



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2011621

of 28 July 2017

Opponent: **GILFIN S.P.A.**
Via G. Leopardi 3/5
46043 Castiglione Delle Stiviere (MN)
Italy

Representative: **GEVERS**
Holidaystraat 5
1831 Diegem
Belgium

Invoked right 1: **European Union trademark 11088739**



Invoked right 2: **European Union trademark 13724158**

SISI

against

Defendant: **ETP Technologies Limited**
Regent Street 207 3rd floor
W1B 3HH London
Great Britain

Contested trademark: **Benelux application 1321305**

SISU

I. FACTS AND PROCEEDINGS

A. Facts

1. On 17 November 2015 the defendant filed an application for a trademark in the Benelux for the word mark "SISU" for goods and services in classes 9, 25 and 35. This application was processed under number 1321305 and was published on 24 November 2015.

2. On 22 January 2016 the opponent filed an opposition against the registration of the application. The opposition is based on the following trademarks:

- European Union trademark 11088739 of the following combined word/figurative mark filed on 1



August 2012 and registered on 17 December 2012 for goods in class 25: ;

- European Union trademark 13724158 of the word mark SISU, filed on 10 February 2015 and registered on 10 July 2015 for goods in class 25;

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

4. The opposition is directed against all of the goods in class 25 and part of the services in class 35 of the contested application and is based on all of the goods 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. Chronological order of the proceedings

7. The opposition is admissible and was notified to the parties on 28 January 2016. During the administrative phase of the proceedings both parties filed arguments. 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 once at the request of the parties. The administrative phase was completed on 25 November 2016.

II. ARGUMENTS

8. The opponent filed an opposition at the Benelux Office for Intellectual Property (hereinafter: "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

9. The opponent considers that the goods and services of the contested sign are identical and similar to the goods of the opponent.

10. The opponent stresses that the most distinctive element of the complex trademark is the word element SISI. Therefore the arguments regarding the earlier word mark can be considered applicable for the earlier figurative complex trademark as well.

11. Visually, the signs coincide in the three letters "SIS", placed in the same order in the same position, at the beginning of each sign. The signs are the same length (four letters). They only differ in their final letter, "I" vs. "U". According to the opponent, the trademarks are similar from a visual point of view. Aurally, the pronunciation of the signs coincides in the sound of the first identical letters "SIS". Furthermore, the signs have the same rhythm (two syllables) and intonation. The pronunciation differs only in the sound of the signs' final letters, "I" vs. "U", which are both vowels. The opponent concludes that the signs are aurally similar to a high degree. Conceptually, the word SISI of the earlier mark has no meaning for a large part of the public. However, part of the public may perceive it as a nickname, especially because SISI was the nickname of Elizabeth of Bavaria, a fact that has been made widely known by a number of movies and TV series. However this concept has no clear meaning in relation to the goods at issue and this element enjoys an average degree of distinctiveness. The word SISU has no meaning for the relevant consumers, except for Finnish consumers, for whom it describes the Finnish spirit (perseverance, bravery, guts), according to the opponent. However the relevant territory is the Benelux. Therefore, for a large part of the public in the relevant territory neither of the signs has a meaning and thus a conceptual comparison is not possible. The opponent concludes that the signs are visually and aurally similar to a high degree.

12. The relevant public at issue is the public at large. The opponent states that their degree of attention is considered average. Moreover the opponent considers that since the goods at issue are clothing, footwear and headgear, for which the visual aspect plays a greater role in the global assessment of the likelihood of confusion, the aural aspect remains relevant to the assessment of the likelihood of confusion.

13. In view of the foregoing, the opponent is of the opinion that the differences between the signs are not sufficient to enable consumers to accurately distinguish between the goods and services of the opponent and those of the defendant. Thus there is a likelihood of confusion on the part of the public. The opponent therefore requests that the Office declares the opposition admissible and well founded and thus upholds the opposition for all the contested goods and services, rejects the application of the contested sign and orders the applicant to bear the costs and the opponent's fees in the opposition proceedings.

B. Arguments of the defendant

14. The defendant states that the goods and services of the conflicting signs, while coinciding in some degree of their specifications, are not entirely identical or similar and therefore do not risk creating a likelihood of confusion in the mind of the relevant public, particularly taking into account the dissimilarity of the signs.

