

## Schedule 1

### Explanation of grounds:

The sign MACARAJA (the "Sign") applied for by the Applicant in this application (the "Application") is similar to the Opponent's marks MAC, MAC OS and IMAC (the "Marks"), as protected by the registrations referred to above (the "Prior Registrations").

The goods and services covered by the Application are identical or similar to those protected by the Prior Registrations. Because of the similarity between the Marks and the Sign and the identity or similarity of the goods and services covered by the Application and the goods and services protected by the Prior Registrations, there is a likelihood of confusion (including the likelihood of association) on the part of the public throughout the European Union between the Marks and the Sign. As a result, the Application should be refused under **Article 8(1)(b)** of Council Regulation 207/2009/EC.

The Opponent relies also on the reputation of the Marks, as a result of which there will be an increased likelihood of confusion on the part of the relevant public between these Marks and the Sign.

As a result of the Opponent's extensive use of the Marks, the Opponent has acquired a substantial reputation in the Marks throughout the European Union, and the use of the Sign would take unfair advantage of, or be detrimental to, the distinctive character and/or the repute of the Marks. As a result, the Application should be refused under **Article 8(5)** of Council Regulation 207/2009/EC.

This applies regardless of whether the goods and services of the Application are found to be identical and/or similar and/or dissimilar to the goods and services protected by the Prior Registrations.

The Marks are well-known marks in the European Union within the meaning of Article 6bis of the Paris Convention. Because of the similarity between the Sign and the Marks, the use of the Sign is liable to be prevented under the terms of the Paris Convention.

The Opponent is the proprietor of earlier signs consisting of the Marks, whether used alone or in conjunction with other signs of the Opponent, which are used in the course of trade throughout the European Union as indicating the goods and/or services of the Opponent. The use of the Marks confer on the Opponent the right to prohibit the use of the Sign. As a result, the Application should be refused under **Article 8(4)** of Council Regulation 207/2009/EC and at least under the following national laws:

Passing off and Section 5(4) TMA 1994 (in the United Kingdom);

Passing off and Section 10(4)(a) TMA 1996 (in the Republic of Ireland);  
Section 31 Markenschutzgesetz 1970 (MG) as last amended by law of 1999 (in Austria);  
Article 12B Uniform Benelux Law on Marks and Article 93 de la loi du 14 juillet 1991 sur les pratiques du commerce et sur l'information et la protection du consommateur (in Belgium);  
Article 7(1)(g) TML (in the Czech Republic);  
Section 15(4)(ii) TMA (in Denmark);  
Sections 1, 2 (3), 6, 14 (6) TML (in Finland);  
Article 711-4(b) and (c) CPI (in France);  
Sections 4(2), 12, 14 and 14 (2) MG (in Germany);  
Article 4(3)(a) of TML 2239/1994 and Article 13(1) Law 146/1914 on Unfair Competition (in Greece);  
Article 5(2)(a) (in Hungary);  
Article 12(1)(b) and Article 25(1)(a) Codice Proprietà Industriale (in Italy);  
Article 4(4), (7) TML (in Latvia);  
Article 12B Uniform Benelux Law on Marks and Article 17 alinéa f, de la loi du 27 November 1986 réglementant certaines pratiques commerciales et sanctionnant la concurrence déloyale (in Luxembourg);  
Article 6(4)(a) TML (in Malta);  
Article 12B Uniform Benelux Law on Marks and Law of 5 July 1921 on trade names and Article 6:612 of Dutch Civil Code (in Netherlands);  
Article 191 and Article 33(1)(b), PT Industrial Property Code (in Portugal);  
Article 4(d) TML (in Slovakia);  
Article 3(2), Ley de Marcas (in Spain);  
Sections 1, 2(1), 2(3), 6, 14(6) Swedish Trade Mark Act (in Sweden);  
Chapter 2 Section 6 (e) Law on Trade Marks and Geographical Indications No.84-1998 (Romania); and  
Article 12 Law on Marks and Geographical Indications (Bulgaria)

The Opponent requests the refusal of the Application in its entirety.

