

BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2010090
of 8 December 2016

Opponent: **BEESWIFT LIMITED**
West Wing, Delta House
Delta Point, Greetes Green Road
B70 9PL West Bromwich, West Midlands
United Kingdom

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

Invoked right: **European registration 4488854**



against

Defendant: **Olivia T.M. Jeursen-Boers h.o.d.n. JJ Sports**
Wermersveldstraat 47
7532 BJ Enschede
Netherlands

Representative: **Markeys**
Voortsweg 131
7523 CD Enschede
Netherlands

Contested trademark: **Benelux application 1289894**



I. FACTS AND PROCEEDINGS


A. Facts

1. On 21 May 2014 the defendant made a Benelux trademark application, for the figurative mark



for goods in classes 25 and 28. This application was processed under number 1289894 and was published on 26 May 2014.

2. On 24 July 2014 the opponent filed an opposition against the registration. The opposition is based

on the earlier European application 4488854, for the figurative mark , filed on 9 June 2005 and registered on 17 November 2014, for goods in classes 9, 10 and 25.

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

4. With the submission of his arguments, the opponent has limited the opposition. The opposition is directed against all of the goods in class 25 of the contested sign and is based on all of the goods in class 25 of the trademark 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. Chronological order of the proceedings

7. The opposition is admissible and was notified to the parties on 29 July 2014 by the Benelux Office for Intellectual Property (hereinafter "the Office"). During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. All of the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter "IR"). In addition the proceedings were suspended several times at the request of the parties. The administrative phase was completed on 7 January 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. The opponent first states that the goods in class 25 are identical.

10. With regard to the comparison of the signs, the opponent states that the signs are visually similar to the extent that they coincide in the letters 'B**SEEN', in the same order. They differ in the letters 'EE' of the contested sign. However, although the figurative elements of both signs are different, according to the opponent, these differences are not sufficient to compensate for the prevailing similarity of the word elements. The opponent states that the signs are aurally identical, because both signs will be pronounced as "BEE-SEEN". Conceptually, the opponent argues that the public will understand the identical words 'SEEN'. With regard to the letter B in the trademark invoked, the opponent states that the public will understand that this letter refers to the opponent's company name Beeswift, whose prefix has the same meaning as the word BEE in the contested sign. For this reason, the opponent concludes that the marks are conceptually similar to the extent that both signs refer to the ability to see as well as to the honey bee.

11. Considering the foregoing, the opponent concludes that there is a likelihood of confusion on the part of the public. Consequently, the opponent requests that the Office grants the opposition and awards the opponent the reimbursement of the opposition fee.

12. At the request of the defendant, the opponent filed proof of use.

B. Defendant's arguments

13. With respect to the proof of use filed by the opponent the defendant states that the documents submitted by the opponent are insufficient to prove use for the relevant goods in the relevant territory, the European Union. Firstly, the defendant argues that the affidavit, signed by the opponent's director, originates from the opponent itself and therefore has little probative value. The defendant also remarks that the other documents do not substantiate the sales figures mentioned by the opponent in the affidavit. Furthermore, according to the defendant, the pictures submitted do not indicate the place, time, extent and nature of use of the trademark invoked. The defendant states that the catalogues the opponent provided do not contain any indication of the place, duration, extent and manner of use of the earlier trademark. The defendant also argues that the invoices that have been submitted do not prove that the trademark invoked is sufficiently used in the European Union.

14. The defendant agrees with the opponent that the goods mentioned in class 25 are identical. However, the defendant states that the proof of use does not show the effective and genuine use of the trademark invoked for the goods "clothing, footwear, headgear and belts" in the European Union. The defendant argues that, if the proof of use were to be deemed sufficient for the use of high-visibility clothing products, the opposition should still be rejected, because these goods are dissimilar to the goods of the defendant.

15. Regarding the comparison of the signs the defendant argues that the public will not perceive the



figurative element as the letter B. Furthermore, the defendant finds that, taking into account the clear figurative differences in both signs, there is no similarity between the contested signs. Therefore, it will be improbable that a likelihood of confusion may arise.

16. The defendant concludes that the opposition should be rejected, because the opponent has failed to submit genuine use of the trademark invoked. In addition, the contested sign is not confusingly similar to the trademark invoked due to the visual differences and differences in the nature of the goods. The defendant thus

requests that the Office registers the contested sign and orders the opponent to pay the fees and costs of this opposition.

III. DECISION

A.1 Proof of use

17. 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 within the Benelux territory for a continuous period of five years prior to the publication date of the sign against which the opposition is lodged. The contested sign was published on 26 May 2014. Therefore the opponent was required to show use of the right invoked, during the period from 26 May 2009 to 21 May 2014 ('the relevant period') for the goods "clothing, footwear, headgear and belts" mentioned in Class 25.

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

19. 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.

Analysis of the proof of use

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

1. Affidavit dated 23 October 2015, signed by Mr Les Giles, managing director of Beeswift Limited, in which it is stated that the trademark invoked is mainly used for the sale of high visibility workwear. According to the affidavit, the approximate annual turnover for goods sold under the trademark invoked was around 5.5 million pounds in 2013;
2. Pictures, not dated, which display the goods, such as yellow constructor traffic jackets, on which the trademark invoked is applied;
3. Pictures of the opponent's display at the A plus A Trade Fair 2011 in Dusseldorf;
4. Copies of product catalogues of 2008 – 2009 and 2010-2011, displaying products on which the trademark invoked is applied;
5. 13 invoices regarding sales in the United Kingdom, Ireland and the Netherlands, dated between 2011-2013, including specification sheets showing which goods were sold under the trademark invoked.

