

**DECISION
of the First Board of Appeal
of 27 April 2026**

In case R 1293/2022-1

Joint-Stock Company «System of secure Communications»

st. Marshala Proshlyakova, 30, office 307,
room. 1
Moscow 123 458
Russian Federation

IR Holder / Appellant

represented by Plasseraud IP, 77 boulevard de la Bataille de Stalingrad, Park View - Tête
d'Or, 69100 Villeurbanne, France

v

COMMUNIGATE SYSTEMS SAS

230 Avenue De La Californie, Villa Kappas
06200 Nice
France

Opponent / Defendant

represented by IPSILON, Le Contemporain 50, Chemin de la Bruyère, 69574 Dardilly
Cedex, France

APPEAL relating to Opposition Proceedings No B 3 130 386 (International Registration
No 1 534 056 designating the European Union)

THE FIRST BOARD OF APPEAL

composed of G. Humphreys Bacon (Chairperson), A. González Fernández (Rapporteur) and
C. Bartos (Member)

Acting Registrar: K. Zajfert

gives the following

Decision

Summary of the facts

- 1 By an application filed on 26 March 2020, Aktsionernoe Obshestvo ‘StalkerSoft’ (‘the IR holder’) claiming priority of the Russian trade mark No 2 020 706 824 of 13 February 2020 sought to register the figurative mark



for the following list of goods and services:

Class 9: Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus; 3D spectacles; DVD players; ticket dispensers; coin-operated musical automata [juke boxes]; fire engines; answering machines; electrical adapters; batteries for electronic cigarettes; accumulators, electric; accumulators, electric, for vehicles; accelerometers; actinometers; alidades; altimeters; ear pads for headphones; ammeters; nanoparticle size analysers; anemometers; anodes; antennas; anticathodes; apertometers [optics]; high-frequency apparatus; testing apparatus not for medical purposes; remote control apparatus; electro-dynamic apparatus for the remote control of railway points; electro-dynamic apparatus for the remote control of signals; monitoring apparatus, other than for medical purposes; sound recording apparatus; Global Positioning System [GPS] apparatus; distillation apparatus for scientific purposes; diffraction apparatus [microscopy]; air analysis apparatus; apparatus to check franking; sound transmitting apparatus; apparatus for fermentation [laboratory apparatus]; breathing apparatus for underwater swimming; breathing apparatus, except for artificial respiration; apparatus and installations for the production of X-rays, not for medical purposes; cash registers; electric apparatus for commutation; magnetic resonance imaging [MRI] apparatus, not for medical purposes; intercommunication apparatus; stills for laboratory experiments; projection apparatus; fire extinguishing apparatus; radiological apparatus for industrial purposes; X-ray apparatus not for medical purposes; blueprint apparatus; flashing lights [luminous signals]; stereoscopic apparatus; telephone apparatus; facsimile machines; phototelegraphy apparatus; igniting apparatus, electric, for igniting at a distance; acid hydrometers; salinometers; acidimeters for batteries; aerometers; beacons, luminous; battery jars; automated teller machines [ATM];

barometers; anode batteries; galvanic batteries; batteries for lighting; solar batteries; solar panels for the production of electricity; batteries, electric; balances [steelyards]; betatrons; binoculars; biochips; electronic tags for goods; lens hoods; magnetic tape units for computers; computer memory devices; fire hose nozzles; encoded identification bracelets, magnetic; connected bracelets [measuring instruments]; safety tarpaulins; electronic key fobs being remote control apparatus; bullet-proof clothing; signalling buoys; life buoys; marking buoys; directional compasses; vacuum gauges; electrolysers; variometers; verniers; scales; baby scales; bathroom scales; letter scales; weighbridges; precision balances; scales with body mass analysers; levelling staffs [surveying instruments]; camcorders; video baby monitors; video cassettes; video projectors; video telephones; video screens; viewfinders, photographic; electric plugs; micrometer screws for optical instruments; viscosimeters; circuit closers; wavemeters; voltmeters; mechanical signs; signs, luminous; switchboxes [electricity]; current rectifiers; gas testing instruments; gasometers [measuring instruments]; galvanometers; hands-free kits for telephones; heliographic apparatus; hygrometers; hydrometers; weights; peepholes [magnifying lenses] for doors; hairdressing training heads [teaching apparatus]; holograms; plotters; sounding leads; plumb bobs; range finders; parking sensors for vehicles; piezoelectric sensors; densimeters; densitometers; detectors; smoke detectors; infrared detectors; counterfeit coin detectors; joysticks for use with computers, other than for video games; transparencies [photography]; slide projectors; diaphragms [photography]; dictating machines; dynamometers; quantum dot light-emitting diodes [QLED]; organic light-emitting diodes [OLED]; light-emitting diodes [LED]; floppy disks; sound recording discs; disks, magnetic; optical discs; circular slide rules; disk drives for computers; juke boxes for computers; wearable video display monitors; electronic numeric displays; DNA chips; electronic interactive whiteboards; electronic notice boards; electric wire harnesses for automobiles; bullet-proof vests; life jackets; reflective safety vests; identification threads for electric wires; nose clips for divers and swimmers; padlocks, electronic; locks, electric; alarm bells, electric; electric door bells; signal bells; bells [warning devices]; audio interfaces; acoustic conduits; mirrors for inspecting work; road signs, luminous or mechanical; downloadable emoticons for mobile phones; marine depth finders; probes for scientific purposes; buzzers; needles for surveying compasses; needles for record players; eyewear; reflective articles for wear, for the prevention of accidents; measures; pressure measuring apparatus; simulators for the steering and control of vehicles; inverters [electricity]; pressure indicators; automatic indicators of low pressure in vehicle tires; temperature indicators; incubators for bacteria culture; measuring instruments; cosmographic instruments; mathematical instruments; levelling instruments; instruments containing eyepieces; surveying instruments; azimuth instruments; interfaces for computers; ionisation apparatus not for the treatment of air or water; satellite finder meters; spark-guards; coaxial cables; fiber optic cables; cables, electric; calipers; slide calipers; screw-tapping gauges; calorimeters; calculating machines; pocket calculators; decompression chambers; rearview cameras for vehicles; cinematographic cameras; thermal imaging cameras; mouth guards for sports; life-saving capsules for natural disasters; electronic pens [visual display units]; holders for electric coils; biometric identity cards; identity cards, magnetic; video game cartridges; toner cartridges, unfilled, for printers and photocopiers; ink cartridges, unfilled, for printers and photocopiers; memory cards for video game machines; encoded magnetic cards; riding helmets; protective helmets; carriers for dark plates [photography]; cathodes; choking coils [impedance]; spools [photography]; coils, electric; electromagnetic coils; cinematographic film, exposed;

