

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
CANCELLATION DECISION
N° 3000304
of 16 May 2023

Claimant: **MUSTANG - Bekleidungswerke GmbH + Co. KG**
Karl-Kurz-Straße 44/1
74523 Schwäbisch Hall
Germany

Representative: **Cöster & Partner Rechtsanwälte mbB**
Theodorstraße 9
90489 Nürnberg
Germany

against

Defendant: **Hästens Sängar AB**
Box 130
731 23 KÖPING
Sweden

Representative: **NautaDutilh N.V.**
Beethovenstraat 400
1082 PR Amsterdam
Netherlands

Contested trademark: International registration 1579478



I. FACTS AND PROCEEDINGS

A. Facts

1. On 19 May 2021 the claimant filed an application for cancellation with the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") in accordance with Article 2.30bis (1)(b) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP"), invoking the relative grounds for invalidity as stated under Article 2.2ter (1)(b) BCIP, namely that there exists a likelihood of confusion on the part of the public.

2. The application for cancellation is based on the earlier EU trademark 357392 of the figurative mark



, filed on 3 January 1997 and registered for goods and services in the classes 3, 9, 14, 16, 18, 24, 25, 26, 28, 30, 32, 34 and 41.

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

4. The application for cancellation is aimed at the Benelux part of International registration 1579478



of the figurative mark , filed on 19 November 2020 and registered on 11 March 2021 for goods in the classes 20, 24 and 25.

5. The cancellation claim is directed against all goods in class 25 of the contested trademark and is based on all goods and services of the invoked earlier trademark.

6. The language of the proceedings is English.

B. Course of the proceedings

7. The application for cancellation is admissible and was notified by the Office to the parties on 4 June 2021. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant, the claimant filed proof of use. Furthermore, the parties requested jointly to suspend the proceedings for four months. 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 2 August 2022.

II. ARGUMENTS

A. Claimant's arguments

8. The claimant states that the relevant signs are both figurative trademarks. Regarding the phonetic comparison between the contested trademark and the trademark invoked, it should be noted that a figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or

conceptual content can be described orally. The defendant argues that in case the public would aurally describe the two figurative marks, they both would be called "horses". Therefore, according to the claimant the signs are aurally identical or at least very similar.

9. The claimant argues that the signs are visually similar to the extent that they coincide in the presentation of horses. More precisely said, both trademarks provide a graphical representation of horses that are in motion. The representation shows the horses with each horse's head on the right side of the pictorial representation and its tail on the left side. In both signs, the horses move to the right and the figurative element shows only the silhouette of the horses in motion. Only the tail and the horse's mane are detailed illustrated in both marks. Furthermore, both trademarks show horses without a rider. The claimant argues that there are a lot of different trademarks which show a horse but always with a rider, a polo player or a knight. According to the claimant, the illustration of the horse in motion is the dominant element and in this dominant element the signs coincide. Therefore the signs are visually identical or at least very similar.

10. According to the claimant, the trademarks have an identical meaning. Both signs show representations of horses in motion, which are identically illustrated as silhouettes. Therefore, the trademarks are conceptually identical.

11. With regard to the goods concerned, the claimant states that the goods are identical.

12. The claimant also argues that the invoked 'horse' trademark is not descriptive for the goods in class 25. Therefore, the mark is distinctive per se. In addition, the claimant states that the trademark invoked is well-known in the European territory and therefore has increased distinctiveness.

13. According to the claimant, because the goods are identical or at least very similar, the contested trademark should maintain a greater distance from the trademark invoked. However, this is not the case. On the contrary, the signs are similar to a very high degree.

14. The claimant concludes that there is a likelihood of confusion and therefore requests that the Office cancels the registration of the contested trademark with regard to the goods concerned.

Proof of use and additional arguments

15. In his arguments, the defendant requests proof of use. Subsequently, the claimant submits proof of use, also addressing the arguments of the defendant regarding the likelihood of confusion.

