

BENELUX-OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2009082

of 21 October 2016

Opponent: **Jaguar Land Rover Limited**

Abbey Road
Whitley, Coventry CV3 4LF
Great Britain

Representative: **Novagraaf Nederland B.V.**

Hoogoorddreef 5
1101 BA Amsterdam,
The Netherlands

Invoked right 1: JAGUAR (Benelux registration 428697)



Invoked right 2: JAGUAR (Benelux registration 462314)



Invoked right 3: (European registration 10935997)

against

Defendant: **COMPAGNIA DEL VIAGGIO S.R.L.**

Via Senna, 18 Loc Osmannoro
50019 SESTO FIORENTINO (FI)
Italy

Representative: **V.O.**

PO Box 87930
2508 DH Den Haag
Netherlands

Contested trademark:




(International registration 1163758)

I. FACTS AND PROCEEDINGS

A. Facts

1. On 17 April 2013 the defendant made an international trademark application, having effect in the Benelux,




for the complex mark  for goods in class 18. This application was processed under number 1163758 and was published on 4 July 2013 in the WIPO Gazette of International Marks 2013/24.


2. On 27 September 2013 the opponent filed an opposition against this registration. The opposition is based on the following earlier trademarks:

- Benelux registration 428697 for the word mark JAGUAR, filed on 11 February 1987 for goods in classes 3, 8, 14, 16, 18, 20, 24, 25, 28, 33 and 34;



- Benelux registration 462314 for the complex mark , filed on 14 March 1989 for goods in classes 3, 8, 14, 16, 18, 20, 24, 25, 28, 33 and 34;



- European registration 10935997 for the complex mark , filed on 6 May 2011 and registered on 22 May 2012 for goods in classes 16, 18, 21, 25 and 28.

3. According to the registers the opponent is the actual holder of the trademarks invoked.

4. The opposition is directed against all the goods of the contested application and is based on a part of the goods in class 18 of the trademarks invoked.

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

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 7 October 2013. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed by the opponent. All of the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase of the procedure was completed on 29 February 2016.

II. ARGUMENTS OF THE PARTIES

8. 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 trademarks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. According to the opponent all the goods applied for have to be considered identical or at least highly similar to the goods of the rights invoked. They can be produced by the same manufacturers since they share the same nature and purpose, target the same public and are promoted and rendered through the same channels.

10. As the average consumer will more readily refer to the goods in question by quoting a trademarks name than by describing its figurative elements, the opponent considers the word JAGUAR as the distinctive and dominant element of the signs at hand.

11. As a consequence, the marks are visually very similar to the extent that they share the word JAGUAR and/or the image of a leaping feline. Although the figurative elements are different, these differences are not sufficient to offset the prevailing similarity, according to the opponent.

12. Aurally, as figurative elements are not pronounced, the marks are identical. Conceptually, they are identical as well, since the two marks share the same meaning.

13. At the defendant's request, the opponent has submitted proof of use of the rights invoked.

14. The opponent concludes that there exists a likelihood of confusion and hence the opposition should be upheld. He therefore requests that the Office grants the opposition so that the contested international registration shall be rejected in its entirety as far as it concerns the Benelux.

B. Defendant's arguments

15. First of all, the defendant has requested the proof of use of the first two rights invoked.

16. With respect to the proof of use filed by the opponent, the defendant states that the two brochures submitted by the opponent are largely insufficient to prove genuine use for the relevant goods. Firstly, the brochures are not dated and furthermore, a brochure alone does not after all proof the use of the mark. It actually does not even proof that products bearing the mark were offered for sale and surely not that they have been sold. Therefore, the defendant is of the opinion that the Benelux marks used as a basis for the opposition should not be taken into account.

17. Should the Office consider that genuine use has been proven by the opponent, the defendant states that the trademarks in question cannot be considered confusingly similar. The marks all contain the element JAGUAR and in this respect they are similar. However, the figurative elements of the marks at hand could be considered different.

