

BOIP



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2014312
of 17 July 2020

Opponent: **GILMAR S.P.A.**
Via Malpasso 723/725
47842 S. Giovanni in Marignano
Italy

Representative: **Office Kirkpatrick S.A.**
Avenue Wolfers 32
1310 La Hulpe
Belgium

Invoked trademark: **EU trademark 10941615**

ICE

against

Defendant: **Drelin and Co Limited**
Block B, Tonic Industrial Centre, 19 Lam Hing Street, Kowloon
Bay, Kowloon B2, 5 /F
Hong Kong
China

Representative: **Jean-Pierre Vandersteen**
Avenue Cardinal Micara 89
1160 Brussels
Belgium


Contested trademark: **Benelux application 1374669**



Ice
watch

I. FACTS AND PROCEEDINGS

A. Facts

1. On 3 May 2018 the defendant filed a Benelux trademark application for the combined

word/figurative mark  for goods in class 18. This application was processed under number 1374669 and was published on 23 May 2018.

2. On 20 July 2018 the opponent filed an opposition against the registration of the application. The opposition is based on EU trademark 10941615 of the combined word/figurative mark , filed on 6 June 2012 and registered on 9 June 2017 for goods and services in classes 9, 11, 16, 18, 20, 21, 24, 25, 27 and 35.

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

4. The opposition is directed against all of the goods of the contested application and is based on all of the goods and services of the trademark 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").¹

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 24 July 2018. 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"). In addition the proceedings were suspended *ex officio* because of a pending cancellation action against the EU trademark invoked before the European Union Intellectual Property Office (EUIPO). Upon a decision by EUIPO dated 17 September 2018 the application for a declaration of invalidity of said EU trademark was rejected as inadmissible and thus the suspension of the present proceedings was lifted. The administrative phase was completed on 8 October 2019.

II. ARGUMENTS

8. The opponent filed an 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 the identity or similarity of the goods or services concerned.

¹ 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.

A. Opponent's arguments

9. The opponent argues that there is a likelihood of confusion between the trademarks. He believes that the goods in class 18 of the defendant are identical to the goods 'trunks and travelling bags' in class 18 of the opponent. Should the Office consider that these goods are not identical, they must at least be considered highly similar given that they share the same nature, intended purpose and method of use. Moreover, these goods are in competition with each other.

10. As for the comparison of the trademarks, the opponent observes that the term ICE is the only and central element in the trademark invoked. In the contested trademark the term ICE is the dominant and distinctive element. Visually, the word element of the trademark invoked is fully integrated in the contested trademark. The difference between the use of lower case letters in the contested trademark and upper case letters in the trademark invoked does not influence this identity, according to the opponent. The trademarks differ because of their figurative elements and the word 'watch' in the contested trademark. Visually, the trademarks are highly similar.

11. Phonetically, the word ICE in the trademark invoked is integrated in the contested trademark. This common word ICE is the distinctive and dominant element in the contested trademark and it will be pronounced first. Therefore, the opponent claims that the trademarks are phonetically highly similar.

12. Conceptually, the English word 'ice' refers to frozen water or something very cold. The English word 'watch' may refer to a small timepiece worn typically on a strap on one's wrist or to the action of looking at or observing attentively over a period of time. Thus, the opponent believes that the trademarks evoke highly similar conceptual associations to the extent that they both contain the word ICE.

13. As for the distinctiveness of the trademark invoked, the opponent states that this trademark has no meaning in relation to the goods at hand. Therefore, the inherent distinctiveness of said trademark must be considered normal. As for the level of attention of the relevant public, the opponent points out that the goods are consumer goods aimed at the public at large with an average degree of attentiveness.

14. As the trademarks are highly similar and used in relation to identical goods, the relevant public will believe that the goods offered by the defendant under the contested trademark are put on the market by the opponent and vice versa or that the goods originate from economically-linked undertakings. The opponent thus concludes that there is a serious risk of confusion.

