



Benelux Office for  
**Intellectual  
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2014139**  
**of 31 August 2022**

**Opponent:** **Loft Ipco LLC**  
933 MacArthur Boulevard  
Mahwah New Jersey 07430  
United States of America

**Representative:** **Holla Advocaten**  
PO-box 396  
5201 AJ 's-Hertogenbosch  
Netherlands

**Invoked right:** **European Union trademark registration 5616925**

LOFT

*against*

**Defendant:** **LOFT MAGAZACILIK ANONIM SIRKETI**  
ZAFER MAH. CINAR SOKAK 2 ASMA KAT  
34197 YENIBOSNA BAHCELIEVLER ISTANBUL  
Turkey

**Representative:** **RISE**  
Postbus 5366  
2000 GJ Haarlem  
Netherlands

**Contested sign:** **Benelux trademark application 1369020**



## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 31 January 2018, the defendant filed a Benelux trademark application for the following figurative trademark for goods and services in the classes 18, 25 and 35:



This application was processed under the number 1369020 and was published on 12 March 2018.

2. On 12 May 2018 the opponent's legal predecessor filed an opposition against the registration of the application. The opposition was initially based on:

- the European Union trademark 5616925 of the word mark LOFT, filed on 16 January 2007 and registered on 4 August 2009 for goods in class 25;
- International registration 540508, designating the Benelux, of the word mark LOFT, filed on 29 June 1989 and registered for goods in classes 18 and 25.

3. In his arguments, the opponent states that the opposition is only based on the European Union trademark invoked.

4. During the proceedings the ownership of the trademark invoked was transferred to the opponent. According to the registers the opponent is the actual holder of the trademark invoked.

5. The opposition is directed against all goods and services covered by the contested application and is based on all goods covered by the trademark invoked.

6. The grounds for opposition are those laid down in article 2.14, (2)(a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").<sup>1</sup>

7. The language of the proceedings is English.

### B. Proceedings

8. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 17 May 2018. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. In addition, the proceedings were suspended several times at the request of the parties. The course of the

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<sup>1</sup> This decision shall always refer to the laws and regulations applicable on the date of the decision, except in the case of provisions which have undergone a material change during the proceedings and which are relevant to the decision.

proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 27 October 2021.

## **II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES**

9. The opponent filed his opposition at the Office under article 2.14, (2)(a) BCIP, in accordance with the provisions of article 2.2ter, (1)(b) BCIP: the likelihood of confusion based on the identity or similarity of trademark and sign and of the goods or services concerned.

### **A. Opponent's arguments**

10. With respect to the relevant public, the opponent states that the category of goods and services revolves around clothing, perfumes, and accessories. These are everyday consumer items and for this reason the public will have an average degree of attention.

11. Regarding the visual comparison of the signs, the opponent argues that the decorative element in the middle of the contested sign almost has no distinctive character, because a pictured pair of scissors for a clothing brand is purely descriptive, as it evokes the process of tailoring and thus reinforces that the mark relates to a clothing brand. According to the opponent, the dominant element of the contested sign is the word 'LOFT'. Although it is not the first part of the verbal element in the sign, this element is the most distinctive. The opponent argues that the trademark invoked is completely incorporated in the contested sign. In both signs, the word 'LOFT' is the dominant element and for this reason the opponent states that the signs at least have an average degree of visual similarity.

12. With regard to the aural comparison, the opponent argues that when using the verbal elements of the contested mark, it is more than reasonable to presume that the mark could be pronounced as "LOFT" instead of "THE ORIGINAL LOFT (1986)" as it is the natural tendency of the consumer to shorten long marks when pronouncing them. For this reason, the opponent states that the signs are aurally highly similar.

13. The opponent argues that the signs are conceptually the same, because both signs refer to the word 'loft', which refers to a large apartment without separate rooms, usually in buildings previously used as warehouses of factories and converted into living spaces. According to the opponent, the public in the Benelux will understand the meaning of the word 'loft'. The opponent also states that the other word elements of the contested sign are purely descriptive and do not create a different conceptual meaning. For this reason, the opponent states that the signs are conceptually highly similar.

14. With regard to the comparison of the goods and services, the opponent argues that the goods in class 18 of the contested sign are closely related to the goods in class 25 of the trademark invoked. Furthermore, the goods in class 25 of the contested sign are identical. With regard to the services in class 35 of the contested sign, the opponent states that these services are complementary to the goods for which the trademark invoked has been registered.