In the alternative, the Opponent requests refusal of that part of the Application for which it is shown that grounds for refusal of the Application exist.

The Opponent requests that an award of costs be made in these proceedings in favour of the Opponent.

## Schedule 2

Goods and services for which the Marks are used in the course of trade and are well known.

### Class 9

Data processing equipment; computer software; computers, computer terminals, computer peripherals; computer hardware; computer networks; microprocessors; central processing units; circuit boards; integrated circuits; computer and communications network controllers; computer firmware; magnetic, optical, and electronic data storage materials and devices; optical and magnetic disks for data storage; solid-state data storage devices; electronic data storage cards; instructional material relating to the foregoing, all recorded magnetically, optically, or electronically.

### Class 16

Printed matter in the field of computers; multimedia products, interactive products and online services; catalogues relating to computer software; computer brochures; computer handbooks; computer hardware publications; computer hardware reference manuals; computer hardware users guide; instruction manuals; user manuals; publications relating to technology, digital technology and gadgets.

### Class 35

Exhibitions; business seminars and business conferences in the field of computer software, computer peripherals, portable and/or handheld electronic devices, online services, high technology, communications, information technology, information services, music entertainment and publishing; arranging and conducting of fairs and exhibitions for business and advertising purposes; conducting of online trade show exhibitions in the fields of computers, computer software, computer peripherals, portable and/or handheld electronic devices, online services, high technology, communications, information technology, information services, music entertainment and publishing; data storage and retrieval services; computerised data storage services; data processing; data verification and file management; demonstration of computer software; information, advisory and consultancy services relating to all the aforesaid.

### Class 37

Installation, maintenance and repair services relating to computers, computer hardware, computer networks and computer systems; installation, maintenance and repair of electric and electronic equipment, computers and data processing equipment; maintenance of computer

and communications networks, and computer systems; consultancy, information and advisory services relating to all the aforesaid goods.

#### **Class 38**

Telecommunication services; communications by computer terminals; electronic transmission and retrieval of data, images, audio, video and documents over local or global communications networks; distribution of computer software over local or global communications networks; electronic mail services; web site portal services; distribution of computer software services provided on-line from a computer database or network, including the internet; consultancy and provision of information and advice on-line from a computer database or provided from facilities on local or global networks, including the internet, extranet, television, mobile communication, cellular or satellite networks, all relating to telecommunications.

#### **Class 41**

Education and training services relating to computers, computer hardware, computer networks, computer systems and to computer software; arranging and conducting workshops, seminars, exhibitions, training and conferences; entertainment; provision of electronic publications (not downloadable); providing on-line electronic publications; computer assisted education services; computer assisted teaching services; computer assisted training services; computer based educational services; education services, providing of training, instruction and entertainment relating to computers, computer software, multimedia products, interactive products and online services, and distributing course materials therewith; education services relating to online exhibitions and displays and interactive exhibits in the fields of computers, computer software, computer peripherals, portable and/or electronic devices, online services, high technology, communications, information technology, information services, music, entertainment and publishing; arranging and conducting of commercial, trade and business conferences; organising and conducting exhibitions, workshops, seminars, training, conferences and video conferences; publication of printed matter and of instructional and teaching materials; information, advisory and consultancy services relating to all the aforesaid.

#### **Class 42**

Design and development of computer hardware and software; computer services; consultancy in the field of computer hardware; computer software consultancy; computer programming; computer data recovery; updating of computer software; maintenance of computer software; research and development of computer hardware and software; providing use of on-line, non-downloadable software; services relating to the protection of computer hardware, computer software, computer networks and computer systems against computer viruses, attacks, or failures; services for enhancing the performance, security and functionality of computer and communications networks; computer help-line services; technical support services relating to computers, computer software, telecommunications, and the Internet; installation, maintenance

and repair services relating to computer software; leasing and rental of computer hardware and software apparatus and equipment.