



Benelux Office for
**Intellectual
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2014714
of 9 November 2021**

Opponent: **CACTUS S.A.**
Route d'Arlon Belle Etoile
8050 Bertrange
Luxembourg

Representative: **Office Freylinger S.A.**
Route d'Arlon
8010 Strassen
Luxembourg

Invoked right: **Benelux trademark registration 1249887**

CACTUS

against

Defendant: **Louis Vuitton Malletier, Société Anonyme**
rue du Pont-Neuf 2
75001 Paris
France

Representative: **ALTIUS CVBA**
Tour & Taxis Building, Havenlaan 86, B.414
1000 Bruxelles
Belgique

Contested trademark: **Benelux trademark application 1383777**


CACTUS GARDEN

I. FACTS AND PROCEEDINGS

A. Facts

1. On 23 October 2018 the applicant filed a Benelux trademark application for the wordmark "CACTUS GARDEN" for goods in class 3. This application was processed under the number 1383777 and was published on 30 October 2018. The application claimed as a priority the French trademark application "CACTUS" number 184451686 with a priority date of 7 May 2018. During the course of the proceedings the ownership of the trademark was transferred to the defendant.

2. On 21 December 2018 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- European Union trademark registration 000963694 of the wordmark "CACTUS", filed on 16 October 1998 and registered on 18 October 2002 for goods in classes 2, 3, 5, 6, 7, 8, 9, 11, 16, 18, 20, 21, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 39, 41 and 42.
- European Union trademark registration 000963595 of the semi-figurative trademark , filed on 16 October 1998 and registered on 6 April 2001 for goods in classes 2, 3, 5, 6, 7, 8, 9, 11, 16, 18, 20, 21, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 39, 41 and 42.
- Benelux trademark registration 1249887 of the wordmark "CACTUS", filed on 21 June 2012 and registered on 10 September 2012 for goods in class 35.

3. Following a cancellation decision for the trademarks nr 000963694 and 000963595 concerning classes 3 and 35, the sole classes for these rights upon which the opposition was based, the parties were notified on the 11 of November 2020 that these trademarks would not be considered for the opposition. With the submission of his arguments the opponent limited the basis of his opposition to the Benelux trademark registration nr 1249887.

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

5. The opposition is directed against all of the goods covered by the contested application and is based on all of the 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").¹

7. The language of the proceedings is English.

B. Course of the proceedings

8. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") to the parties on 27 December 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"). Due to pending cancellation actions

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.

concerning two of the trademarks invoked, namely the trademarks with the application numbers 000963694 and 000963694, the opposition proceedings were temporarily suspended. The end of the suspension period was notified to the parties on the 11 of November 2020. The administrative phase was completed on 18 May 2021.

II. ARGUMENTS

9. 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.

A. Opponent's arguments

10. The opponent starts his arguments with the comparison of the goods and services in question. He notes in this regard that retail services concerning the sale of specific goods are similar to these goods because, while they differ in nature, these goods and services are complementary and generally offered in the same places. It results from this, that, according to the opponent, the goods of the contested trademark are similar to the "Retailing of a variety of products in the fields of hygiene and beauty" of the invoked right.

11. Addressing the comparison of the trademarks, the opponent considers these visually similar to a high degree in that the word "CACTUS", which, according to the opponent is highly distinctive for the products and services covered by the trademark at stake, composing the invoked right, is entirely included in the first part of the contested trademark. The opponent notes furthermore that consumers generally attach more importance to the first part of trademarks which are identical in this case. The separation of the word "CACTUS" and "GARDEN" in the contested trademark makes it so that both will be considered separate elements according to the opponent.

12. Phonetically, the opponent notes that the only word composing the invoked trademark is also the first word pronounced in the contested trademark. In addition, the separation of both words and the phonetically minor nature of the second word "GARDEN" according to the opponent, make it so that both trademarks are phonetically highly similar.

13. Conceptually, the opponent argues that both trademarks are identical in that they both refer to cacti.

14. As regards the likelihood of confusion, the opponent considers that the high distinctiveness of the invoked trademark, for which he submits elements of proof showing that the latter has acquired a high level of distinctiveness through 50 years of use within the EU, increases the risk of confusion as the earlier right will be recognized by the public.