21. After careful analysis of all of the proof of use provided, the Office concludes that the evidence submitted only refers to the marketing and sale of '*high visibility clothing*'. For this reason, the assessment of the likelihood of confusion will be based on these goods only.

A.2 Likelihood of confusion

22. 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, or may give rise to confusion with its well-known trademark within the meaning of Article 6*bis* of the Paris Convention.

23. Article 2.3 (a) and (b) 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.*”

24. According to case law 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

25. 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).

26. 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 (Sabel and Lloyd, already cited).

27. 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).

28. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

Conceptual comparison

29. Both signs share the identical word element SEEN, which in English is the past participle of the verb 'to see', indicating that something or someone can be perceived with the eyes or is discerned¹. The Office considers that the relevant public will understand this English word. However, the word element 'seen' describes the goods of the trademark invoked, because it indicates the purpose of the '*high visibility work clothing*', namely that that a person is 'seen'. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003).

30. With regard to the trademark invoked, the Office considers that part of the public could perceive the figure on the left as a stylized letter B. Part of the public could also recognise an image of a flying bird. The argument of the opponent that the public will perceive this figurative element as 'Bee', because it refers to the opponent's company name Beeswift (paragraph 10), is not relevant, because only the trademark invoked as displayed in the register should be assessed.

31. With regard to the contested sign, the Office considers that the first part of the contested sign contains the word element BEE, which in combination with the word element SEEN will be perceived as a conjugation of the verb 'to see'. To this extent, the meaning of the word elements in both signs is nearly identical. However, the Office is of the opinion that the public, when it is confronted with the contested sign, will also think that the word BEE refers to "*the stinging winged insect which collects nectar and pollen, produces wax and honey, and lives in large communities*"², because of the stylized figure of a bee depicted in the centre of the contested sign.

32. In the light of the above, the Office concludes that, considering that the conceptually identical word 'SEEN' is descriptive, the signs are conceptually similar to a low degree.

Visual comparison

33. The trademark invoked and the contested sign are both combined verbal/figurative marks. The trademark invoked consists of the word SEEN displayed in orange letters, placed in a yellow frame. On the left of the word SEEN, the sign shows a stylized white image which could be perceived as a flying bird or the letter B, displayed on an orange background. The contested sign is a black and white sign and contains the words BEE and SEEN. The contested sign includes a stylized image of a bee between the word elements. The contested sign also includes the ® logo on the right.

34. In complex signs (verbal and figurative elements), word elements often have a greater impact on the public than figurative elements. This is because the average consumer will not always analyse the signs and will often refer to a sign by using the word element (see EGC, Selenium-Ace, T-312/03, 14 July 2005). Although the signs share the identical word SEEN, which has a clear visual position in both signs, in the light of the descriptive character of this element, the figurative elements will not be ignored by the public (reference is made to Court of Appeal of The Hague, MOOVE-4MOVE, 200.105.827/0, 11 September 2012). These figurative elements, mainly the colours and the stylized image of a flying bird (which could also be perceived as a B), cause a clear visual difference between the trademark invoked and the contested sign.

¹ <https://en.oxforddictionaries.com/definition/see>

² <https://en.oxforddictionaries.com/definition/bee>

35. Furthermore, it is also important that the consumer normally attaches more value to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004). For these reasons, the Office is of the opinion that the signs are visually similar to a low degree.

Aural comparison

36. With regard to the aural comparison, it must be remembered that, in the strict sense, the phonetic reproduction of a complex sign corresponds to that of all its verbal elements, regardless of any 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-361/0821, April 2010).

37. As mentioned above, part of the public will perceive, and therefore also pronounce, the first part of the trademark invoked as the letter 'B'. This pronunciation is identical to the pronunciation of the word element BEE of the contested sign. Therefore, for part of the public, the first part of both signs have the same pronunciation. Furthermore, both signs include the word SEEN which is pronounced identically.

38. In the light of the foregoing, the Office is of the opinion that the signs are aurally identical.

Conclusion

39. The similarities between the trademark invoked and the contested sign only lie within a descriptive element. The Office also takes into account that the signs contain clear visual differences and that the first part of the contested sign also has a different meaning, which is emphasized by the figurative element of a honey bee. Therefore, the Office is of the opinion that the differences are sufficient to neutralize the similarities. This means that the signs, considered as a whole, are not similar, or at least are not similar enough, that there could exist a likelihood of confusion.

Comparison of the goods

40. For reasons of procedural economy, the Office will not conduct a comparison of the goods. This comparison would not influence the outcome of this decision. Even if the goods were identical, there would be no likelihood of confusion, because the signs are dissimilar. Only for the purpose of the readability and the scope of this opposition, are the goods concerned listed below.

Opposition based on:	Opposition directed against:
Class 25 High visibility clothing.	Class 25 Clothing, footwear, headgear.

B. Other factors

41. The opposition proceedings with the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.16, 5 BCIP and rule 1.32, 3 IR only stipulates in this respect that an amount equaling the basic opposition fee shall be borne by the losing party (paragraph 16).

C. Conclusion

42. The overall impression of the signs is not similar. For this reason, it is not necessary that the Office conducts a comparison of the goods, nor a substantive assessment of the proof of use. After all, there could not exist a likelihood of confusion if the signs are not similar, even if the goods and services were to be found to be identical (see EGC decisions, easyHotel, T-316/07, 22 January 2009 en YOKANA, T-103/06, 13 April 2010).

IV. DECISION

43. The opposition with number 2010090 is refused.

44. Benelux application with number 1289894 will be registered for all goods for which it has been applied.

45. The opponent shall pay the defendant 1,000 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 Implementing Regulations, as the opposition is refused in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 8 December 2016

Eline Schiebroek
(*rapporteur*)

Saskia Smits

Camille Janssen

Administrative officer: Raphaëlle Gérard