



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2012167

of 30 July 2018

Opponent: **ORBIS TEXTIL GmbH & Co. KG**
Industriegebiet Oeckinghausen,
Kruppstraße 20
58553 Halver
Germany

Representative: **Heffels Spiegeler Advocaten**
Oranjestraat 8
2514 JB Den Haag
Netherlands

Invoked right: **International registration 558324**

Condor

against

Defendant: **CONTOR INTERNATIONAL LIMITED**
Regent Street 207 3rd Floor
W1B 3HH London
Great Britain

Representative: **Trademarkers Merkenbureau C.V.**
Amersfoortsestraatweg 33b
1401 CV Bussum
Netherlands

Contested trademark: **Benelux application 1332550**

Contor.com

I. FACTS AND PROCEEDINGS

A. Facts

1. On 18 May 2016 the defendant filed a Benelux application for the wordmark Contor.com for goods and services in classes 3, 9, 14, 16, 25, 26, 35, 38 and 41. This application was processed under number 1332550 and was published on 19 May 2016.

2. On 18 July 2016 the opponent filed an opposition against the registration of the application. The opposition is based on International registration 558324 with designation Benelux of the wordmark Condor, filed on 30 July 1990 and registered on 15 November 1990 for goods in class 25.

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

4. The opposition is directed against all the goods in class 25 of the contested application and is based on all the goods of the trademark invoked.

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

6. The language of the proceedings is English.

B. 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 19 July 2016. 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 20 June 2017.

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, founded in 1971, provides its customers with the latest fashion in business, uniform and casual clothing and specializes also in country, traditional and hunting style. Amongst other brands, the opponent, offers its products under the name Condor which is his brand for business, uniform and casual shirts. Condor is the classic line for working, business and pilot shirts.

10. First of all, the opponent would like to establish that the element .COM in the contested sign must not be taken into account while assessing the comparison of the signs, whereas this element is merely descriptive as being a well-known and world-wide used domain name extension.

11. From a visual point of view, the opponent is of the opinion that the signs are highly similar. Both consist of six letters, the first letter, -C being written in an uppercase letter. Both signs share the same beginning, -Con, and the same ending, -or. The only difference is the middle letter –d, in the right invoked and –t in the contested sign. The central position and the similar design of these letters contribute to a certain confusion, as the consumer will not likely pay attention to this detail. The signs at hand are identical or at least highly similar, according to the opponent.

12. The opponent also finds that the signs are almost identical or at least highly similar from an aural point of view. They differ only in one letter, -d versus –t. Both these letters are soft letters and are often confused due to their similarity in pronunciation. Consumers are more likely to pay attention to the first and the last parts of the litigious signs. The aural perception of the signs corresponds due to their sounds, an identical number of letters and number of syllables.

13. The opponent is of the opinion that a conceptual comparison is deprived of any interest, whereas the contested sign, Contor, does not have any meaning.

14. With regard to the comparison of the goods, the opponent finds that the goods are either identical or at least highly similar.

15. Given the fact that the relevant goods are identical and bearing in mind the striking similarity of the signs, the opponent finds that the contested sign might well be perceived as the internet version of the right invoked.

16. The opponent concludes that there is a likelihood of confusion. He therefore requests the Office to grant the request of opposition against the contested sign.

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

B. Defendant's arguments

18. The defendant is of the opinion that the opponent failed to prove genuine use of the right invoked. According to the defendant the evidence submitted does not provide sufficient evidence of the duration, place, manner and extent of the use of the right invoked in relation to (all) the registered goods in Class 25. Moreover, decreased sale of shirts in the relevant period clearly indicates that, even if there was genuine use, the opponent has failed to maintain his market share. The defendant finds no proof at all in relation to the use of the sign for "footwear" and "headgear". Therefore, according to the defendant, the opposition at hand has to be dismissed as unfounded.

19. Insofar as the Office finds that the opponent has shown sufficient use of the right invoked, the defendant submits that the opposition should fail due to the lack of confusing similarity of the signs.

