

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY  
CANCELLATION DECISION  
N° 3000166  
of 25 August 2020**

**Claimant:** **Henkel AG & Co. KgaA**  
Henkelstr. 67  
40589 Dusseldorf  
Germany

**Representative:** **CMS DeBacker**  
Terhulpesteenweg 178  
1170 Brussels  
Belgium

*against*

**Defendant:** **Good-Bye S.à.r.l.**  
A rue Wiltheim 11  
5465 Waldbredimus  
Luxembourg

**Representative:** /

**Contested trademark: Benelux registration 1392047**

GOODBYE YELLOW

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 31 October 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)(a), invoking the absolute grounds stated under Article 2.2bis (1)(b) and (c) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP")<sup>1</sup>, namely that the contested trademark is devoid of any distinctive character and is descriptive.

2. The invalidity claim is directed against Benelux trademark registration 1392047, which was filed by the defendant on 13 March 2019 and was registered on 6 June 2019 for goods in classes 3 and 16, and which consists of the following word mark:

GOODBYE YELLOW

3. The invalidity application is directed against all of the goods in class 3 and part of the goods in class 16 of the contested trademark.

4. The language of the proceedings is English.

### **B. Course of the proceedings**

5. The cancellation request is admissible and was notified by the Office to the parties on 21 November 2019. During the administrative phase of the proceedings both parties filed arguments. 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 17 February 2020.

## **II. ARGUMENTS**

### **A. Claimant's arguments**

6. The claimant argues that the goods covered by the contested trademark concern cosmetics of all types and are aimed at a broad public that consists of both average consumers and professionals like beauticians. As these goods are fast-moving consumer goods, the level of attention is considered normal.

7. According to the claimant it is reasonable to expect that the relevant public in the Benelux has sufficient knowledge of the English language to understand the meaning of both the individual words GOODBYE and YELLOW, but also the meaning of the combination GOODBYE YELLOW.

8. The claimant is of the opinion that the contested trademark is descriptive in relation to the contested goods. The words GOODBYE YELLOW on a cosmetic product (for which the contested trademark is registered) will inform the relevant user that by using this cosmetic product he/she says goodbye to or gets rid of the yellowish blemishes and discolorations of hair, teeth or skin, for which the

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<sup>1</sup> This decision shall always refer to the laws and regulations applicable on the date of the decision, except in the case of provisions which have undergone a material change during the proceedings and which are relevant to the decision.

product is intended. The claimant submits evidence to support his claim that there are many products in the market that use the phrase GOODBYE in combination with a negative characteristic, like stress, cellulite, damage, redness, stretch marks, yellow hair, make-up, blackhead, ingrown hair, dryness. The word 'goodbye' describes the intended purpose of the product, that is getting rid of the characteristic. The average consumers buying a cosmetic product called GOODBYE YELLOW know that this product will help them say 'goodbye' to yellow discolorations or blemishes, according to the claimant.

9. Especially as regards hair care products, GOODBYE YELLOW is purely descriptive. There are many products on the market that aim to remove yellow discolorations from blonde hair. According to the claimant, yellowness in coloured blonde hair is a common problem. Such yellow discolorations can be counteracted by particular shampoos that help to say 'goodbye' to the residues responsible for the yellow (instead of blonde) hair. The claimant refers to several websites discussing this problem, showing that 'yellow' is a characteristic that one wants to say goodbye to.

10. Furthermore, the claimant refers to a decision by the European Union Intellectual Property Office ('EUIPO') dated 26 December 2018 regarding the EU trademark GOODBYE YELLOW filed for the same goods in class 3 and 16 as those against which the present cancellation is directed. EUIPO refused the trademark on the grounds of descriptiveness and lack of distinctive character. The claimant explains that this decision was confirmed by the Board of appeal of EUIPO dated 11 September 2019. He cites the Board's reasoning regarding the descriptiveness of the trademark for the goods in class 3 and 16. This decision is also in line with earlier refusal decisions by EUIPO according to the claimant.

11. It thus follows that the words GOODBYE YELLOW will be understood as referring to the nature and purpose of all of the designated goods in class 3 as well as the contested goods in class 16, as a result of which the contested trademark is descriptive.