18. As the Benelux trademarks on which the opposition is based, have not been proved to be valid, the goods to be compared are the remaining goods of the last right invoked, namely *parasols*, *umbrellas*, *walking sticks* and *umbrella sticks*. Between these goods, only *umbrellas* are similar to the goods of the contested sign, according to the defendant.

19. The defendant concludes that the opposition should be rejected, partly because the proof of genuine use submitted by the opponent has to be considered insufficient, partly because the signs are not confusingly similar and partly because the goods are different. He therefore requests that the Office rejects the opposition, registers the Benelux part of the contested international application and orders the opponent to pay the costs of these proceedings.

III. DECISION

A.1 Proof of use

20. Articles 2.16, 3 (a) and 2.26, 2 (a) BCIP and rule 1.29 IR stipulate that the right invoked should be put to genuine use for a continuous period of five years prior to the publication date of the sign against which the opposition is lodged.

21. Given the fact that the first two rights invoked are registered more than five years prior to the publication of the contested sign, the defendant's request that proof of use is submitted is legitimate.

22. The contested sign was published on 4 July 2013. Therefore the opponent was required to show use of the rights invoked, during the period from 4 July 2008 to 4 July 2013 ("the relevant period").

23. 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.

Assessment of the proof of use

24. In order to demonstrate genuine use of the two rights invoked that fall under the obligation of use, the opponent submitted two brochures, one of them entitled "Jaguar Merchandise" and the other "The collection Jaguar".

25. Both brochures are undated, but the opponent states that they date from 2011 and 2013 respectively. The fact that this statement originates from the opponent himself and not from an independent party, 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 the case at hand however, the only material at disposal are the two brochures, so the opponent's assertion cannot be supported nor verified by other exhibits. Moreover, one of the brochures is claimed to be from 2013, so it is not even possible to determine whether it falls within or outside the relevant period. Furthermore, a brochure as a mere collection of various articles is not very likely to establish that these products are actively present on the market. Indeed, in the present case the brochures don't give any information about the place, duration, extent and manner of use of the rights invoked for the goods on which the opposition is based.

Conclusion

26. The evidence filed by the opponent does not demonstrate genuine use of the trademarks invoked that fall under the obligation of use. Therefore, the Office will only proceed to the assessment of the likelihood of confusion with regard to the third right invoked which is not yet submitted to the obligation of use.

A.2 Likelihood of confusion

27. In accordance with article 2.14, 1 BCIP, the applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.3 (a) and (b) BCIP.

28. Article 2.3 (a) and (b) BCIP stipulates that *“In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in: a. identical trademarks filed for identical goods or services; b. identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark.”*

29. According to case law of the Court of Justice of the European Union (hereinafter: the “CJEU”) concerning the interpretation of Directive 2008/95/EG of the European Parliament and of the Council of 22 October 2008 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; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999; 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; Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs



30. The wording of Article 4, 1 (b) of the Directive (cf. article 2.3, (b) BCIP) “there exists a likelihood of confusion on the part of the public” 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).

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

32. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, Limonchello, C-334/05 P, 12 June 2007). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the

various components within the arrangement of the complex mark (EGC, Matratzen, T-6/01, 23 October 2002 and El Charcutero Artesano, T-242/06, 13 December 2007).

33. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

Visual comparison

34. Both signs are combined word/figurative marks. The right invoked contains the word JAGUAR in a somewhat squarely font, placed in a horizontally elongated hexagon. The contested sign contains the same word, in white double bordered letters, placed in an equally double bordered horizontal rectangle. Above that rectangle is depicted a slightly stylized leaping jaguar.

35. Where a sign 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 in question by quoting their name than by describing the figurative element of the trademark (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). Given the scant figurative elements of the right invoked, merely existing of a basic geometric figure and a specific font, the Office agrees with the opponent that the word JAGUAR is undoubtedly the dominant element in that trademark (see above point 10). The figure of the jaguar in the contested sign on the other hand cannot be overlooked. Nevertheless the identical word JAGUAR is clearly legible, represented in tall letters and positioned in the centre of the sign.

