



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2011371

of 22 May 2018

Opponent: **United Parcel Service of America, Inc., Delaware corporation**
Glenlake Parkway, NE 55
Atlanta, Georgia GA 30328
United States of America

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwenveldseweg 12
1382 LX Weesp
The Netherlands

Invoked right 1: **Benelux trademark 606517**
UPS

Invoked right 2: **Benelux trademark 150688**
UPS

Invoked right 3: **Benelux trademark 642208**
UPS

against

Defendant: **Tjerk Homminga h.o.d.n. Multi-tier Consultancy**
Desguinlei 166 b3
2018 Antwerp
Belgium

Representative: **Dirk Van Coppenolle, advocaat**
Beverzakbroekweg 97
3520 Zonhoven
Belgium

Contested trademark: **Benelux application 1317557**
dps.com

I. FACTS AND PROCEEDINGS

A. Facts

1. On 24 September 2015 the defendant filed an application for a trademark in the Benelux for the word mark "dps.com" for goods and services in classes 9, 12, 20, 35, 36, 38, 39 and 42. This application was processed under number 1317557 and was published on 25 September 2015.

2. On 12 November 2015 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier rights:

- Benelux trademark registration 606517 of the word mark "UPS", filed on 6 February 1997 and registered for goods and services in classes 9, 35 and 36;
- Benelux trademark registration 150688 of the word mark "UPS", filed on 6 January 1987 and registered for services in classes 38 and 39;
- Benelux trademark registration 642208 of the word mark "UPS", filed on 24 August 1998 and registered for services in class 42.

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

4. The opposition is directed against all goods and services in classes 9, 12, 35, 36, 38, 39 and 42 of the contested application and is based on all goods and services of the trademarks 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. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 16 November 2015. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 3 June 2016.

II. ARGUMENTS

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 marks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. The opponent starts by comparing the activities of both parties.

10. He emphasizes the fact that his mark is listed number 29 of Interbrand's Best Global Brands 2015. With a brand value of 14,723 \$m, the opponent is of the opinion that the mark UPS has gained a high distinctive character over the years through very intensive use.

11. Regarding the signs to be compared, the opponent is of the opinion that the element .COM is clearly a generic top-level domain which does not contribute to the distinctiveness of the mark. Therefore, according to the opponent, the marks to be compared are UPS vs DPS. He finds the opposed trademark DPS similar to the prior mark UPS as the last two letters are identical and visually the letter "U" and "D" are easily confused. Conceptually the marks are similar due to the fact that "PS" is known as an abbreviation of "Parcel Services". The U in UPS stands for "United", the D in DPS for "Delivery".

12. According to the opponent, the goods in class 9 are very broad. Most of them are however similar to the goods and/or services of the opponent in classes 9, 39 and 42. The goods in class 12 are highly related to the services in class 39 of the trademark invoked. The services in class 35 of the contested sign are all part of the business administration services for which the trademark invoked is registered and used. The services in class 36 and 38 are all specifications of the services mentioned in class 36 and 38 of the opponent's mark and are therefore identical or at least highly similar. The services in class 39 are identical or at least highly similar, as is the case for the services in class 42.

13. As the goods and services for which the mark is applied for are meant for the general public, the opponent is of the opinion that the level of attention must be deemed normal.

14. Based on the foregoing, in particular the high distinctive character of the rights invoked as well as the highly similar signs and partly identical and partly similar goods and services, the opponent concludes that there is a likelihood of confusion. He therefore requests the Office to allow the opposition entirely, to reject the Benelux trademark application and award payment of the costs by applicant to the opponent.

B. Defendant's arguments

15. The defendant also starts by elaborating on his activities, as well as those of the opponent.

16. In response to the arguments of the opponent, the defendant states that the former did not prove that there is a likelihood of confusion.

17. With regard to the comparison of the signs, the defendant argues that the right invoked only exists of three letters and the contested sign of 6, whereby the word is divided in two sections by a point. The second part is indivisibly connected with the part "DPS" and has to be read and pronounced as one whole word. Also, the first letter is the most important letter. The defendant concludes that the signs are visually and aurally not identical or similar.

18. As regards the conceptual comparison, the defendant states that "PS" is known as an abbreviation of "Parcel Services". However, the fact that the description of the trademarks invoked both include the word "Parcel Services" does not necessarily give rise to a conceptual similarity. According to the defendant, it is generally known that in the logistics sector, most companies make use of marks existing of only a few letters, mostly abbreviation of the terms "Parcel(s)", "Distribution", "Logistics", "Services",... The public will not consider such descriptive element as the distinctive and dominant element. He therefore finds the signs conceptually not identical or similar.

19. The defendant argues that the opponent uses vague terms to describe the services offered, whereas he uses undeniably clear descriptions that limit the claimed protection to the services actually offered.