15. As a result of the above, the opponent considers that there exists a likelihood of confusion for the consumer. Thus, he asks the Office to grant the opposition, not to register the contested trademark and to order that the costs be borne by the defendant.

B. Defendant's arguments

16. The defendant starts his arguments with an introduction of the applicant's company and a summary of the procedure.

17. Concerning the comparison of goods and services, the defendant notes that only in the case of identical goods can retail services relating to these be considered similar. However, the defendant notes that the "products in the field of hygiene and beauty" is a vague term and should not be considered identical to at least some of the goods covered by the contested trademark. Therefore, the defendant finds the goods and services only similar to a low degree.

18. As regards the relevant public, the defendant refers to caselaw to conclude that the level of attention can vary with products in class 3. In this case, the defendant considers that the level of attention will be high for some products and average for others.

19. In comparing the trademarks in question, the defendant notes in the first place that the word element "CACTUS" of the contested mark is less distinctive due to it potentially referring to an ingredient. As a result the defendant considers "GARDEN" to be the dominant element of the contested trademark. However, should the Office consider that none of the elements are more distinctive than the other, the defendant argues that the trademarks should be considered as a whole without the elements at the beginning being more important than the others.

20. Visually the defendant notes that the contested trademark is twice as long as the invoked right and thus at most similar to a low degree if not dissimilar. The defendant further substantiates his argument by pointing to decisions rendered by the EGC and the EUIPO.

21. Phonetically, the defendant notes that the contested trademark is composed of twice as many syllables and that, contrary to what the opponent argues, the syllables composing the word "GARDEN" are stronger. It follows according to the defendant that both trademarks are at best similar to a low degree if not dissimilar.

22. Comparing the trademarks conceptually, the defendant argues that the concept of a cactus garden is different from that of a single cactus in that the former does not exist in the territory of the Benelux and refers to an exotic concept famous in California. The trademarks are thus, according to the defendant, conceptually only similar to a low degree.

23. As regards the increased distinctiveness argued by the opponent, the defendant considers the proof submitted to that extent insufficient. The defendant notes that there are other trademarks registered in the Benelux containing the word "cactus" in class 35. Furthermore the defendant notes that none of the elements submitted show any use in relation to retail services in the fields of hygiene and beauty and thus that the relevant public would be familiar with the earlier mark in relation to these services. In that regard the defendant notes that the word "cactus" is very commonly used in the field of hygiene and beauty and as a result, the distinctiveness of the invoked right would be low or, at most, average.

24. Considering the arguments above, the defendant finds that there exists no risk of confusion for consumers between the trademarks. Thus, he asks the Office to register the contested trademark and to order that the costs be borne by the opponent.

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; 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

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. In general, two trademarks 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 (EU TUE, MATRATZEN, T-6/01, 23 October 2002, ECLI:EU:T:2002:261), namely the visual, aural and conceptual aspects are relevant. 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 (EU TUE, ECOBLUE, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). This is particularly true if the element common to the signs retains an independent distinctive role in the composite sign (CJEU, THOMSON LIFE, C-120/04, 6 October 2005, ECLI:EU:C:2005:594).

32. The trademarks to be compared are the following:

Opposition based on:	Opposition directed against:
CACTUS	CACTUS GARDEN

Visual comparison

33. The invoked trademark consists of the word element "CACTUS" composed of 6 letters. The contested trademark is composed of the word elements "CACTUS GARDEN" composed of 12 letters. While the contested trademark contains the word element "GARDEN" which is not present in the invoked trademark, the latter is nonetheless entirely incorporated as the first verbal element of the contested trademark. Thus, considering that half of the contested trademark is composed of the invoked trademark, the overall visual impression of the trademarks is similar.

34. The trademarks are visually similar.

Aural comparison

35. The invoked trademarks consist of a single word element, composed of 2 syllables [cac] [tus]. The contested trademark consists of two word elements of two syllables each: [cac] [tus] and [gar] [den]. While, as previously mentioned, the contested trademark contains a word element not present in the invoked trademark, it derives from caselaw that the consumer normally attaches more importance to the first part of a trademark (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). In this case the trademark invoked is identically reproduced at the beginning of the contested trademark, rendering the overall aural perception of both trademarks similar.