computer keyboards; solenoid valves [electromagnetic switches]; wire connectors [electricity]; thin client computers; downloadable cryptographic keys for receiving and spending cryptocurrency; encoded key cards; electronic book readers; electronic agendas; push buttons for bells; mouse pads; magnetic encoders; visors for helmets; collectors, electric; loudspeakers; calibrating rings; smart rings; ring sizers; protective suits for aviators; commutators; compact discs [audio-video]; compact discs [read-only memory]; comparators; marine compasses; computers; wearable computers; laptop computers; tablet computers; notebook computers; condensers [capacitors]; contacts, electric; wind socks for indicating wind direction; traffic cones; branch boxes [electricity]; distribution boxes [electricity]; junction boxes [electricity]; battery boxes; cabinets for loudspeakers; diving suits; downloadable e-wallets; galena crystals [detectors]; covers for electric outlets; logs [measuring instruments]; lasers, not for medical purposes; lactodensimeters; lactometers; vacuum tubes [radio]; flashlights [photography]; darkroom lamps [photography]; thermionic tubes; amplifying tubes; head cleaning tapes [recording]; magnetic tapes; videotapes; surveying chains; fire escapes; rulers [measuring instruments]; square rulers for measuring; slide-rules; optical condensers; contact lenses; correcting lenses [optics]; optical lenses; electricity conduits; sounding lines; measuring spoons; magnifying glasses [optics]; thread counters; magnets; decorative magnets; close-up lenses; crash test dummies; resuscitation mannequins [teaching apparatus]; mouse [computer peripheral]; trackballs [computer peripherals]; pressure gauges; security tokens [encryption devices]; divers' masks; solderers' helmets; protective masks; respiratory masks, other than for artificial respiration; materials for electricity mains [wires, cables]; voting machines; money counting and sorting machines; material testing instruments and machines; furniture especially made for laboratories; megaphones; portable media players; diaphragms [acoustics]; diaphragms for scientific apparatus; metal detectors for industrial or military purposes; digital weather stations; metronomes; carpenters' rules; rules [measuring instruments]; dressmakers' measures; mechanisms for counter-operated apparatus; coin-operated mechanisms for television sets; shutter releases [photography]; micrometers; microprocessors; microscopes; microtomes; microphones; audio mixers; modems; lightning rods; monitors [computer hardware]; monitors [computer programs]; selfie sticks [hand-held monopods]; terminals [electricity]; junction sleeves for electric cables; teeth protectors; temperature indicator labels, not for medical purposes; knee-pads for workers; headphones; earpieces for remote communication; surveyors' levels; sound recording carriers; magnetic data media; optical data media; electronic sheet music, downloadable; computer software, recorded; sheaths for electric cables; identification sheaths for electric wires; weighing machines; computer hardware; punched card machines for offices; life saving apparatus and equipment; shoes for protection against accidents, irradiation and fire; lenses for astrophotography; selfie lenses; objectives [lenses] [optics]; egg-candlers; fire extinguishers; rescue laser signalling flares; electrified fences; limiters [electricity]; clothing for protection against accidents, irradiation and fire; clothing for protection against fire; asbestos clothing for protection against fire; clothing especially made for laboratories; survival blankets; ozonisers [ozonators]; octants; eyepieces; ohmmeters; wrist rests for use with computers; eyeglass frames; oscillographs; plumb lines; mirrors [optics]; eyeglasses; sunglasses; goggles for sports; electronic collars to train animals; finger sizers; signalling panels, luminous or mechanical; biometric passports; wah-wah pedals; radio pagers; pince-nez; electronic pocket translators; transmitters [telecommunication]; telephone transmitters; transmitters of electronic signals; switches, electric; periscopes; data gloves; gloves for

divers; gloves for protection against accidents; gloves for protection against X-rays for industrial purposes; asbestos gloves for protection against accidents; furnaces for laboratory use; droppers for measuring, other than for medical or household purposes; laboratory pipettes; pyrometers; planimeters; plane tables [surveying instruments]; plates for batteries; computer software platforms, recorded or downloadable; wafers for integrated circuits; printed circuit boards; compact disc players; cassette players; protective films adapted for computer screens; protective films adapted for smartphones; sound recording strips; X-ray films, exposed; films, exposed; life-saving rafts; animal signalling rattles for directing livestock; laboratory trays; digital signs; stands adapted for laptops; semiconductors; polarimeters; personal digital assistants [PDAs]; fire pumps; measuring glassware; weight belts for divers; life belts; fuses; circuit breakers; converters, electric; telerupters; food analysis apparatus; diagnostic apparatus, not for medical purposes; distance recording apparatus; distance measuring apparatus; speed measuring apparatus [photography]; appliances for measuring the thickness of leather; apparatus for measuring the thickness of skins; speed checking apparatus for vehicles; teaching apparatus; time recording apparatus; hemline markers; measuring apparatus; measuring devices, electric; apparatus and instruments for astronomy; surveying apparatus and instruments; weighing apparatus and instruments; nautical apparatus and instruments; navigational instruments; optical apparatus and instruments; apparatus and instruments for physics; chemistry apparatus and instruments; boiler control instruments; meteorological instruments; naval signalling apparatus; observation instruments; navigation apparatus for vehicles [on-board computers]; satellite navigational apparatus; regulating apparatus, electric; telecommunication apparatus in the form of jewellery; precision measuring apparatus; audio- and video-receivers; prisms [optics]; computer software applications, downloadable; ticket printers; printers for use with computers; retorts' stands; apparatus for changing record player needles; drainers for use in photography; cleaning apparatus for sound recording discs; fire beaters; telescopic sights for firearms; telescopic sights for artillery; test tubes; pressure indicator plugs for valves; magnetic wires; telegraph wires; telephone wires; wires, electric; conductors, electric; copper wire, insulated; fuse wire; computer programs, recorded; computer screen saver software, recorded or downloadable; computer game software, downloadable; computer game software, recorded; computer programs, downloadable; computer operating programs, recorded; record players; processors [central processing units]; rods for water diviners; electronic publications, downloadable; distribution consoles [electricity]; control panels [electricity]; radar apparatus; masts for wireless aerials; radios; vehicle radios; transmitting sets [telecommunication]; sprinkler systems for fire protection; frames for photographic transparencies; screens for photoengraving; flowmeters; walkie-talkies; voltage surge protectors; voltage regulators for vehicles; stage lighting regulators; light dimmers [regulators], electric; speed regulators for record players; cell switches [electricity]; washing trays [photography]; marking gauges [joinery]; T-squares for measuring; time switches, automatic; relays, electric; safety restraints, other than for vehicle seats and sports equipment; body harnesses for support when lifting loads; X-ray photographs, other than for medical purposes; rheostats; respirators for filtering air; retorts; refractometers; refractors; grids for batteries; security surveillance robots; laboratory robots; teaching robots; telepresence robots; humanoid robots with artificial intelligence; electric sockets; height measuring instruments; speaking tubes; horns for loudspeakers; subwoofers; saccharometers; optical fibers [light conducting filaments]; traffic-light apparatus [signalling devices]; dog whistles; signalling whistles; sports whistles; sextants; inductors [electricity];

