



**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
CANCELLATION DECISION
N° 3000379
of 23 June 2023**

Claimant: **KENZO, société anonyme**
18 Rue Vivienne
75002 Paris
France

Representative: **Novagraaf Belgium N.V./S.A.**
187 Chaussée de la Hulpe
1170 Brussels
Belgium

against

Defendant: **EDMACO International S.A.**
Bahnhofstrasse 10
6300 Zug
Switzerland

Representative: **Chiever BV**
Barbara Strozzilaan 201
1083 HN Amsterdam
The Netherlands

Contested trademark: Benelux registration 1423700

KINZO

I. FACTS AND PROCEEDINGS

A. Facts

1. On 30 November 2021 the claimant filed an application for a declaration of invalidity 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 with earlier trademark rights.

2. The application for a declaration of invalidity is based on the following earlier trademarks:

- European Union trademark registration 000720706 of the word KENZO, filed on 12 December 1997 and registered on 20 February 2001 for goods and services in the classes 3, 8, 9, 11, 12, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 33, 34, 35, 38, 40, 41 and 42.

- International registration 1517097, designating the European Union, of the combined word/figurative mark , filed on 26 December 2019 and, after limitation, registered for goods and services in classes 9, 14, 18, 25 and 35.

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

4. The application for a declaration of invalidity is aimed at Benelux registration 1423700 of the word mark KINZO, filed on 26 August 2020 and registered on 8 December 2020 for goods in class 25. During the proceedings defendant limited the goods in class 25 to 'Workwear; Socks (being workwear)'.

5. The claim for a declaration of invalidity is directed against all goods of the contested trademark and is based on all goods in class 25 of the invoked earlier trademarks.

6. The language of the proceedings is English.

B. Course of the proceedings

7. The application for a declaration of invalidity is admissible and was notified by the Office to the parties on 6 December 2021. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use of the European Union trademark was submitted by claimant. The course of the proceedings meets the requirements as stated in Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 18 August 2022.

II. ARGUMENTS

A. Claimant's arguments

8. According to the claimant, the signs at stake have the same structure since they are composed of one word. They also share 4 letters in the same order and in the same place. In the earlier semi-figurative trademark the letters are perfectly recognizable and readable. According to the above, claimant concludes that the signs are visually similar to a high degree.

9. Taking into account that the signs share 4 letters out of 5 in the same order and in the same position, the pronunciation will therefore be highly similar. Moreover the letter that differs in the contested trademark is I instead of E, so that the sound of the first syllable will be very close. Claimant concludes that the signs are phonetically similar to a high degree.

10. Conceptually, neither of the signs as a whole has a meaning for the public. Accordingly, a conceptual comparison between the signs is not possible.

11. The goods are identical or at least highly similar. The contested goods are included in the broader category of clothing for which the invoked trademarks are registered.

12. In the present case, the contested trademark covers mass market products that target the public at large. The trademarks invoked also cover the same range of mass market products that target the public at large. Considering the nature of these goods, the public has an average level of attention.

13. The earlier KENZO trademarks are inherently distinctive. In addition, claimant mentions that the defendant could not ignore that famous trademarks named KENZO for clothes were already existing. Claimant describes the history of the famous KENZO trademark and submits evidence of its reputation. In addition, claimant refers to several judgments of the General Court in which the reputation of the KENZO trademark for classes 3, 18 and 25 is recognized. Consequently, the distinctiveness of the earlier trademark must be seen as high or at least above normal.

14. Based on the foregoing, claimant concludes that there is a likelihood of confusion and that the Benelux trademark KINZO must be declared invalid for all goods. Claimant also asks the Office to take a decision on the costs in favour of the claimant.

B. Arguments of the defendant

15. The defendant firstly emphasizes that KINZO is not a new trademark, because it has been used for decades already. The trademark KINZO has been in use since 1968 and in the Benelux at least since 1971. The trademark is mainly in use for electrical and mechanically driven tools for agriculture and garden use. Defendant refers to European Union trademark 000349944 KINZO. Defendant is now simply extending its trademark protection to workwear (including socks) after having broadened an already existing product line. From this it follows that both marks already peacefully co-exist since the seventies.

16. With regard to the visual comparison defendant mentions that although the semi-figurative mark is mainly a word mark, the figurative elements may not be omitted. Defendant states that the root of both words is different, namely KEN vs. KIN. In addition, the trademarks are 'one word marks' and in these cases the relevant public is generally able to perceive all of the letters and thus the existing differences. Although four letters are the same, the letter I in the middle is noticeable different when seeing, reading and interpreting both words. Defendant concludes that the trademarks as a whole are visually not similar.

