

BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2010013

of 11 April 2016

Opponent: **Join Experience S.A.**
Rue de Bitbourg 11
1273 Luxembourg
Grand Duchy of Luxembourg

Representative: **Office Freylinger S.A.**
234 route d'Arlon
8010 Strassen
Grand Duchy of Luxembourg

Invoked right: **Benelux registration 949260**

JOIN

against

Defendant: **Decos Beheer B.V.**
Huygensstraat 30
2201 DK Noordwijk
Netherlands

Representative: **Nederlandsch Octrooibureau**
Anna van Buerenplein 21a
New Babylon City Offices
2595 DA Den Haag
Netherlands

Contested trademark: **Benelux application 1288281**

JOIN

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

1. On 22 April 2014 the defendant filed an application for a trademark in the Benelux for the word mark JOIN for goods and services in classes 9 and 42. This application was processed under number 1288281 and was published on 2 May 2014.

2. On 30 June 2014 the opponent filed an opposition against the registration of the application. The opposition is based on Benelux registration 949260 of the following combined word/figurative mark filed on 23 December 2013 and registered on 12 March 2014 for goods and services in classes 35, 38, 39 and 42:



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

4. The opposition is directed against all of the goods and services of the contested application and is based on all of the goods and services of the trademark invoked.

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

6. The language of the proceedings is English.

B. Chronological order of the proceedings

7. The opposition is admissible and was notified to the parties on 4 July 2014.

8. The adversarial phase of the procedure started on 5 September 2014. The Benelux Office for Intellectual Property (hereinafter: "the Office") sent the notification of the commencement of the proceedings on 30 September 2014 to the parties, giving the opponent the opportunity to substantiate the opposition by submitting arguments and documents no later than 30 November 2014.

9. The defendant limited his application on 19 September 2014. This was confirmed to both parties on 17 October 2014.

10. On 26 November 2014 the opponent submitted arguments to substantiate the opposition. These arguments were sent by the Office to the defendant on 15 December 2014, giving the defendant the opportunity to submit a reply no later than 15 February 2015.

11. The defendant filed a reply on 13 February 2015. This reply was sent by the Office to the opponent on 3 March 2015.

12. Each party filed its observations within the time limits imposed by the Office.
13. The Office has sufficient information to come to a decision on the opposition.

II. ARGUMENTS

14. 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. Arguments of the opponent

15. The opponent considers the goods and services covered by both trademarks to be either identical or very similar.

16. Regarding the comparison of the signs, the opponent is of the opinion that the prior trademark is distinctive for all the services covered and that the signs are highly similar and almost identical due to their high similarity from a visual point of view and identity from an aural and conceptual point of view.

17. According to the opponent, the global appreciation of the signs at issue leads to an almost identical perception of these trademarks. Both are composed of the same dominant term and the slightly special typography of the trademark invoked will probably not even be noticed by the consumers.

18. For all these reasons, the opponent requests that the Office should reject the registration of the application and asks that all the costs be borne by the applicant pursuant to Art. 85 CTMR.

B. Arguments of the defendant

19. The defendant underlines the visual differences between both signs. He finds that the right invoked could be read and pronounced as JOUN. Conceptually, he is of the opinion that the contested sign has a meaning whereas the right invoked, which can be read as JOUN, has no meaning. He concludes that there are sufficient differences between the short signs at issue.

20. As far as the goods and services are concerned, the defendant stresses that the application was made in respect to a very specific type of goods and services. The right invoked, on the other hand, is registered in respect to a wide variety of services. The defendant finds the services in classes 35, 38 and 39 different from the services covered by the right invoked. Due to the specific nature of the services in class 42 provided by the defendant, he argues that the services in this class are sufficiently dissimilar to prevent the relevant public from being confused. Based on the foregoing, the defendant concludes that his goods and services are dissimilar from the services relating to the right invoked.

