



BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2009040
of 17 December 2015

Opponent: **Think Schuhwerk GmbH**
Hauptstrasse 35
4794 Kopfing
Austria

Representative: **Helga Pernez**
27, Rue du Pont Neuf
75001 Paris
France

Invoked right: **International registration 801405**



against

Defendant: **Brett Holding B.V.**
Haarlemmerstraat 102 B
1013 EW Amsterdam
Netherlands

Representative: **Novagraaf Nederland B.V.**
Hoogoorddreef 5
1101 BA Amsterdam
Netherlands

Contested trademark: **Benelux application 1271883**



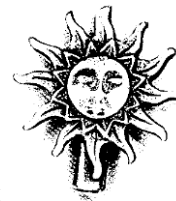
I. FACTS AND PROCEEDINGS**A. Facts**

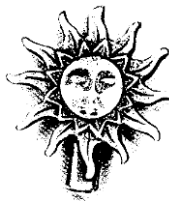
1. On 16 July 2013 the defendant filed an application for a trademark in the Benelux for the figurative mark



for goods and services in classes 14, 16, 18, 24, 25, 31, 34, 35 and 43. This application was processed under number 1271883 and was published on 7 August 2013.

2. On 9 September 2013 the opponent filed an opposition against the registration of the application. The



opposition is based on International registration 801405 of the figurative mark , filed on 8 April 2003 and registered for goods in classes 18, 24 and 25.

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

4. The opposition is directed against all goods in classes 18, 24, 25, as well as part of the services in class 35 of the contested application and is based on all goods relating to the trademark invoked.

5. The grounds for opposition are those laid down in article 2.14, 1 (a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified to the parties on 16 September 2013.

8. The adversarial phase of the procedure started on 17 November 2013. The Benelux Office for Intellectual Property (hereinafter: "the Office") sent the notification of the commencement of the proceedings on 23 December 2013 to the parties, giving the opponent the opportunity to substantiate the opposition by submitting arguments and documents no later than 23 February 2014.

9. On 3 February 2014, the opponent submitted arguments to substantiate the opposition. These arguments were sent by the Office to the defendant on 25 March 2014, giving the defendant the opportunity to submit a reply no later than 25 May 2014.

10. The defendant informed the Office on 20 May 2014 that he does not wish to respond to the arguments of the opponent and that he requests that the opponent submits proof of use regarding the trademark invoked.

11. On 10 June 2014 the Office requested that the opponent submits the proof of use no later than 10 August 2014.

12. The opponent submitted the proof of use requested on 8 August 2014. The proof of use was sent by the Office to the defendant on 12 August 2014, giving the defendant the opportunity to submit a reply no later than 12 October 2014.

13. The defendant filed a reply to the proof of use submitted, as well as a reply to the arguments of the opponent on 9 October 2014. As this reply was not submitted in duplicate, the Office requested on 14 October 2014 that the defendant should submit a second identical copy, no later than 14 December 2014. The defendant submitted a copy of his reply on 5 November 2014. This reply was sent by the Office to the opponent on 11 November 2014.

14. Each party filed its observations within the time limits imposed by the Office.

15. The Office has sufficient information to come to a decision on the opposition.

II. ARGUMENTS

16. The opponent filed an opposition at the Office under article 2.14, 1 (a) BCIP, in accordance with the provisions of article 2.3 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

17. The opponent argues that the goods against which the opposition is filed are either identical or similar, because they fall within the general category of goods for which the trademark invoked is registered. With regard to the services, the opponent argues that these are complementary to the goods in classes 18, 24 and 25.

18. The opponent states that both figurative trademarks represent a sun with a human face. For this reason, according to the opponent, the signs are visually similar and conceptually identical.

19. With regard to the aural comparison, the opponent states that both signs are purely figurative without any verbal element. According to the opponent, the public will perceive the signs as representations of the sun with a human face. For this reason, the opponent argues that an important part of the public is likely to use the same words if they refer to the signs.

20. According to the opponent, any visual differences are neutralized by the fact that the signs are conceptually and phonetically identical or at least very similar, as well as the identity with or strong similarity between the goods and services at issue.

21. The opponent concludes that there exists a likelihood of confusion and requests that the Office should reject the registration of the contested sign.

