



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2012790

of 30 July 2018

Opponent: **Facebook Inc.**
Willow Road 1601
94025 Menlo Park
United States of America

Representative: **Bird & Bird LLP**
Avenue Louise 235 box 1
1050 Brussels
Belgium

Invoked right 1: **EU trademark 9151192**

FACEBOOK

Invoked right 2: **EU trademark 2483857**

FACEBOOK

against

Defendant: **XEA bvba**
Paradijskouter 34 B
9031 Drongen
Belgium

Contested trademark: **Benelux application 1343743**

FACEBOOKARTIST.COM

I. FACTS AND PROCEEDINGS

A. Facts

1. On 28 November 2016 the defendant filed an application for a trademark in the Benelux for the wordmark FACEBOOKARTIST.COM for services in classes 35, 38 and 41. This application was processed under number 1343743 and was published on 30 November 2016.

2. On 30 January 2017 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- EU trademark 9151192 of the word mark FACEBOOK, filed on 3 June 2010 and registered on 17 December 2010 for goods and services in classes 9, 35, 36, 38, 41, 42 and 45;
- EU trademark 2483857 of the word mark FACEBOOK, filed on 30 November 2001 and registered on 13 June 2003 for goods and services in classes 16, 35, 38 and 41.

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

4. The opposition is directed against all services of the contested application and is based on the services in classes 35, 38 and 41 of the trademarks invoked.

5. The grounds for opposition are those laid down in article 2.14, 1 (a) of 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 1 February 2017. 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 20 July 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. As regards the visual comparison of the trademarks and the sign, the opponent observes that the rights invoked are fully and identically reproduced in the contested sign. The only difference is found in the additional element ARTIST.COM. The mere presence of this additional word element does not suffice to counter or even compensate the strong similarity between the respective signs, according to the opponent. Besides the fact that the rights invoked are fully and identically reproduced, the common element is featured at the beginning of the contested sign, to which the consumer attaches greater importance. Furthermore, according to the opponent, the element FACEBOOK remains obviously the dominant element. The element ARTIST in the contested sign will only raise the impression of a new declination of the FACEBOOK umbrella brand. The element .COM is devoid of any distinctive character. Therefore, the opponent finds that the contested sign is visually highly similar to the rights invoked.

10. According to the opponent the abovementioned analysis applies *mutatis mutandis* to the aural comparison. The pronunciation of the signs coincides in the sound of the eight first letters, FACEBOOK. The respective elements ARTIST and .COM are insignificant or generic to the extent that they will not catch the attention of the average consumer. The "new declination" argument also applies for the aural similarity. The opponent holds the contested sign and the rights invoked similar to a high degree.

11. Conceptually, the opponent stresses the fact that the word FACEBOOK as such is a fantasy term created by the opponent. According to the Collins English Dictionary it refers indeed to the popular social networking website. Because of the fact that the rights invoked and the contested sign share this common element, there exists a conceptual identity, according to the opponent. The additional element ARTIST in the contested sign will be understood by the relevant Benelux public. However, this word does not create a conceptual difference between the signs. On the contrary, the addition of this element wrongly gives the impression that the contested sign is a derivate of the rights invoked. This applies even more due to the fact that the opponent has an ongoing art programme since several years called "Facebook Artist In Residence". The element .COM is descriptive, according to the opponent, because it indicates that the "goods" concerned are offered on a website. Overall, the opponent is of the opinion that both signs are conceptually highly similar.

12. The relevant services are identical or highly similar, according to the opponent.

13. The opponent is of the opinion that the rights invoked possess a high, or at the very least a normal inherent distinctive character. Moreover, the opponent states that the FACEBOOK trademarks are one of the few brands that almost everyone knows and that they have gained a very high degree of distinctive character and an extraordinary reputation in the Benelux as well as on a global level. This status as a brand with a very high reputation has already been established on multiple occasions by EUIPO and WIPO, according to the opponent, who thereby refers to several annexes. The opponent elaborates on the intensive and widespread use on the market and supports this with evidence.¹

¹ such as statistics (user statistics, brand rankings, advertisement services), publications, articles, movies and trademark registrations.

14. According to the opponent, on an overall assessment and taking into account the high similarity of the services concerned and the (high) similarity of the signs, the public could be led to believe that the services in question originate from the same or economically linked undertakings, or that they are at least connected to, sponsored by, or otherwise provided with the consent of the opponent. This risk is further increased as a result of the extraordinary reputation and the high distinctive character that the rights invoked enjoy globally. According to the opponent, it should be concluded that there exists a likelihood of confusion. The opponent therefore requests that the Office upholds the opposition in its entirety, rejects the contested application for all the services applied for and orders the defendant to bear the costs.