12. The claimant considers that the contested trademark lacks distinctive character. As said trademark has a clearly descriptive meaning, the impact of the mark on the relevant public will primarily be descriptive, thus eclipsing any impression that the mark could indicate an origin. The claimant recalls that EUIPO's invalidity division, as well as the Boards of Appeal fully concurred with these observations.

13. Therefore, the claimant requests that the Office declares the contested trademark invalid for all goods in class 3 and for 'tissues of paper for removing make-up' in class 16.

## **B. Defendant's arguments**

14. The defendant explains that he is the owner of the trademark 'good bye' in Europe and many other countries. He started selling cosmetic products since 2009 under the sign 'good bye' and is selling a shampoo under the name 'good bye orange blue' since 2015.

15. In 2017 the claimant filed an application for the EU trademark GOODBYE YELLOW. The defendant asked the claimant to stop using this trademark or to negotiate a license agreement as both parties using the term GOODBYE in combination with a colour for shampoos would cause confusion. The claimant however did not want to negotiate and this created the basis for all further disputes and this cancellation.

16. According to the defendant, the claimant let its application GOODBYE YELLOW lapse in Europe and argued against the identical EU trademark application of the defendant later. Furthermore, the

claimant filed the same trademark GOODBYE YELLOW for skin and hair care products in the USA. In order to fulfil the use requirement applicable there, the claimant introduced a picture of his shampoo GOODBYE YELLOW. While in a native English speaking market there seems enough distinctiveness for the claimant to file, register and demonstrate use of the trademark GOODBYE YELLOW for his shampoo, he is arguing here exactly the opposite. The defendant thus questions whether the claimant truly believes that the trademark is not distinctive or if he is just trying to avoid getting into trouble in infringement proceedings and therefore argues here in a way completely opposite from how he is acting abroad.

17. The defendant is of the opinion that the contested trademark is clearly not descriptive for the opposed goods. He refers to the claimant's argument that GOODBYE YELLOW on a cosmetic product would inform the relevant consumer that it helps to say goodbye to/get rid of yellow blemishes and discolorations of skin, hair or teeth and he also refers again to several examples given by the claimant of products using the term GOODBYE in the same sense, like 'good bye stress', 'good bye cellulite (by Nivea)', 'GOODBYE DAMAGE (L'Oreal)' and 'Good Bye Make-Up'. The defendant points out that the first three examples are trademarks registered with other national, regional and international offices. Given these registrations, the defendant states that the general distinctiveness of the wording 'goodbye', whether used in combination with or without additional terms, is acknowledged. As for the last example, the defendant successfully filed an infringement action against it.

18. Furthermore, the defendant argues that the contested trademark is not really descriptive, as the sign only informs about a potential result of the use of the product, not about the product itself. Said trademark cannot be descriptive for shampoos as no targeted customer who hears the sentence GOODBYE YELLOW or sees it on neutral packaging would know that it concerns a shampoo, according to the defendant. He continues that even though there is a product, here a shampoo, which may have an effect to neutralize yellow, the term GOODBYE YELLOW itself is not descriptive. Neither the shampoo itself is yellow nor does one literally say to someone 'goodbye yellow'. Thus, this combination of words cannot be descriptive and the contested trademark has to be registered at least for shampoos.

19. The defendant explains that the claimant sells a product called 'Schwarzkopf Professional goodbye yellow - neutralizing wash/shampooing neutralisant'. The product is sold under their well-known umbrella trademark 'Schwarzkopf' which is known for shampoos, and they even add the term 'shampoo' to make it clear that it is a shampoo.

20. For these reasons, the defendant concludes that the contested trademark was correctly registered, is distinctive and is not descriptive for the registered goods and services.

### **III. GROUNDS FOR THE DECISION**

#### **A.1 Legal framework**

21. Pursuant to Article 2.30bis (1)(a) BCIP an application for invalidity may be filed with the Office based on the grounds set out in Article 2.2bis (1) BCIP.