20. With regard to the goods in class 9, the defendant argues that there is no similarity whatsoever between the description of the goods in class 9 and the the goods and services of the opponent in classes 9, 39 and 42. Regarding the goods in class 12, the defendant states that the description of the goods also relates to the scientific development of those vehicles and that he does not own nor operates any courier fleet, but just provides software solutions. The defendant argues that opponent's "business administration" does not allow to define which specific services are referred to. Moreover, the final goal of the services provided to customers is different: UPS aims at the logistic services itself whilst the defendant aims at organising the logistic services without providing for physical transport. As far as the services in class 36 and 38 are concerned, the defendant finds them dissimilar. With regard to class 39, the defendant argues that his services all relate to the organisation of the transport and not the transport itself. As for the services in class 42, the defendant finds that they have a different purpose as his services are only focussed on developing the software solutions.

21. The defendant argues that the goods and services are considered to be aimed to meet a particular technological and professional need, and consequently the level of attention of the consumer will be higher than average. He aims its activities at a niche market in a geographically limited area. Opponent on the contrary aims its activities at a broad and general public.

22. The defendant concludes that there is no similarity between the signs. As far as the Office does accept some degree of similarity, this does not give rise to a likelihood of confusion, not in the least taking into account the fact that the relevant public has a high degree of attention. He therefore requests the Office to reject the opposition, register the application and award payment of the costs by opponent to the defendant.

III. DECISION

A. 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 date 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: "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 signs to be compared are the following:

Opposition based on:	Opposition directed against:
UPS	dps.com

29. Visually, both signs are purely verbal marks. The difference in the use of capitals and lower-case letters is irrelevant for the purposes of a visual comparison of verbal marks (see EGC, babilu, T-66/11, 31 January 2013).

30. The trademark invoked consists of a three letter acronym, “DPS”. The contested sign consists of a three letter acronym “dps”, followed by a point and the three letter word “com. The latter element “.com” – as correctly stated by the opponent – is a generic top-level domain, which is commonly used and will be recognised as such by the relevant public. Therefore, the dominant element of the contested sign is “dps”. This element and the right invoked coincide in their last two letters, “PS”, but differ in the first. The ending “.com” is merely secondary, referring simply to an internet address (see, EGC, pagesjaunes.com, T-134/06, 13 December 2007).

31. According to consistent case law it must be taken into account that the consumer normally attaches more importance to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004). Moreover, in short signs, small differences are more easily noticed by the public (reference is made to EGC, COR/DOR, T-342/05, 23 May 2007).

32. Aurally, the right invoked coincides with the contested sign in the sounds of the letters “PS”, but they differ in their first letters (“U” vs “D”), as well as the secondary element “.COM”. As far as this last element is concerned however, the Office points out that it cannot be ruled out that the contested sign will only be referred to by its dominant element, as it will be abbreviated by the relevant public.

33. Conceptually, although parties seem to agree that “PS” stands for “Parcel Service”, both signs have no meaning. The addition of the internet extension “.COM” does not confer a particular meaning to the sign.

34. The first letter, which in this case also attracts the most attention, differs in both signs. The letter “U” is visually clearly different when compared to the letter “D”. Furthermore, the vowel U and the consonant D are pronounced completely different. Consequently, the fact that they coincide only in two letters and that the differing one is not phonetically or visually similar, does not lead to a finding of likelihood of confusion (see by analogy, EGC, ELS, T-388/00, 23 October 2002).

35. Therefore, there is no likelihood of confusion between these signs either, as the overall impression of the signs is clearly different.

Comparison of the goods and services

36. 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 are 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

37. Since the rights invoked are identical, the goods and services of the rights invoked are shown below in a consolidated manner. The goods and services to be compared are the following:

Opposition based on:	Opposition directed against:
KI 9 Wetenschappelijke, zeevaarkundige, landmeetkundige en elektrische toestellen en instrumenten voor zover niet begrepen in andere klassen, fotografische, cinematografische, optische, weeg-, meet-, sein-, controle- (inspectie-), hulpverlenings- (reddings-) en onderwijstoestellen en -instrumenten; apparaten voor het opnemen, het overbrengen en het weergeven van geluid of beeld; magnetische gegevensdragers, schijfvormige geluidsdragers; verkoopautomaten en mechanismen voor apparaten met vooruitbetaling; kasregisters, rekenmachines, apparatuur voor het verwerken van gegevens, computers; brandblusapparaten.	CI 9 Computer software platforms; Application software for cloud computing services; Computer application software for mobile telephones; Computer application software; Software applications for use with mobile devices; Application software; Application software for mobile phones; Application software for wireless devices; Computer software applications, downloadable; Computer software for application and database integration; Computer software for controlling and managing access server applications; Devices for hands-free use of mobile phones; Hands free devices for mobile-phones; Computer interface software; Interface software; Computer programs for network management; Network management computer software; Network management software; Electronic payment terminal; Terminals for electronically processing credit card payments; Computer e-commerce software; Handheld computers; Digital signage; Digital signage display panels; Computer programmes for data processing; Computer software for Global Positioning Systems; Electronic point of sale terminals; Encoded cards for use in point of sale transactions; Point of sale terminals; Computer software for biometric systems for the identification and authentication of persons; Databases; Electronic security tags; Electronic tags; Electronic tags for goods; Radio-frequency identification (RFID) readers; Radio-frequency identification (RFID) tags; Encoded loyalty cards; Keys (Encoded -)