safety nets; nets for protection against accidents; fire alarms; signals, luminous or mechanical; rescue flares, non-explosive and non-pyrotechnic; sirens; electronic access control systems for interlocking doors; scanners [data processing equipment]; hand-held electronic dictionaries; integrated circuit cards [smart cards]; smartglasses; smartphones; smartwatches; connections for electric lines; couplings, electric; connectors [electricity]; sonars; sound locating instruments; lighting ballasts; resistances, electric; spectrograph apparatus; spectrosopes; speed indicators; alcoholmeters; satellites for scientific purposes; protection devices for personal use against accidents; audiovisual teaching apparatus; charging stations for electric vehicles; radiotelegraphy sets; radiotelephony sets; spectacle lenses; anti-glare glasses; optical glass; personal stereos; stereoscopes; stands for photographic apparatus; stroboscopes; fire boats; sulfotometers; bags adapted for laptops; drying racks [photography]; spherometers; integrated circuits; printed circuits; counters; parking meters; kilometer recorders for vehicles; revolution counters; abacuses; egg timers [sandglasses]; taximeters; ear plugs for divers; tachometers; television apparatus; telegraphs [apparatus]; telescopes; teleprompters; teleprinters; cordless telephones; cellular phones; theodolites; credit card terminals; interactive touch screen terminals; thermo-hygrometers; thermometers, not for medical purposes; thermostats; thermostats for vehicles; climate control digital thermostats; crucibles [laboratory]; tone arms for record players; totalizers; transistors [electronic]; transponders; protractors [measuring instruments]; step-up transformers; transformers [electricity]; resuscitation training simulators; vehicle breakdown warning triangles; triodes; starter cables for motors; discharge tubes, electric, other than for lighting; capillary tubes; neon signs; Pitot tubes; X-ray tubes not for medical purposes; telephone receivers; headgear being protective helmets; squares for measuring; gauges; quantity indicators; gasoline gauges; water level indicators; electric loss indicators; light-emitting electronic pointers; slope indicators; levels [instruments for determining the horizontal]; mercury levels; spirit levels; urinometers; amplifiers; particle accelerators; electric installations for the remote control of industrial operations; baby monitors; steering apparatus, automatic, for vehicles; balancing apparatus; video recorders; sound reproduction apparatus; invoicing machines; tape recorders; protection devices against X-rays, not for medical purposes; railway traffic safety appliances; data processing apparatus; oxygen transvasing apparatus; theft prevention installations, electric; devices for the projection of virtual keyboards; film cutting apparatus; drying apparatus for photographic prints; optical character readers; centering apparatus for photographic transparencies; dosage dispensers; battery chargers; chargers for electric accumulators; chargers for electronic cigarettes; acoustic alarms; sounding apparatus and machines; apparatus for editing cinematographic film; cathodic anti-corrosion apparatus; couplers [data processing equipment]; wearable activity trackers; anti-theft warning apparatus; computer peripheral devices; anti-interference devices [electricity]; demagnetising apparatus for magnetic tapes; acoustic couplers; alarms; fog signals, non-explosive; whistle alarms; adding machines; readers [data processing equipment]; bar code readers; heat regulating apparatus; photocopiers [photographic, electrostatic, thermic]; electric and electronic effects units for musical instruments; downloadable ring tones for mobile phones; downloadable image files; downloadable music files; animated cartoons; filters for respiratory masks; filters for ultraviolet rays, for photography; filters for use in photography; USB flash drives; magic lanterns; signal lanterns; optical lamps; cameras [photography]; glazing apparatus for photographic prints; shutters [photography]; darkrooms [photography]; photometers; flash-bulbs [photography];

digital photo frames; enlarging apparatus [photography]; photovoltaic cells; containers for contact lenses; eyeglass cases; containers for microscope slides; cases for smartphones; cases especially made for photographic apparatus and instruments; chromatography apparatus for laboratory use; chronographs [time recording apparatus]; laboratory centrifuges; eyeglass chains; cyclotrons; compasses for measuring; frequency meters; time clocks [time recording devices]; Petri dishes; sleeves for laptops; covers for personal digital assistants [PDAs]; covers for tablet computers; covers for smartphones; fire blankets; chips [integrated circuits]; jigs [measuring instruments]; pedometers; meteorological balloons; electrified rails for mounting spot lights; asbestos screens for firemen; fire hose; virtual reality headsets; protective helmets for sports; head guards for sports; lifeboats; snorkels; cell phone straps; eyeglass cords; tripods for cameras; switchboards; distribution boards [electricity]; equalisers [audio apparatus]; workmen's protective face-shields; projection screens; radiology screens for industrial purposes; fluorescent screens; screens [photography]; exposure meters [light meters]; ducts [electricity]; galvanic cells; downloadable graphics for mobile phones; epidiascopes; ergometers; armatures [electricity]; black boxes [data recorders].

Class 38: Telecommunications services; news agency services; wireless broadcasting; television broadcasting; cable television broadcasting; electronic bulletin board services [telecommunications services]; providing user access to global computer networks; providing access to databases; providing internet chatrooms; providing telecommunications connections to a global computer network; providing telecommunication channels for teleshopping services; video-on-demand transmission; transmission of podcasts; transmission of greeting cards online; message sending; computer aided transmission of messages and images; transmission of telegrams; transmission of digital files; providing information in the field of telecommunications; providing online forums; videoconferencing services; rental of message sending apparatus; rental of access time to global computer networks; rental of modems; rental of telecommunication equipment; rental of smartphones; rental of telephones; rental of facsimile apparatus; radio broadcasting; radio communications; transmission of electronic mail; communications by fiber optic networks; communications by cellular phones; communications by computer terminals; satellite transmission; communications by telegrams; communications by telephone; facsimile transmission; paging services [radio, telephone or other means of electronic communication]; teleconferencing services; telex services; voice mail services; telecommunications routing and junction services; streaming of data; telegraph services; telephone services.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; water analysis; computer system analysis; handwriting analysis [graphology]; chemical analysis; rental of meters for the recording of energy consumption; energy auditing; recovery of computer data; business card design; graphic design of promotional materials; industrial design; graphic arts design; computer virus protection services; oil-field surveys; geological surveys; engineering; installation of computer software; interior design; meteorological information; clinical trials; material testing; textile testing; bacteriological research; biological research; geological research; research in the field of environmental protection; cosmetic

research; mechanical research; research in the field of welding; research in the field of building construction; research in the field of telecommunications technology; research in the field of physics; chemical research; research and development of new products for others; medical research; scientific and technological research relating to patent mapping; scientific and technological research in the field of natural disasters; scientific research; analysis for oil-field exploitation; underwater exploration; technological research; calibration [measuring]; web site design consultancy; computer security consultancy; information technology [IT] consultancy; consultancy in the design and development of computer hardware; architectural consultancy; internet security consultancy; computer software consultancy; data security consultancy; technological consultancy; oil-well testing; quality control; vehicle roadworthiness testing; land surveying; dress designing; updating of computer software; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems by remote access; software as a service [SaaS]; maintenance of computer software; authenticating works of art; design of interior decor; quality evaluation of standing timber; quality evaluation of wool; digitization of documents [scanning]; conversion of data or documents from physical to electronic media; urban planning; platform as a service [PaaS]; providing information relating to computer technology and programming via a web site; providing scientific information, advice and consultancy relating to carbon offsetting; providing search engines for the internet; conversion of computer programs and data, other than physical conversion; conducting technical project studies; computer system design; rental of web servers; computer rental; rental of computer software; unlocking of mobile phones; geological prospecting; oil prospecting; hosting computer sites [web sites]; server hosting; duplication of computer programs; development of computer platforms; construction drafting; computer software design; software development in the framework of software publishing; cloud seeding; consultancy in the field of energy-saving; creating and designing website-based indexes of information for others [information technology services]; creating and maintaining web sites for others; computer programming; technical writing; architectural services; information technology services provided on an outsourcing basis; chemistry services; packaging design; off-site data backup; computer technology consultancy; telecommunications technology consultancy; scientific laboratory services; cloud computing; user authentication services using single sign-on technology for online software applications; user authentication services using technology for e-commerce transactions; weather forecasting; styling [industrial design]; cartography services; exploration services in the field of the oil, gas and mining industries; data encryption services; electronic data storage; surveying; electronic monitoring of credit card activity to detect fraud via the internet; electronic monitoring of personally identifying information to detect identity theft via the internet.