15. The opponent also finds that the distinctive character of the trademark invoked is inherently high, because it is not descriptive.

16. The opponent concludes that there exists a likelihood of confusion and requests that the Office upholds the opposition and orders that the costs be borne by the defendant.

17. At the request of the defendant, the opponent submits proof of use of the trademark invoked.

**B. Defendant's arguments**

18. The defendant argues that the submitted proof of use is insufficient to show that the trademark invoked has been genuinely used. According to the defendant, the evidence does not show that the trademark invoked has been applied to the relevant goods, nor that the trademark has been used for these goods in the relevant territory. The territorial extent of the use concerns mostly France, and there is no use in the Benelux. In the light of the nature of the goods, the defendant also argues that the potential market for these goods is extensive. Furthermore, the use of the name 'Loft' or 'Loft design by' for clothing stores only shows use of retail services.

19. The defendant also states that the level of attention of the public is average. Furthermore, according to the defendant, the trademark invoked refers to a 'storage room', which has no distinctive character for the goods in classes 18 and 25 and services of a store in class 35, since it is the place where the goods will be stored.

20. Regarding the comparison of the signs, the defendant argues that the signs are only visually and aurally similar to a low degree, due to the fact that the contested sign contains various words and figurative elements that are different. Furthermore, the signs are conceptually similar to, at most, a low degree, as their semantic coincidence stems from elements which are non-distinctive in relation to the relevant goods and services. For this reason, the defendant argues that the coincidence in this concept has very limited weight in the comparison of the contested sign.

21. According to the defendant, at least a part of the goods and services of the contested sign are dissimilar to those of the trademark invoked.

22. Defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition.

**III. DECISION****A.1 Proof of use**

23. In accordance with Article 2.16bis BCIP, the opponent, at the request of the defendant, shall furnish proof that the trademark invoked has been put to genuine use as provided for in Article 2.23bis BCIP or that proper reasons for non-use existed. In view of the filing date of the opposition, the evidence must show genuine use in a period of five years prior to the publication date of the sign against which the opposition is lodged.

24. The publication date of the contested trademark is 12 March 2018. Therefore, the opponent was required to show use of the invoked trademark during the period from 12 March 2013 to 12 March 2018 ('the relevant period'). Given the fact that the trademark invoked was registered more than five years prior to the filing date of the contested trademark, the defendant's request that proof of use is submitted is legitimate.

*In general*

25. In accordance with the case-law of the European Court of Justice ("CJEU") there is genuine use of a trademark if the mark, 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, is used in order to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.<sup>2</sup> When assessing whether use of the trade mark is genuine, regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.<sup>3</sup> 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.<sup>4</sup>

26. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.<sup>5</sup> In interpreting the concept of genuine use, account should be taken of the fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade mark protection to the case where large-scale commercial use has been made of the marks.<sup>6</sup>

27. 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.<sup>7</sup>

28. The trademark invoked is a trademark of the European union. Whilst it is reasonable to expect that an EU trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be put to use in a larger area than the territory of a single Member State in order for that use to be capable of being deemed to be ‘genuine use’, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market.<sup>8</sup> It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU, taking into account all relevant facts and circumstances such as characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.<sup>9</sup>

29. Following rule 1.41 io. 1.25 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the trademark invoked for the goods on which the opposition is based.

#### *Analysis of the proof of use*

30. The opponent submitted the following exhibits to demonstrate the genuine use of the invoked trademark in the European Union:

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<sup>2</sup> CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis), and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

<sup>3</sup> CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:80, point 83 (Pandalis), and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

<sup>4</sup> General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

<sup>5</sup> General Court (EU) 8 July 2004, T-334/01, ECLI:EU:T:2004:223, point 36 (Hipoviton), and General Court (EU) 30 April 2008, T-131/06, ECLI:EU:T:2008:135, point 41 (Sonia Sonia Rykiel).

<sup>6</sup> General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

<sup>7</sup> General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

<sup>8</sup> General Court (EU) 1 June 2022, T-316/21, ECLI:EU:T:2022:310, point 73 (Superior Manufacturing) and CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, points 50 and 54 (ONEL).

<sup>9</sup> CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 58 (ONEL).

