

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2011606**  
**of 12 July 2017**

**Opponent:** **ADVANCE MAGAZINE PUBLISHERS INC.**  
One World Trade Center  
New York, NY 10007  
United States of America

**Representative:** **Arnold & Siedsma**  
Postbus 18558  
2502 EN Den Haag  
Netherlands

**Invoked right 1:** **European registration 183756**  
  
VOGUE

**Invoked right 2:** **Benelux registration 527961**

**VOGUE**

**Invoked right 3:** **According to the opponent a well-known trademark within the meaning of Article 6bis of the Paris Convention**

VOGUE

*against*

**Defendant:** **Arsal Shabbir Khanani**  
Adamjee Nagar Syed Ghafar Shaheed Road 28 A  
0000 Karachi  
Pakistan

**Representative:** **DLA Piper Nederland N.V.**  
Amstelveenseweg 638  
1081 JJ Amsterdam  
Netherlands

**Contested trademark: Benelux application 1321477**




## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 18 November 2015 the defendant filed an application for a trademark in the Benelux for the combined word/figurative mark  BLACKVOGUE for goods in class 25. This application was processed under number 1321477 and was published on 24 November 2015.

2. On 20 January 2016 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- European registration 183756 of the word mark VOGUE, filed on 1 April 1996 and registered on 28 May 2014 for goods and services in classes 9, 16, 25 and 41.
- Benelux registration 527961 of the combined word/figurative mark , filed on 18 February 1993 and registered for goods in classes 16, 25 and 28.
- The word mark VOGUE, according to the opponent, a well-known trademark within the meaning of Article 6bis of the Paris Convention.

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

4. The opposition is directed against all goods of the contested application and is based on all goods and services of the first trademark invoked and all goods in classes 16 and 25 of the second trademark invoked.

5. The grounds for opposition are those laid down in article 2.14, 1 (a) and (b) 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 25 January 2016. An invalidation or revocation action has been filed against the first trademark invoked (183756). Consequently, the opposition proceedings were suspended until the Office was notified that this action has been ended. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. 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 2 March 2017.

## II. ARGUMENTS

8. The opponent filed an opposition at the Office under article 2.14, 1 (a) and (b) 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 argues that the contested sign consists of a composition of the noun VOGUE and the adjective BLACK. According to the opponent, an adjective is almost always placed before a noun. This is also the case when the adjective is a colour. The opponent states that the word VOGUE is the dominant element as the adjective is subordinate to the noun. Furthermore, the opponent states that the figurative element is not distinctive, because it consists of a hexagon in which the first letters of the adjective BLACK and the noun VOGUE are depicted.

10. Visually, the opponent argues that the font used for the wording in the contested sign is almost identical to the font used for the second trademark invoked. Furthermore, the opponent states that the dominant part of the contested sign is identical to the trademarks invoked. Also, the letter V used in the figurative element of the contested sign is identical to the V used in the second trademark invoked. For these reasons, the opponent concludes that the signs are visually highly similar.

11. With regard to the aural comparison, the opponent states that the public will not refer to the two letters that are depicted in the figurative element, but will only pronounce the word element BLACKVOGUE. According to the opponent, this element will be pronounced as two words and the focus will lie on the word VOGUE. This word is identical to the trademarks invoked. The opponent therefore concludes that the signs are aurally highly similar.

12. The opponent states that the contested sign will be perceived as the adjective BLACK and the noun VOGUE. Both signs include the word VOGUE, which refers to a certain style at a particular moment. Therefore, the signs are conceptually similar.

13. According to the opponent, the goods and services of the trademarks invoked are identical or highly similar to the goods of the contested sign.

14. The opponent argues that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards their visual, aural and conceptual aspects.

15. The opponent concludes that there is a likelihood of confusion and requests that the Office upholds the opposition and rejects the contested sign for all goods.

16. At the request of the defendant, the opponent filed proof of use with regard to the second trademark invoked.

**B. Defendant's arguments**

17. The defendant states that the opponent has not submitted any evidence with regard to its statement that the opposition is also based on an unregistered well-known trademark.

18. 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 genuine use for the goods in classes 25 and 28 in the Benelux. According to the defendant, the opponent has only genuinely used the second trademark invoked for the goods in class 16. With regard to the goods in class 16, the defendant argues that these goods are not similar to the goods of the contested sign.