- 2 The IR holder claimed the following colours: blue, white and orange.
- 3 The application was republished on 8 June 2020.
- 4 On 9 September 2020, COMMUNIGATE SYSTEMS SAS ('the opponent'), filed an opposition against the registration of the published trade mark application for all the above the goods and services.
- 5 The grounds of opposition were those laid down in Article 8(4) EUTMR.

- 6 The opposition was based on the following earlier rights:
- a) French Company name: ‘COMMUNIGATE SYSTEMS SAS’ used for the distribution and marketing of software and computer applications, development, publishing and integration services for software and computer applications, as well as all related services including support and maintenance services.
 - b) Trade name: ‘COMMUNIGATE SYSTEMS’, used in Belgium, Germany, Greece, Hungary, Italy, Luxembourg, and in The Netherlands, for the distribution and marketing of software and computer applications, development, publishing and integration services for software and computer applications, as well as all related services including support and maintenance services.
 - c) Domain name ‘communicate.eu’ used in the whole EU, as well as in the United Kingdom, for software, software development and related services.
- 7 On 10 January 2021, the opponent submitted the following evidence:

- Annex 1: an extract of the French company register for the company ‘CommuniGate Systems SAS’ and its English translation, with incorporation date of 19 April 2019 and address in Nice (France), indicating as activity: ‘the distribution and commercialisation of software and computer applications, development, publishing and integration services for software and computer applications, as well as all related services including support and maintenance services’.
- Annex 2: a selection of 6 invoices dated from 29 May 2019 to 7 October 2019 issued by the opponent to business customers in Montpellier, Saint Cyr au Mont d’Or, Paris, Saint Jean de Vedas, as well as English translations, and a map of France indicating the location of the business customers in question. All these invoices depict the opponent’s company name, both at the top and twice at the bottom, namely along with the opponent’s bank details, and in the footer. All invoices include a description of the services (‘Comments’) and product name references (‘Product name’).
- Annexes 3, 4 and 6: three articles, namely ‘New Office in Nice France’, dated 26 August 2019 (Annex 3), ‘Comment protéger votre messagerie d’entreprise des hackers’, and its English counterpart ‘How to protect your corporate email from hackers’, dated 17 October 2019, on the website <https://communicate.com> (Annex 4) and ‘They Thrive at Sewan – S01E04 [Spin Off]’, dated 29 May 2019, on the website <https://sewan.jobs> (Annex 6). Annexes 3 and 4 include ‘archives’ referring to a period starting in January 2016 and ending in January 2021 (which is the month of the printing date).
- Annex 5: an announcement ‘Formation Communigate à Nice’ (translated as ‘Communicate training in Nice’) on the website <https://optedif-formation.fr>, which the opponent explains to be an ‘entity specialised in training and

detailing the content of COMMUNIGATE training sessions'. The document holds the printing date of 15 January 2021, and refers to '2020 training'.

- Annex 7: screenshots of posts in French on the opponent's Twitter account, dated 24 September 2019, 1 October 2019 and 4 October 2019.
- Annex 8: opponent's annual report from 10 April 2019 to 31 December 2019, printed on the heading of Cabinet De Paz & Tomasini, which the opponent explains to be an independent firm of chartered accountants, and partial English translations.
- Annex 9: a selection of 31 invoices dated from 23 July 2019 to 31 October 2019 issued by the opponent to business customers in Belgium, Bulgaria, Denmark, Germany, Greece, Hungary and Italy, and a map of Europe indicating the location of the business customers in question.
- Annex 10: a Google Trends analysis of the evolution of interest for the term 'communigate' between 9 April 2019 and the relevant date, including a ranking of 'interest by region' with Germany and Italy ranking first and third respectively.
- Annex 11: a customer list available at <https://communigate.com/jp/main/customers/references.html> bearing the printing date of 19 January 2021 and including clients which the opponent explains to be based in Germany and Italy.
- Annex 12: applicable laws in support of the opposition insofar as based on the 'CommuniGate' trade name.
- Annex 13: a Whois printout of <communigate.eu>, indicating 21 November 2006 as creation date, and including the opponent's contact details.
- Annexes 14 and 15: screenshots bearing the printing date of 16 January 2021 of webpages of www.communigate.com, including a presentation of the activity of the Group to which the opponent belongs, as well as historic screenshots from the corresponding website obtained through the Wayback Machine on 15 July 2019, 8 August 2019 and 6 October 2019.

8 On 5 November 2021, after the expiry of the time limit, the opponent filed additional evidence, namely several screenshots of different websites (including screenshots obtained through the Wayback Machine and another Whois printout of <communigate.eu>), case-law for the countries where the opponent relied on rights of the CommuniGate trade name, and a decision of the Cancellation Division of 11 December 2020.

9 By decision of 28 June 2022 ('the contested decision'), the Opposition Division partially upheld the opposition for the following contested goods and services:

Class 9: Computer software; interfaces for computers; monitors [computer programs]; computer software, recorded; computer software platforms, recorded or downloadable;

computer software applications, downloadable; computer programs, recorded; computer programs, downloadable; computer operating programs, recorded.

Class 42: Technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; design and development of computer hardware and software; computer system analysis; recovery of computer data; industrial design; computer virus protection services; engineering; installation of computer software; research in the field of telecommunications technology; technological research; web site design consultancy; computer security consultancy; information technology [IT] consultancy; consultancy in the design and development of computer hardware; internet security consultancy; computer software consultancy; data security consultancy; technological consultancy; updating of computer software; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems by remote access; software as a service [SaaS]; maintenance of computer software; digitization of documents [scanning]; conversion of data or documents from physical to electronic media; platform as a service [PaaS]; providing information relating to computer technology and programming via a web site; providing search engines for the internet; conversion of computer programs and data, other than physical conversion; conducting technical project studies; computer system design; rental of web servers; computer rental; rental of computer software; unlocking of mobile phones; hosting computer sites [web sites]; server hosting; duplication of computer programs; development of computer platforms; computer software design; software development in the framework of software publishing; creating and designing website-based indexes of information for others [information technology services]; creating and maintaining web sites for others; computer programming; technical writing; information technology services provided on an outsourcing basis; off-site data backup; computer technology consultancy; telecommunications technology consultancy; cloud computing; user authentication services using single sign-on technology for online software applications; user authentication services using technology for e-commerce transactions; data encryption services; electronic data storage; electronic monitoring of credit card activity to detect fraud via the internet; electronic monitoring of personally identifying information to detect identity theft via the internet.