1. Statement of C.E. Klinger, Assistant Secretary of Annco, Inc. and Vice President and Chief Counsel for litigations & intellectual property for Ascena Retail Group, Inc. (the ultimate parent company of Annco, Inc. (the former opponent), dated 8 April 2019;
  2. Screenshots of the website [www.loft.com](http://www.loft.com), dated 5 January 2017 and 21 April 2017, showing the name 'Loft' and photos of models showing pieces of clothing;
  3. Shipping confirmation documents;
  4. License agreement;
  5. Screenprints of the website [www.loftdesignby.com](http://www.loftdesignby.com), obtained through the Wayback Machine, dated 23 December 2016, showing the name 'Loft design by' and photos of clothing and models showing pieces of clothing;
  6. Confirmations of orders and shipping of products to Spain, France, Germany and the United Kingdom, the documents show the name 'Loft design by' and the URL [www.lofteshop.com](http://www.lofteshop.com), as well as product names and numbers and are dated between 19 January 2017 to 2 May 2017;
  7. Copies of sales receipts of stores in France and the United Kingdom, dated in 2013, 2014, 2015 and 2017, indicating product descriptions and product numbers;
  8. Photos of several stores in France and the United Kingdom showing the name 'Loft' or 'Loft design by' on the front. These photos are annexes to another affidavit, dated 16 December 2016;
  9. Copies of several pages of accounting reports showing tables with sales figures and revenues between 2012 and 2016;
  10. Invoices and order confirmations sent to Spain, France, Germany and the United Kingdom, showing the name 'Loft' or 'Loft design by' on the document and indicating the product numbers, dated between 2012 and 2016;
  11. Photos of pieces of clothing, of which several pieces show the name 'Loft' in the label, including tags that show product numbers;
  12. Copies of catalogues of 2014 and 2015 with images of models showing clothing. On several pictures, the names 'Loft' and 'Loft design by' is displayed on the background decor, and also on the final pages with a list of stores addresses;
  13. A compilation of several news articles and advertisements regarding clothing in which the names 'Loft' and 'Loft design by' are mentioned, published in French magazines and newspapers or on social media dated in 2013, 2014 and 2015;
  14. Invoices from French advertisement companies regarding the costs for advertisements, dated in 2012, 2013 and 2015;
  15. Information regarding the social media accounts of 'Loft design by' and print screens of items on social media, posted by 'Loft design by', dated in 2010.
31. The orders and invoices (numbers 6 and 10) regarding sales in several countries in the European Union as well as the sales receipts of the stores in France and the United Kingdom (number 7) cover the period 2012-2017. The trademark invoked is mentioned several times in these documents, but nowhere is shown for which goods it was used, as the defendant states. Although it is not apparent for every invoice or receipt submitted, for some of these documents the product numbers mentioned therein correspond to those of the various types of clothing on which the trademark invoked is applied (either on the pricing tag or the label withing the clothes) as is shown on several photos of pieces of clothing (number 11). Therefore, it follows that the trademark mentioned in the invoices is used for selling those products.
32. Furthermore, the extensive overview of news articles and advertisements (number 13) that are published in several French magazines and newspapers during the relevant period also show that the trademark invoked is used as a trademark for clothing. The Office finds that these documents sufficiently

show that the goods are offered for sale and are therefore present on the market, as well as that the sales exceed mere token use.

33. However, the Office considers that the evidence does not sufficiently show that the trademark invoked is used for the goods 'footwear' and 'headgear' mentioned in class 25, as the evidence submitted does not provide any or sufficient information on this.

#### *Conclusion*

34. The Office concludes that the evidence of use, taken together, sufficiently demonstrates that the trademark invoked has been put to genuine use in a significant part of the EU, i.e., France, Germany, Spain and the UK (at that time still a member of the EU), during the relevant period for clothing.

35. For this reason, the Office will continue with the assessment of the likelihood of confusion considering solely these goods for which the opponent has proven genuine use of his invoked trademark.

#### **A.2 Likelihood of confusion**

36. In accordance with article 2.14 BCIP, the 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 2.2ter BCIP.

37. Article 2.2ter (1) BCIP stipulates insofar as relevant that, "*A trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.*"<sup>10</sup>

38. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.<sup>11</sup>

39. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.<sup>12</sup>

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

40. To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive

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<sup>10</sup> Art. 2.2ter (1)(b) BTIP implements art. 5 (1)(b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in art. 8 (1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

<sup>11</sup> CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).