21. In contrast to the opponent, the defendant considers that "JOIN" could refer to the designated goods and services. Therefore, he finds the signs of a low distinctive character and any small difference between the goods and services is sufficient to prevent a risk of confusion on the part of the public.

22. Based on the above, the defendant requests that the Office reject the opposition and let the application proceed to registration.

III. DECISION

A.1 Likelihood of confusion

23. 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.

24. 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.”*

25. 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



26. 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).

27. 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).

28. 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).

29. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

Visual comparison

30. The contested sign is a verbal mark, consisting of a single word of four letters, JOIN. The right invoked is a combined word/figurative mark, depicting in large black letters the four letter word JOIN of which the lower half of the letter I and N are interconnected through the use of a sign resembling the vowel u or the typographic sign for a space.

31. 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 trade mark (EGC, Presto! BizCard Reader, T-205/06, 22 May 2008).

32. The figurative elements of the right invoked are limited. The sign is represented in a normal black typeface. The only divergent figurative element is that of the connection between the letters I and N. Nevertheless, the Office is of the opinion that the relevant public will still perceive the right invoked as the word JOIN, due to the use of the dot on top of the third letter. Furthermore, the Office is of the opinion that the visual element reinforces the meaning of the verbal element, seeing that it visually connects the letters.

33. Visually the signs are highly similar.

Aural comparison

34. 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).

35. Notwithstanding the connector at the bottom the letters I and N, the Office finds that the right invoked will be perceived and pronounced as JOIN.

36. Aurally the signs are identical.

Conceptual comparison

37. Both the right invoked and the contested sign consist of the English word “JOIN”, which means “an act of joining; put together, so as to unite or make continuous; fasten, attach, connect, unite (one thing to another, or several together)”¹.

38. Conceptually, the signs are identical.

Conclusion

39. The right invoked and the contested sign are aurally and conceptually identical. Visually, the signs are highly similar.

Comparison of the goods and services

40. 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).

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

42. The goods and services to be compared are the following:

Opposition based on:	Opposition directed against:
	KI 9 Software, ontwerpen om processen uit te voeren op het gebied van informatiemanagement. <i>CI 9 Software, designed to execute processes in the field of information management.</i>
CI 35 Publicité; gestion des affaires commerciales; administration commerciale; travaux de bureau; location de temps publicitaire sur tout moyen de communication; publicité en ligne sur un réseau informatique; promotion des ventes pour des tiers; démonstration de produits et services; mise à jour de matériel publicitaire; diffusion de matériel publicitaire; publicité par correspondance; location de matériel publicitaire; rédaction de textes publicitaires; mise en pages à buts publicitaires; courrier publicitaire; services d'abonnement à des services de télécommunications pour des tiers; transcription de communications; affaires commerciales; gestion des affaires commerciales et conseils en organisation et direction des affaires;	

¹ Shorter Oxford English Dictionary, 6th Edition.

expertises en affaires; services d'étude de marché; recherches et investigations d'informations commerciales; estimations en affaires commerciales; prévisions économiques; analyse du prix de revient; établissement de statistiques; agence d'informations commerciales; consultation pour la direction des affaires; consultation professionnelle d'affaires; informations d'affaires; renseignements d'affaires; informations et conseils commerciaux aux consommateurs; aide à la direction d'entreprises industrielles ou commerciales; aide à la direction des affaires; projets (aide à la direction des affaires); investigations pour affaires; recherches pour affaires; recherches d'informations dans des fichiers informatiques pour des tiers; agences d'informations commerciales; regroupement pour le compte de tiers d'informations sur des fournisseurs de services liés aux produits informatiques, permettant aux clients de les voir et de les choisir commodément; recueil de données dans un fichier central; systématisation de données dans un fichier central; gestion de fichiers informatiques; gérance administrative de distribution de produits et services informatiques; gérance administrative de plates-formes informatiques; agences d'import-export; services d'approvisionnement pour des tiers [achat de produits et de services pour d'autres entreprises]; traitement administratif de commandes d'achat; services de réponse téléphonique pour abonnés absents; services de secrétariat; services de sous-traitance (assistance commerciale); services de vente au détail de logiciels, de produits informatiques ou de produits de téléphonie; présentation de logiciels, de services informatiques, de produits informatiques ou de produits de téléphonie sur tout moyen de communication pour la vente au détail.

