

BOIP



Benelux Office for  
Intellectual  
Property

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# Annual overview BOIP decisions 2023



## BOIP webinar

28 November 2023  
Eline Schiebroek & Camille Janssen





# The webinar on 'Annual overview BOIP decisions 2023' will start shortly.

- Tineke Van Hoey & Marjolein Bronneman moderate our chat during this webinar.
- Questions can be raised at any time by using the chat function.
- There is a Q&A section foreseen at the end as well.
- All the slides used and the full webinar will be made available through BOIP's website.
- Please fill in the survey after this webinar!



## Agenda: Last Year's Highlights

1. Complementarity
2. Comparison of signs
3. Tubacex
4. Genuine Use
5. Procedural Issues



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# 1. Complementarity



## Complementarity. BOIP Decision



CI 32 Energy drinks

CI 6 Cans

Energy drinks are always sold in cans and therefore, cans are indispensable for energy drinks

Granted

Appealed





## Decision BenCJ



Cans, when filled, will reach the end consumer. Therefore, drinks and their packaging ultimately share the same public/ are aimed at the same public

Confirmed





## Complementarity – key takeaways

- Goods are complementary when they are so interrelated that one is indispensable or important for the use of the other, so that consumers may believe that the production of both goods is in the hands of one and the same undertaking
- Always give a second thought to the relevant public. This may not necessarily be the (first )buyer of the goods
- Complementarity is invoked a lot, applied only little
- Provide arguments to show the importance/ indispensability. Don't just claim complementarity to exist



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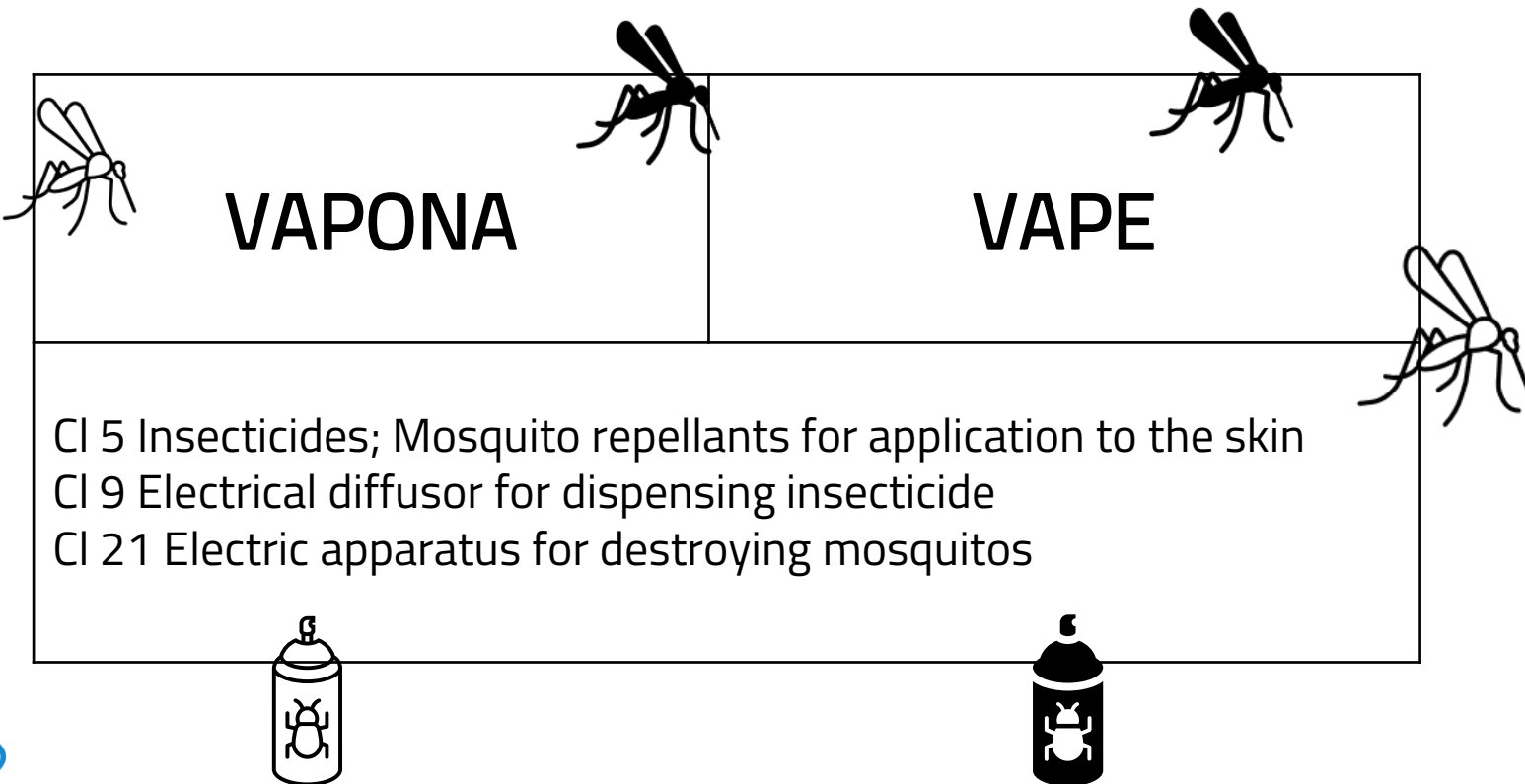
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## 2. Comparison of signs





