

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**CANCELLATION DECISION**  
**N° 3000132**  
**van 8 March 2021**

**Claimant:** **SAHM GMBH & Co KG**  
Westerwaldstrasse 13  
56203 HÖHR-GRENZHAUSEN  
Germany

**Representative:** **V.O.**  
Carnegieplein 5  
2517 KJ The Hague  
Netherlands

*against*

**Defendant:** **GUANGDONG SHANGMING INDUSTRIAL CO., LTD.**  
UNIT 401, 402, FLOOR 4, BUILDING 3,  
PHASE 2, STANDARD INDUSTRIAL UNIT,  
NO.7 SPIRAL 4TH ROAD,  
INTERNATIONAL BIOLOGICAL ISLAND,  
GUANGZHOU  
GUANGDONG  
China

**Representative:** **K.O.B. N.V.**  
President Kennedypark 31c  
8500 Kortrijk  
Belgium

**Contested trademark: International trademark 1459845**

**sama  
GLAS**

## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 17 July 2019 the claimant filed an application for a declaration of invalidity with the Benelux Office for Intellectual Property (hereinafter: "the Office") in accordance with Article 2.30bis (1)(b), invoking the relative ground for invalidity as stated under Article 2.2ter (1)(b) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP")<sup>1</sup>, namely that there exists a likelihood of confusion on the part of the public due to the identity with, or similarity to the earlier trademark(s) and the identity or similarity of the goods or services covered by the trademarks.

2. The claim for invalidity is based on the earlier international trademark 545507, designating among others the Benelux, of the word trademark 'sahm', filed on 17 November 1989 and registered for goods and services in classes 21, 34, 40 and 42.

3. According to the register the claimant is the actual holder of the earlier trademark invoked.

4. The claim for invalidity is aimed at the Benelux designation of international registration 1459845,

**sama  
GLAS**

of the combined word-/figurative trademark, filed on 15 November 2018 and registered on 4 July 2019 for goods in class 21.

5. The cancellation claim is directed against all goods of the contested trademark and based on all goods and services of the trademark invoked.

6. The language of the proceedings is English.

### B. Course of the proceedings

7. The cancellation claim is admissible and was notified by the Office to the parties on 19 August 2019. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was submitted. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 9 June 2020.

## II. ARGUMENTS

### A. Claimant's arguments

8. The claimant explains that he produces and sells glass since 1900. SAHM is one of the world's leading suppliers of glasses for the beverage industry.

9. As to the comparison of the trademarks, the claimant states first that SAHM is a surname with no particular meaning. SAMA may refer to the city in Hainan China. GLAS is Dutch for glass and is thus descriptive for the goods of interest in class 21, glassware, according to the claimant.

10. Visually, the trademarks are similar to a high degree. The letter font of SAMA GLAS is not special and no other visual elements are used. Therefore, the claimant is of the opinion that the comparison should be made between SAHM and SAMA (the most important part in the contested trademark given the descriptive character of the word GLAS). Both trademarks start with the letters SA. Furthermore, the trademarks also contain the letter M, resulting in three out of four letters that are identical.

11. Phonetically, the trademarks are similar to a high degree. The claimant explains that, although the trademark invoked consists of one syllable and the dominant element of the contested trademark SAMA of two, both will sound very similar when pronounced quickly.

12. As for the comparison of the goods and services, the claimant observes that the goods of the defendant are identical or highly similar to the goods and services of the claimant. Some of the goods could also be seen as complementary since they are all used on the table or in kitchens (at home or in restaurants). Therefore, the claimant states that their value and purpose are the same.

13. The claimant remarks that the goods and services at issue target both the public at large and the professional public. Accordingly, the level of attention of the relevant consumer varies from average to higher than average.

14. Considering the above, a serious risk of confusion must be confirmed. Therefore, the claimant asks that the contested trademark is cancelled for the Benelux and that the defendant be ordered to compensate the claimant's fees and costs incurred.

