

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2014538**  
**of 5 November 2020**

**Opponent:** **Falke KGaA**  
Oststrasse 5  
57392 Schmallenberg  
Germany

**Representative:** **Muller & Eilbracht B.V.**  
Postbus 1080  
2260 BB Leidschendam  
The Netherlands

**Right invoked:** **European Union trademark 17185349**  
  
FALKE  
  
*against*

**Defendant:** **CKL Holdings N.V.**  
Kloosterstraat 28-30  
4700 Eupen  
Belgium

**Representative:** **Trademarkers Merkenbureau C.V.**  
Prinses Beatrixstraat 7  
5953 LL Reuver  
The Netherlands

**Contested trademark: Benelux trademark 1377862**  
  
falke

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 20 August 2018 the defendant filed a Benelux trademark application for the word mark falke for goods and services in the classes 3, 25, 28 and 41. The application was processed under number 1377862 and was published on 21 August 2018.

2. On 19 October 2018 the opponent filed an opposition against the registration of the application. The opposition is based on the earlier EU trademark 17185349, the word mark FALKE, filed on 8 September 2017 and registered on 8 January 2018 for goods and services in classes 3, 9, 10, 14, 18, 25, 28 and 35.

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

4. The opposition is directed against all the goods and services of the contested application and is based on all the goods and services of the registered trademark invoked.

5. 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>

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 25 October 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"). The administrative phase was completed on 24 June 2019. However, on 9 September 2019 the Office notified the parties about the ex-officio suspension of this procedure due to a cancellation action against the trademark invoked. On 5 October 2020 the parties were informed about the ending of the ex officio suspension.

## **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 the relevant marks and the identity or similarity of the goods or services concerned.

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

9. According to the opponent both trademarks are purely verbal marks containing only one and the same word. Therefore the opponent finds the earlier trademark and the contested trademark to be highly

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<sup>1</sup> This decision refers to the laws and regulations applicable at the date of the decision, unless it concerns provisions that have undergone a material change relevant to the decision during the proceedings.

similar if not identical. The only difference can be found in the capital letters versus the lower case, which is not relevant for the comparison between two word marks. Whereas the trademarks consist of the same word, they are visually, aurally and conceptually identical, according to the opponent.

10. According to the opponent the contested goods in classes 25 and 28 are identical to the goods of the earlier trademark. The contested goods in class 3 are partly identical or highly similar. The services in class 41 of the contested application are partly complementary to the (fashion) goods and services mentioned in the earlier trademark.

11. The level of attention of the public for the relevant goods and services may be deemed normal, according to the opponent. The trademark invoked has a normal level of distinctiveness as it is not descriptive of the goods and services concerned. The opponent also refers to the reputation of the trademark invoked which has not been disputed by the defendant.

12. Additionally the opponent points to the reputation of both the trademark owner and the applicant. The opponent, Falke KgaA, is a well-known company, that has a strong reputation in the field of fashion goods. The applicant of the contested trademark is one of the companies of Mr Michael Gleissner who, according to the opponent, also enjoys a reputation. The opponent hereby refers for example to the numerous trademark cases involving companies of Mr Gleissner. The opponent is of the opinion that the defendant must have been aware of the earlier trademark of the opponent and finds the filing of the contested trademark application therefore questionable. The opponent also points to a large scale study performed by World Trademark Review into the trademark filing activities of Mr Gleissner. According to the opponent one might conclude that the applicant filed the contested application in bad faith.

13. The opponent concludes that there is a likelihood of confusion due to the identity and (high) similarity of the trademarks and the relevant goods and services.

14. The opponent therefore asks that the Office awards the opposition and rejects the contested Benelux application.

## **B. Defendant's arguments**

15. The defendant admits that the visual appearance of the earlier trademark and the contested trademark is identical and also admits that there are substantial similarities between the relevant goods in the classes 3, 25 and 28.

16. The defendant however does not agree with the finding of the opponent that the services of the contested application in Class 41 are similar or identical to the goods and services mentioned in classes 25 and 35 of the earlier trademark.

17. Lastly, the defendant requests the Office to disregard any 'conspiracy theories and unproven speculations regarding Mr Gleissner'.

18. The defendant requests that the Office rejects the opposition for the services in Class 41 and that it grants the contested application protection in the Benelux for the services in Class 41.

### III. DECISION

#### A.1 Likelihood of confusion

19. 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.

20. Article 2.2ter (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."*

21. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of 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 (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

#### **Comparison of the trademarks**

22. 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).

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. The trademarks to be compared are the following:

| Opposition based on: | Opposition directed against: |
|----------------------|------------------------------|
| FALKE                | falke                        |

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25. The identity of the trademarks is undisputed (see para. 15). The Office also establishes that the trademarks are identical. The fact that trademark invoked is written in capitals whereas the contested trademark is depicted in lower-case letters does not alter this conclusion (see for example BOIP, opposition decision HY-BOND RESIGLASS, nr 2000572, 8 April 2008).

*Conclusion*

26. The earlier trademark and the contested trademark are identical.

**Comparison of the goods and services**

27. 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).