## Neutralisation





## POLL QUESTION 1

In which “Equivalenza”-phase should neutralisation take place?



Phase 1 = comparison of the signs

Phase 2 = global assessment

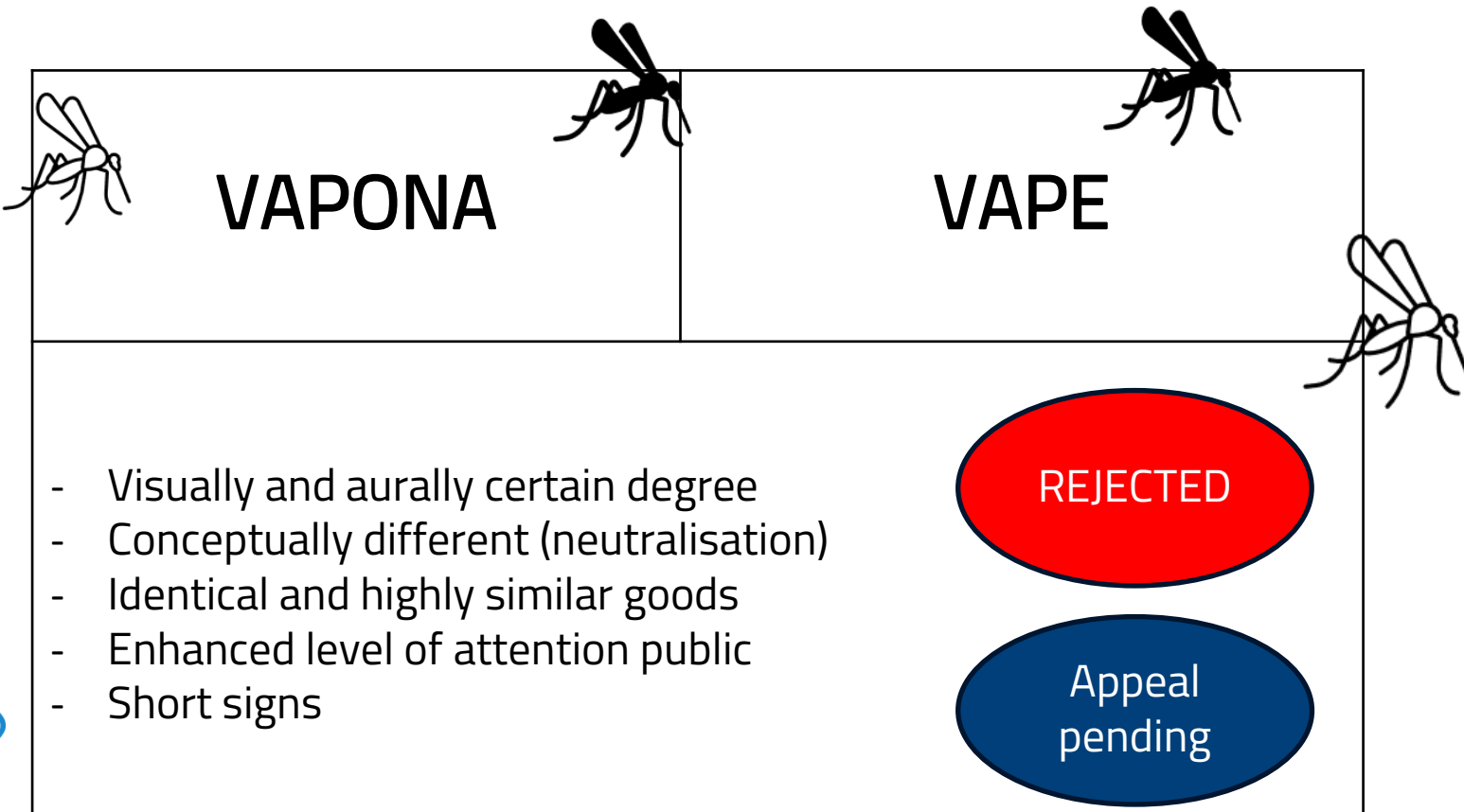


- A. Always in phase 1, which means no further assessment is necessary
- B. Only in phase 2, a conceptual difference is only one of the ingredients of the LoC assessment 'cocktail'
- C. Phase 1 is possible, but only in obvious cases.
- D. The concept of neutralisation should be abolished





## BOIP decision





## POLL QUESTION 1

In which “Equivalenza”-phase should neutralisation take place?



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## Distinctive and dominant elements

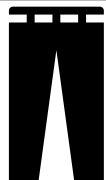
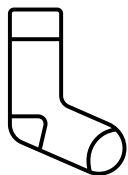


# FALKE

# DOHA FALCONS

CI 25 Hosiery, clothing, knitted and knit fabric garments, underclothing, ties and gloves.

CI 25 Clothing; footwear; headgear, aforementioned products solely related to equestrian sports and jumping.





## BOIP decision

FALKE	DOHA FALCONS
<ul style="list-style-type: none"><li>- Conceptually similar</li><li>- Visually low degree</li><li>- Aurally certain degree</li><li>- Identical and similar goods</li><li>- Normal level of attention public</li><li>- Sub brand in the clothing industry</li></ul> <p data-bbox="1103 585 1489 790">Granted</p>	



Appealed





## Descriptive signs. BOIP decision



*Grill'd*



- Identical or similar services (restaurant)
- Conceptually and aurally identical
- Visually low degree

Although words are the same, the indication 'grill'd' is fully descriptive. Therefore, the figurative elements are of more importance.

**REJECTED**

No appeal





## Benelux Court of Justice

**FALKE**

**DOHA FALCONS**

- Elements Doha and Falcons are **equally dominant**