36. Due to the identical (dominant) word element, the signs are visually highly similar.

Aural comparison

37. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level (EGC, PC WORKS, T-352/02, 25 May 2005 and Thai Silk, T-361/08, 21 April 2010).

38. In the case at hand however, the most distinctive figurative element of the contested sign could be pronounced as "jaguar". Nevertheless, this pronunciation is identical to that of the right invoked as well as the word element of the contested sign.

39. Aurally the signs are identical.

Conceptual comparison

40. The opponent prudently describes the animal depicted in the contested sign as a "leaping feline" (see above point 11). The Office yet considers that the public will perceive it undoubtedly as a jaguar, due to its characteristic rosette design on the one hand and because of the word below it on the other. Both the word and the figurative element of the contested sign are thus conceptually identical to the right invoked.

41. Conceptually, the signs are identical.

Conclusion

42. The right invoked and the contested sign are highly similar in terms of visual perception and identical from the aural and conceptual points of view.

Comparison of the goods

43. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. 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).

44. With the comparison of the goods of the trademark invoked and the goods against which the opposition is filed, the goods are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

45. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Class 18 Parasols; Umbrellas; Walking sticks; Umbrella sticks.	Class 18 Leather and imitations thereof; purses, valises, suitcases, travelling sets (leatherware), travelling bags, handbags, travelling trunks, bags for sports, briefcases, pocket wallets, card cases, purses, key cases, rucksacks, umbrellas.

46. The goods umbrellas are mentioned in both lists and are thus identical.

47. The other goods for which the contested sign is applied are of a different nature and their method of use is different from that of the right invoked. Furthermore, these goods are not in competition with each other, neither are they complementary. Therefore, these goods are not similar to the goods on which the opposition is based.

Conclusion

48. The goods at issue are partly identical and partly not similar.

A.3 Global assessment

49. 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 signs are important factors.

50. 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 in accordance with the category of goods or services in question. The goods at issue are intended for the public at large with a normal level of attention.

51. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken in account, particularly between the level of similarity of the signs 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).

52. It should also be taken into consideration here that normally, the average consumer perceives a mark as a whole and does not proceed to an analysis of 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 trademarks but must place his trust in the imperfect picture of them that he has kept in his mind.

53. 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). In the present case, the trademark invoked has a normal level of distinctiveness, as it is not descriptive of the goods concerned.

54. The signs are visually similar in a high degree and aurally and conceptually they are identical. Some of the goods concerned are identical and some are not similar. Based on these grounds, the Office finds, given the interdependence between all the circumstances to take into account, that the relevant public might believe that the identical goods originate from the same undertaking or from economically-linked undertakings.

B. Other factors

55. The defendant asks that all the costs of these proceedings be borne by the opponent (see above point 19). However, rule 1.32 (3) IR clearly stipulates that the costs referred to in article 2.16 (5) BCIP are determined at an amount equalling the basic opposition fee. The request of the defendant can therefore not be honoured.

C. Conclusion

56. Since the proof of use of the rights invoked submitted to the obligation of use is deemed insufficient, there was no need for the Office to examine the existence of a likelihood of confusion regarding these rights. As for the third right invoked, the Office holds that there exists a likelihood of confusion for the identical goods.

IV. DECISION

57. The opposition with number 2009082 is partially upheld.

58. The international registration with number 1163758, having effect in the Benelux, will not be registered for the following goods:

Class 18 Umbrellas.

59. The international registration with number 1163758, having effect in the Benelux, will be registered for the following goods, which were not found to be similar:

Class 18 Leather and imitations thereof; purses, valises, suitcases, travelling sets (leatherware), travelling bags, handbags, travelling trunks, bags for sports, briefcases, pocket wallets, card cases, purses, key cases, rucksacks.

60. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.32(3) IR, as the opposition is partly justified.

The Hague, 21 October 2016

Willy Neys
(*rapporteur*)

Eline Schiebroek

Pieter Veeze

Administrative officer: Raphaëlle Gérard