Cl 35 Advertising; business management; business administration; office functions; rental of advertising time on all types of communication; online advertising on a computer network; sales promotion for others; demonstration of goods and services; updating of advertising material; dissemination of advertising material; advertising by mail order; rental of publicity material; writing of publicity texts; layout services for advertising purposes; publicity columns preparation; arranging of subscriptions for

<p><i>others; transcription of communications [office functions]; commercial affairs; business management and business organisation and management consultancy; business expertise services; market research services; research and investigations relating to business information; business appraisal; economic forecasting; cost price analysis; compilation of statistics; commercial information agencies; business management consulting; professional business consulting; business information; business inquiries; commercial information and advice for consumers; commercial or industrial management assistance; business management assistance; projects (business management assistance); business investigation; business research; data search in computer files for others; commercial information agencies; bringing together for others of information on providers of services linked to computer products, enabling customers to view and choose them conveniently; compilation of information into computer databases; systemization of information into computer databases; computerised file management; administrative management relating to the distribution of computer products and services; administrative management of computer platforms; import-export agencies; procurement services for others [purchasing goods and services for other businesses]; administrative processing of purchase orders; telephone answering services for unavailable subscribers; clerical services; outsourcing services (business assistance); retailing of computer software, computer products or telephony products; presentation of computer software, computer products, telephony products, using all means of communication, for retail purposes.</i></p>	
<p>Cl 38 Télécommunications, à l'exception de portails Internet et / ou portails accessibles par des appareils mobiles et liés à presse féminine, notamment concernant la mode, la beauté et les célébrités; services téléphoniques; communications téléphoniques; radiotéléphonie mobile; services d'appel radioélectrique [radio, téléphone ou autres moyens de communications électroniques]; messagerie électronique; conseils techniques en matière de télécommunications et de communications électroniques; services de messagerie vocale; communications par terminaux</p>	

d'ordinateurs; services d'acheminement et de jonction pour télécommunications; transmission de messages et d'images assistée par ordinateurs; services d'affichage électronique [télécommunications]; informations en matière de télécommunications; location d'appareils pour la transmission de messages; location d'appareils de télécommunication; location de téléphones; location de temps d'accès à des réseaux informatiques mondiaux; communications par réseau de fibres optiques; informations en matière de communications par réseau de fibres optiques; raccordement par télécommunications à un réseau informatique mondial; informations en matière de raccordement par télécommunications à un réseau informatique mondial; fourniture d'accès à un réseau informatique mondial; informations en matière de fourniture d'accès à un réseau informatique mondial; diffusion de programmes de télévision; services de diffusion sans fil; fourniture d'accès à des bases de données; fourniture de forums de discussion sur l'internet; consultation technique en matière de systèmes et réseaux de télécommunication et de transmission de données.

Cl 38 Telecommunications, excluding internet portals and/or portables accessible by mobile phones and connected with women's magazines, especially concerning fashion, beauty and celebrities; telephone services; telephone communications; cellular telephone communication; paging services [radio, telephone or other means of electronic communication]; email services; technical consultancy in the field of telecommunications relating to electronic communications; voice mail services; communications by computer terminals; telecommunications routing and junction services; computer-aided transmission of messages and images; electronic bulletin board services [telecommunications services]; information about telecommunication; rental of message sending apparatus; rental of telecommunication equipment; rental of telephones; rental of access time to global computer networks; communications by fibre optic networks; providing of information relating to communications via fibre optic networks (telecommunications); providing telecommunications connections to a global computer network; information relating to