22. At the request of the defendant, the opponent has also submitted proof of use regarding the trademark invoked.

B. Defendant's arguments

23. The defendant argues that the proof of use submitted by the opponent does not substantiate the assertion that the trademark invoked has been used in the five years prior to the filing of the contested sign. According to the defendant, it is not possible to determine whether certain documents relate to the relevant period or to the territory of the Benelux. Furthermore, the defendant states that the image of the opponent's sign is used as decoration and not as a trademark. The defendant also argues that the invoices that have been submitted do not prove that the trademark invoked is sufficiently used in the Benelux.

24. The defendant confirms that the goods and services for which the contested sign is registered can be considered similar to the goods of the opponent.

25. With regard to the comparison of the signs, the defendant states that although both signs represent a sun with a human-like face, there are several visual differences, including the colour, facial expression of the sun and the shape of the flames. Furthermore, the defendant states that it is not uncommon to use an image of a sun for a figurative or a combined figurative/verbal sign with regard to the goods and services mentioned in classes 18, 24, 25 and 35. For this reason, according to the defendant, even a small difference in the graphic stylization of the signs can be sufficient to conclude that the signs are not similar and that there is no likelihood of confusion.

26. The defendant concludes that the signs are sufficiently different to co-exist and that the opponent has not substantiated the genuine use of the trademark invoked. The defendant requests that the Office should reject the opposition.

III. DECISION

A.1 Proof of use

27. Articles 2.16, 3 (a) and 2.26, 2 (a) BCIP and rule 1.29 Implementing Regulations (hereinafter "IR") stipulate that the right invoked should be put to genuine use in the Benelux territory within a period of five years prior to the publication date of the sign against which the opposition is filed.

28. Given the fact that the right invoked was registered more than five years prior to the publication date of the contested sign, the defendant's request that proof of use is submitted is justified.

29. The contested sign was published on 7 August 2013. Therefore the opponent was required to show use of the right invoked, during the period from 7 August 2008 to 7 August 2013 ('the relevant period') in the Benelux for all goods in classes 18, 24 and 25, as well as the services "*Retail and wholesale services, including retail and wholesale provided electronically through internet, in relation to the sale of household linens, clothing, headgear and footwear*", in class 35.

30. Following rule 1.29 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the earlier trademark for the goods and services on which the opposition is based.

In general

31. In accordance with the decision of the European Court of Justice (hereinafter referred to as "ECJ") in the case *Ansul* (11 March 2003, C-40/01) there is genuine use of a trademark if the mark is used in accordance with

its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered. This is done in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (see also General Court of the European Union (hereinafter referred to as "EGC"), *Silk Cocoon*, T-174/01, 12 March 2003; EGC, *Vitafruit*, T-203/02, 8 July 2004; EGC, *Charlott*, T-169/06, 8 November 2007).

32. The EGC held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (EGC, *Hipoviton*, T-334/01, 8 July 2004; EGC, *Sonia-Sonia Rykiel*, T-131/06, 30 April 2008). The purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trademark protection to the case where large-scale commercial use has been made of the mark (EGC, *Vitafruit*, already referred to above).

33. In addition, the EGC held that genuine use of a trademark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned (see EGC, *Hiwatt*, T-39/01, 12 December 2002; EGC, *Vitakraft*, already referred to above and EGC, *Sonia-Sonia Rykiel*, already referred to above).

Analysis of the proof of use

34. The opponent submitted the following exhibits in order to demonstrate the genuine use of the trademark invoked:

1. Two images of a pair of shoes on which a metal pin in the shape of the trademark invoked is attached on the tongue of the right shoe.
2. Several pictures of a shoebox on which the trademark invoked is displayed.
3. A declaration by Mr Breuer, employed as business manager for the opponent, dated 8 August 2014, stating that the opponent markets its products in the Benelux using a shoebox that displays the trademark invoked. Furthermore, the declaration provides an overview of the minimum net sales of shoes sold in the Benelux.
4. Invoice dated 31 October 2010.
5. Order confirmation dated 6 August 2014.
6. Invoice dated 10 July 2011.
7. Order confirmation dated 6 August 2014.
8. Invoice dated 10 April 2011.
9. Order confirmation dated 6 August 2014.
10. Several copies of the Think! catalogue, dated 2011-2014, featuring various models of shoes.