10 It gave, in particular, the following grounds for its decision:

- As regards the evidence submitted on 5 November 2021, it does not require re-opening the proceedings. Even if this additional evidence is taken into account, this does not alter the outcome of the assessment.
- As regards the prior use in the course of trade of the CommuniGate company name:
 - The evidence shows that the opponent has been using the sign ‘CommuniGate Systems SAS’ in the course of trade as its company name. This is clearly shown on the invoices (Annexes 2 and 9), in the annual report (Annex 8) and in the Whois printout (Annex 13).
 - This all denotes use of the CommuniGate company name in the course of trade of more than local significance in France, before the priority date of

the contested trade mark, in relation to *distribution and commercialisation of secure messaging software solutions*.

- As regards the other business activities for which the CommuniGate company name has been invoked, the claimed *related services including support and maintenance services* are not independent services, but merely form part of, or are ancillary to, the opponent's distribution and commercialisation activities; none of the evidence refers to any *development of software*, that is to say development of software for third parties; for reasons of completeness, to the extent that the opponent's translation of 'commercialisation' as 'marketing' was meant to effectively include 'marketing' in the sense of advertising, nothing in the evidence shows that the opponent was involved in such activities.
- As regards the CommuniGate trade name, considering that the opponent has invoked the trade name for the same activities as its French company name, and that the evidence does not include any references to business activities other than those for which the geographical and economic dimension of use of the company name has been established, the contested decision assumed that prior use in the course of trade of more than mere local significance has been proven for the trade name for *distribution and commercialisation of secure messaging software solutions*.
- As regards the CommuniGate domain name, the opponent has invoked the domain name in relation to *software, software development and related services*.
- As regards *software*, the evidence does not succeed in establishing that the CommuniGate domain name has been used in the course of trade of more than local significance for such goods. The product name references of the invoices submitted as Annexes 2.1 and 9.1 systematically refer to other (branded) products, such as 'Cloudmark Plugin', 'MessagePlus SMB', 'Cloudmark Anti-Spam', 'Spam Catcher', 'Sophos AntiVirus', 'MailShell Plugin' and 'Kaspersky Anti-virus'. There are only few product name references and descriptions of services that mention 'CommuniGate', namely invoice 2019-100 (29/05/2019) which refers to 'CommuniGate support basic', invoice 2019-105 (26/06/2019) which refers to 'Invoicing the remaining 60 % of the CommuniGate Phase 2 service delivery of your infrastructure virtualization project', and invoices 2019-106 (23/07/2019) and 2019-110 (25/08/2019) which refer to 'CommuniGate Pro MessagePlus'. The information 'Bits and Bytes about us' on the opponent's website, as shown in Annex 14.1, explicitly refers to the opponent's *platform and server*. It explains for instance that 'the core platform "CommuniGate Pro" provides unprecedented resiliency with open APIs to support business applications in a multitenancy environment'. The platform is ideally suited for Cloud hosting deployments. Furthermore, Annex 4.2 refers to the opponent offering 'a secure file sharing and messaging solution in a private cloud', whilst Annex 14.2 refers to the opponent's 'end to end Unified Communications technology' and the webpage included as Annex 14.4 welcomes the visitor to 'CommuniGate Pro, the Unified Internet Communication Server', explaining that 'CommuniGate Pro provides an integrated platform (...)'. Considering these explanations, in particular the opponent's own explanation on its website, and in

the absence of any documents, other than the few abovementioned invoices, which enable to cross-reference their references to ‘CommuniGate’ as goods, it is impossible for the Opposition Division to establish use of the sign ‘CommuniGate’ in relation to software. Even though the evidence clearly refers to *distribution and commercialisation of secure messaging software solutions* (as explained above) and to other IT related services (the information on the opponent’s website refers to the sign ‘CommuniGate’ being used for its Platform as a service [PaaS]), none of it refers to software, which is composed of programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation, at least not to use of the CommuniGate domain name of more than mere local significance for such goods.

- Consequently, use of the CommuniGate domain name has not been proven for any of the goods and services for which it has been invoked, and the opposition must be rejected as unfounded insofar as it has been based on the CommuniGate domain name.
- As regards the applicable law for the CommuniGate company name, the opponent relied on Article L 711-3 of the French Intellectual Property Code, for which it submitted both the French original text and its English translation. According to Article L 711-3 of the French Intellectual Property Code, as amended by Ordinance No 2019-1169 of 13/11/2019, signs may not be adopted as marks where they infringe earlier rights, particularly a company name where there is a risk of confusion in the public’s mind. The opponent also provided a certificate (with English translation) showing its registration in France as a company with the name ‘CommuniGate Systems’, before the priority date of the contested sign.
- As regards the applicable law for the CommuniGate trade name, the opponent relied on several national stipulations, for which it submitted both the original texts and their English translation. For reasons of procedural economy, in the present case it does not have to be assessed whether the opponent has proved that it may rely on the CommuniGate trade name.
- The contested decision first examined the opposition in relation to the CommuniGate company name. The concept of likelihood of confusion in French law is no different from that under EU law, drawing of an analogy with the criteria for the application of Article 8(1)(b) EUTMR.
- The contested *computer software; interfaces for computers; monitors [computer programs]; computer software, recorded; computer software platforms, recorded or downloadable; computer software applications, downloadable; computer programs, recorded; computer programs, downloadable; computer operating programs, recorded* in Class 9 includes broadly defined software (platforms) and data carriers for software. These goods are similar to the opponent’s *distribution and commercialisation of secure messaging software solutions*, because they target the same public and may come from the same companies. Furthermore, they are in competition with the opponent’s services in that these goods and services serve the same or a similar purpose and are offered to the same actual and potential customers.

- The contested *design and development of computer hardware and software; computer system analysis; recovery of computer data; computer virus protection services; installation of computer software; research in the field of telecommunications technology; web site design consultancy; computer security consultancy; information technology [it] consultancy; consultancy in the design and development of computer hardware; internet security consultancy; computer software consultancy; data security consultancy; updating of computer software; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems by remote access; software as a service [saas]; maintenance of computer software; digitization of documents [scanning]; conversion of data or documents from physical to electronic media; platform as a service [paas]; providing information relating to computer technology and programming via a web site; providing search engines for the internet; conversion of computer programs and data, other than physical conversion; computer system design; rental of web servers; computer rental; rental of computer software; unlocking of mobile phones; hosting computer sites [web sites]; server hosting; duplication of computer programs; development of computer platforms; computer software design; software development in the framework of software publishing; creating and designing website-based indexes of information for others [information technology services]; creating and maintaining web sites for others; computer programming; technical writing; information technology services provided on an outsourcing basis; off-site data backup; computer technology consultancy; telecommunications technology consultancy; cloud computing; user authentication services using single sign-on technology for online software applications; user authentication services using technology for e-commerce transactions; data encryption services; electronic data storage; electronic monitoring of credit card activity to detect fraud via the internet; electronic monitoring of personally identifying information to detect identity theft via the internet* in Class 42 are at least similar to the opponent's *distribution and commercialisation of secure messaging software solutions*, as they are generally provided by the same kind of undertakings (employing professionals in the IT field), which normally provide a full spectrum of IT solutions tailored to the needs of their customers.
- The contested *technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; industrial design; engineering; technological research; technological consultancy; conducting technical project studies* are broad categories of services which can relate to various fields of activity, including the IT field. The Opposition Division cannot dissect *ex officio* the broad categories of these services. Therefore, considering that these services can specifically relate to the IT field, they are similar to the opponent's *distribution and commercialisation of secure messaging software solutions*.
- The remaining contested goods and services are dissimilar.
- The relevant territory is France.
- The signs are visually, aurally and conceptually similar to a high degree. It is therefore considered that the relevant public, even when displaying a high degree

of attention, will confuse the signs and assume that the goods and services found to be at least similar come from the same undertaking as the one trading under the company name invoked by the opponent.