19. With regard to the comparison of the first trademark invoked, the defendant argues that the contested goods in class 25 are partially identical and partially similar.

20. The defendant argues that the word element VOGUE is descriptive for the goods in class 25, because it means 'fashion', and for this reason cannot be considered the distinctive and dominant element of the contested sign. According to the defendant, the public will not perceive the word BLACK as an indication of black coloured clothes. Therefore, the word BLACK is distinctive for the goods in class 25. The defendant also disputes the argument of the opponent that the contested sign will be perceived as an adjective and a noun, because the word element is presented as one word. Even if the word BLACK were perceived as an adjective, the defendant is of the opinion that this word is not subordinate to the noun VOGUE, because the word VOGUE is descriptive and the word BLACK is not.

21. The defendant argues that the figurative element in the contested sign is distinctive and is more important than, or has at least as much relevance as, the word element. For this reason, the figurative sign, due to its position and size, will make an impression on consumers and will be remembered by them.

22. With regard to the visual comparison of the signs, the defendant argues that the first trademark invoked is not styled, has no other word elements and lacks a figurative element. Only the word element of the contested sign is similar to a low degree to the trademark invoked. However, according to the defendant, the overall impression conveyed by each sign is different, due to the differences in length, different beginnings and the presence of a figurative element in the contested sign. With regard to the second trademark invoked, the defendant argues that the signs also have a different font. These differences annul the slight visual similarity.

23. Aurally, the defendant argues that only the word VOGUE is identical and will be pronounced identically. However, the word VOGUE is not the dominant element of the contested sign and the public will pronounce the word BLACK first. The signs also significantly differ in length. For this reason the degree of aural similarity is low.

24. The defendant states that for the French speaking part of the public, the word 'vogue' has the usual meaning 'fashion'. For the Dutch speaking part of the public, the defendant argues that the word 'vogue' has no direct and conceptual meaning. Conceptually, the word BLACK is the most distinctive element in the contested sign, because it is not descriptive and draws the attention of the public, because it gives the word 'vogue' an additional connotation. According to the defendant, in the light of the goods concerned, the public can perceive the word BLACK as 'dark' in the meaning of 'rebellious'. The word BLACK could also be perceived as referring to 'black tie', in which case it will mean 'luxurious'. Therefore, the defendant concludes that the signs are conceptually dissimilar, or at most similar to a low degree due to the usual definition of the word VOGUE.

25. The defendant further states that the degree of aural similarity between the signs is of less importance than the degree of visual similarity, because the goods are marketed in such a way that the relevant public, when making a purchase, will perceive the signs visually.

26. With regard to the low level of distinctiveness of the word VOGUE, the defendant also argues that this word is a common element used in other registered trademarks. The defendant points out that the opponent has not launched any opposition proceedings against these trademarks.

27. The defendant acknowledges that the opponent is not yet obliged to prove genuine use for the first trademark invoked. However, the opponent is also the holder of several other trademark registrations, which also include the word VOGUE. According to the defendant, neither the trademarks invoked, nor these other trademarks have been used by the opponent for the goods in class 25. The defendant argues that the opponent has not

explained or indicated in any way that the first trademark invoked will actually be used for goods in class 25 in the future. The defendant therefore states that the public will not perceive the contested sign as one of the trademarks of the opponent.

28. The defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition, registers the contested sign and orders the opponent to pay the costs of these proceedings.

### **III. DECISION**

#### **A.1 Likelihood of confusion**

29. 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.

30. 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.”*

31. 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 goods and services**

32. 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).

33. With the comparison of the goods and services of the trademark invoked and the goods 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.

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

*With regard to the first trademark invoked (EU trademark 183756)*

Opposition based on:	Opposition directed against:
CI 9 Software; CD-ROMs; audio and videocassettes; electronic, optical and digital publications; optical apparatus and products including eyewear- eyeglasses and sunglasses.	
CI 16 Printed matter (magazines, newsletters, and books; computer programs); paper products (posters, paper patterns)	
CI 25 Clothing	CI 25 Clothing and Footwear
CI 41 Electronic information and entertainment services accessible via global or non-global computer network.	

35. The goods “*clothing*” are mentioned *expressis verbis* in both lists of goods and services and are therefore identical.