35. The defendant argues that several documents are not dated and do not prove the use of the trademark invoked in the Benelux (paragraph 23). The images of the shoes (exhibits 1 and 2) are indeed not dated. However, it should be noted here that the possibility that some of the proof of use falls outside of the relevant period, does not necessarily mean that these exhibits cannot be taken into consideration. They can still serve to support other proof that was submitted or can contribute to a better analysis of the scope of the use of the right invoked in the relevant period (see ECJ, *La Mer Technology*, C-259/02, 27 January 2004; ECJ, *Alcon*, C-192/03 P, 5 October 2004 and the case law referred to there and ECJ, *Aire Limpio*, T-168/04, 7 September 2006). Nevertheless, the

Office considers that these images also do not show that the trademark invoked is used within the territory of the Benelux. For this reason, the Office concludes that these exhibits cannot be considered as valid proof of use.

36. With regard to the declaration of Mr Breuer (exhibit 3), the Office considers that the fact that this statement has not been drawn up by an independent party, but by an employee of the opponent, does not necessarily mean that it is ruled out as evidence. The outcome depends on the overall assessment of the evidence in each particular case. In general, further material is necessary to establish evidence of use, since such statements have to be considered to have less probative value than evidence originating from independent sources (see EGC, Salvita, T-303/03, 7 June 2005). In this case, the statements regarding the total net sales in the Benelux and the display of the trademark invoked on the shoeboxes are not substantiated by other evidence. For example no invoices or sales figures have been produced in this respect. For this reason, the declaration cannot be taken into account.

37. Exhibits 4-9 are all copies of invoices and order confirmations addressed to one shoe store in the Netherlands and one shoe store in Luxembourg. The Office considers that, according to the evidence, the models of shoes on which the metal pin in the shape of the trademark invoked is affixed are identified in these documents by the numbers 85002, 86002, 87002, 89002 and 86501.

38. After examination, the Office concludes that the exhibits 5, 7 and 9 are dated 6 August 2014 and therefore fall outside of the relevant period. The invoices and order confirmations that relate to the relevant period show that a total of 13 pairs (amounting to € 700.60) have been sold. The period of time of use of the earlier mark that can be deduced from the evidence submitted is a total of three months spread out over two years (October 2010, April 2011 and July 2011).

39. Exhibit 10 contains various issues from the Think! catalogue. The Office considers that not all catalogues contain the trademark invoked. Only the catalogues from 2011 and 2012 display the models of shoes which bear the trademark invoked. As to the extent of use of the earlier mark, these catalogues provide no information on the quantity of goods actually sold by the opponent under the trademark invoked. The Office remarks that under certain circumstances, even circumstantial evidence such as catalogues featuring the trademark, despite not providing direct information on the quantity of goods actually sold, can be sufficient by themselves to prove the extent of use in an overall assessment (EGC, Peerstorm, T-30/09, 8 July 2010). However, with regard to the Benelux, the catalogues only refer to one address of a representative located in the Netherlands. This does not constitute significant use of the trademark invoked within the territory of the Benelux.

40. When assessing whether certain use of the trademark is genuine, all the facts and circumstances relevant to establishing whether the commercial use of the mark is real in the course of trade must be taken into account. In particular it is of importance whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see ECJ, La Mer Technology, already referred to above). However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness (ECJ, VOGUE, T-382/08, 18 January 2011).

41. After careful analysis of all of the proof of use provided, the Office considers that in view of the nature of the goods, the indication of time, as well as the modest quantities sold, this evidence does not sufficiently demonstrate that the right invoked has been put to genuine use in the Benelux territory within a period of five years

prior to the publication date of the contested sign. As indicated above, some of the proof cannot be taken into consideration. The other exhibits do not sufficiently demonstrate the extent, duration and way in which the right invoked has been used.

C. Conclusion

42. It follows from the foregoing that the evidence the opponent filed with the Office, even when assessed overall, does not meet the requisite legal standard regarding the genuine use of the earlier trademark in the Benelux during the relevant period. The opponent fails to file proof that substantiates the place, time or extent of the use, as required by article 1.29, 2 IR. As a result of the lack of sufficient proof of use, there is no need for the Office to examine the existence of a likelihood of confusion.

IV. DECISION

43. The opposition with number 2009040 is rejected.

44. Benelux application with number 1271883 will be registered for all the goods and services for which it is requested.

45. The opponent is under obligation to pay the defendant 1,000 euro in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is not justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 17 December 2015

Eline Schiebroek
(*rapporteur*)

Saskia Smits

Diter Wuytens

Administrative officer: Rémy Kohlsaet