B. Arguments of the defendant

16. The arguments of the defendant also contain a request for proof of use of the trademark invoked. According to the defendant, in the light of this request, it is not yet possible to make an appropriate comparison between the relevant goods. However, according to the defendant, if the claimant would succeed in showing that he has genuinely used the trademark invoked, this could only relate to specific goods that are not similar to the goods of the contested sign.

17. Regarding the aural similarity, the defendant argues that a comparison is not possible because both signs are purely figurative signs. In contrary to what the claimant states, the defendant points out that the meaning that the image evokes, or its description, should be assessed under the visual and conceptual comparison. In addition, the defendant argues that the mere fact that the public may recognise or associate a shape with a word (e.g. "horse") not necessarily means that this word will also be

pronounced. In this case, according to the defendant, it is not possible to assert that both trademarks will be referred to by using the same wording, such as "horses" or "racing horses". This means that the signs are not aurally similar.

18. The defendant remarks that the signs at issue are purely figurative marks which merely have in common the appearance of an animal (i.e. horses). As a result, when comparing these signs visually, no importance can be given to generic features such animals have in common (e.g. the appearance of legs, heads, manes and tail). Instead, the specific appearance and presentation of the horses is key in the assessment of the visual comparison.

19. The defendant states that the visual similarities described by the claimant are merely the result of a concept and generic features of horses, which is an incorrect assessment. According to the defendant, the signs show a completely different graphical composition. On the one hand, the trademark invoked represents a device mark with two horses, a black horse in the foreground and a white horse in the background, which are overlapping. It is clear that these horses are in a fast movement, as can be seen from the tails and manes standing straight out after the horses, the running legs and the running positions of the horses (body and head in a forward leaning position).

20. On the other hand, the contested sign represents a square device, which is divided into four squares (boxes) of the same size, each in a different colour (i.e. different shades of blue and white) and all with a woven structure. The upper right box and bottom left box each depict the same horse in white. Already this graphical representation alone results in a significant difference from an overall visual point of view. Furthermore, the horses in the trademark invoked are clearly running/galloping fast forward (i.e. a dynamic movement), whereas the horses in the contested sign are not running/galloping but trotting and not in a rush (i.e. a more static movement). In addition, the respective horses are different in e.g. the shape of the manes, noses, heads, in the position of the legs and in the tails. As a result, the signs are visually dissimilar.

21. The defendant points out that the fact that both signs include the mere concept of a horse in motion is, as said, not sufficient to find that they are visually similar. Contrary to what the claimant states, the defendant argues that there are many other device marks showing a horse without a rider in class 25.

22. With regard to the conceptual comparison, the defendant states that the signs are different. On the one hand, the trademark invoked evokes the meaning of two side-by-side fast moving horses which are running/galloping, as if they are in a competition/race. On the other hand, the contested sign will be perceived differently by the relevant public, namely as a blue-white check pattern with two trotting horses. The horses in the contested sign are not racing. It merely consists of a horse in duplicate, which has a tall and proud appearance, trotting controlled and in no rush.

23. The defendant further argues that even if the signs would be considered conceptually similar, according to standard case law that follows from the case Puma/Sabel, the mere analogous semantic content of the signs is not a sufficient ground for concluding that there is a likelihood of confusion.

24. The defendant disputes that the trademark invoked would be well known. This statement has not been substantiated, let alone evidenced by the claimant. As a result, the degree of distinctiveness cannot be higher than normal. The defendant also states that the mere representation of horses for the goods concerned may indicate the intended purpose, such as clothing intended to be used by horse riders and for horse riding. For this reason, the trademark invoked has a low degree of distinctiveness.

25. According to the defendant, because it concerns clothing and when these goods are purchased the choice of the item of clothing is primarily made visually, the visual aspect of the signs concerned plays a

greater role in the global assessment of the likelihood of confusion. As a result, the striking visual differences between the signs make that the signs in their overall impression are dissimilar.