20. The defendant is of the opinion that the signs at hand are visually dissimilar. The right invoked consists of one word of six letters, the contested sign consists of nine letters and made up of two separate elements. The contested sign will instantly be perceived as a website by the consumer who will also notice the differing letters -d and –t.

21. From an aural perspective, the defendant finds that the right invoked will be clearly pronounced differently to the contested sign, the first consisting of two syllables, the latter of four. This distinction alters the number, sequence and rhythm of the syllables, according to the defendant, who consequently finds that the signs are aurally dissimilar.

22. The defendant states that the signs are conceptually different in their nature. According to the defendant the “.” may seem like a small addition, but it totally alters the meaning of the contested sign. It will therefore instantly be perceived as a website due to the addition of the TLD “com”. The defendant is of the opinion that the right invoked will simply be understood as a common English word referring to “a very large New World vulture with a bare head and mainly black plumage, living in mountainous country and spending much time soaring on outstretched wings”. Consequently, the defendant finds that there is no possibility whatsoever that the relevant consumer could be confused.

23. The defendant acknowledges that there are some similarities in the specifications of the goods of both signs, but in any case there are also some notable differences. The defendant finds that “swimwear”, “sportswear” and “leisurewear” are not included in the list of goods of the right invoked. It is therefore reasonable to assume that they may be sold in different sales outlets, have a different intended purpose, be produced by different manufacturers or be directed at diverse publics. With his remarks on the proof of use provided, the defendant specifically finds that the right invoked has not at all been used for the goods “footwear” and “headgear” (see paragraph 18). The defendant concludes that the goods, although they coincide in parts of their specifications, are not entirely identical and therefore they do not risk creating a likelihood of confusion in the mind of the relevant public, taking into account the dissimilarity of the signs.

24. The defendant requests that the opposition at hand be rejected in its entirety as unfounded and that the contested sign be granted protection in the territory of the Benelux. It is further requested that the opponent shall bear all costs and fees.

III. DECISION

A.1 Proof of use

25. 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 19 May 2016. Therefore the opponent was required to show use of the right invoked, during the period from 19 May 2011 to 19 May 2016 (‘the relevant period’).

26. 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.

27. 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/or services on which the opposition is based.

In general

28. In accordance with the decision of the European Court of Justice (hereinafter referred to as "ECJ") of 11 March 2003 (ECJ, Ansul, C-40/01, ECLI:EU:C:2003:438) there is genuine use of a trademark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered. This is done in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (see also General Court of the European Union (hereinafter referred to as "EGC"), Silk Cocoon, T-174/01, 12 March 2003, ECLI:EU:T:2003:68; EGC, Vitafruit, T-203/02, 8 July 2004, ECLI:EU:T:2004:225; EGC, Charlott, T-169/06, 8 November 2007, ECLI:EU:T:2007:337).

29. The EGC held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (EGC, Hipoviton, T-334/01, 8 July 2004, ECLI:EU:T:2004:223; EGC, Sonia-Sonia Rykiel, T-131/06, 30 April 2008, ECLI:EU:T:2008:135). The purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trademark protection to the case where large-scale commercial use has been made of the mark (EGC, Vitafruit, already referred to above).

30. In addition the EGC held that genuine use of a trademark cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned (see EGC, Hiwatt, T-39/01, 12 December 2002, ECLI:EU:T:2002:316; EGC, Vitakraft, already referred to above and EGC, Sonia-Sonia Rykiel, already referred to above).

Analysis of the proof of use

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

- 1) Sale statistics for Belgium and The Netherlands;
- 2) 29 invoices to clients in Belgium with the addition of photographs of the models referred to on the invoices;
- 3) 7 invoices to clients in The Netherlands with the addition of photographs of the models referred to on the invoices.

32. The statistics mentioned under 1) show sales of 5.083 shirts in Belgium in the relevant period. In the same period 683 shirts were sold in The Netherlands.

33. The invoices under 2) and 3) mention product numbers which can be identified by the added photographs of the products itself. The products can all be identified as shirts on which the right invoked is applied.