36. With regard to the goods “*footwear*”, the Office considers that these goods are similar to the goods “*clothing*” mentioned in Class 25 of the opponent. Both goods are worn by people in order to cover and protect the body. Furthermore, these goods are often commercialized by the same distribution channels and clothing and shoes are often introduced to the market under the same trademark. The Office is of the opinion that the consumer is aware of this and will assume that these products originate from the same undertaking (reference is made to BOIP, Nano, opposition decision 2002033, 25 May 2009).

#### *Conclusion*

37. The goods of the contested sign are partially identical and partially similar to the goods of the first trademark invoked.

#### **Comparison of the signs**

38. 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).


39. 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).

40. 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).

41. The signs to be compared are the following:

*With regard to the first trademark invoked (EU trademark 183756)*

Opposition based on:	Opposition directed against:
VOGUE	

42. According to relevant case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, inter alia the visual, aural and conceptual aspects (reference is made to Matratzen and Sabel, already cited).

43. In addition, according to the case-law, when a complex mark consists of an element juxtaposed with another trade mark, that latter mark, even where it is not the dominant component in the complex mark, may still have an independent distinctive role in the complex mark. In such a case, the complex mark and the other mark can be regarded as similar (EGC, Life Blog, T-460/07, 20 January 2010).

#### *Conceptual comparison*

44. The Office is of the opinion that the term VOGUE in the trademark invoked will be understood by part of the Dutch and French speaking public as 'fashion', or as 'fashionable/in fashion/be all the rage'.<sup>1</sup> Since this word is not commonly used in this way in the Benelux, the Office also considers that part of the public will perceive VOGUE as an imaginary word without any specific meaning. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd, already cited), the fact remains that, when perceiving a verbal sign, he will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him (EGC, Respicur, T-256/04, 13 February 2007; Aturion, T-146/06, 13 February 2008 and Galvalloy, T-189/05, 14 February 2008). The word BLACKVOGUE in the contested sign has no meaning in its entirety and therefore it is likely that the public will split the word into different parts: BLACK and VOGUE. The word VOGUE will be understood as defined previously, and the term BLACK will be understood as the colour black.

45. The defendant argues that the word BLACK is the dominant element, because the word VOGUE is descriptive and the word BLACK is not (paragraph 20). However, in the light of the goods concerned (clothing and footwear) and the fact that the word element in the contested sign will be perceived by the public as two words with separate meanings, the Office is of the opinion that the public could think that the word BLACK indicates the nature of the goods, for example the colour. For this reason, it is not likely that the public will perceive the word BLACK as the dominant element in the contested sign.

46. Although the element BLACK has a different meaning, it is considered that the identical word VOGUE refers to the same concept and therefore the signs are conceptually similar to a certain degree.

<sup>1</sup> reference is made to Van Dale Dictionary, Nederlands-English, 4<sup>e</sup> Edition and <http://www.mijnwoordenboek.nl/vertaal/FR/EN/vogue>



47. The signs are conceptually similar to a certain degree.

*Visual comparison*

48. The trademark invoked is a verbal mark, consisting of a single word of five letters, "Vogue". The contested sign is a combined word/figurative mark. It depicts the word "blackvogue", in a black typeface. On the left of the word element, the contested sign shows a figurative element of a hexagon in which the letters B and V are displayed intertwined.

49. When 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 using the word element than by describing the figurative element of the trademark (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). The Office finds that, although the figurative element at the beginning of the contested sign will not be overlooked (see Court of Appeal The Hague, MOOVE-4MOVE, 200.105.827/0, 11 September 2012), it is rather abstract and liable to various interpretations. The word element BLACKVOGUE has a clear and central position and constitutes a significant part of the sign as compared to the figurative element and will therefore catch the eye at least as much as the latter.

50. Although the consumer normally attaches more importance to the first part of words (MUNDICOR, cited at paragraph 27 above, at paragraph 81), that consideration cannot apply in every case (EGC, ALLTREK, T-158/05, 16 May 2007). The trademark invoked is completely included in the ending of the contested sign and even if it is not a dominant element, it still has an independent distinctive role (EGC, Life Blog, already cited).

51. Both signs contain the identical word VOGUE. The signs differ because of the addition of the word BLACK and a figurative element in the contested sign.

52. In the light of the above, the signs are visually similar to a certain degree.

*Aural comparison*

53. In the strict sense, the aural reproduction of a complex sign corresponds to that of all of 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). Furthermore, in the light of the presence of the word element BLACKVOGUE, the Office is of the opinion that the public will refer to the contested sign using the word elements and not the figurative element, nor the letters depicted therein.