22. It follows from the case-law that the relevant date for the purposes of examining, in the context of an application for a declaration of invalidity based on Article 2.30bis (1)(a) BCIP, the compliance of a trademark with Article 2.2bis (1) of the BCIP is that of the date of filing of the application for registration (see by analogy CJEU, *Flugbörse*, 23 April 2010, C-332/09 P, ECLI:EU:C:2010:225). The Supreme Court

of the Netherlands ruled that in the absence of transitional provisions, the assessment of the distinctive character of a registered trademark should take account of the factual situation at the time of application, but apply the law applicable at the time of assessment (Supreme Court of the Netherlands, BACH FLOWER REMEDIES, 20 January 2012, ECLI:NL:HR:2012:BU7244).

## **A.2 Regarding the ground set out in Article 2.2bis (1)(c) - Descriptive trademarks**

23. According to Article 2.2bis (1)(c) BCIP, trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or performance of the service, or other characteristics of the goods or services shall not be registered or, if registered, shall be liable to be declared invalid.

24. According to settled case-law, the prohibition of registration of descriptive signs or indications (cf. Article 2.2bis (1)(c) BCIP) pursues an aim that is in the public interest, which requires that such signs and indications may be freely used by all. The provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trademarks (see CJEU, DOUBLEMINT, 23 October 2003, C-191/01 P, ECLI:EU:C:2003:579; CHIEMSEE, 4 May 1999, C-108/97 and C-190/97, ECLI:EU:C:1999:230 and LINDE AND OTHERS (three-dimensional shape of product mark), 8 April 2003, C-53/01 to C-55/01, ECLI:EU:C:2003:206).

25. A trademark is descriptive under Article 2.2bis (1)(c) BCIP, if it is composed of elements that may be used to describe the (characteristics of) the goods or services indicated. This follows from the wording of said article. It is not necessary to establish whether the trademark is actually used in a descriptive way on the market. If at least one of its possible meanings designates a characteristic of the goods or services concerned (CJEU, DOUBLEMINT, already mentioned) it is descriptive and should not be registered.

26. The descriptive character of a sign must be assessed, firstly, by reference to the goods and services concerned and, secondly, in relation to the perception of that sign by the relevant public, which is composed of consumers of those goods and services (see CJEU, judgment POSTKANTOOR, 12 February 2004, C-363/99, ECLI:EU:C:2004:86) who are reasonably well-informed and reasonably observant and circumspect.

27. The invalidity claim is directed against all of the goods in class 3 and part of the goods in class 16 of the contested trademark. These goods for which the disputed sign is registered are the following:

- Cl 3 Soaps and gels; Tissues impregnated with cosmetics; Cosmetics preparations; Hair shampoo; Aloe vera preparations for cosmetic purposes; Deodorants and antiperspirants; Beauty milk; Pedicure preparations; Suncare lotions [for cosmetic use]; Body cleaning and beauty care preparations; Cosmetics containing keratin; perfumery; Cotton swabs for cosmetic purposes.; Cosmetics containing panthenol; Non-medicated cosmetics and toiletry preparations; Beauty balm creams; Cosmetic kits; Cosmetics for children; Cosmetics and cosmetic preparations; Beauty lotions; Body shampoos; Cosmetic preparations for slimming purposes; essential oils; Facial preparations; Suncare lotions; Cosmetics in the form of

oils; Cotton balls for cosmetic purposes; Non-medicated soaps; non-medicated hair lotions; Body and facial oils; Make-up; Sunblock; Body gels; Beauty serums; Cosmetic preparations for body care; Hair removal and shaving preparations; Multifunctional cosmetics; Impregnated cleaning pads impregnated with cosmetics; Non-medicated cosmetics; Hair preparations and treatments; Skin, eye and nail care preparations; Sun protection preparations; Baby suncreams; Cotton wool for cosmetic purposes; Cosmetics for personal use; Body cleansing foams; Aloe vera gel for cosmetic purposes; Beauty care cosmetics; Cosmetics; Body and facial creams [cosmetics]; Cuticle cream; Cleaning pads impregnated with cosmetics; Paper hand towels impregnated with cosmetics; Cosmetics containing hyaluronic acid; Body and facial gels [cosmetics]; Bath preparations; Cuticle removers; shampoos; Organic cosmetics; Toiletries; Natural cosmetics.