<sup>12</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.<sup>13</sup>

41. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.<sup>14</sup> The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.<sup>15</sup>

42. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, *inter alia*, their distinctive and dominant components.

43. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
LOFT	

#### *Visual comparison*

44. The trademark invoked is a purely verbal sign, that consists of one word of four letters: 'LOFT'. The contested sign is a combined word and figurative trademark consisting of the image of a pair of opened scissors depicted in white and placed against a black round background. Around it is a larger circle in which the words THE ORIGINAL LOFT – 1986 – THE ORIGINAL LOFT – 1986 is depicted.

45. 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 or services in question by quoting their name than by describing the figurative element of the trademark.<sup>16</sup> Therefore, although the image of the pair of scissors will not be overlooked due to its positioning and size, the public will also pay attention to the words THE ORIGINAL LOFT. These words will

<sup>13</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

<sup>14</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

<sup>15</sup> General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

<sup>16</sup> General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 and the case-law mentioned there (Smarter Travel).



be perceived as more dominant than the element 1986, as the indication of a year usually refers to the year of establishment of a company and this element will therefore be perceived as descriptive.

46. Trademark and sign are visually similar to a certain extent because the trademark invoked is entirely incorporated in the contested sign. On the other hand, the contested sign contains significantly more word elements, as well figurative elements that are not present in the trademark invoked.

47. In view of the foregoing, the Office considers that the signs are visually similar to a certain extent.

#### *Phonetic comparison*

48. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all 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.<sup>17</sup> Furthermore, considering that the element '1986' is considered descriptive, it will probably not be pronounced by the consumer, also because, regarding the length of the words in the contested sign, the average consumer will tend to abbreviate the sign.<sup>18</sup>

49. The verbal elements to be compared are thus "LOFT", composed of 1 syllable for the invoked trademark and "THE ORIGINAL LOFT" composed of 6 syllables [THE] [O] [RI] [GI] [NAL] [LOFT] for the contested trademark. Indeed, while the trademarks differ in length, the verbal element "LOFT" is identically present in both signs, resulting in an aural similarity to a certain extent.

#### *Conceptual comparison*

50. Trademark and sign both refer to the word 'LOFT', which is the name for, inter alia, a space just below the roof of a house or a flat in a former factory, etc., that has been made suitable for living in.<sup>19</sup> The presence of the words 'THE ORIGINAL' does not alter the fact that the contested sign still conceptually refers to a loft. Furthermore, the contested sign also contains a prominent image of a pair of scissors, a reference that is not present in the trademark invoked.

51. In the light of the above, the Office finds that trademark and sign are conceptually similar to a certain extent.

#### *Conclusion*

52. The signs are visually, aurally and conceptually similar to a certain extent.

53. Since there is a certain degree of visual, aural and conceptual similarity between the signs, an overall assessment of the likelihood of confusion in the light of the other relevant factors must be carried out.<sup>20</sup>

#### ***Comparison of the goods and services***

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<sup>17</sup> General Court (EU) 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

<sup>18</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 95 (Equivalenza).

<sup>19</sup> [https://www.oxfordlearnersdictionaries.com/definition/english/loft\\_1?q=loft](https://www.oxfordlearnersdictionaries.com/definition/english/loft_1?q=loft)

<sup>20</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 60 and the case-law mentioned there (Equivalenza).

54. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. 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.<sup>21</sup>

55. In comparing the goods and services, the goods and services shall be considered in the terms set out in the register in as far as genuine proof of use was provided, and not the actual or intended use.<sup>22</sup>

56. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
	CI 18 Unworked or semi-worked leather and animal skins, imitations of leather, stout leather, leather used for linings; bags; wallets; boxes and trunks made of leather or stout leather; key cases; trunks [lug-gage]; suitcases; umbrellas; parasols; sun umbrellas; walking sticks; whips; harness; saddlery; stirrups; straps of leather (saddlery).
CI 25 Clothing.	CI 25 Clothing, including underwear and outer clothing, other than special purpose protective clothing; socks; mufflers [clothing]; shawls; bandanas; scarves; belts [clothing]; footwear; shoes; slippers; sandals; headgear; hats; caps with visors; berets; caps [headwear]; skull caps.
	CI 35 Advertising, marketing and public relations; organization of exhibitions and trade fairs for commercial or advertising purposes; the bringing together, for the benefit of others, of a variety of goods in particular clothing, headgear and footwear, jewelry, watches, fashion accessories, textiles, cosmetics, perfumes, eau de toilette, eau de perfume, colognes, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores, wholesale outlets, through vending machines, mail order catalogues or by means of electronic media, for example, through web sites or television shopping programs.