- Considering all the above, the Opposition Division finds that the opposition is partly well founded on the basis of the CommuniGate company name, namely insofar as it is directed against some of the contested goods and services in Classes 9 and 42.
 - The rest of the contested goods and services are dissimilar to the opponent's *distribution and commercialisation of secure messaging software solutions*. As similarity of goods and services is a necessary condition for the application of Article 8(4) EUTMR in the present case where French national law requires the contested sign to be liable to cause confusion with the opponent's company name, the opposition based on this article and directed at these goods and services cannot be successful.
 - The opponent has also based its opposition on the CommuniGate trade name and the CommuniGate domain name. However, the outcome cannot be different insofar as it is based on these earlier rights.
 - The opposition has been found unfounded insofar as it has been based on the CommuniGate domain name, as no use of the CommuniGate domain name of more than mere local significance has been proved for the goods and services for which it has been invoked.
- 11 On 18 July 2022, the IR holder filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal, including a suspension request, was received on 27 October 2022.
 - 12 On 25 May 2023, the opponent requested an extension of the deadline to file a response.
 - 13 On 26 May 2023, the Registry of the Boards of Appeal notified the refusal to extend a deadline, as no reasoning, as regards the necessity for an extension, has been provided by the opponent. On the same day, the Registry of the Boards of Appeal notified to the IR holder a deficiency regarding the suspension request received by the Office on 27 October 2022.
 - 14 In its response received on 26 May 2023, the opponent requested that the appeal be dismissed and that the suspension request be rejected.
 - 15 By communication of 15 December 2023, the Rapporteur invited the parties to submit their arguments about a possible suspension of the case, while waiting for the final Judgment of the Court of Justice in case C-337/22 P, *Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al.* In addition, the parties were invited to provide clarifications and additional evidence as to the conditions for invoking Article 8(4) EUTMR for the earlier trade name and domain name, in particular, their geographical and economic dimension of use and the applicable law, not assessed in the contested decision for reasons of procedural economy. In addition to the goods and services of the earlier

trade name and domain name for which prior use in the course of trade of more than mere local significance has been claimed.

- 16 On 12 January 2024, the opponent replied that it did not agree with a suspension of the proceedings.
- 17 On 15 and 18 January 2024, the IR holder stated that it did not oppose the suspension of the proceedings.
- 18 On 26 February 2024, the opponent replied to the IR holder's reply dated 15 and 18 January 2024.
- 19 On 6 November 2025, the Rapporteur suspended the appeal proceedings since the invoked earlier French company name could significantly impact the outcome of the opposition, the Board decides to suspend the present proceedings in accordance with Article 71(1) EUTMDR.
- 20 On 5 February 2026, the judgment of the Court of Justice of the European Union in case C-337/22 P, against the Judgment of the General Court of the European Union 16/03/2022, T-281/21, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:T:2022:139 became final.
- 21 On 12 March 2026, the Registry of the Boards of Appeal informed the parties that the appeal has been resumed following the final decision rendered in case C-337/22 P. The Board will take a decision based on the arguments and evidence before it.

Submissions and arguments of the parties

- 22 The arguments raised in the statement of grounds may be summarised as follows:
 - As regards the company name, on 16 November 2021, the shareholders of 'COMMUNIGATE SYSTEMS SAS' amended by a unanimous decision the company name to 'MailSPEC SAS' (Annex 1). At the time when the contested decision was issued, the company name was no longer valid and could no longer constitute an earlier right to base the opposition.
 - As regards the domain name, the contested decision correctly found that use of the CommuniGate domain name has not been proven for any of the goods and services for which it has been invoked.
 - As regards the earlier trade name, the contested decision did not assess its geographical and economic dimension. It assumed that prior use in the course of trade of more than mere local significance has been proven for the trade name for *distribution and commercialisation of secure messaging software solution*. Since the company name is no longer a valid earlier right, an assessment must be performed in relation to the earlier trade name.
 - Having regard to the contested goods and services in Classes 9 and 42 for which the opposition was upheld, the IR holder submits that these goods and services differ fundamentally in nature from the earlier goods and services. Specifically, they are intangible in character, whereas the earlier products at issue are tangible.

Furthermore, they are intended to satisfy distinct needs. The respective goods and services also differ in their methods of use and are neither in competition with, nor complementary to, one another.

- The IR holder, together with its statement of grounds, submitted the following evidence:
 - Annex 1: extract from the minutes of 16 November 2021, when shareholders of ‘COMMUNIGATE SYSTEMS SAS’ amended the name of the company to ‘MailSPEC SAS’.
 - Annex 2: 14/02/2019, T-162/18, ALTUS (fig.) / ALTOS et al., EU:T:2019:87.
 - Annex 3: 13/09/2006, T-191/04, METRO (fig.) / METRO, EU:T:2006:254.
 - Annex 4.1: Copy of a Statement of claim introduced by Mr Dmitry Evgenyevich Akindinov, for recognition of the right of Co-authorship and Ownership of the CommuniGate Pro Multi-protocol Communication Server Software, followed by its English free translation
 - Annex 4.2: Copy of a Statement of claim introduced by Mr Roman Vyacheslavovich Prokhorov, for recognition of the right of Co-authorship and Ownership of the CommuniGate Pro Multi-protocol Communication Server Software, followed by its English free translation.
 - Annex 4.3: Copy of counterclaim dated January 12, 2021 introduced by AKTSIONERNOE OBSHESTVO "STALKERSOFT" (in English STALKERSOFT JOINT-STOCK COMPANY or JSC), followed by its English free translation.
 - Annex 4.4: Copy of counterclaim dated May 17, 2021 introduced by Mrs Anna Vladimirovna Butenko, followed by its English free translation.

23 The arguments raised in response may be summarised as follows:

- As regards the company name, even though the earlier company name has changed prior to the contested decision, it still fulfils the conditions of opposability to an earlier right. French Courts confirmed that a change of the company name does not prevent its owner from prohibiting any use infringing its rights on the previous company name (Annex 1).
- At the EU level, judgment 16/03/2022, T-281/21, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:T:2022:139 ruled that it is irrelevant to the outcome of the opposition whether the earlier right loses its effect prior to the opposition decision, as long as it was a valid ground for refusal at the time of filing the contested application (Annex 2).
- As regards the domain name, the opponent acknowledges a discrepancy between the decisions issued in oppositions Nos B 3 127 824 and B 3 130 386. Nonetheless, the decision in case No B 3 127 824 should be followed. The IR

holder itself recognises that ‘COMMUNIGATE’ designates a computer software and speaks about the “COMMUNIGATE software” (page 8 of the statements of grounds).