<p><i>connection via telecommunications to a worldwide computer network; providing user access to a global computer network (service providers); information relating to the provision of access to a worldwide computer network; television broadcasting; wireless broadcasting; providing access to databases; providing Internet chat rooms; technical consultancy in the field of telecommunications and data transmission systems.</i></p>	
<p>CI 39 Transport; emballage et entreposage de marchandises; entreposage de supports de données ou de documents stockés électroniquement; location de conteneurs d'entreposage; stockage, emmagasinage.</p> <p><i>CI 39 Transport; packaging and storage of goods; storage of electronically-stored data or documents; rental of storage containers; storage.</i></p>	
<p>CI 42 Services scientifiques et technologiques ainsi que services de recherches et de conception y relatifs; services d'analyses et de recherches industrielles; conception et développement d'ordinateurs et de logiciels; services scientifiques et technologiques, ainsi que services de recherches et de conception y relatifs, à savoir évaluations, recherches dans le domaine informatique, dans le domaine des logiciels informatiques, dans le domaine des applications informatiques ainsi que dans le domaine de la téléphonie; services d'analyses et de recherches industrielles dans le domaine de l'informatique, des logiciels informatiques ainsi que dans le domaine de la téléphonie, notamment analyses pour l'implantation d'ordinateurs et d'installations de téléphonie; services de recherche et de développement de nouveaux produits pour le compte de tiers; recherche et développement de logiciels d'ordinateur pour des tiers; programmation pour ordinateurs; location de serveurs électroniques de stockage et d'entreposage; conception de systèmes informatiques; consultations en matière d'ordinateurs; maintenance de logiciels d'ordinateurs; duplication de programmes informatiques; élaboration (conception), mise à jour, installation et location de logiciels informatiques; conseils techniques relatifs à la conception (élaboration), la mise en place, la gestion de sites Internet; conversion de données et de programmes</p>	<p>KI 42 Het verstrekken van online software (zgn. "case management systeem") die gebruikers in staat stelt om bestanden en documenten te beheren te verwerken en op te vragen.</p> <p><i>CI 42 Providing online software (so-called "case management system") enabling users to manage, process and retrieve files and documents.</i></p>

informatiques (autre que la conversion physique);
 conversion de données ou de documents d'un
 support physique vers un support électronique;
 création et entretien de sites web pour des tiers;
 hébergement de sites informatiques (sites web);
 consultation scientifique en matière de logiciels, de
 services informatiques; conception de systèmes et
 réseaux de télécommunication et de transmission
 de données; établissement de plans pour la
 construction; dessin industriel [ingénierie];
 expertises [travaux d'ingénieurs]; études de projets
 techniques.

*Cl 42 Scientific and technological services and
 research and design relating thereto; industrial
 analysis and research services; design and
 development of computer hardware and software;
 scientific and technological services, and research
 and design relating thereto, namely evaluations and
 research in the fields of computing, computer
 software, computer applications and telephony;
 industrial analysis and research in the field of
 computing, computer software and telephony, in
 particular analyses for the installation of computers
 and telephone installations; research and
 development of new products, for others; research
 and development of computer software for others;
 computer programming; rental of electronic storage
 and warehousing servers; computer system design;
 consultancy in the field of computer hardware;
 maintenance of software; duplicating computer
 programs; creation (design), updating, installation
 and rental of computer software; technical
 consultancy relating to the design (development),
 installation, management and use of websites;
 conversion of computer data and programs (except
 physical conversion); conversion of data or
 documents from physical to electronic media;
 creating and maintaining web sites for others;
 hosting computer sites [websites]; scientific
 consultancy relating to computer software and
 computer services; design of telecommunications
 and data transmission systems and networks;
 construction drafting; engineering and industrial
 design; surveying; technical project studies.*

*N.B. The original language of this registration is French. The
 translation is only added to improve the readability of this
 decision.*