	<p>CI 12 Driverless cars; Driverless cars [autonomous cars]; Driverless transporter vehicles; Electrically operated vehicles; Electrically powered vehicles; Electrically operated theft prevention installations for vehicles</p>
<p>KI 35 Reclame; beheer van commerciële zaken; zakelijke administratie; administratieve diensten.</p>	<p>CI 35 Advertising relating to transport and delivery; Business administration in the field of transport and delivery; Business consultancy, in the field of transport and delivery; Business management consultancy in the field of transport and delivery; Business management in the field of transport and delivery; Supply chain management services; Retail services in relation to smartphones; Provision of an on-line marketplace for buyers and sellers of goods and services; Compilation of direct mailing lists; Direct mail advertising; Direct mail advertising services; Preparation of mailing lists for direct mail advertising services [other than selling]; Advertising services for the promotion of e-commerce; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Computerised point-of-sale data collection services for retailers; Promoting the sale of goods and services of others by awarding purchase points for credit card use; Sales promotions at point of purchase or sale, for others; Administration of consumer loyalty programs; Administration of loyalty programs involving discounts or incentives; Customer loyalty services for commercial, promotional and/or advertising purposes; Loyalty card services; Loyalty, incentive and bonus program services; Loyalty scheme services; Management of customer loyalty, incentive or promotional schemes; Organisation and management of customer loyalty programs; Organisation, operation and supervision of customer loyalty schemes; Organisation, operation and supervision of loyalty schemes and incentive schemes; Computerised stock management; Electronic stock management services; Invoicing; Invoicing services; Database management; Data entry and data processing; Automatic re-ordering service for business; Computerised stock ordering; Computerized on-line ordering services; Ordering services [for others]; Ordering services for third parties</p>
<p>KI 36 Verzekeringen; financiële zaken; monetaire zaken; makelaardij en handel in onroerende goederen.</p>	<p>CI 36 Valuation of cargo for insurance purposes; Valuation of freight and cargo; Transport insurance brokerage; Providing multiple payment options by means of customer-operated electronic terminals available on-site in retail stores; Arranging the payment of customs duties; Automated payment of accounts; Automated payment services; Bank card, credit card, debit card and electronic payment card services; Collection of payments; Collection of payments for goods and services; Conducting cashless</p>

	<p>payment transactions; Credit card and payment card services; Credit card payment processing; Electronic payment services; Electronic processing of payments; Electronic wallet services (payment services); Financial transfers and transactions, and payment services; Information services relating to the automated payment of accounts; Issuing electronic payment cards in connection with bonus and reward schemes; Payment services provided via wireless telecommunications apparatus and devices; Payment transaction card services; Processing electronic payments made through prepaid cards; Remote payment services; Issuing of tokens of value in relation to customer loyalty schemes; Issuing tokens of value as a reward for customer loyalty; Insurance services; Brokerage of insurance</p>
<p>KI 38 Overbrengen van boodschappen, brieven, documenten en andere teksten via telex of via een andere al dan niet elektronische weg.</p>	<p>CI 38 Collection and delivery of messages by electronic mail; Electronic message delivery services; Providing access to platforms and portals on the Internet; Providing access to e-commerce platforms on the Internet; Providing user access to platforms on the Internet; Telecommunication services provided via platforms and portals on the Internet and other media; Provision of access to an electronic marketplace [portal] on computer networks</p>
<p>KI 39 Transport van pakjes, brieven, documenten en andere stukken.</p>	<p>CI 39 Arrangement for the delivery of parcels by sea and by air; Collection, transport and delivery of goods, documents, parcels and letters; Courier services for the delivery of parcels; Delivery and forwarding of letters and parcels; Delivery of parcels; Delivery of parcels by courier; Parcel delivery; Parcel delivery services; Pickup and delivery of parcels and goods; Providing information relating to the delivery of documents, letters and parcels; Road delivery of parcels; Arranging the collection of parcels; Arranging the transportation of parcels; Arranging the transportation of parcels by air; Arranging the transportation of parcels by land; Arranging the transportation of parcels by sea; Forwarding of parcels; Parcel collection services; Parcel distribution; Parcel receipt services; Parcel shipping services; Parcel storage services; Storage of parcels; Tracking and tracing services for letters and parcels; Transport of parcels; Transportation of parcels overnight; Transportation of parcels; Arranging and conducting of mail order delivery services; Arranging the delivery of goods; Arranging the delivery of gifts; Arranging the delivery of goods by post; Cargo delivery services; Collection, transport and delivery of goods; Correspondence delivery by post and/or messenger; Courier services for the delivery of goods; Courier services for the delivery packages; Delivery and forwarding of mail;</p>