#### Class 18

57. The goods '*Unworked or semi-worked leather and animal skins, imitations of leather, stout leather, leather used for linings*' concern raw materials. The fact that one product is used to manufacture another (e.g. leather for clothing) is not sufficient in itself to conclude that the goods are similar, as their nature,

<sup>21</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

<sup>22</sup> General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

purpose, relevant public and distribution channels are very different. These raw materials are intended for use in industry rather than for direct purchase by the final consumer. They are sold in different outlets, have different natures, and serve different purposes from the opponent's clothing. Therefore, these goods are not similar.

58. The goods '*bags; wallets; boxes and trunks made of leather or stout leather; key cases; trunks [lug-gage]; suitcases*' are not similar to the opponent's goods in class 25. These goods in class 18 are for carrying things when travelling and do not satisfy the same needs as clothing. The nature and intended purpose for these goods are therefore different. They have different distribution channels and are not made by the same manufacturers. The fact that goods such as bags and clothes may be sold in the same commercial establishments, such as large shops and warehouses, is not particularly significant since very different kinds of goods may be found in such locations, without consumers automatically believing that they have the same origin. Moreover, these goods are neither in competition nor complementary.<sup>23</sup>

59. The same reasoning applies to the goods '*umbrellas; parasols; sun umbrellas; walking sticks; whips; harness; saddlery; stirrups; straps of leather (saddlery)*'. These goods are devices that protect from the weather or assist people with walking or horse riding. The nature of these goods is different to the opponent's clothing in Class 25, as they serve very different purposes. They do not usually have the same retail outlets and are not usually made by the same manufacturers. Therefore, these goods are not similar.

#### Class 25

60. The goods '*Clothing, including underwear and outer clothing, other than special purpose protective clothing; socks; mufflers [clothing]; shawls; bandanas; scarves; belts [clothing]*' mentioned in class 25 of the contested sign fall under the general term 'clothing' for which the trademark invoked is registered. These goods are therefore identical.<sup>24</sup>

61. The goods '*footwear; shoes; slippers; sandals; headgear; hats; caps with visors; berets; caps [headwear]; skull caps*' are similar to clothing as mentioned in class 25 of the trademark invoked. Both clothing, as well as headgear and footwear are used to cover parts of the human body and protect them against the elements. They are also articles of fashion. They can be produced by the same manufacturers. Consumers will therefore easily attribute the same origin to such goods.<sup>25</sup>

#### Class 35

62. In general, products and services are of a different nature, due to the fungible nature of the former and the non-fungible nature of the latter. Furthermore, they do not have the same use. However, products and services can be complementary: after all, some services cannot be rendered without using some products.

63. In this context, it should be recalled that complementarity only exists where the products and/or services are so closely related to each other that one is indispensable or important for the use of the other so that consumers may believe that the same undertaking is responsible for those products.<sup>26</sup>

<sup>23</sup> General Court (EU) 13 December 2004, T-8/03, ECLI:EU:T:2004:358, point 43 (Emilio Pucci) and General Court (EU) 11 July 2007, T-443/05, ECLI:EU:T:2007:219, point 44 (Piranam).

<sup>24</sup> General Court (EU) 23 October 2002, T-104/01, ECLI:EU:T:2008:399, point 33 (Fifties) and General Court (EU) 24 November 2005, T-346/04, ECU:EU:T:2005:420, points 36-39 (Arthur et Félicie).

<sup>25</sup> General Court (EU) 16 December 2009, T-483/08, ECLI:EU:T:2009:515, point 20 (Giordano).

<sup>26</sup> General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

64. The goods covered by the invoked trademark, namely 'clothing', are the subject matter of the services "*the bringing together, for the benefit of others, of (...) clothing, enabling customers to conveniently view and purchase those goods*" covered by the defendant.