*N.B. The original language of this application is Dutch. The translation is
 only added to improve the readability of this decision.*

Class 9

43. With regard to the nature of the goods and services in question, it cannot be held that these services and products are similar. Indeed the nature of the goods and services in question is different, because the former are tangible and the latter are not. Goods and services can however be complementary. Regarding the complementary nature of the services and goods in question, it should be noted that, according to established case law, complementary goods and services are those which are so closely connected that one is indispensable or highly important for the use of the other, resulting in the fact that consumers may think that the same undertaking is responsible for the both of them (see, to that effect, EGC, SISSI ROSSI, T-169/03, 1 March 2005; PAM PLUVIAL, T-364/05, 22 March 2007 and Pirañam, T-443/05, 11 July 2007).

44. The goods in class 9 covered by the contested sign are the result of the services covered by the right invoked in class 42, namely "design and development of computer hardware and software" and are needed to be able to render the services "maintenance of software". Therefore, the Office finds that the goods in class 9 of the contested sign are complementary to the abovementioned services, which justifies the conclusion of a limited degree of similarity.

Class 42

45. The services in class 42 of both the right invoked as well as the contested sign are highly similar. The services covered by the contested sign are intended to provide third parties with a specific type of software. The services "rental of computer software", protected by the right invoked, have the same purpose, namely to allow third parties to use software. The fact that the classification of the right invoked does not specify the specific type of software does not exclude the similarity, as the broader category of software also includes the specific software mentioned in the classification of the contested sign.

Conclusion

46. The goods at issue are similar to a limited degree. The services are highly similar.

A.2 Global assessment

47. 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.

48. 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 according to the category of goods or services in question. The level of attention of the relevant consumer will be higher than average for goods and services which are expensive or aim to meet a particular technological need such as the design and development of computer hardware and software (EGC, AAVA MOBILE, T-554/12, 27 March 2014). The goods and services at hand are intended for a professional public with either an average or above average level of attention, depending on the goods and services in question.

49. 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).

50. 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 and services concerned.

51. However, even if the Office assumed, like the defendant (paragraph 21), that the trademark invoked has a weak distinctive character, it is of importance that, according to European case law, a weak distinctive character does not, by definition, imply the absence of a likelihood of confusion. Although the distinctive character of the marks must be taken into account with the assessment of the likelihood of confusion, it is only one of a number of elements which influences that assessment (CJEU, Ferromix, C-579/08, 15 January 2010). Even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion, particularly because of a similarity between the signs and between the goods or services covered (EGC, Flexi Air, T-112/03, 16 March 2005). Moreover, even likelihood of confusion with respect to a part of the relevant public is sufficient to grant an opposition (EGC, Hai/Shark, T-33/03, 9 March 2005).

52. Based on the abovementioned circumstances, especially the fact that the signs are highly similar which compensates a possible minor similarity of the goods, the Office is of the opinion that the relevant public might believe that the goods and services in question originate from the same undertaking or from economically-linked undertakings.

B. Other factors

53. The opponent asks that all the costs be borne by the applicant pursuant to Art. 85 CTMR (see paragraph 18). Opposition proceedings in the Benelux are governed by the Benelux Convention on Intellectual Property and its Implementing regulations. Rule 1.32 (3) clearly stipulates that the costs referred to in article 2.16 (5) of the BCIP are determined at an amount equalling the basic opposition fee. The request of the opponent can therefore not be honoured.

C. Conclusion

54. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

IV. DECISION

55. The opposition with number 2010013 is justified.

56. Benelux application with number 1288281 will not be registered.

57. The defendant shall pay the opponent 1.000 euros in accordance with article 2.16 (5) BCIP in conjunction with rule 1.32 (3) Implementing Regulations, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.

The Hague, 11 April 2016

Diter Wuytens
(*rapporteur*)

Pieter Veeze

Tomas Westenbroek

Administrative officer: Anna Dina Dikken