the applicant are the costs of representation which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

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According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed

within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.