65. Clearly, in the present case, the relationship between the abovementioned services and the goods covered by the trademark invoked 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 those goods are sold. The objective of retail trade is the sale of goods to consumers and that trade includes, in addition to the legal sales transaction, all activity 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.<sup>27</sup>

66. The goods covered by the trademark invoked are identical to those to which the abovementioned services relate. Those goods and services are therefore so closely linked that the public may think that the same undertaking is offering such goods using its own trademark. The relationship between these services and these goods is therefore complementary. For that reason, the Office considers that those services are similar to a certain degree to the goods of the trademark invoked.

67. The addition '*such services may be provided by retail stores, wholesale outlets, through vending machines, mail order catalogues or by means of electronic media, for example, through web sites or television shopping programs*' does not alter the similarity that has already been found. After all, it concerns a modality of the service and does not essentially change the nature of the services themselves.

68. The other services mentioned in class 35 are not similar. The services of the defendant concern inter alia advertising as well as services that relate to goods which are not identical to clothing. There is no complementarity between those services and the opponent's clothing in the sense that the goods in class 25 of the trademark invoked are indispensable for the provision of the services of the contested sign.

#### *Conclusion*

69. The goods and services of the defendant are partly identical, or similar to a certain degree and partly not similar to the goods of the opponent.

#### **Global assessment**

70. The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.<sup>28</sup> In the present case, the goods covered are aimed at the public at large for which the level of attention is deemed to be normal.

71. The greater the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their

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<sup>27</sup> General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 54 (O STORE).

<sup>28</sup> CJEU 22 Juni 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.<sup>29</sup> According to the defendant, the word 'LOFT' is not distinctive because it could be considered descriptive (see paragraph 19). However, the Office finds that the word 'Loft' does not describe the characteristics of the goods in question. The Office strongly doubts that this word will be perceived by the public as the place where the relevant goods are stored, as argued by the defendant. Even if this would be the case, this would cause the word to be understood as an indirect reference to the goods, but not as a description. For this reason, the trademark invoked has to be considered as having normal distinctiveness for the goods concerned.

72. With regard to the opponent's argument that the trademark invoked LOFT has an inherently high distinctive character as it is not descriptive for the products concerned (see paragraph 15), the Office points out that according to article 2.1, (a) BCIP a sign should by definition be distinctive in order for it to be able to constitute a trademark.<sup>30</sup>

73. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and, in particular, between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.<sup>31</sup>

74. In this case the signs are visually, aurally, and conceptually similar to a certain degree. The relevant goods are partly identical, partly (to a certain extent) similar and partly dissimilar. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that there is a likelihood of confusion in the sense that the public may believe that the identical and (to a certain extent) similar goods designated by the trademark relied on and those to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically linked. It is also relevant that the public might consider that the contested sign is a variation of the trademark invoked since they share the distinctive element 'LOFT' and it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates. It is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark, and which share with it a common dominant element) in order to distinguish its various lines from one another. It is therefore conceivable that the relevant public may consider the goods that are similar designated by the conflicting signs to be two separate product lines, originating from the same manufacturer.

## **B. Conclusion**

75. Based on the foregoing, the Office concludes that there is a likelihood of confusion for the goods and services that are identical or similar.

## **IV. DECISION**

76. The opposition with number 2014139 is partly justified.

77. The Benelux application with number 1369020 will not be registered for the following goods and services:

- class 25 (*all goods*)

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<sup>29</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

<sup>30</sup> Court of appeal The Hague 30 March 2010, 200.044.463/01 (Roxstar).

<sup>31</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there. (Equivalenza)

- class 35 the bringing together, for the benefit of others, of a variety of goods in particular clothing, enabling customers to conveniently view and purchase those goods.

78. The Benelux application with number 1369020 will be registered for the following goods and services that are not similar:

- class 18 (*all goods*)
- class 35 Advertising, marketing and public relations; organization of exhibitions and trade fairs for commercial or advertising purposes; the bringing together, for the benefit of others, of a variety of goods in particular headgear and footwear, jewelry, watches, fashion accessories, textiles, cosmetics, perfumes, eau de toilette, eau de perfume, colognes, non-medicated toilet preparations, eye wear, carrying cases, leather goods, handbags and all manner of bags (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores, wholesale outlets, through vending machines, mail order catalogues or by means of electronic media, for example, through web sites or television shopping programs.

79. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.28(3) IR, as the opposition is partly justified.

The Hague, 31 August 2022



Eline Schiebroek  
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