  - Visually and aurally low degree
  - Conceptually certain degree of similarity
  - Identical and similar goods
  - Normal level of attention public
- Considering the degree of similarity between the signs....

**REJECTED**







## Poll Question 2

In which phase should descriptiveness of word elements of the marks be considered?

- A. Phase 2 only, because assessing similarity is an objective test.
- B. In both phases: In phase 1 since this influences the degree of similarity and in phase 2 to assess the distinctive character of the signs as a whole, including market reality.
- C. I have no strong opinion about it, because it probably does not change the outcome of the decision.



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# 3. Tubacex



## Distinctive and dominant elements

**TUBACEX**

**TUBEX**  
PIPING

CI 6 Common metals and their alloys; building materials of metal; tubes of metal.

CI 37 Installation of industrial piping systems;  
Maintenance and repair of industrial piping systems;  
Installation of piping systems.

CI 40 Treatment of metal.





## BOIP decision

TUBACEX

TUBEX  
PIPING

- TUBACEX and TUBEX have no clear meaning
- Piping will be understood but is descriptive
- Piping is also not dominant because of its size and place
- Visually and aurally certain degree
- Identical and similar goods and services
- Normal level of attention public

Granted

Appealed





## Benelux Court of Justice

TUBACEX

TUBEX  
PIPING

- Piping is descriptive and therefore **not dominant**
- Visually low degree
- Aurally certain degree
- Conceptually different, because in the contested sign the public will understand the reference to tubes/piping.
- Identical and similar goods
- Slightly enhanced level of attention public
- Professional public will have more attention for the differences...