15. The defendant compares first of all the complex trademark invoked and the contested sign. Visually the signs differ significantly, according to the defendant. In the case at hand the dominant elements of the earlier mark are likely to stay in the mind of the public and, as such, mitigate the chances of being confused with other trademarks such as the contested sign. The stylised font and the different letter "I" at the end of the sign, will not

go unnoticed by the relevant consumer. As such the conflicting signs are not visually similar. Aurally, the contested sign is clearly pronounced differently to the trademark invoked, respectively SISU and SISI. The final syllables are clearly different. Therefore the defendant is of the opinion that it is not possible that the trademarks could be found aurally similar. Conceptually, neither one of the signs has a clear meaning in one of the languages of the Benelux. Thus, no conceptual comparison shall be made.

16. Regarding the comparison of the verbal trademark invoked and the contested sign, the defendant explains that visually the signs at issue differ significantly. Three of the four letters of the contested sign are repeated in the earlier trademark. The final letter "l" of the earlier trademark differentiates the pronunciation of the trademarks and, as such, will remain in the mind of the relevant consumer. Aurally, the trademarks to be compared are dissimilar. The contested sign is pronounced as SISU, while the earlier trademark is pronounced as SISI. The final syllables are thus clearly different. Finally, conceptually, neither one of the signs has a clear meaning in one of the languages of the Benelux. Therefore, no conceptual comparison shall be made.

17. In the case at hand, the services specified by the respective signs are entirely dissimilar, according to the defendant. This level of dissimilarity is sufficient to offset the similarities between the two marks. As a result, a likelihood of confusion cannot exist and the relevant consumer will easily be able to differentiate between the goods and services under the signs.

18. The defendant concludes that no similarity exists between the opponent's earlier trademarks and the contested sign. Therefore, the defendant requests that the opposition at hand be rejected in its entirety as unfounded, that the contested sign be granted protection in the territory of the Benelux and that all costs and fees arising in connection with the proceedings are imposed on the opponent.

III. DECISION

A.1 Likelihood of confusion

19. 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.

20. 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."*

21. 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

22. 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).

23. In the comparison of the goods of the trademarks 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.

24. The goods of the rights invoked are listed here together. The goods and services to be compared are the following:

Opposition based on:	Opposition directed against:
CI 25 Clothing, footwear, headgear. <i>(European registration 11088739)</i> CI 25 Stockings; Slippers; Socks; Tights; Underwear; Suspenders; Brassieres; Boxer shorts; Undergarment slips; Petticoats; Bodies; Underwear; Ready-to-wear clothing; Skirts; Shirts and slips; Jumpers; Corsetry; Underwear; Footwear; Footwear; Boots; Mules; Shirts; Chemisettes; Pajamas (am.); Clothing; Gowns; Lounging robes; Topcoats; Headgear; Berets; Swimming costumes; Smocks; Corsets; Ties; Sashes for wear; Shawls; Scarves; Gloves; Pelisses; Stoles and clothing of fur. <i>(European registration 13724158)</i>	CI 25 Clothing; footwear; headgear; swimwear; sportswear; leisurewear.
	CI 35 Retail services connected with the sale of clothing and clothing accessories; online retail store services in relation to clothing.

Class 25

25. The goods “*clothing; footwear; headgear*” are mentioned *expressis verbis* in both lists of goods and services and are thus identical.

26. The goods “*swimwear; sportswear; leisurewear*” of the defendant are identical to the goods “*clothing*” of the opponent. The Office considers that according to established case law, if the goods and services of the earlier trademark also contain goods and services that are mentioned in the application for the contested sign, these goods and services are considered identical (see EGC, Fifties, T-104/01, 23 October 2002; Arthur et Félicie, T-346/04, 24 November 2005 and Prazol, T-95/07, 21 October 2008). The trademark invoked covers all clothing and is, therefore, identical to the defendant’s goods “*swimwear; sportswear and leisurewear*”.

Class 35

27. In general goods and services differ as to their nature. Goods are physical products that can be transferred. Services concern the execution of intangible activities. An inherent consequence of these differences is that the use of goods and services also differs. However, goods and services can be complementary, as certain services cannot be rendered without using certain goods.

28. Regarding the complementary nature of goods and services, it should be pointed out that, according to settled case law, complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (EGC, The O STORE, T-116-06, 24 September 2008).