34. Although the sales figures itself are very modest in view of the market for shirts in the Benelux, the Office is of the opinion that the figures exceed the threshold for mere token sales. As mentioned above the purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking. The assessment is made in order to establish if the registered trademark has been put to use to fulfill its essential function as a badge of origin in a way that exceeds mere token use, i.e. use for the sole purpose of preserving the rights conferred by the mark.

35. According to the Office, a decrease in sale (of shirts) alone should however not automatically imply that the opponent has failed to try to maintain a market share for its products (see paragraph 18).

Conclusion

36. The Office finds that the right invoked has been put to genuine use in the relevant period for the following goods:

- CI 25 Shirts.

A.2 Likelihood of confusion

37. 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.

38. 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."*

39. According to case law of 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, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; 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, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs

40. 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, ECLI:EU:C:1997:528).

41. 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).

42. The signs to be compared are the following:

| Opposition based on: | Opposition directed against: |
|-----------------------------|-------------------------------------|
| Condor | Contor.com |

43. 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 EGC Matratzen, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and Sabel, already cited).

Visual comparison

44. Both signs are purely verbal. The right invoked consists of one word of six letters, Condor. The contested sign consists of two words which are (visually) clearly divided by a “.”. The first element consists of six letters, Contor. The second element consists of three letters, com. The dominant element of the contested sign is the first element, whereas the second element, .com, is the most widely known generic top level domain (gTLD). This element simply refers to an internet address and can be held descriptive for goods offered via and services provided for by the Internet.

45. Both the right invoked as well as the dominant element of the contested sign consist of six letters. Five out of six letters are identical, the only difference being the fourth letter in both signs, -d versus -t. 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, ECLI:EU:T:2004:79). The first three letters, Con, are identical as well as the ending of both signs -or.

46. The Office finds that the right invoked and the contested sign are visually highly similar.

Aural comparison

47. The right invoked consists of one word of two syllables, Con-dor, and will be pronounced as [kan-dər] or [kɔn-dɔr/ɛ]. The dominant element of the contested sign also consists of two syllables, Con-tor, and will be pronounced as [kan-tər], [kɔn-tɔr/ɛ]. When and if pronounced the last element will sound as [dat-cam], [punt-kom] or [pwā-kom]. As mentioned before (paragraph 45) consumers generally take more note of the beginning of a sign than of its end (Mundicor, already cited).

48. The right invoked and the contested sign are aurally similar to a high degree.

Conceptual comparison

49. 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, ECLI:EU:T:2007:46; Aturion, T-146/06, 13 February 2008, ECLI:EU:T:2008:33; Galvalloy, T-189/05, 14 February 2008, ECLI:EU:T:2008:39 and Ecoblue, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). As already mentioned, the Office is of the opinion that the element “.com” of the contested sign will be perceived as a descriptive element, simply referring to a webpage indicating that goods are provided and services rendered via the Internet.

50. The right invoked, Condor, refers to a very large vulture as pointed out by the defendant (see paragraph 22).¹ It will be understood as such by the relevant Benelux public, because of the fact that the word is the same in English, Dutch and French; in German the word for this vulture is Kondor.² The dominant element of the contested sign Contor can be found as a “hip way of saying to another that you are sober”.³ However, the Office finds that this meaning will not be known (as yet) to the Benelux public.

51. According to the Office, the majority of the public in the relevant territory will perceive the meaning of the right invoked as explained above, the contested sign has no (known) meaning in the Benelux territory. Since one of the signs will not be associated with any meaning, the signs are not conceptually similar.

52. It is established case-law that visual and phonetic similarities between the signs can be neutralized by semantic differences. To assume such a neutralization, at least one of the two signs involved has to have a clear and fixed meaning which the relevant public will understand immediately. It is sufficient that only one of these signs has such a meaning, notwithstanding the fact that the other sign has a different meaning or has no meaning at all, in order to highly neutralize the visual and phonetic similarities between the trademarks (see: ECG, Bass, T-292/01, 14 October 2003, ECLI:EU:T:2003:264 and ZIRH, T-355/02, 3 March 2004, ECLI:EU:T:2004:62 as well as CJEU, Picasso-Picaro, C-361/04, 12 January 2006, ECLI:EU:C:2006:25).