REJECTED





## Comparison of signs – key takeaways

- Still a debate about neutralisation and in which phase this must be assessed.
- Interdependence between distinctive character of word elements and position within the sign (Falke).
- Interdependence between importance of word elements and figurative elements if word elements are descriptive (Grill'd).
- A conceptual difference can be caused by the descriptive meaning of one of the signs (Tubacex).



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## 4. Distinctive Character



## Distinctive character

M000I

m o o o i



ZOMOOI

Cl 11, 14, 18, 20 and 25

Lighting, jewelry, bags, furniture, clothing







## Decision BOIP

M000I  
m o o o i



- Moooi is recognised as 'mooi' and is descriptive for the goods and services of the trademark(s)
- ZO MOOI is descriptive, ZM in circle dominates the sign
- Only similarity in descriptive elements of trademark and sign
- Too little similarity

REJECTED

Appealed





## Benelux Court of Justice

M000I  
m o o o i



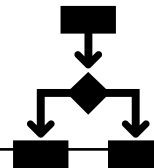
- Appellant shows enlarged distinctive character or maybe even reputation through use
- Considering:
  1. the similarities between trademark(s) and sign
  2. the similarities between the goods
  3. the distinctive character/reputation of the trademarks invoked

Granted





## Distinctive character

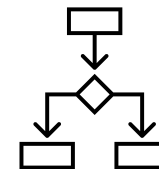


### UBO

Class 35: Management consultancy; Business consultancy; Business management consultancy; Business research consultancy; Business organizational consultancy and advisory; Business consultancy services.

Cancellation claim:

- Non-Distinctive
- Descriptive
- Usual Indication
- Misleading
- Application in Bad Faith





## Decision BOIP

### UBO

- UBO means Ultimate Beneficial Owner. TM holder does not say anything different
- Relevant public (business owners) knows this abbreviation/ word/ indication
- Services are, admittedly, aimed at identifying UBOs
- Therefore, descriptive indeed
- All other invoked grounds no longer relevant for consideration

Granted

Appealed





## Benelux Court of Justice

### UBO

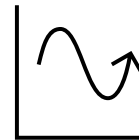
- UBO means Ultimate Beneficial Owner. TM holder does not say anything different
- Relevant public (business owners) knows this abbreviation/ word/ indication
- Services are, admittedly, aimed at identifying UBOs
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- All other invoked grounds no longer relevant for consideration

Confirmed

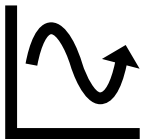




## Distinctive Character – key takeaways



- Distinctive character may grow (or shrink) through use
- Enlarged distinctive character needs to be shown/proven
- Enlarged distinctive character can be invoked in an appeal



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# 5. Genuine Use



## CATOR

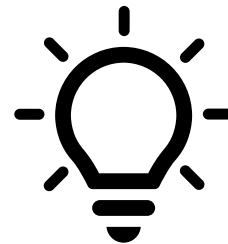
Class 39 Transport; packaging and storage of goods; travel arrangement.

Class 40 Treatment of materials.

Class 41 Education; providing of training; entertainment; sporting and cultural activities.



TIP OF THE DAY...limit any vague terms







## No use for the G&S registered

Class 39 Transport; packaging and storage of goods; travel arrangement.

~~Class 40 Treatment of materials. (vague)~~

Class 41 Education; providing of training; entertainment; sporting and cultural activities.

Proof of use: Collection of used oil and refining of waste oil

No use for services in class 39 and 41

NO  
GENUINE  
USE

No appeal





# Volumia – Volumia! - v@l u m i a !

CI 9 Sound and/or image recording media containing sound or video recordings.

CI 25 Clothing, footwear, headgear.

CI 41 Performance of **entertainment** programmes; **live performances**; production and distribution of music and entertainment recordings; publishing of music; organisation of performances; recording studio services; **services of a pop and party band (pop music)**

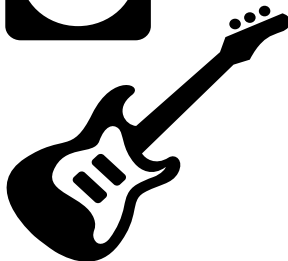
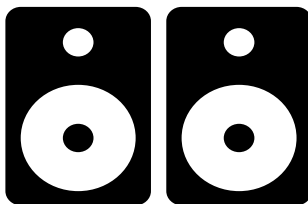




### 3. Question for the chat

What does a band that no longer exists use its trademark for?