26. The defendant requests that the Offices rejects the cancellation and orders the claimant to pay all costs.

Proof of use and additional arguments

27. Regarding the proof of use the defendant argues that the evidence submitted does not show that the trademark invoked is genuinely used, because – in short – the majority of the evidence is in German, it does not show use of the trademark, it does not show use in the relevant period nor in the relevant territory and the evidence does not concern all the goods for which the trademark invoked is registered. Furthermore, the defendant replies to the claimant's arguments regarding the likelihood of confusion.

III. DECISION

A.1 Likelihood of confusion

28. 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 trademark which ranks after his own in accordance with the provisions in Article 2.2ter BCIP.

29. Article 2.2ter (1) BCIP stipulates, as far as relevant in this case: "*a trademark shall, [...], if registered, 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.*"¹

30. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.²

31. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.³

Comparison of the goods

32. In assessing the similarity of the goods or services concerned, all the relevant factors relating to these goods or services themselves should be considered. These factors include, inter alia, their nature,

¹ Article 2.2ter, 1 (b) BCIP implements article 5, 1 (b) 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. A similar provision can be found in article 8, 1 (b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

² CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

their end-users and their method of use and whether they are in competition with each other or are complementary.⁴

33. In comparing the goods or services, the goods or services shall be considered in the terms set out in the register, and not the actual or intended use.⁵

34. The goods to be compared are the following:

Cancellation based on:	Cancellation directed against:
CI 25 Clothing, corsets, sportswear, clothing of leather, belts, shoes, footwear for sports, headgear.	CI 25 Clothes, namely pyjamas, night gowns and robes; footwear, namely slippers and down socks; headwear, namely night caps and sleep masks.

35. The goods of the contested sign all fall under the broad category 'clothing, shoes and headgear', for which the trademark invoked is registered. For this reason, the goods are identical.⁶

Comparison of the trademarks

36. To assess the degree of similarity between the conflicting signs, their visual, phonetic and conceptual similarity should be determined. Although the comparison must be based on the overall impression that the signs leave in the memory of the relevant public, it must nevertheless be made in the light of the intrinsic qualities of the conflicting signs.⁷

37. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.⁸ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.⁹

38. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, inter alia, their distinctive and dominant components.

⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁵ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).



⁶ General Court (EU) 23 October 2002, T-104/01, ECLI:EU:T:2008:399, point 33 (Fifties) and General Court (EU) 24 November 2005, T-346/04, ECU:EU:T:2005:420, points 36-39 (Arthur et Félicie).

⁷ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 (Equivalenza).

⁸ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

⁹ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

39. The trademarks to be compared are the following:

Earlier trademark:	Contested trademark:
	

Phonetic comparison

40. The Office agrees with the defendant that a phonetic comparison is not relevant, because the signs concerned are purely figurative (see paragraph 17). After all, a figurative trademark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question.¹⁰ Consequently, since the trademarks do not contain any word elements, there is no need to carry out a phonetic comparison.

Visual comparison

41. The trademark invoked is a figurative mark, containing the image of a galloping horse. Contrary to what the defendant argues (see paragraph 19), the Office finds that the public is more likely to perceive the trademark as depicting one black horse with a white contour. The contested sign is a figurative trademark that consists of a square divided into four equal compartments, each in a different colour blue. The upper right and lower left compartment contain an identical white/light-blue horse.

42. Both signs contain the silhouette of a horse. However, the horses are depicted in a very different way. The trademark invoked only shows a galloping horse, of which all four legs of the horse are bent and do not seem to touch the ground. The head of the horse clearly stretches forward. The contested sign consists of four squares in which two identical horses are depicted. Furthermore, the depiction of the horses differs in the shape of the manes, the tails and in the position of the legs. Furthermore, neck and head of the horses in the contested sign are pulled back. The overall impression of the movement of the horse is therefore different, namely that the horse of the trademark invoked is running/galloping and showing much more speed than the horses in the contested sign, which takes a more 'defensive' or 'proud' posture while trotting.