- The opponent, together with its response, submitted the following evidence:
 - Annex 1: Judgment of the Court of Appeal of Paris, 11.04.2008, RG 06/15403.
 - Annex 2: Judgment on 16/03/2022, T-281/21, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:T:2022:139.
 - Annex 3: screenshot dated 23 March 2023 of the defendant’s (opponent’s) website www.communigate.com, where the business is still identified under ‘COMMUNIGATE’, although the contact details for Europe refer to ‘MailSPEC’.
 - Annex 4: copy of the Decision issued by the Opposition Division on March 14, 2022 in opposition B 3 127 824.

24 The opponent’s reply to the Rapporteur’s communication can be summarised as follows:

- The opponent objected to a suspension of the case while awaiting the final judgment of the Court of Justice. The opponent argues that the conditions under national law to prohibit the use of the contested trade mark are met. In particular, under French law, as confirmed by national case-law, a change of company name does not prevent the owner from enforcing rights in its former name against infringing use (Paris Court of Appeal, April 11, 2008, 06/15403 Annexes 1.1 and 1.2).
- Having regard to the trade name, its use has been proved through invoices issued before the priority date, showing use across the claimed EU countries. The invoices (Annex 9.1) confirm the place and timing of use and, together with other evidence, establish commercial activity in relation to COMMUNIGATE PRO software and related services. Overall, the evidence shows genuine use in the course of trade within the relevant territory, rather than merely token activity. In addition, Annex 8 (annual report extract) confirms sales of goods and services in Europe, including countries such as Italy, Greece, and Luxembourg. Annex 10 provides Google Trends data showing consistent online interest in ‘CommuniGate’ between April and October 2019, notably in Germany and Italy. Annex 11 further supports use through a customer list demonstrating services provided to European clients in the relevant territories.
- The opponent submits that a trade name constitutes a protected industrial property right under Article 8 of the Paris Convention, without the need for registration, in conjunction with the relevant national laws, as supported by the legal provisions provided in Annex 12.
- Having regard to the goods and services of the earlier trade name for which prior use in the course of trade of more than mere local significance has been claimed,

the opponent confirms that they are the same as claimed regarding the company name, as the activity under both is strictly identical, namely: ‘the distribution and marketing of software and computer applications, development, publishing and integration services for software and computer applications, as well as all related services including support and maintenance services’.

- Having regard to the domain name, Annexes 13–15 show that the earlier sign was genuinely used in the course of trade via the website prior to the filing and priority date of the contested mark. The “more than local significance” of this use is supported by additional evidence, including the annual report (Annex 8), invoices across the EU (Annexes 2 and 9), Google Trends data (Annex 10), and a customer list (Annex 11), all indicating activity throughout multiple Member States. As the website is the opponent’s primary means of promotion, the evidence also demonstrates its reach and impact, confirming that the use extends beyond a merely local scope.
 - Having regard to the law governing the domain names, the opponent refers to Article L.711-3 of the French IP Code. Regarding Germany, Italy, Luxembourg, Belgium, Greece, Hungary and Netherlands, the legal provisions will be the same for trade names and domain names, already referred to in Annexes 12 to 14.
 - Regarding the goods and services of the earlier domain name for which prior use in the course of trade of more than mere local significance has been claimed, the claimed domain name is in use for ‘software, software development and related services’.
 - Having regard to the suspension request made by the IR holder due to the pending proceedings concerning the ownership of the software COMMUNIGATE, the opponent claims that the mentioned proceedings ended by a decision from the Russian Court issued on 10 July 2023, attached as Annex 1.
 - This decision confirms that the ownership of the software copyright is not attached to the adverse party but to Ms Anna Butenko, heir of Vladimir Butenko, and Chairman of the Board of Directors at CommuniGate Systems.
- 25 In its reply to the Rapporteur’s communication dated 15 January 2024, the IR holder agrees to suspend the case until the final Judgment of the Court of Justice is issued in the abovementioned case C-337/22 P.
- 26 The IR holder’s reply to the Rapporteur’s communication dated 18 January 2024 can be resumed as follows:
- The Opposition Division reviewed the evidence regarding prior use of the CommuniGate domain name and concluded that use of the domain had not been proven for any goods or services and rejected the opposition as unfounded. The IR holder endorses this conclusion.
 - The earlier domain name at issue is not <communicate.com> or <communicate> with any other country code or gTLD, but specifically <communicate.eu>. The opponent was therefore required to demonstrate significant use of this specific.eu domain across the EU, country by country for each claimed Member State, which

it failed to do. It claims that the <communigate.eu> domain would be redirected to the said website.

- As to the documentation provided by the opponent on 5 November 2021 and showing notably Whois printout of <communigate.eu> were filed after the expiry of the time limit and have not been submitted to the appellant (IR holder) in due time as recalled by the Opposition Division. They should be put aside.
- In its initial opposition dated 22 January 2021, the opponent attempted to substantiate its claimed trade name with several annexes. Overall, the following evidence is insufficient to substantiate the earlier trade name rights in the targeted EU countries:
 - Annex 8: Annual account extract for 2019, intended to show sales of goods and services in Europe, including licences and maintenance in Italy, Greece, and Luxembourg. The extract is only partially translated, making its evidential value highly disputable.
 - Annex 9: Invoices issued by COMMUNIGATE SYSTEMS SAS to clients in several EU countries shortly before the priority date. The invoices feature a stylised sign identical to an earlier international trademark belonging to AKTSIONERNOE OBSHESTVO "STALKERSOFT", rather than a trade name, and do not clearly demonstrate actual use of the trade name.
 - Annex 10: Google Trends data for "COMMUNIGATE", which is illegible and unexplained, providing no clear evidence of public interest.
 - Annex 11: Pages from the Japanese section of the opponent's website listing European companies as clients, without explanation of the nature or extent of business relationships.
 - Annex 12: Copies and translations of national law extracts, without analysis of how national courts interpret them or how they would prevent use of the contested mark under each applicable law.

Reasons

27 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Scope of the appeal

28 According to Article 67 EUTMR, a party adversely affected by a decision may appeal that decision.

29 The IR holder appealed the contested decision in its entirety. The scope of the appeal is limited to those contested goods and services, for which the opposition was considered successful by the Opposition Division (the contested goods and services listed above at paragraph 9). The IR holder is adversely affected only to that extent. Since the opponent did not file a separate appeal or an ancillary appeal, the rejection of the

opposition for the remaining goods and services has therefore become final and will not be reassessed.

Preliminary remark as regards the suspension request

- 30 Independently of its request for annulment of the contested decision, the IR holder also sought the suspension of the present appeal proceedings in view of pending litigation before foreign courts concerning the ownership of the COMMUNIGATE software.
- 31 In its response of 12 January 2024, the opponent submits that those proceedings have been concluded by a Judgment of a Russian court dated 10 July 2023 (opponent's Annex 1).
- 32 The IR holder did not put forward any further arguments on the suspension in its replies of 15 and 18 January 2024.
- 33 In light of the above, the request for suspension has become devoid of purpose.