Please mention your ideas in the chat!





# Volumia – Volumia! - v@lumi@!

CI 9 Sound and/or image recording media containing sound or video recordings.

CI 25 Clothing, footwear, headgear.

CI 41 Performance of **entertainment** programmes; **live performances**; production and distribution of music and entertainment recordings; publishing of music; organisation of performances; recording studio services; **services of a pop and party band (pop music)**

PoU related to exposure online and royalties – not enough

NO  
GENUINE  
USE

Appeal  
pending





# Slaap ID



CI 20 Beds, mattresses

CI 24 Bed linen

CI 35 Advertising

CI 42 Scientific research services and digital measurement of people's body profile of people for the purpose of adjusting bed bases mattresses and pillows to the body of individual users

Class 44 Measuring people's sleep behaviour with a view to adjusting bed bases mattresses, duvets and pillows to the body of individual users





## Decision BOIP

What kind of service?

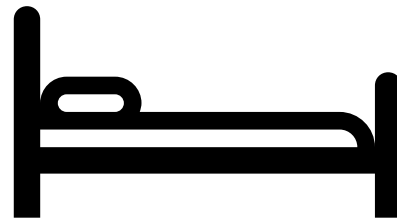
- System that assesses sleeping behaviour
- Test is offered free of charge
- Customers of bed shops



Claimant referred to CJEU 'Silberquelle' case (free soda if you buy a T-shirt)

Is this the same situation?

- Underlying commercial agreement with bed supplier and sleep measurement provider.
- Even if a service is offered for free to the public, this could be done to obtain a (b2b) market share for these services.



Appeal  
pending



## HOTEL CIPRIANI



Class 42 hotel services.

Hotel located in Venice (Italy) – can there be genuine use in the Benelux?



**BOIP and BenCJ:** yes

- The relevant public is also the public in the Benelux
- Acts of use seeking to promote and to offer for sale such services are necessarily taking place outside of the territory where the hotel is (General Court EU – STANDARD)

So even if the services as such are not delivered in the Benelux, there can still be genuine use for a BX trademark.





## BAIDU

5 BAIDU cases:

- 4 based on non-usus
- 1 based on bad faith



### Non usus

- BOIP decided that proof of use did not show genuine use

Appeal  
pending

### Bad faith

- Same proof submitted to defend the commercial logic of the new Baidu registration

Granted and  
no appeal







## Genuine use – key takeaways

- Make sure the list of goods and services does not contain any vague terms.
- Not every activity of a company also involves a service provided to third parties (transportation, recording and producing music).
- In appeal, additional proof of use can be submitted (BenCJ Bala Booste)
- In case of trademarks for which genuine use is not proven, a new filing of an identical trademark could be in bad faith if no commercial logic is demonstrated.



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# 5. Procedural



## Nielson – Conclusion of AG BenCJ

### – Nielson vs Mr Nielson

1. BOIP cancellation | partially awarded | appeal by claimant @ BOIP
2. @ BenCJ: defendant states in his response to appeal the BOIP decision for as far as he lost
  - BenCJ: Is incidental appeal possible in this procedure?
  - BenCJ: Seeks advice of AG
3. AG: Not possible | Also not before in Brussels and The Hague | 2021 decisions allowing this “not to be considered as settled case law”





## ALKU



ALKU

ALKU NATIONALE  
KUNSTSTOF KOZIJN DAGEN

- Both active in the field of window frames
- Extensive lists of goods and services on both sides





## Decision BOIP



- Under linings in the list mean limitation
- Under lining in both lists and solely stating these goods are identical or similar does not meet the requirement to substantiate the claim
- Identity doesn't have to be motivated/ specified

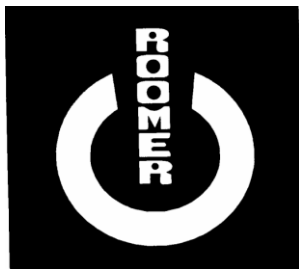


Granted  
Partially





## ROOMER. Decision BOIP



ROOMER

- Goods in classes 32 and 33
- Genuine use shown
- LoC (undisputed)

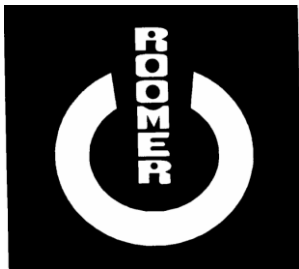
What  
would you  
do? ;-)