- Cl 16 Tissues of paper for removing make-up.

28. The relevant public for the goods and services of the contested trademark consists of both average consumers as well as professional users.

29. A trademark composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive of the characteristics of those goods or services for the purposes of article 2.2bis (1) (c) BCIP, unless there is a perceptible difference between the trademark and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the trademark creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (see CJEU, BIOMILD, 12 February 2004, C-265/00, ECLI:EU:C:2004:87).

30. The contested trademark is a word mark composed of two English words: GOODBYE and YELLOW. The word GOODBYE is a conventional expression used to express good wishes when parting or at the end of a conversation<sup>2</sup>. Although it is most often used when parting from a person the word GOODBYE can also be used at the loss or rejection of things or ideas<sup>3</sup>. The word YELLOW refers to a colour<sup>4</sup>. These words are basic English words that will be understood by the relevant public.

31. The defendant believes that the contested trademark is not really descriptive, as the sign only informs about a potential result of the use of the product, not about the product itself (see paragraph 18). As already mentioned above a trademark, if registered, shall be liable to be declared invalid if it consists exclusively of signs or indications which may serve, in trade, to designate, amongst others, the intended purpose of the goods or other characteristics of the goods. The fact that the contested trademark can inform the relevant public about the potential result of the goods, which in fact is a certain characteristic of the goods, establishes the descriptiveness of said trademark. The defendant himself thus acknowledges the descriptive character of the contested trademark. His argument that neither the shampoo itself is yellow, nor does one literally say to someone 'goodbye yellow' cannot change that the contested trademark describes one of the characteristics of the goods.

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<sup>2</sup> <https://www.lexico.com/definition/goodbye>.

<sup>3</sup> <https://www.collinsdictionary.com/dictionary/english/goodbye>;

<https://www.thefreedictionary.com/goodbyes><

<sup>4</sup> <https://www.lexico.com/definition/yellow>.

32. The present cancellation action is directed against all of the goods in class 3, which concern different types of cosmetics and toiletry preparations, and against the goods tissues of paper for removing make-up in class 16. As is illustrated by the evidence submitted by the claimant (see paragraph 8), the Office finds with regard to the word GOODBYE that there are many cosmetic products on the market that use the word GOODBYE in combination with a negative characteristic, like stress, cellulite, damage (in relation to damaged hair), redness, stretch marks, make-up, blackheads, ingrown hair. Given this use of the word GOODBYE in trade as well as its meaning as an expression used at the loss or rejection of things, the word GOODBYE can be used here in relation to the contested cosmetic products and toiletry preparations in order to indicate that they can help with the elimination of something, like for example a negative characteristic.

33. The word YELLOW in the contested trademark can be perceived by the consumer as the negative characteristic the contested goods in classes 3 and 16 are helping the consumer to get rid of. Yellowness occurring on skin, hair, teeth and nails is cosmetically often perceived as unpleasant or unwanted. It also follows from the evidence presented by the claimant in relation to hair care that yellowness in coloured blonde hair is perceived as a common problem (see paragraph 9). As a result, numerous cosmetic products are available on the market that claim to help eliminate or remove yellow tones or yellowness. The relevant public buying a cosmetic product or toiletry preparation called GOODBYE YELLOW will understand that these goods will help to eliminate/say 'goodbye' to yellow discolorations or blemishes of the skin, teeth, hair or nails. The contested trademark thus describes a desirable characteristic of the contested cosmetic goods in classes 3 and 16 which is decisive for the relevant consumer's purchase decision.

34. As a result, the Office concludes that the contested trademark is descriptive for the goods in classes 3 and 16 against which the present cancellation is directed.