Article 8(4) EUTMR

- 34 According to Article 8(4) EUTMR, 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 will not be registered where and to the extent that, pursuant to the European Union 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 European Union trade mark, or the date of the priority claimed for the application for registration of the European Union trade mark; (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.
- 35 The opponent invoked, inter alia, the French company name 'COMMUNIGATE SYSTEMS SAS' for the distribution and marketing of software and computer applications, development, publishing and integration services for software and computer applications, as well as all related services including support and maintenance services.
- 36 In its statement of grounds, the IR holder submits that, on 16 November 2021, prior to the adoption of the contested decision, the shareholders of 'COMMUNIGATE SYSTEMS SAS' unanimously resolved to change the company name to 'MailSPEC SAS' (Annex 1). It follows, according to the IR holder, that the former company name 'COMMUNIGATE SYSTEMS SAS' could no longer be relied upon as an earlier right for the purposes of the opposition.
- 37 The opponent did not contest that the company name had been changed.
- 38 Firstly, the opponent's arguments based on the prior General Court judgment in 16/03/2022, T-281/21, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:T:2022:139 must be rejected as ineffective in light of the subsequent ruling of the Court of Justice in 10/04/2025, C-337/22 P, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:C:2025:272.

- 39 The Court of Justice, held in its ‘Ape tees’ judgment (05/02/2026, C-337/22 P, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:C:2026:71) that where the earlier mark relied upon no longer enjoys protection at the time the decision on the opposition is adopted, its essential function can no longer be jeopardised by the registration of the contested EUTM. Consequently, the Court of Justice expressly rejected the proposition that the existence of a relative ground must be assessed solely with reference to the filing date of the contested application. The Court of Justice stated, inter alia, the following:

‘in a situation in which the earlier mark no longer enjoys such protection, the essential function of that mark can no longer be compromised by the registration of the EU trade mark, since such an earlier mark is no longer capable of fulfilling that essential function. Consequently, the interpretation of Regulation No 207/2009 on which the conclusion in paragraph 31 of the judgment under appeal is based is contrary to the general objective of that regulation of balancing the interests of the proprietor of an earlier mark and those of third parties in having signs capable of designating their goods and services.

It follows from all of the foregoing that the General Court erred in law in relying (...) on the premise that the existence of a relative ground for refusal relied on in support of an opposition to the registration of an EU trade mark must be assessed only as at the date of filing of the application for that registration.’

(05/02/2026, C-337/22, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:C:2026:71, § 121-122)

- 40 Therefore, it follows from the Court of Justice’s findings that the earlier right invoked in opposition proceedings must exist at the time the Office adopts its final decision.
- 41 Secondly, as regards the opponent’s arguments that, notwithstanding the change of its company name prior to the contested decision, the earlier company name still fulfils the conditions required to constitute an earlier right, and that French courts have confirmed that a change of company name does not prevent its proprietor from prohibiting uses infringing rights acquired under the former company name (Annex 1.1), the Board notes that the cited case-law concerns infringement proceedings. As such, it relates to the enforcement of rights, rather than to their registration in opposition proceedings.
- 42 In that regard, the Board recalls that opposition proceedings differ, in both their subject matter and legal effects, from infringement proceedings. In particular, the filing of an opposition, which may be rejected by the Office without any examination on the merits, does not deprive an infringement action of its purpose, namely to prohibit the use, in the course of trade, of signs that are identical or similar to the earlier trade mark, including where such use relates to a subsequently registered EUTM, or to claim damages for the infringement of the domain name occurred prior to its change (05/02/2026, C-337/22, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:C:2026:71, § 123, 125).
- 43 In so far as the opponent had, under French law, the right to prohibit the use of a subsequent trade mark, within the meaning of Article 8(4) EUTMR, it was, during that period, entitled to bring an action before the French courts for infringement of its rights against the use of the EUTM that is the subject of the application for registration at

issue, without the subsequent registration of that latter mark being able, in any event, to preclude that action (see, by analogy, 05/02/2026, C-337/22, Ape tees (fig.) / DEVICE OF APE HEAD (fig.) et al., EU:C:2026:71, § 128).

- 44 As a result, given that the earlier French company name ‘COMMUNIGATE SYSTEMS SAS’, relied upon in the opposition proceedings, was changed prior to the adoption of the final decision, it can no longer be successfully invoked as a basis for the opposition.

Article 71(1) and (2) EUTMR – remittal for further prosecution

- 45 Having regard to the earlier trade name ‘COMMUNIGATE SYSTEMS’, the Board notes that the contested decision did not assess whether said sign was used in the course of trade with more than mere local significance. Instead, it merely assumed that such use had been proven, relying on the evidence submitted in respect of the earlier French company name. In particular, the contested decision assumed that use had been proven for the trade name in relation to the *distribution and commercialisation of secure messaging software solutions*.
- 46 Having regard to the earlier domain name, the contested decision found that no genuine use had been established in relation to any of the goods and services for which it was invoked. Consequently, the opposition was rejected as unfounded to the extent that it relied on the CommuniGate domain name.
- 47 However, the Board notes that in a parallel opposition case pending between the same parties and the same earlier rights (No 3 127 824, appeal pending in case R 823/2022-1, CommuniGate / COMMUNIGATE SYSTEMS SAS et al.), the Opposition Division did not assess the evidence relating to the use of the domain name, but instead proceeded on the assumption that prior use in the course of trade of more than mere local significance had been established for secure messaging software solutions, and not for the broad category software, nor for software development and related services because, as none of the evidence refers to any software development activity.
- 48 That finding should be clarified by means of an assessment of the evidence concerning the use of the domain name in order to avoid any inconsistency.
- 49 According to Article 71(1) EUTMR, following the examination regarding the admissibility of the appeal, the Board of Appeal shall decide on the appeal. It may either exercise any power within the competence of the department that was responsible for the decision appealed or remit the case to that department for further prosecution.
- 50 According to Article 71(2) EUTMR, if the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal.
- 51 In the present case, the Board considers that the parties should not be deprived of one instance of examination before the Office, particularly in circumstances where the assessment of the remaining earlier rights has either not been carried out or has been conducted in a contradictory manner. It is therefore appropriate to remit the case to the Opposition Division pursuant to Article 71(1) EUTMR so that it may examine the merits of the opposition on the grounds of Article 8(4) EUTMR, taking into account the

ratio decidendi of the present decision pursuant to Article 71(2) EUTMR as regards the non-opposability of the earlier French company name.

Conclusion

- 52 For the reasons above, the appeal must be allowed, and the contested decision must be annulled.
- 53 The case is remitted to the Opposition Division for further prosecution.

Costs

- 54 For reasons of equity, each party must bear its own costs in the appeal proceedings, in accordance with Article 109(3) EUTMR since at this stage of proceedings there is no losing party.
- 55 The final decision on the costs of the opposition proceedings falls within the competence of the Opposition Division, following its assessment of the merits of the case.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision.**
- 2. Remits the case to the Opposition Division for further prosecution.**
- 3. Orders each party to bear its own costs in the appeal proceedings.**

Signed

G. Humphreys Bacon

Signed

A. González Fernández

Signed

C. Bartos

Acting Registrar:

Signed

K. Zajfert