Appealed





## Benelux Court of Justice



ROOMER

- Filing an opposition is an act of governance
- If several owners, one of them may act
- Provided that his national law allows this
  
- Argument may be raised in appeal without having been raised before BOIP earlier

Granted





## Procedural issues – key takeaways

- Filing an appeal as a reply after the appeal period of 2 months is (probably) not possible.
- Under linings or highlighting of goods & services may very well indicate a limitation and can then be considered as such, but this can be confusing.
- If an invoked trademark is owned by several, one of them may file a cancellation or opposition based upon it.





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## Q&A

Discussion, questions, answers...





## Final tips

- BOIP's new Guidelines on Opposition are ready and published on our website!
- This presentation including key takeaways and an overview of case law will be made available on the website.
- Register for our New Year's Reception: **Thursday 18 January 2024**





## Thank you for joining!

- PE Points
  - Confirmation e-mail
  - Code word (for the BMM)
- Survey, please give us your feedback
- Wishing you a great holiday season!
- Codeword = CROMPOUCE



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# Claiming PE points: In the BMM portal only!



BMM intranet.bmm.nl/nl/app/education/create

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## BMM INTRANET

### Aanmelden voor nieuwe opleidingspunten

Opleiding

Aantal punten

Omschrijving

Datum opleiding behaald

Opleidingsbewijs 1  No file chosen

Opleidingsbewijs 2  No file chosen

Opleidingsbewijs 3  No file chosen

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# Thank you for watching our webinar!

Please fill in the **survey** and help us improve our services.



# Cases and where to find them

ALKU	BOIP	20-Jun-23	2017903		MOOOI	BenCJ (2nd)	18-Apr-23	C 2021/19	-
B52	BOIP	19-Jul-19	2016350	-	NIELSON	BenCJ (AG)	17-Jan-23	C 2021/18	-
B52	BenCJ (2nd)	15-Dec-22	C 2021/4	-	Pam Pluvial	GC	22-Mar-07	T-364/05	ECLI:EU:T:2007:96
Baidu	BOIP	29-Dec-22	3000316		Pirañam	GC	11-Jul-07	T-443/05	ECLI:EU:T:2007:219
baidu	BOIP	29-Dec-22	3000312		ROOMER	BOIP	02-Jul-21	2015354	
BAIDU	BOIP	29-Dec-22	3000315		ROOMER	BenCJ (2nd)	18-Apr-23	C 2021/12	
BAIDU	BOIP	02-Feb-23	3000314		SILBERQUELLE	CJ EU	15-Jan-09	c-495/07	ECLI:EU:C:2009:10
BAIDU Europe	BOIP	29-Dec-22	3000313		Sissi Rossi	GC	01-Mar-05	T-169/03	ECLI: EU:T:2005:72
Bala Booste	BenCJ (2nd)	28-Jun-23	c 2021/11	-	SITEL	BenCJ (2nd)	18-Oct-22	C 2021/13	-
Bala Booste	BOIP	30-Jun-21	2015668	-	Slaap ID	BOIP	30-Jun-23	3000381	
Cator	BOIP	31-Jan-23	2016750		TUBACEX	BenCJ (2nd)	23-Jan-23	C 2021/17	-
CIPRIANI	BOIP	14-Dec-20	3000060	-	TUBACEX	BOIP	12-Aug-21	2015903	-
CIPRIANI	BenCJ (2nd)	15-Feb-23	C 2021/3	-	UBO	BOIP	13-Jan-22	3000217	-
Falke	BenCJ (2nd)	23-Jan-23	c 2022/1	-	UBO	BenCJ (2nd)	18-Apr-23	C 2022/4	-
Falke	BOIP	23-Nov-21	2015650	-	Vapona	BOIP	20-Feb-23	2017476	-
Flugbörse	CJ EU	23-Apr-10	C-332/09 P	ECLI:EU:C:2010:225	Volumia	BOIP	27-Jun-23	3000402	
Grill'd	BOIP	27-Jul-23	2018268		Volumia!	BOIP	27-Jun-23	3000403	
MOOOI	BOIP	20-Aug-21	2015776	-	Volumia! (fig)	BOIP	27-Jun-23	3000404	