B. Defendant's arguments

15. The defendant explains that FACEBOOKARTIST.COM is in fact an "evaluative artwork"² about the application of freedom of speech in the sense of the explanation about the opponent's mission statement. The defendant hereby quotes opponent's CEO Mark Elliot Zuckerberg: "*An important aspect of freedom of speech is that you need to be able to get pretty close to offensive*".³ The defendant is therefore surprised about the opposition.

16. The defendant finds FACEBOOK "really no more than a generic term and daily banal utility". The meaning of the word predominates the meaning of the similar brand name and is thus understood and read in the contested sign, according to the defendant.

17. The defendant criticizes the current owners of Facebook, Inc. for "not having the courage to transform the company into a cooperative democratic company of which all users become responsible owners instead of communication slaves from a multinational".

18. The defendant concludes his arguments by stating: "the right to copy for a better world is a universal law that is above USA laws". The defendant annexes 14 pages of "artwork", partly addressed to Mr. Zuckerberg.

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 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.

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.*"

² defendant is cited literally: meant was "evaluative"? or perhaps even "evolutive"?

³ 22 June 2017.

21. According to case law of the Court of Justice of the European Union 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; Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs

22. 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).

23. 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).

24. As the rights invoked are identical, they will only be mentioned once below and they will be referred to together as 'the right invoked'. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
FACEBOOK	FACEBOOKARTIST.COM

Conceptual comparison

25. The right invoked, FACEBOOK, literally means "book of faces". According to the Office the word is, in the aforementioned meaning, specifically related to its use on American universities. However, the Office finds that this meaning will not be understood as such by the Benelux consumer, also because of the fact that this word does not appear in English dictionaries other than as a trademark related to the opponent (see also BOIP: opposition decisions 2010092, 12 May 2016 Facethat and 2012032, 26 January 2018, FACEBOOK LIVE).

26. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, Lloyd, already mentioned), 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 and Galvalloy, T-189/05, 14 February 2008, ECLI:EU:T:2008:39). The right invoked could be seen as a contraction of the words FACE and BOOK, whereas the contested sign, which consists partly of these identical words could be seen as a combination of the words FACE, BOOK and ARTIST. The element .COM is a descriptive element, simply indicating that goods are offered or services are rendered through the Internet.

27. The Office is of the opinion that the knowledge of the English language of the average Benelux consumer is sufficient to recognize and understand the meaning of the words FACE, BOOK and ARTIST.

28. Overall, neither the invoked right nor the contested sign have a concrete meaning. The conceptual similarity would therefore be found in the elements FACE and BOOK. From this perspective, the Office must conclude that there is an average degree of conceptual similarity between the right invoked and the contested sign.

Visual comparison

29. Both signs are word marks. The trademark invoked consists of eight letters, FACEBOOK. The contested sign consists of 17 letters, FACEBOOKARTIST.COM. The first eight letters are identical. 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 right invoked is fully represented in the contested sign and has an independent distinctive role therein, which may in itself be an indication for a likelihood of confusion (see: CJEU, Thomson Life, C-120/04, 6 October 2005, ECLI:EU:C:2005:594).⁴ Because of the fact that the consumer will break down verbal signs into elements already known to him or suggesting a concrete meaning (see paragraph 26) he will visually perceive the contested sign as partly identical to the right invoked, only differing in the addition of the word ARTIST.

30. Therefore, the Office concludes that, although the right invoked and the contested sign differ significantly in the amount of letters, they are visually at least similar to a certain degree.

Verbal comparison

31. The right invoked is pronounced in two syllables as [face-book] or [fe:s-buk]. The contested sign has four or six syllables, depending on the fact if the element .COM will be pronounced by the consumer. The first two syllables are identical to the right invoked. The contested sign will be pronounced as [face-book-ar-tɛst] or [fe:s-buk-ar-tɪst]. When and if pronounced the last element will sound as [dat-cam], [punt-kom] or [pwã-kom]. As mentioned before (paragraph 29) consumers generally take more note of the beginning of a sign than of its end (Mundicor, already cited).

32. In view of the aforementioned considerations, the Office is of the opinion that the right invoked and the contested sign are aurally similar to a certain degree.

⁴ provided that the goods and/or services are identical.

Conclusion

33. The right invoked and the contested sign are conceptually, visually and aurally similar to a certain degree.

Comparison of the goods and services

34. 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).