	<p>Delivery and storage of goods; Delivery, despatching and distribution of newspapers and magazines; Delivery of food and drink prepared for consumption; Delivery of food by restaurants; Delivery of goods; Delivery of goods by messenger; Delivery of groceries; Delivery of magazines; Delivery of letters; Delivery of mail by courier; Delivery of newspapers; Delivery services; Express delivery of goods; Food delivery; Food delivery services; Mail delivery and courier services; Storage and delivery of goods; Transport and delivery of goods; Transportation and delivery of goods; Transportation and delivery services by air, road, rail and sea; Air courier services; Courier services; Courier services for merchandise; Courier services for the transportation of cargo; Courier services [merchandise]; Courier services [messages or merchandise]; Delivery of messages [courier]; Messenger courier services; Transportation by courier; Air transportation services for cargo; Air cargo transport services; Airline services for the transportation of cargo; Arranging the transportation of cargo; Arranging the unloading of cargo; Cargo forwarding services; Cargo handling; Cargo handling and freight services; Cargo loading services; Cargo ship transport; Cargo tracking services; Cargo transportation; Cargo unloading; Cargo unloading services; Freight and cargo services; Freight and cargo transportation and removal services; Information services relating to the movement of cargo; Loading of cargo; Providing information relating to cargo unloading services; Unloading of cargo (Services for the -); Booking of transport via global computer networks; Freight and transport brokerage services; Freight and transport brokerage; Providing information relating to travel and transport, via electronic means; Providing transport and travel information via mobile telecommunications apparatus and devices; Arranging and providing transport by land, sea and air; Vehicle routing by computer on data networks; Rental of frozen food lockers</p>
<p>KI 42 Onderzoek op wetenschappelijk en industrieel gebied; computerprogrammering.</p>	<p>CI 42 Hosting of e-commerce platforms on the Internet; Platform as a Service [PaaS]; Programming of software for Internet platforms; Programming of software for e-commerce platforms; Development and testing of computing methods, algorithms and software; Design and development of computer software for logistics; Design and development of computer software for logistics, supply chain management and e-business portals; Cloud computing; Consulting in the field of cloud computing networks and applications; Design and development of operating software for accessing and using a cloud computing network; Programming of operating software for accessing and using a cloud computing network; Rental of</p>

	<p>operating software for accessing and using a cloud computing network; Providing temporary use of on-line non-downloadable operating software for accessing and using a cloud computing network; Design and development of computer software for supply chain management; Consultancy relating to the creation and design of websites for e-commerce; Design and development of software for website development; Website design; Provision of geographical information; Data mining; Data warehousing; Computer programming services for data warehousing; Providing temporary use of online, non-downloadable computer software for use in broadcast monitoring applications; Providing temporary use of non-downloadable software applications accessible via a web site; Rental of application software; Development of computer software application solutions; Installation and customisation of computer applications software; Technical consultancy relating to the application and use of computer software; Advisory services relating to man-machine interfaces for computer software; Constructing an internet platform for electronic commerce; Design and development of data entry systems; Hosting platforms on the Internet; Hosting services and software as a service and rental of software</p>
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B. Other factors

38. It must be stated that the letter combinations “UPS” and “DPS” both possess a ‘normal’ degree of inherent distinctiveness.

39. 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). However, where there is no similarity between the earlier mark and the contested sign, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services respectively covered are identical or similar are not sufficient for it to be found that there is a likelihood of confusion between the marks at issue or that the relevant public makes a link between them (see, to that effect, ECJ, CK CREACIONES KENNYA, C-254/09 P, 2 September 2010 and TiMi KiNDERJOGHURT, C-552/09 P, 24 March 2011). Even assuming the earlier marks enjoying an enhanced distinctiveness due to extensive use, would not alter the outcome. It is therefore not necessary to examine this argument.

B. Conclusion

40. Based on the foregoing the Office is of the opinion that the overall impression of the signs is different and therefore, there exists no likelihood of confusion.

IV. DECISION

41. The opposition with number 2011371 is rejected.

42. Benelux application with number 1317557 will be registered.

43. The opponent shall pay the defendant 1,030 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is rejected in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 22 May 2018

Diter Wuytens
(rapporteur)

Camille Janssen

Tomas Westenbroek

Administrative officer: Paul Vink