54. The right invoked consists of one syllable, VOGUE and will be pronounced as [vog]. The word element of the contested sign consists of two syllables BLACK-VOGUE, which will be pronounced as [blæk vog]. As also considered with regard to the visual comparison, even though the beginning of the signs are different, this does not change the fact that the pronunciation coincides in the sound of the word VOGUE, and to that extent the signs are aurally similar to a certain extent.

*Conclusion*

55. Trademark and sign are conceptually, visually and aurally similar to a certain extent.

## **A.2 Global assessment**

56. 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.

57. 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 present case concerns goods which are targeted at the public in general. For these goods the average level of attention of the public concerned may be deemed normal.

58. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken into 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).

59. 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). The defendant argues that the trademark invoked lacks distinctive character because of the fact that the word VOGUE is descriptive (paragraph 20). The Office is of the opinion that even though the term 'vogue' means 'fashion' or 'in fashion', it is not a common word used by the average consumer in the Benelux in this sense. Although the word could be considered as strongly allusive, the Office does not hold it to be descriptive for the relevant goods. Moreover, even if the Office assumed, like the defendant, 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, mean that there is no 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 concerning 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 on account, in particular, of a similarity between the signs and between the goods or services covered (EGC, Flexi Air, T-112/03, 16 March 2005 and Pages Jaunes, T-134/06, 13 December 2007). Moreover, a likelihood of confusion among part of the relevant public is sufficient to grant an opposition (EGC, Hai/Shark, T-33/03, 9 March 2005).

60. Account must also be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse 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 marks but must place his trust in the imperfect picture of them that he has kept in his mind.

61. Based on the above-mentioned circumstances, given the interdependence between the identity and similarity of the goods and the certain visual, aural and conceptual similarity of the signs, the Office is of the opinion that the relevant public might believe that the goods in question originate from the same undertaking or from economically-linked undertakings.

**B. Other factors**

62. With regard to the defendant's argument that the trademark invoked is descriptive, since it is also part of several other trademark registrations for similar goods (paragraph 26), the Office considers that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings before the Office, the defendant duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC Top iX, Case T-57/06, 7 November 2007 and Life Blog, T-460/07, 20 January 2010). However, in this case the evidence that coexisting registrations on the market were identical has not been submitted. Furthermore, the defendant has not shown that any coexistence was based on the absence of a likelihood of confusion.

63. The defendant also argues that the opponent has not launched any opposition proceedings against other trademark registrations containing the word VOGUE (paragraph 26). The fact that the opponent has not, for whatever reason, taken any action against other (similar) trademark registrations is not relevant in this case. Indeed, it is up to the opponent to decide whether or not he wants to file an opposition against a younger trademark application, if he is of the opinion that this constitutes a risk of confusion with the public (see BOIP, Benzo, opposition decision 2002357, 30 June 2009).

64. The defendant acknowledges that for the first trademark invoked, the opponent is not obliged to prove genuine use. However the defendant argues that neither this trademark, nor any of the opponent's other trademarks, containing the word VOGUE, are actually used for the goods concerned (paragraph 27). The Office points out that the opposition procedure leaves no room for considerations concerning the actual use of the signs concerned or any other signs. The comparison of the signs is solely based the information mentioned in the registration, possibly limited by the evidence of genuine use provided by an opponent (see to that effect: CJEU, Quantum, C-171/06, 15 March 2007, O2 Holdings Limited, C-533/06, 12 June 2008 and EGC, Ferromix e.a., T-305/06-T-307/06, 15 October 2008). Moreover, as the defendant already stated, the first trademark invoked is not subject to an obligation of use.

65. With reference to the defendant's request that the opponent should bear all costs of the proceedings (paragraph 28), the Office considers that opposition proceedings with the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.16, 5 BCIP, as well as 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.

**C. Conclusion**

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

67. Since the opposition based on the first trademark invoked is already justified, it is not necessary to examine the proof of use regarding the second trademark invoked, nor the opponent's statement that the trademark invoked is a well-known trademark within the meaning of Article 6bis of the Paris Convention, because this will not alter the outcome of these proceedings.

**IV. DECISION**

68. The opposition with number 2011606 is justified.

69. Benelux application with number 1321477 will not be registered.

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

The Hague, 12 July 2017

Eline Schiebroek  
(rapporteur)

Saskia Smits

Tomas Westenbroek

Administrative officer: Paul Vink