15. At the request of the defendant the claimant provided proof of use.

## **B. Arguments of the defendant**

16. With regard to the proof of use submitted by the claimant, the defendant observes that all use only refers to one type of product, glasses. Therefore, he believes that the only goods that should be taken into account for this opposition are *'utility and decorative objects made of glass for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses'*.

17. As for the comparison of the trademarks, the defendant observes that there are clear visual differences between the trademarks. The defendant is of the opinion that the claimant errs in only comparing SAMA and SAHM as the trademarks should be considered as a whole, as registered. Because of the different elements and the visually different styling, the defendant believes that the trademarks differ and cannot be considered similar.

18. Phonetically, the trademarks differ. The defendant explains that the trademark invoked will be pronounced as one syllable, SAAM, while the contested trademark is pronounced in three syllables as SA-MA-GLAS. The common element SA will be pronounced differently, long (SAA) in the trademark invoked and short (SA) in the defendant's trademark. Thus, the pronunciation of the trademarks is dissimilar.

19. Conceptually, both trademarks have no meaning, and thus no comparison is possible here.

20. For the comparison of the goods and services, the defendant is of the opinion that only the goods in class 21 are relevant here. Moreover, as mentioned above, only glass/glassware can be invoked as a basis for this opposition. The defendant agrees that the goods 'glassware' are similar to glass. However, the goods 'kitchen utensils' are different to 'glass', as well as 'daily pottery [including pots, bowls, plates, jars, pots, casseroles, pots, pottery utensils] as they serve a different purpose and will be sold via different channels. The defendant states that the claimant does not have any registration or use for goods similar to 'works of art of porcelain; cleaning instruments, hand-operated; coffee percolators, non-electric' so these goods are dissimilar.

21. According to the defendant, the relevant public of the goods at issue is the public at large.

22. The defendant states that as the trademarks are different, one of the necessary conditions is not fulfilled and the opposition must be rejected. The global impression between the trademarks is different, thus the public will not be confused about the origin of the goods at hand. The defendant also mentions that since the contested trademark was registered in 2018 in the Benelux, there has never been any conflict.

23. The defendant refers to caselaw from the European Union Intellectual Property Office ('EUIPO') in similar cases where no likelihood of confusion was established in order to support his line of reasoning.

24. Based on the foregoing, the defendant concludes that there will be no likelihood of confusion or association when consumers are confronted with these trademarks. Therefore, the cancellation claim should be rejected, and the costs of these proceedings should be borne by the claimant.

### **III. DECISION**

#### **A.1 Regarding the ground set out in Article 2.2ter (1)(b) BCIP – relative grounds for invalidity and likelihood of confusion**

25. Pursuant to Article 2.30bis (1)(b)(i) BCIP the proprietor of an earlier trademark may file an application for invalidation with the Office against a registered trademark based on the relative grounds for invalidity referred to in Article 2.2ter BCIP.

26. According to Article 2.2ter (1) BCIP *"a trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where: (...) b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*

27. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd

Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

### **Proof of use**

28. The application for a declaration of invalidity was filed on 17 July 2019. The contested trademark was filed on 15 November 2018. The claimant invokes a trademark that was filed and registered on 17 November 1989.

29. In accordance with articles 2.30quinquies (1) and (2), 1 and 2.23bis, 1 BCIP the trademark invoked must have been put to genuine use during the five years preceding the date on which the application for cancellation of the contested trademark was filed if, at that time, the trademark invoked was already registered for a period exceeding that five-year period. Furthermore, it must also have been put to genuine use during the five years preceding the application date of the contested trademark if the trademark invoked was registered at that time for a period exceeding that five years.

30. Both situations occur here. Therefore, there are two relevant, overlapping, periods during which proof of use of the trademark invoked should be demonstrated. The relevant periods are from 17 July 2014 to 17 July 2019 and from 15 November 2013 to 15 November 2018.