17. Phonetically the trademarks are also not similar. The relevant public will pronounce the E in KENZO and the I in KINZO differently. The E will be pronounced like a soft 'EH' and the I more like a hard 'I'. The relevant public also tends to focus more on the beginning of the trademarks, which is different.

18. The words in the trademarks do not have a specific meaning for the relevant public so comparing the marks conceptually is not possible.

19. Defendant filed a restriction for the goods to workwear and socks (being workwear). Defendant cannot deny that the goods are similar with regard to their character of 'clothing' and that their common

purpose is to protect the body. However, the goods differ in their nature, purposes, characteristics, methods of use, distribution channels, manufacturers and sale outlets. The goods of the contested mark are really working clothes. They are used to protect against possible exposure in the working environment. They are also manufactured in a different way, due to the special and high protective purposes of those goods. Moreover, the relevant public is different. The relevant public of the trademarks invoked is the broad public with an average degree of attention, while the public of the contested goods is a specific public for workwear which has a higher degree of attention. The KINZO goods are sold in special stores, namely garden centers, constructions markets etc. The KENZO goods are exclusively sold in clothing shops (of the slightly higher segment). Therefore, the distribution channels are also completely different. The mere fact that both goods are clothing or fall under the same broad category does not make the goods identical or highly similar.

20. The earlier trademarks are inherently distinctive and thus the degree of distinctiveness is average. Even if the Office should decide that the earlier marks have a greater distinctive character because of their reputation, there is still no risk of likelihood of confusion. It follows from case law that in principle the greater the recognition of the mark, the greater the likelihood of confusion. However, the risk of confusion may also be less if the mark enjoys a high reputation, because the relevant public will immediately recognize a well-known trademark.

21. Defendant concludes that taking all relevant factors into account, for the goods in question, there is no likelihood of confusion on the part of the public. According to defendant the invalidity action against the trademark KINZO must be rejected.

22. In reply to the submitted evidence of use with regard to the invoked European Union trademark defendant argues and explains that the proof of use is insufficient.

III. DECISION

A. Likelihood of confusion

23. 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.

24. 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

25. 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 earlier trademark come from the same undertaking or, where appropriate, from undertakings which are economically linked.²

26. According to settled case-law of the Court of Justice of the European Union (hereinafter: CJEU), the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering

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).

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

27. For reasons of procedural economy, the Office proceeds below with the comparison of the International registration invoked and the contested trademark.


Comparison of the trademarks

28. To assess the degree of similarity between the conflicting trademarks, their visual, aural and conceptual similarity should be determined. Although the comparison must be based on the overall impression that the trademarks leave in the memory of the relevant public, it must nevertheless be made in the light of the intrinsic qualities of the conflicting signs.⁴

29. 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.⁵

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

31. The trademarks to be compared are⁶:

Earlier trademark:	Contested trademark:
	KINZO

Visual comparison

32. The International trademark invoked is a combined word/figurative mark consisting of one word with five letters, KENZO. The word element is depicted in black bold stylized letters.

33. The contested trademark is a word mark consisting of one word of five letters, KINZO.

34. 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

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

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

⁵ 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).

⁶ See above under 27.

trademark.⁷ In this case, the figurative elements of the earlier trademark will not go unnoticed to the average customer. However, the attention of the public will particularly be focused on the word KENZO.

35. Both trademarks consist of five letters. Four letters of the invoked trademark appear at the same place and in identical order in the contested trademark. Only the second letter in the signs differs. As the trademarks are rather short, this difference is more noticeable. The figurative elements, which appear only in the trademark invoked, also differ.

36. Given the above, the Office finds that the trademarks are visually similar.

Aural comparison

37. As regards the aural comparison, it must be borne in mind that, strictly speaking, the aural representation of a combined word/figurative mark is the same as that of its word elements, irrespective of the graphical characteristics of those components, which are more subject to examination in the context of the visual aspect of the sign.⁸

38. Both trademarks consist of two syllables: KEN-ZO versus KIN-ZO. The pronunciation of the signs matches in length and rhythm. The pronunciation of the second syllable is identical. The pronunciation of the first syllable is slightly different (E versus I).