35. With the comparison of the services of the trademarks invoked and the services against which the opposition is filed, the services are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

36. The services to be compared are the following:

Opposition based on:	Opposition directed against:
CI 35 Marketing, advertising and promotion services; market research and information services; promoting the goods and services of others via computer and communication networks; facilitating the exchange and sale of decorating supplies, cleaning preparations, toiletries, cosmetics, candles, pharmaceuticals, small items of metal hardware, machines and machine tools, hand tools, consumer electronics, computers, computer peripherals, telephones, cameras, CD's and DVD's, household electric machines, vehicles, cycles, jewellery, clocks and watches, printed matter, leather goods, handbags, purses and wallets, furniture, housewares, household or kitchen utensils and containers, textiles, clothing, footwear, headgear, haberdashery, floor coverings, games and playthings, gymnastic and sporting equipment, foodstuffs, drinks, alcoholic beverages and candy via computer and communication networks; online retail store services featuring online delivery of digital media, namely images movies, musical and audiovisual works and related merchandise; charitable services, namely promoting public awareness about charitable, philanthropic, volunteer, public and community service and humanitarian activities; buyer to supplier matching services rendered through an online computerized network; providing information regarding products	CI 35 Advertising, marketing and promotional services.

<p>from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks.</p> <p><i>(EU trademark 9151192)</i></p> <p>Cl 35 Publication of advertising texts and dissemination of advertisements; rental of advertising space, sales promotion (for others), arranging newspaper subscriptions (for others), marketing studies; opinion polling; statistical information.</p> <p><i>(EU trademark 2483857)</i></p>	
<p>Cl 38 Providing access to computer, electronic and online databases; telecommunications services, namely electronic transmission of data, messages and information; providing online forums for communication on topics of general interest; providing online communications links which transfer web site users to other local and global web pages; facilitating access to third party web sites via a universal login; providing online chat rooms and electronic bulletin boards; audio, text and video broadcasting services over computer or other communication networks namely, uploading, posting, displaying, tagging, and electronically transmitting data, information, audio and video images; providing an online network service that enables users to transfer personal identity data to and share personal identify data with and among multiple websites; providing access to computer databases in the fields of social networking, social introduction and dating; providing an online forum for the buying and selling of products and materials and exchanging of sourcing data via a computerized network; electronic transmission of bill payment data for users of computer and communication networks.</p> <p><i>(EU trademark 9151192)</i></p> <p>Cl 38 Telecommunications; telecommunications via Internet networks, communications by computer terminals.</p> <p><i>(EU trademark 2483857)</i></p>	<p>Cl 38 Telecommunication services.</p>

<p>CI 41 Providing computer, electronic and online databases for educational, recreational and amusement use in the field of entertainment and in the fields of secondary, collegiate, social and community interest groups; photosharing and video sharing services; publication of electronic journals and web logs, featuring user generated or specified content; electronic publishing services for others; entertainment services, namely facilitating interactive and multiplayer and single player game services for games played via computer or communication networks; providing information about online computer games and video games via computer or communication networks; arranging and conducting competitions for video gamers and computer game players; Contest and incentive award programs designed to recognize, reward and encourage individuals and groups which engage in self-improvement, self-fulfillment, charitable, philanthropic, volunteer, public and community service and humanitarian activities and sharing of creative work product; providing information regarding news, cultural and academic matters from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks.</p> <p><i>(EU trademark 9151192)</i></p> <p>CI 41 Publishing services; publication of books, magazines and texts, organisation of competitions and cultural events or entertainment, cultural information and information relating to entertainment.</p> <p><i>(EU trademark 2483857)</i></p>	<p>CI 41 Publishing and reporting.</p>
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Conclusion

37. Whereas the defendant did not contest the identity and/or high similarity of the relevant services (see paragraph 12) this fact will be deemed undisputed according to Rule 1.21 paragraph d. IR.

A.2 Global assessment

38. 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.

39. 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 relevant services are aimed at the general public, which is deemed to have a normal level of attention.

40. 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).

41. 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 at least a normal distinctiveness, as it does not describe the relevant services. The opponent claims that the rights invoked have been extensively used and enjoy an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case, as it will not affect the outcome of the decision.

42. 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.

43. Based on the abovementioned circumstances, the Office finds that, given the interdependence between the identical and highly similar services and the degree of similarity of the signs, the relevant public might be led to believe that the services in question originate from the same undertaking or from economically-linked undertakings.

B. Conclusion

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

IV. DECISION

45. The opposition with number 2012790 is justified.

46. Benelux application with number 1343743 will not be registered.

47. The defendant shall pay the opponent 1,030 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, 30 July 2018

Tomas Westenbroek

Diter Wuytens

Pieter Veeze

Administrative officer:

Raphaëlle Gérard