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

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

| <b>Opposition based on:</b>  | <b>Opposition directed against:</b>   |
|--|---|
| Cl 3 Non-medicated soaps; Detergent soap; Perfumery; Body cleaning and beauty care preparations; Soaps for body care; Deodorants for body care; Cosmetic preparations for body care; Pre-shaving preparations; After-shave preparations. | Cl 3 Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps. |
| Cl 9 Spectacles [optics]; Spectacle frames; Sunglasses.  |   |
| Cl 10 Support hosiery; Stockings with a compression effect; Running trousers with a compression effect; Knee-high running socks with a compression effect; Medical tops; Medical stockings, Medical tights; Medical trousers.            |   |
| Cl 14 Ornaments [jewellery, jewelry (Am)]; Jewels; Clocks and watches.   |   |

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| CI 18 Casual bags; Travel cases; Backpacks; Handbags, purses and wallets; Keycases; Umbrellas.  |   |
| CI 25 Clothing; Hosiery; Stockings; Tights; Socks; Footwear; Headgear; Kerchiefs [clothing]; Neckties; Waist belts.   | CI 25 Clothing; footwear; headgear; swimwear; sportswear; leisurewear.  |
| CI 28 Sporting goods and equipment; Games; Toys.  | CI 28 Games; playthings; gymnastic articles not included in other classes.  |
| CI 35 Wholesaling, retailing, online retailing in relation to soaps, not for medical purposes, soaps (detergents), perfumery, body cleaning and body care preparations, soaps for body care, deodorants for body care, cosmetic preparations for body care, shaving preparations, after-shave preparations; Wholesaling, retailing, online retailing in relation to spectacles, spectacle frames, sunglasses; Wholesaling, retailing, online retailing in relation to stockings with a supporting effect, stockings with a compression effect, running trousers with a compression effect, knee-high running socks with a compression effect, medical tops, medical stockings, medical tights, medical trousers; Wholesaling, retailing, online retailing in relation to jewellery, wristwatches, horological instruments; Wholesaling, retailing, online retailing in relation to bags, travel cases, backpacks, handbags, purses and wallets, key cases, umbrellas; Wholesaling, retailing, online retailing in relation to clothing, hosiery, stockings, tights, socks, footwear, headgear, neckerchiefs, neckties, belts (clothing); Wholesaling, retailing, online retailing in relation to sporting articles and sports equipment, games, playthings. |   |
|   | CI 41 Teaching; education; training; entertainment services; production of television programs; film distribution; production of shows; production of films; provision of non- downloadable films and television programs via a video-on-demand service; arranging, conducting and organisation of workshops; conducting of seminars and congresses; arranging of exhibitions for cultural purposes; organizing and arranging |

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|  | exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes. |
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#### *Classes 3, 25 and 28*

30. The defendant does not contest the identity or similarity of the goods as mentioned in the classes 3, 25 and 28 (see paras. 15, 16 and 18). The Office will therefore not compare these goods of the contested application with those of the earlier trademark.

#### *Class 41*

31. Goods and services are different in nature and are therefore generally not considered to be similar. However, they can be found to be complementary. Goods and services are complementary if there is a close connection between them, in the sense that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking (see, to that effect, EGC, Flaco, T-74/10, 11 May 2011, EU:T:2011:207); Artis, T-558/11, 21 November 2012, EU:T:2012:615 and Dignitude, T-504/11, 4 February 2013, EU:T:2013:57).

32. The opponent finds the services "arranging, conducting and organisation of workshops; conducting of seminars and congresses; arranging of exhibitions for cultural purposes; organizing and arranging exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes" of the contested application to be (partly) complementary to the goods in Class 25 and the services in Class 35 of the earlier trademark (see para. 10).

33. The Office points out that the simple fact that clothing manufacturers sometimes organise fashion shows does not lead to a finding of complementarity. After all, the services are not rendered to third parties, but only for commercial purposes of the clothing manufacturer himself. Therefore they cannot be found to be complementary to the goods and services of the earlier trademark.

34. The services in Class 41 of the contested application are dissimilar to the goods and services of the earlier trademark. They have a different purpose and target a different public. Moreover, they are also manufactured/provided by different companies, as it is not common for the producers of the goods on which the opposition is based to also offer the contested services or vice versa. In addition, these goods and services are neither in competition with, nor complementary to each other.

#### *Conclusion*

35. The similarity of the goods and services of the earlier trademark and the contested application in the classes 3, 25 and 28 is not disputed. The services in Class 41 of the contested application are dissimilar to the goods and services of the earlier trademark.

## **A.2 Global assessment**

36. 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.

37. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question. The goods and services concerned are targeted at the public in general. For these goods and services the average level of attention of the public concerned may be deemed normal.

38. 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).

39. 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). The distinctive character of the earlier trademark may be deemed at least normal as it is not descriptive for the relevant goods and services.

#### *Conclusion*

40. In view of the aforementioned circumstances, taking into account the limitation of the dispute by the parties, the Office is of the opinion that the relevant public might believe that the goods of the contested application whose identity or similarity is not disputed, originate from the same undertaking or from economically-linked undertakings.

#### **B. Other factors**

41. According to the opponent one might conclude that the applicant filed the contested application in bad faith (see para. 12). In this context the Office refers to the changes in the BCIP as of 1 March 2019. Although invoking "bad faith" as a legal ground in opposition proceedings is still not possible, a claim for cancellation of a trademark registration can since that date be based on "bad faith" according to Article 2.2bis (2) BCIP.

#### **C. Conclusion**

42. Based on the foregoing the Office is of the opinion that there is a likelihood of confusion for the goods which are considered to be identical or similar. The Office finds the services of the contested application, as mentioned in Class 41, not to be identical nor similar.

#### **IV. DECISION**

43. The opposition with number 2014538 is partly justified.

44. Benelux application with number 1377862 will not be registered for the following goods:



- CI 3 (*all goods*)
- CI 25 (*all goods*)
- CI 28 (*all goods*).

45. Benelux application with number 1377862 will be registered for the following services which are dissimilar to the goods and services of the earlier trademark:

- CI 41 (all services)

46. 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, 5 November 2020

Tomas Westenbroek

Pieter Veeze

Willy Neys

(*rapporteur*)



Administrative officer: Raphaëlle Gerard