31. After a first analysis of the proof of use provided the Office establishes that it only concerns part of the goods and services for which the trademark invoked is registered. The Office also notes that the defendant does not contest genuine use for part of the goods of the trademark invoked. The defendant states that all proof of use refers to one type of product, glasses, and that the only goods that should be taken into account for this opposition are *'utility and decorative objects made of glass for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses'* (see paragraph 16). Therefore, the Office will first proceed with an analysis of the likelihood of confusion based on the above-mentioned goods of the trademark invoked for which genuine use is not contested by the defendant.

## **A.2.2 Comparison of the trademarks and goods**

### **Comparison of the goods**

32. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be considered. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary (Canon, already cited).

33. With the comparison of the goods of the earlier trademark invoked and the goods against which the cancellation is filed, the goods are only considered on the basis of what is expressed in the register and for which proof of use has been submitted.

34. The goods to be compared are the following:

Cancellation based on:	Cancellation directed against:
Cl 21 Utility and decorative objects made of glass for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.	Cl 21 Daily glassware [including cups, plates, pots, cylinders]; kitchen utensils; drinking vessels; daily porcelain [including pots, bowls, plates, pots, jars, cans]; daily pottery [including pots, bowls, plates, jars, jars, pots, casseroles, pots, pottery utensils]; works of art of porcelain, ceramic, earthenware, terra-cotta or glass; enamelled glass, not for building; bottles; cleaning instruments, hand-operated; coffee percolators, non-electric.

35. The goods *drinking vessels* are mentioned in both lists and are thus identical.

36. The goods *Daily glassware [including cups, plates, pots, cylinders]; bottles* of the defendant are identical to the claimant's goods. The word 'especially' in the list of goods of the claimant, indicates that the specific goods are only examples of items included in the category, and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (The word 'especially' is a synonym for the words 'in particular'. Regarding the use of 'in particular' see EGC, Nu-Tride, T-224/01, 9 April 2003, EU:T:2003:107). As a result, the defendant's different types of either utility glass products that are used in the household can all be included in the claimant's utility objects made of glass for household and industrial use (for gastronomy). According to established case law, if the goods of the earlier trademark also contain goods that are mentioned in the contested trademark, these goods are considered identical (see EGC, Fifties, T-104/01, 23 October 2002, ECLI:EU:T:2008:399 and EGC, Arthur et Felicie, T-346/04, 24 November 2005, ECLI:EU:T:2005:420). As the claimant's goods cover the specific goods of the defendant, they are identical.

37. The goods *works of art of porcelain, ceramic, earthenware, terra-cotta or glass; enamelled glass, not for building* of the defendant are similar to the claimant's *decorative objects made of glass for household and industrial use (for gastronomy)*. Works of art are essentially decorative in nature and purpose. Irrespective of their material content, the goods of the claimant and the defendant are decorative goods. As such both may be available alongside one another in the same stores and sold to the same public. Furthermore, utility and decorative glass objects for the household or gastronomy can be made of enamelled glass. They can thus have the same manufacturers, as well as the same distributors. These goods are therefore deemed similar.

38. The goods *kitchen utensils; daily porcelain [including pots, bowls, plates, pots, jars, cans]; daily pottery [including pots, bowls, plates, jars, jars, pots, casseroles, pots, pottery utensils]; coffee percolators, non-electric* of the defendant are similar to the *utility objects made of glass for household and industrial use (for gastronomy)* of the claimant. All of these goods concern utensils for the household, kitchen or gastronomy. Irrespective of the material that they are made of, they can be manufactured by the same companies and be distributed through the same trade channels. Their nature is similar. Besides that, they also target the same public. Therefore, these goods are considered similar.

39. The goods *cleaning instruments, hand-operated* of the defendant are not similar to the goods of the claimant. The goods of the claimant concern utility and decorative objects for household or industrial use (for gastronomy). The contested trademark's goods in class 21, on the other hand, are intended for cleaning purposes. It is true that both types of goods can be used in the household, however, this is not enough to render them similar. Their purpose is different, as is their nature. Therefore, the relevant public will not expect these goods to be manufactured and sold by the same undertakings and thus they are dissimilar.