15. The opponent refers to a decision of the Paris Court of Appeal opposing the same parties as in this opposition. The court confirmed the likelihood of confusion between the trademark invoked and a French trademark application that is identical to the contested trademark for the same goods in class 18.

16. The opponent concludes that there is a likelihood of confusion between the trademarks. He therefore requests that the opposition is accepted, the contested trademark application is refused and the defendant is ordered to bear the costs of the opposition proceedings.

B. Defendant's arguments

17. The defendant first refers to legislation and case law regarding a likelihood of confusion and then states that this opposition should be rejected for all goods in class 18.

18. The goods concerned are dissimilar according to the defendant. He believes that the terms 'suitcase' and 'trunk' are different. They refer to goods which are different by nature and purpose. One

is intended for storage and transportation (trunk), the other accompanies a traveller (suitcase). Besides, the goods have a different method of use, different manufacturers as well as different distribution channels. Therefore, the goods 'suitcases' are dissimilar to 'trunks'. The opponent also failed to argue similarity of 'suitcases' to any other goods of the trademark invoked, according to the defendant.

19. As to the comparison of the trademarks, the defendant feels the words ICE and WATCH are equally important visually. Consumers will perceive the mark as a whole and will not dissect it into parts. Moreover, the defendant states that the word WATCH is equally distinctive as the word ICE in the contested trademark now that the trademark concerns 'suitcases; travel articles' and the term WATCH is not descriptive for such goods. In addition the contested trademark contains other distinctive elements, such as the figurative sign on the letter I. Thus the overall distinctiveness of the contested trademark is determined by all these factors and the term ICE does not prevail in any way.

20. Visually, ICE is neither dominant, nor the only distinctive element in the contested trademark, according to the defendant. It is one of several equally important distinctive elements, which result in an overall visual impression which is rather different from the overall impression of the trademark invoked.

21. Phonetically, the trademark invoked consists of a single syllable. The contested trademark is formed of two syllables. The trademarks are short. Therefore, the defendant thinks that the absence of the element WATCH is a rather significant difference which may not go unnoticed by the consumers.

22. Conceptually, the defendant believes that the consumer will perceive the trademark invoked in accordance with its first meaning of 'frozen water'. However, when facing the combination ICE WATCH consumers are unlikely to understand ICE as frozen water as the concept of frozen water does not create a meaningful expression with the notion of 'watch'. The combination ICE WATCH conveys a meaning to ICE which differs from its main meaning. The defendant explains ICE could also be understood as diamonds. Such definition goes well together with the notion of WATCH. It will be understood as alluding to a decorated watch or a watch as a piece of jewelry. Given that the contested mark conveys a meaningful expression, the meaning of the expression as a whole is relevant and not that of the individual words. Hence the trademarks are conceptually different.

23. The defendant claims that the trademark invoked does not result in absolute unrestricted rights in the word ICE in favour of the opponent to exclude any trademark use or registration of that word by third parties. The opponent's rights extend to situations where a later application may affect the distinctive function of the trademark ICE because consumers will not be able to distinguish the opposed trademark from it or they may attribute common origin to the goods bearing the marks. A likelihood of confusion is excluded here because of the different overall impression created by the trademarks concerned. The defendant refers to a decision by the German Patent and Trademark Office which came to the same conclusion in a decision under identical circumstances.

24. In light of the above, the defendant requests that this opposition is rejected, the contested trademark be registered and that the opponent bears the costs of these proceedings.

III. DECISION

A.1 Likelihood of confusion

25. 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.

26. Article 2.2ter, Para. 1 BCIP stipulates 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."*

27. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive 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 (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; Cube, 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 trademarks

28. The wording of Article 5, 1 (b) of the Directive (cf. article 2.2ter, 1 (b) BCIP) according to which "there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark" 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).

29. 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).

30. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, Limonchello, C-334/05 P, 12 June 2007, ECLI:EU:C:2007:333). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, Matratzen, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and El Charcutero Artesano, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

31. The trademarks to be compared are the following:

Opposition based on:	Opposition directed against:
ICE	

32. According to relevant case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, inter alia the visual, aural and conceptual aspects (reference is made to *Matratzen and Sabel*, already cited). The fact that a mark consists exclusively of the earlier mark, to which another word has been added, is an indication that the two trademarks are similar (*EGC, ECOBLUE, T-281/07*, 12 November 2008, ECLI:EU:T:2008:489). This is especially the case when the element that the signs have in common still has an independent distinctive role in the composed sign (*CJEU, THOMSON LIFE, C120/04*, 6 October 2005, ECLI:EU:C:2005:594).

Conceptual comparison

33. The word ICE in the trademark invoked and the contested trademark will be understood by the relevant public as an English word meaning 'frozen water'. This word is part of the basic English knowledge of the Benelux public.

34. The word WATCH in the contested trademark can be understood as a verb meaning 'to look at or attentively observe over a period of time' or as noun referring to 'a small timepiece'.²

31. Conceptually, the trademarks are similar in so far as they both refer to ICE.

Visual comparison

35. The trademark invoked is a combined word/figurative trademark consisting of one word of three letters ICE. The word ICE is written in bold black capital letters. The contested trademark is a combined word/figurative mark consisting of two words ICE and WATCH. Both words are separated by a horizontal line. Both words are written in a bold black font. The word ICE is written in a bigger typeface than the word WATCH. Furthermore, the dot on the letter I in ICE is replaced with an abstract stylized figure.

36. Where a sign consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods or services in question by quoting their name than by describing the figurative element of the trademark (*EGC, SELENIUMACE, T-312/03*, 14 July 2005, ECLI:EU:T:2005:289). The graphical aspect of the trademark invoked can be qualified as rather marginal, merely consisting of the use of a bold typeface, which the consumer will perceive as an adornment (see *EGC, Dieselit, T-186/02*, 30 June 2004, ECLI:EU:T:2004:197). As a result, the relevant public will without any doubt perceive the verbal element ICE as the dominant element of the trademark invoked. Although the figurative elements of the line, the stylized dot and the bold typeface in the contested trademark will not be overlooked (see *Gerechtshof 's Gravenhage, MOOVE-4MOVE, 200.105.827/0*, 11 September 2012, ECLI:NL:GHSGR:2012:BX8916), they are not likely to be perceived by the public as the visually dominant elements of the contested trademark as it concerns rather decorative elements of subordinate importance. The word elements ICE and WATCH will primarily attract the consumer's attention as they make up most of the trademark and are represented centrally in a big, bold typeface.

37. The consumer normally attaches more importance to the first part of a sign (*EGC, Mundicor, T-183/02 and T-184/02*, 17 March 2004, ECLI:EU:T:2004:79). In this case the trademark invoked is

² See www.lexico.com.

identically reproduced at the beginning of the contested trademark. The contested trademark differs because of the addition of the word WATCH and the use of graphical elements.

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

Aural comparison

39. The trademark invoked is pronounced in one syllable as ICE. The contested trademark will be pronounced in two syllables as ICE WATCH. Aurally the consumer will in general also attach more importance to the first part of a sign (EGC, Mundicor, already cited). The pronunciation of the first three letters of the trademarks is identical. The pronunciation of the trademarks differs as regards the word WATCH in the contested trademark.

36. Aurally the trademarks are similar to a certain degree.

Conclusion

40. Conceptually, the trademarks are similar. Visually and aurally the trademarks are similar to a certain degree.

Comparison of the goods and services

41. 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).