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

² Van Dale, Groot woordenboek Nederlands, 14de druk, Groot woordenboek Engels-Nederlands, 2de druk, Groot woordenboek Frans-Nederlands, 3de druk en Groot woordenboek Duits-Nederlands, 3de druk.

³ <https://www.urbandictionary.com/define.php?term=Contor>

53. However, in this specific case, the Office is of the opinion that the fact alone that the right invoked has a known meaning to the Benelux consumer does not suffice in itself to neutralize the high degree of visual and aural similarity. The Office finds that, exactly due to this high degree of visual and aural similarity, it cannot be ruled out that the contested sign will simply be confused with the right invoked and will thus be given the same meaning (e.g. an error in writing/misspelling). The Office hereby brings to mind that account must be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind (Lloyd, already cited).

Conclusion

54. The right invoked and the contested sign are visually and aurally highly similar. They are conceptually dissimilar. The Office is of the opinion that the (high degree of) visual and aural similarity cannot be overcome by neutralization.

Comparison of the goods and services

55. 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).

56. With the comparison of the goods of the right invoked and the goods against which the opposition is filed, the goods are considered only on the basis of what is expressed in the register or the goods for which genuine use has been proven on the one hand and the goods as indicated in the trademark application on the other hand.

57. The goods to be compared are the following:

| Opposition based on: | Opposition directed against: |
|-----------------------------|--|
| CI 25 Shirts. | CI 25 Clothing; footwear; headgear; swimwear; sportswear; leisurewear. |

58. The goods “*clothing and leisurewear*” of the contested sign are identical to the opponent’s goods, because the contested goods overlap with the opponent’s goods or consist of broad categories which include the opponent’s “*shirts*” (see to that effect: EGC, METABIOMAX, T-281/13, 11 June 2014, ECLI:EU:T:2014:440).

59. The goods “*footwear; headgear; swimwear; sportswear*” of the contested sign are similar to the goods of the right invoked. These goods coincide partially in their nature and may also coincide in their purpose. Even where the contested goods have a specific purpose (e.g. clothes for sports), the goods under comparison still have relevant connections, since they are often produced by the same undertakings and distributed through the same channels. In addition, the goods may target the same consumers. They serve the same purpose as the opponent’s goods, since they are used to cover and protect various parts of the human body against the elements. They are also articles of fashion and are often found in the same retail outlets. Therefore, they are considered similar to the opponent’s “*shirts*” (in that sense: EGC, GIORDANO, T-483/08, 16 December 2009, ECLI:EU:T:2009:515).

Conclusion

60. The goods of the right invoked are partly identical and partly similar to the goods of the contested sign.

A.2 Global assessment

61. 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.

62. 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 goods concerned are targeted at the public in general. Therefore the Office finds that for these goods the average level of attention of the public concerned may be deemed normal.

63. 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).

64. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). In the present case, the trademark invoked has a normal distinctiveness, as it is not descriptive of the goods concerned.

65. Based on the abovementioned circumstances, given the interdependence between the identity and similarity of the goods and the highly visual and aural 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. Conclusion

66. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion between the signs for all the goods against which the opposition was directed.

IV. DECISION

67. The opposition with number 2012167 is justified.

68. Benelux application with number 1332550 will not be registered for the goods against which the opposition was directed, namely:

Class 25: (*all the goods applied for*)

69. Benelux application with number 1332550 will be registered for the goods and services against which the opposition was not directed, namely:

Class 3: *(all the goods applied for)*;
Class 9: *(all the goods applied for)*;
Class 14: *(all the goods applied for)*;
Class 16: *(all the goods applied for)*;
Class 26: *(all the goods applied for)*;
Class 35: *(all the services applied for)*;
Class 38: *(all the services applied for)*;
Class 41: *(all the services applied for)*.

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

The Hague, 30 July 2018

Tomas Westenbroek
(rapporteur)

Eline Schiebroek

Camille Janssen

Administrative officer: Raphaëlle Gérard