### **A.3 Regarding the ground set out in Article 2.2bis (1)(b) - Trademarks devoid of distinctive character**

35. The trademarks referred to in Article 2.2bis (1)(b) BCIP are those that are regarded as incapable of performing the essential function of a trademark, namely that of identifying the commercial origin of the goods or services in question, thus enabling the consumer without any possibility of confusion, to distinguish the product or service from others which have another origin (see CJEU, DAS PRINZIP DER BEQUEMLICHKEIT, 21 October 2004, C-64/02 P, ECLI:EU:C:2004:645; BioID, 15 September 2005, C-37/03 P, ECLI:EU:C:2005:547 and EUROHYPO, 8 May 2008, C-304/06 P, ECLI:EU:C:2008:261).

36. The distinctive character of a trademark must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (see e.g. CJEU, VORSPRUNG durch Technik, 21 January 2010, C-398/08 P, ECLI:EU:C:2010:29; Procter & Gamble v OHIM (three-dimensional tablets for washing machine or dishwashers), 29 April 2004, C-473/01 P, ECLI:EU:C:2004:260, and judgments EUROHYPO and POSTKANTOOR, both already cited).

37. Furthermore, it is settled case-law that a sign's lack of distinctive character cannot arise merely from the finding that it does not look unusual or striking. Registration of a sign as a trademark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trademark. It suffices that the trademark should enable the relevant public to

identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings (see CJEU, SAT.2, 16 September 2004, C-329/02 P, ECLI:EU:C:2004:532).

38. It is in the light of the aforementioned considerations that it must be ascertained whether the contested trademark lacks distinctive character, as claimed by the claimant.

39. The contested trademark will be perceived as an indication describing the purpose of the goods at issue and thus not as an indication of the commercial origin of the goods (see paragraphs 30 to 34). As it is established that the contested trademark is descriptive, said trademark is also devoid of any distinctive character in the sense of Article 2.2bis 1(b) BCIP. Descriptive designations lack distinctiveness by definition (CJEU, POSTKANTOOR, already cited).

## **B. Other factors**

40. The defendant refers to trademarks similar or identical to the contested trademark that have been registered (see paragraphs 14, 16 and 17). Although decisions made by other offices can be indicative, they can never be decisive for the examination of the merits of this case and thus they can never result in the contested trademark no longer being descriptive. The Office points out that these cancellation proceedings are based on the descriptiveness and the lack of distinctiveness of the contested trademark. Therefore, considerations concerning the actual use of other signs by the claimant (see paragraph 19) or the earlier use of other signs by the defendant (see paragraph 14) are not relevant.

41. The defendant mentions that the claimant registered GOODBYE YELLOW as a trademark in the USA and that the claimant also filed for protection of the trademark GOODBYE YELLOW in the EU and then later argued against the identical EU trademark application by the defendant. The defendant thus questions whether the claimant believes that the trademark is not distinctive (see paragraph 16). The legal positions of the parties in other proceedings cannot have an impact on the position of the parties in these proceedings. The Office will only consider the parties' arguments as they were brought forward during the course of these proceedings. These cancellation proceedings are limited to the specific grounds as invoked by the claimant. Other possible grounds of defence or objection cannot play a role here. To that end the parties should file legal proceedings before a court or initiate separate cancellations proceedings before the Office, whichever one he deems most suited.

## **C. Conclusion**

42. Based on the foregoing the Office is of the opinion that the contested trademark is descriptive and is thus devoid of any distinctive character with regard to the goods against which the present invalidity action is directed.

## **IV. DECISION**

43. The cancellation application with number 3000166 is justified.

44. Benelux registration 1392047 will be declared invalid for all the goods against which the invalidity action is directed:



- Class 3: All goods.
- Class 16: Tissues of paper for removing make-up.

45. Benelux registration 1392047 will be upheld for all the goods against which the cancellation action was not directed:

- Class 16: Decoration and art materials and media; Bags and articles for packaging, wrapping and storage of paper, cardboard or plastics.

46. The defendant shall pay the claimant 1,420 euros in accordance with Article 2.30ter (5) BCIP in conjunction with rule 1.44 (2) IR, as the cancellation application is upheld in its entirety. This decision constitutes an enforceable order pursuant to Article 2.30ter (5) BCIP.

The Hague, 25 August 2020



Tineke Van Hoey  
(*rapporteur*)

Camille Janssen

Pieter Veeze

Administrative officer: Diter Wuytens