39. Consequently, the Office finds that the trademarks are aurally highly similar.

Conceptual comparison

40. The Office agrees with the parties that the trademarks do not have a meaning and that a conceptual comparison is not possible (see above under 10 and 18).

Conclusion

41. The trademarks are visually similar and aurally highly similar. A conceptual comparison is not possible.

Comparison of the goods and services

42. 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, their end-users and their method of use and whether they are in competition with each other or are complementary.⁹

43. 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.¹⁰

44. The goods to be compared are the following:

⁷ General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 and the case-law mentioned there (Smarter Travel).

⁸ General Court (EU) 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

⁹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹⁰ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

Cancellation based on:	Cancellation directed against:
<i>International registration 1517097</i> Class 25 Clothing; underwear; lingerie; sweaters; shirts; tee-shirts; belts (clothing); scarves; neckties; shawls; vests; skirts; waterproof clothing; overcoats; coats; jackets; suspenders; trousers; jeans; pullovers; dresses; belts (clothing); headbands [clothing]; sashes for wear; gloves; tights; socks; bathing suits; bathrobes; pajamas; nightgowns; shorts; shoes, boots, slippers; headwear; caps; Beanies; Hats.	Class 25 Workwear; Socks (being workwear).

45. According to settled case law goods are considered to be identical when the goods of the contested trademark fall within the broader category of goods of the trademark invoked.¹¹ In this case, this situation occurs. 'Workwear' and 'Socks (being workwear)' fall under the broader category of 'Clothing' for which the invoked International trademark is registered.¹² The Office furthermore notes that 'Workwear' and 'Sock (being workwear)' can have the same method of manufacturing and distribution channels as 'Clothing'. The fact that this does not apply to the specific workwear and socks of defendant (see above under 19) cannot be considered in opposition proceedings. As mentioned above under 43, the comparison of the goods is based on registry data. The particular circumstances in which the goods and services covered by the marks are actually marketed have, as a matter of principle, no impact on the assessment of the likelihood of confusion because they may vary in time depending on the wishes of the proprietors of the trademarks.¹³

46. Considering the above, the Office finds that the goods are identical.

Global assessment

47. 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.¹⁴ In the present case, the goods of the invoked trademark are aimed at the public at large for which the level of attention is deemed to be normal. The goods of the contested trademark could be used by the public at large and by the professional public, with a higher level of attention. In case the public consists of different categories of consumers, the consumers with the lowest level of attention should be considered.¹⁵ The Office therefore assumes the level of attention in this case to be normal.

48. 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.¹⁶ In

¹¹ General Court (EU) 2 February 2022, T-694/20, ECLI:EU:T:2022:45, point 31 and the case-law mentioned there (Labello).

¹² See also Board of Appeal EUIPO 2 December 2019, Case R 544/2018-4, point 47 (North Ways).

¹³ CJEU 15 March 2007, C-171/06 P, ECLI:EU:C:2007:171, point 59 (Quantum).

¹⁴ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁵ Benelux Court 18 April 2023, C-2021/19, point 26 (ZM Zo mooi).

¹⁶ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

the present case, parties agree that the invoked International trademark is inherently distinctive (see above under 13 and 20). Consequently, the Office assumes that the International trademark invoked has a normal distinctiveness. The Office will not assess whether the invoked International trademark has acquired enhanced distinctiveness through use as argued by claimant (see above under 13), because this will not affect the outcome of this decision.

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.¹⁷

50. In this case the trademarks are visually similar and aurally highly similar. The goods concerned are identical. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that there is a likelihood of confusion in the sense that the public may believe that the goods designated by the International trademark invoked and the goods of the contested trademark come from the same undertaking or, as the case may be, from undertakings which are economically link.

B. Conclusion

51. Based on the abovementioned factors and considerations, the Office finds that there exists a likelihood of confusion. The application for a declaration of invalidity is justified.

52. Since the claim for invalidity will be rewarded on the basis of the International trademark invoked, it is not necessary to assess the submitted proof of use and claim regarding the European Union trademark invoked.

¹⁷ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there (Equivalenza).

IV. DECISION

53. The application for a declaration of invalidity is justified.

54. Benelux trademark registration 1423700 is declared invalid.

55. 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 application is justified in its entirety. This decision constitutes an enforceable order pursuant to Article 2.30ter (5) BCIP.

The Hague, 23 June 2023



Marjolein Bronneman
(*rapporteur*)

Camille Janssen

Yvonne Noorlander

Administrative officer: Rémy Kohlsaet