#### *Conclusion*


40. The goods of the defendant are either identical, similar or dissimilar to the goods of the claimant.

#### **Comparison of the trademarks**

41. The wording of Article 5 (1)(b) of the Directive (cf. article 2.2ter (1)(b) BCIP) according to which "there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark" shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, Sabel, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

42. Global assessment of the visual, aural or conceptual similarity of the trademarks in question, must be based on the overall impression given by the trademarks, bearing in mind, in particular, their distinctive and dominant components (CJEU, Sabel and Lloyd, already cited).

43. The trademarks to be compared are the following:

<b>Earlier trademark:</b>	<b>Contested trademark:</b>
sahm	

#### *Conceptual comparison*

44. Even if part of the Benelux public could recognize the trademark invoked as a surname, the Office finds that the majority of the public will perceive the word as having no particular meaning.

45. In general, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003, ECLI:EU:T:2003:184). In the contested trademark, the verbal element GLAS can be perceived as the Dutch or German word for 'glass'. Because of this, as well as the proximity to the English word 'glass', the word GLAS will be understood by all of the Benelux public. In relation to the relevant goods of the defendant the word GLAS will be interpreted by the public as non-distinctive as it can describe a characteristic of these goods which concern glassware or goods made of glass. Because the word GLAS is

not to be considered distinctive and (therefore) dominant in the global impression of the contested trademark, more weight should be given to the word SAMA. The word SAMA will be perceived by the Benelux public as having no meaning and thus not as a reference to a Chinese city.

46. Conceptually, a comparison is not relevant as the trademark invoked and the dominant element in the contested trademark have no meaning.

#### *Visual comparison*

47. The trademark invoked is a word mark consisting of one word of four letters 'sahm'. The contested trademark is a combined word/figurative mark consisting of two words SAMA and GLAS written underneath one another in a bold black capital letters. The fact that the trademark invoked is represented in capital and lower-case letters, is irrelevant here (EGC, babilu, T-66/11, 31 January 2013, ECLI:EU:T:2013:48).

48. Where a trademark consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods or services in question by quoting their name than by describing the figurative element of the trademark (EGC, SELENIUMACE, T-312/03, 14 July 2005, ECLI:EU:T:2005:289). The graphical aspect of the contested trademark can be qualified as rather marginal, merely consisting of a specific layout of the letters, which the consumer will perceive as adornment (EGC, Dieselit, T-186/02, 30 June 2004, ECLI:EU:T:2004:197). Due to its position and distinctive character, the relevant public will perceive the verbal element SAMA as the dominant element of the contested trademark.

49. The consumer normally attaches more importance to the first part of a trademark (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). In this case the first two letters of the trademarks at issue are identical, SA. Furthermore, the trademarks also share the letter M. The dominant element of the contested trademark differs because of the elimination of the letter H and the addition of the letter A and because of the use of a graphical element.

50. Visually the trademarks are similar to a certain degree.

#### *Aural comparison*

51. The trademark invoked is pronounced in one syllable as SAM. The letter H will not be perceived in the pronunciation as it is a silent letter. The dominant element of the contested trademark will be pronounced as two syllables SA-MA. The public will not pronounce the word GLAS, which is the second word of the contested trademark, because the average consumer will not pronounce a caption or legend and will generally abbreviate a trademark in order to make it easier to pronounce (EGC, Green by Missako, T-162/08, 11 November 2009, ECLI:EU:T:2009:432 and EGC, BROTHERS by CAMPER, T-43/05, 30 November 2006, ECLI:EU:T:2006:370).

52. Aurally the consumer will also attach more importance to the first part of trademark (EGC, Mundicor, already cited). Both trademarks share the same first letters SAM in their pronunciation. The dominant element of the contested trademark only differs because of the addition of a letter A at the end. A possible difference in the pronunciation of the first letter A in both trademarks, respectively long as AA in the trademark invoked or short as A in the contested trademark, is insufficient to alter the overall similar pronunciation.

53. Aurally the trademarks are similar.



## Conclusion

54. A conceptual comparison is not relevant. Visually the trademarks are similar to a certain degree. Aurally the trademarks are similar.