29. The Office finds that the services "*retail services connected with the sale of clothing and clothing accessories; online retail store services in relation to clothing*" of the defendant are similar to a certain degree to the goods "*clothing*" of the opponent. The goods covered by the earlier mark, that is, clothing, are identical to those to which the applicant's services relate. The relationship between the retail services and the goods covered by the earlier trademark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when these goods are sold. The objective of retail trade, online as well as offline, is the sale of goods to consumers. Trade includes, in addition to the legal sales transaction, all activities carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods. Furthermore, the relationship between the goods covered by the earlier trademark and the services provided in connection with retail trade in respect of goods identical to those covered by the earlier trademark is also characterised by the fact that those services play, from the point of view of the relevant consumer, an important role when he/she comes to buy the goods offered for sale. It follows that, because the services provided in connection with retail trade, which concern, as in the present case, goods identical to those covered by the earlier mark, are closely connected to these goods, the relationship between these services and these goods is complementary. The services of the defendant can therefore be regarded as being similar to a certain degree to the goods "*clothing*" of the opponent.

Conclusion

30. The goods and services of the defendant are identical, or similar to a certain degree to the goods of the opponent.


Comparison of the signs

31. 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. Moreover 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).

32. 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).

33. 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 the 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).

34. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
SISI	SISU
	

Visual comparison

35. The first right invoked is a verbal trademark, consisting of a single word of four letters, SISI. The second right invoked is a combined word/figurative mark. It depicts one word, SISI, in capital letters in a particular typeface. The contested sign is a verbal mark, consisting of a single word of four letters, SISU.

36. Where a sign consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trademark (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). The Office finds that, although the figurative element in the second right invoked will not be overlooked (see *Gerechtshof's Gravenhage, MOOVE-4MOVE*, 200.105.827/0, 11 September 2012), it is rather limited as it only consists of a particular typeface in which the word SISI is written. The Office finds that the public will therefore perceive this typeface as a decorative, secondary element and the letters SISI as the dominant element of the second right invoked.

37. 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). The signs at issue contain three identical letters which are also placed in the same order at the beginning of the signs. The only difference between them is their last letter and the figurative element as far as the second right invoked is concerned.

38. Visually the signs are similar to a certain degree.

Aural comparison

39. 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).

40. The rights invoked consist of two syllables and will be pronounced as SI-SI. The contested sign also consists of two syllables and will be pronounced as SI-SU. Aurally, the consumer normally also attaches more importance to the first part of a sign (EGC, Mundicor, already cited). The pronunciation of the signs at issue coincides in the sound of their first three letters. Only the pronunciation of the last letter of the signs differs. Furthermore the signs share the same length and rhythm.

41. Aurally the signs are similar.

Conceptual comparison

42. The contested sign SISU has no meaning for the Benelux public. As for the rights invoked, the Office finds that part of the public will either not attribute a particular meaning to the word SISI or will perceive it as a girl's name and will thus perceive it in both cases as a fanciful term. Another section of the public might however perceive SISI as a reference to empress Elisabeth of Austria, whose nickname was SISI and whose life was portrayed in several films and TV series. The Office points out here that a risk of confusion with part of the public is sufficient to justify the opposition (see EGC, Hai/Shark, T- 33/03, 9 March 2005).

43. As the contested sign does not have a clear and precise meaning for the Benelux public, a conceptual comparison is not relevant here.

Conclusion

44. The rights invoked and the contested sign are similar to a certain degree in terms of visual perception. Aurally the signs are similar. A conceptual comparison is not relevant.

A.2 Global assessment

45. 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.

46. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question. The goods and services at issue are intended for the public at large with an average level of attention.

47. 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).

48. It should also be taken into consideration here that normally, the average consumer perceives a mark as a whole and does not proceed to an analysis of its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the various trademarks but must place his trust in the imperfect picture of them that he has kept in his mind.

49. 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 trademarks invoked have a normal level of distinctiveness, as they are not descriptive of the goods concerned.

50. Based on the circumstances mentioned above, the Office finds, given the interdependence between the identity and similarity of the goods and services and the similarity of the signs, 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

51. With reference to the opponent's and the defendant's request that the other party should bear all costs of the proceedings (see paragraphs 13 and 18), 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 equalling the basic opposition fee shall be borne by the losing party.

C. Conclusion

52. Based on the foregoing the Office concludes that there exists a likelihood of confusion.

IV. DECISION

53. The opposition with number 2011621 is justified.

54. Benelux application with number 1321305 will not be registered for the goods and services against which the opposition was directed:

- Class 25: All goods.
- Class 35: Retail services connected with the sale of clothing and clothing accessories; online retail store services in relation to clothing.

55. Benelux application with number 1321305 will be registered for the goods and services against which the opposition was not directed:

- Class 9: All goods.

- Class 35: Provision of information and advice to consumers regarding the selection of products and items to be purchased; advertising particularly services for the promotion of goods.

56. 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, 28 July 2017

Tineke Van Hoey
(*rapporteur*)

Saskia Smits

Camille Janssen

Administrative officer: Jeanette Scheerhoorn