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

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

Opposition based on:	Opposition directed against:
Cl 9 Optical apparatus and instruments, Safety goggles, Spectacles, Sunglasses, Lenses, Mounts, Arms (part of frames), Cases and containers, All for spectacles, parts, Components and accessories for all the aforesaid goods.	
Cl 11 Apparatus for lighting, heating, steam generating, cooking, drying, ventilating, water supply and sanitary purposes.	
Cl 16 Paper, cardboard and goods made from these materials, not included in other classes; Printed matter; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and	

office requisites (except furniture); Instructional and teaching material (except apparatus); Plastic materials for packing (not included in other classes); Printers' type; Printing blocks.	
Cl 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas, parasols and walking sticks.	Cl 18 Suitcases; travel articles.
Cl 20 Furniture, mirrors, picture frames; Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.	
Cl 21 Household or kitchen vessels and other utensils (not included in other classes), other than cutlery, corkscrews, spatulas, graters, containers for ice and ice cream, namely fruit bowls, salad bowls, pots, vases, butter dishes, napkin holders, toothpick holders, plates, serving platters, serving trays not of precious metals, mugs, drinking glasses, tea and coffee services, not of precious metal, decorative boxes made of glass or porcelain, decorative plates, flower pots; Glassware, porcelain and earthenware (not included in other classes), namely fruit bowls, salad bowls, mugs, cups, dishes, pitchers, platters, serving trays, vases, including crystal.	
Cl 24 Textiles and textile goods, not included in other classes; Bed and table covers.	
Cl 25 Clothing, footwear, headgear.	
Cl 27 Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; Wall hanging (non-textile).	
Cl 35 Sales services for bringing together, for others, of a variety of goods, (excluding the transport thereof), enabling customers to conveniently view and purchase those goods, in particular, spectacles and cases for spectacles, apparatus for lighting, water supply and sanitary purposes, stationery items, leatherware, luggage, umbrellas, clothing, footwear, headgear, household textiles and linen, furniture and furnishings, household utensils for domestic use.	

44. The goods *suitcases* of the defendant are strongly similar to the goods *trunks and travelling bags* of the opponent. All these goods are used by people for carrying different items, in order to take these items with them when they are travelling or „on their way“. Therefore, their nature and purpose is the same. Furthermore, these goods could be offered to the same end users by the same stores in various shapes and sizes, therefore the consumer could assume that these products originate from the same undertaking (reference is made to BOIP, opposition decision 2005550, Only, 9 December 2011). Furthermore, these goods are also in competition as they can be replaced by each other.

45. The goods *travel articles* of the defendant are identical to the goods *travelling bags* of the opponent in class 18. According to established case law, if the goods of the contested trademark also contain goods that are mentioned in the earlier trademark, these goods are considered identical (see EGC, *Metabiomax*, T-281/13, 11 June 2014, ECLI:EU:T:2014:440). The travelling bags of the opponent can be considered as a category of travel articles and are thus deemed identical.

Conclusion

46. The goods of the defendant are either identical or strongly similar to the goods of the opponent.

A.2 Global assessment

47. 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 trademarks are important factors.

48. 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 trademarks 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).

49. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. 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 (*case Lloyd*, already cited). The present case concerns goods which are targeted at the public in general. For these goods the average level of attention of the public concerned may be deemed normal.

50. 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 level of distinctiveness as it does not describe the goods and services concerned.

51. 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. Finally, a likelihood of confusion among part of the relevant public is sufficient to grant an opposition (*EGC, Hai/Shark*, T-33/03, 9 March 2005, ECLI:EU:T:2005:89).

52. The goods of the defendant are identical or strongly similar to the goods of the opponent. Furthermore, the trademarks are visually and aurally similar to a certain degree and conceptually they are similar. Based on the foregoing, the Office is of the opinion that the relevant public might believe that the goods in question come from the same undertaking or from economically-linked undertakings.

B. Other factors

53. The parties refer to similar proceedings before other national courts or other authorities in order to support their arguments (points 15 and 23). It must however be recalled that the Office is not bound by other and/or its own previous decisions. Each case has to be dealt with separately and on its own merits, taking into account its particularities (see, by analogy with, EGC, Curon, T-353/04, 13 February 2007, ECLI:EU:T:2007:47).

C. Conclusion

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

IV. DECISION

55. The opposition with number 2014312 is justified.

56. Benelux application with number 1374669 will not be registered in the Benelux.

57. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 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, 17 July 2020

Tineke Van Hoey
(*rapporteur*)

Saskia Smits

Pieter Veeze



Administrative officer: Gerda Veltman