### **A.3 Global assessment**

55. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the trademarks are important factors.

56. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question. In the present case, the goods which are found to be identical or similar are different kinds of household and decorative goods. These goods are directed at the public at large whose level of attention is deemed to be normal.

57. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). The earlier trademark has no meaning for any of the goods from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

58. Account must be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. Finally, a likelihood of confusion among part of the relevant public is sufficient to grant an application for a declaration of invalidity invoking the relative ground for invalidity as stated under Article 2.2ter (1)(b) (EGC, Hai/Shark, T-33/03, 9 March 2005, ECLI:EU:T:2005:89).

59. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be considered, particularly between the level of similarity of the trademarks and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

60. Visually the trademarks are similar to a certain degree and aurally the trademarks are similar. A conceptual comparison is not relevant. Based on the foregoing, the Office finds that the relevant public might believe that the identical and similar goods come from the same undertaking or from economically-linked undertakings.

### **B. Other factors**

61. With reference to the parties' request that the other party should bear all costs of the proceedings (see paragraphs 14 and 24), the Office considers that the cancellation proceedings with the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.30ter (5) BCIP, as well as rule 1.44 (2) IR, only stipulates in this respect that an amount equalling the basic cancellation fee shall be borne by the losing party in case the cancellation is justified or rejected in its entirety.

62. The defendant mentions that the contested trademark has already been registered since 2018 in the Benelux and that there has never been any conflict yet (see paragraph 22). The defendant seems to refer to the legal concept of estoppel due to acquiescence in article 2.30septies (1) BCIP that stipulates where the proprietor of an earlier trademark as referred to in article 2.2ter (2) or (3) (a) has acquiesced, for a period of five successive years, in the use of a later registered trademark while being aware of such use, that proprietor shall no longer be entitled on the basis of the earlier trademark to apply for a declaration that the later trademark is invalid in respect of the goods or services for which the later trademark has been used, unless registration of the later trademark was applied for in bad faith. This means the defendant should prove that the contested trademark had been used in the Benelux for at least five consecutive years, that the claimant was aware of this or could have reasonably been aware of this, and that the claimant could have stopped the use but nevertheless tolerated it (CJEU, *Budweiser*, C-482/09, 22 September 2011, EU:C:2011:605, § 44). However, the defendant presents no such evidence.

63. The defendant refers to caselaw from EUIPO in similar cases in order to support his arguments in this case (see paragraph 23). It must however be recalled that the Office is not bound by other and/or its previous decisions. Each case has to be dealt with separately and with regard to its particularities (see, by analogy, *EGC, Curon*, T-353/04, 13 February 2007, ECLI:EU:T:2007:47).

### **C. Conclusion**

64. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion for the identical and similar goods.

65. Because the outcome of the decision would not have been any different even if genuine use would have been demonstrated for the other goods and services of the trademark invoked, the Office did not proceed with a complete examination of the proof of use provided.

### **IV. DECISION**

66. The cancellation application with number 3000132 is partly justified.

67. International registration 1459845, with regard to the Benelux, is declared invalid for the goods deemed identical and similar:

- Class 21: Daily glassware [including cups, plates, pots, cylinders]; kitchen utensils; drinking vessels; daily porcelain [including pots, bowls, plates, pots, jars, cans]; daily pottery [including pots, bowls, plates, jars, jars, pots, casseroles, pots, pottery utensils]; works of art of porcelain, ceramic, earthenware, terra-cotta or glass; enamelled glass, not for building; bottles; coffee percolators, non-electric.

68. International registration 1459845, with regard to the Benelux, will remain registered for the dissimilar goods:

- Class 21: Cleaning instruments, hand-operated.

69. Neither of the parties shall pay the costs in accordance with article 2.30ter (5) BCIP in conjunction with rule 1.44 (2) IR, as the opposition is only partly justified.

The Hague, 8 March 2021



Tineke Van Hoey  
(*rapporteur*)

Diter Wuytens

Pieter Veeze

Administrative officer: Diter Wuytens