43. In the light of the above, the signs are, at most, visually similar to a low degree.

Conceptual comparison

44. The public will perceive both signs as the image of a horse or two horses in motion. However, as stated above, the appearance and the motion of the horses are different. For this reason, the Office finds that trademark and sign are, at most, conceptually similar.

¹⁰ General Court (EU) 12 December 2019, T-266/19, ECLI:EU:T:2019:854, points 38-39 and the case-law mentioned there (Gastivo).

Conclusion

45. The marks are conceptually similar and visually similar to a low degree. A phonetic comparison is not possible.

A.2 Global assessment

46. The global assessment must be made by reference to the average consumer, who is well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.¹¹ In the present case, the goods covered are aimed at the public at large for which the level of attention is deemed to be normal.

47. The greater the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.¹² In this context, the claimant states that the distinctiveness of the trademark invoked is enhanced, because it is well-known (see paragraph 12). However, the claimant has not submitted any arguments nor evidence to substantiate this argument. For this reason, this claim cannot be taken into account.

48. The defendant argues that the trademark invoked has a weak distinctive character, because it indicates the intended purpose of the goods concerned. However the Office finds that the trademark invoked is also registered for goods that are not intended for horse riding, which are identical to the contested goods. With regard to these goods the invoked trademark has to be considered as having normal distinctiveness as it does not describe the characteristics of the goods in question.

49. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.¹³ In this case the goods are identical, the signs are visually similar to a low degree, conceptually similar and a phonetic comparison is not possible.

50. Although the signs share a similar concept (a moving horse), the mere fact that the signs are conceptually similar is not sufficient to give rise to a likelihood of confusion.¹⁴ The Office finds that the different representations of the horses is very noticeable, as almost every aspect of the horses are shaped and stylized differently (see paragraph 42). This, together with the additional figurative elements in the contested sign, leads to a different overall impression. The Office also considers that in the present case the goods concerned are clothing, which means that the visual aspect plays a greater role in the global assessment of the likelihood of confusion.¹⁵

¹¹ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹² CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 (Equivalenza) and the case-law mentioned there.

¹⁴ CJEU 11 November 1997, C-251/95, ECLI:EU:C:1997:528, point 25-26 (Sabel).

¹⁵ General Court (EU) 6 October 2004, T-117/03 to T-119/03 and T-171/03, ECLI:EU:T:2004:293, point 50 (New Look) and General Court (EU) 21 December 2021, T699/20, ECLI:EU:T:2021:928, point 110-111 (Eagle).

51. In the light of the above, the Office finds that the notable visual differences are sufficient to conclude that the relevant public would not assume that the identical goods bearing the contested sign originate from the same or from economically-linked undertakings. The overall differences between the trademark invoked and the contested sign are so clearly perceivable and sufficient as to exclude any likelihood of confusion between them.

B. Other factors

52. The additional arguments submitted by the claimant when submitting the proof of use and the defendant's response to these arguments (see paragraphs 15 and 27) will not be considered. Indeed, Rule 1.31 IR strictly regulates when parties have the opportunity to submit arguments and a response to them.

53. The defendant request that the other party be ordered to pay all costs (see paragraph 26). It should, however, be recalled that, in the context of cancellation proceedings, there is no provision for an order to pay the costs incurred. There is only an allocation of the costs set at the fixed amount of the cancellation fee if the application is granted or rejected in full.

C. Conclusion

54. Based on the abovementioned factors and considerations, the Office finds that there is no likelihood of confusion.

55. Since the cancellation is already rejected based on the assessment of likelihood of confusion, there is no need to proceed to the assessment of the proof of use.

IV. DECISION

56. The application for a declaration of invalidity is rejected.

57. International registration 1579478 is upheld.

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

The Hague, 16 May 2023



Eline Schiebroek
(*rapporteur*)

Camille Janssen

Tomas Westenbroek

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