36. Thus, the Office considers the trademarks to be aurally similar.

Conceptual comparison

37. The invoked trademark refers to an individual cactus and the contested trademark refers to a garden of cacti. In that regard, the Office notes that both trademarks are conceptually similar in that both refer to the same plant.

Conclusion

38. The trademarks in question are similar visually, phonetically and conceptually.

Comparison of the goods and services

39. 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 (CJEU, Canon, already cited).

40. With the comparison of the 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.

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

Opposition based on:	Opposition directed against:
	CI 3 Cosmetics; sun-tanning preparations (cosmetics); essential oils; soaps; perfumed soaps; deodorants for personal use; shower gels; bath gels; scented bath salts; shampoos; scented body lotions and milks; scented body creams; perfumes; perfumery; eau de parfum; toilet water; eau de Cologne; air fragrancing preparations; room fragrancing preparations; bases for flower perfumes; sachets for perfuming linen.
CI 35 Publicité; publicité par correspondance; publicité radiophonique, télévisée, par voie de presse et en ligne sur un réseau de communication mondiale ou privée informatique; publicité directe par distribution de courrier, de prospectus et d'imprimés publicitaires; gestion des affaires commerciales; administration commerciale; travaux de bureau; distribution de prospectus et d'échantillons (publicité); conseils, informations ou renseignements d'affaires; études et recherches de marchés; comptabilité; reproduction de documents; bureaux de placement; gestion de fichiers informatiques; location de temps publicitaire sous tous moyens de communication; organisation d'expositions à buts commerciaux ou de publicité; opérations de mercatique; promotion des ventes pour des tiers; services de promotion des ventes pour des tiers par fidélisation de la clientèle; services de fidélisation utilisant ou non une carte (promotion des ventes); services de mercatique téléphonique; gérance administrative de supermarchés et de magasins; établissement de relevés de comptes; recueil et systématisation de données dans un fichier central; compilation de données dans des banques de données informatiques; services de comparaison de prix; présentation de produits sur tous moyens de communication, et notamment sur Internet, pour la vente au détail; informations et conseils commerciaux aux consommateurs; traitement administratif	

de commandes d'achats; services de vente au détail d'une variété de produits dans les domaines de l'alimentation, de l'hygiène, de la beauté, du nettoyage, de l'entretien, du bureau et de la maison, des vélos et pièces détachées pour vélos ainsi qu'accessoires pour vélos, des bijoux, des montres, chronomètres, instruments chronométriques et d'articles d'horlogerie; regroupement (pour le compte de tiers) de produits alimentaires et de consommation (à l'exception du transport), permettant aux consommateurs de les voir et de les acheter commodément, notamment par Internet; traitement administratif de commandes d'achat; facturation; services d'aide administrative aux franchisés pour la mise en place du système de commande en ligne, de préparation des commandes et du retrait par les clients .

CI 35 Advertising; mail order advertising; radio, television, press and on-line advertising on a global or private computer communications network; direct advertising by distribution of mail, leaflets and printed advertisements; management of commercial affairs; commercial administration; office work; distribution of leaflets and samples (advertising); business advice, information or intelligence; market studies and research; accounting; reproduction of documents; employment agencies management of computer files; rental of advertising time by all means of communication; organisation of exhibitions for commercial or advertising purposes; marketing operations; sales promotion for third parties; sales promotion services for third parties through customer loyalty; loyalty services using or not using a card (sales promotion); telephone marketing services; administrative management of supermarkets and shops; drawing up of statements of account; collection and systematisation of data in a central file compilation of data in computerised databases; price comparison services; presentation of products on all means of communication, including the Internet, for retail sale; commercial information and advice to consumers; administrative processing of

<p><i>purchase orders; retailing services for a variety of products in the fields of food, hygiene, beauty, cleaning, maintenance, office and household goods, bicycles and bicycle parts as well as bicycle accessories, jewellery, watches, chronometers, chronometric instruments and timepieces bundling (on behalf of third parties) of food and consumer products (except transport), enabling consumers to view and purchase them conveniently, including via the Internet; administrative processing of purchase orders; invoicing; administrative support services to franchisees for the implementation of the online ordering system, order preparation and customer collection.</i></p>	
<p><i>(N.B.: The original language of the mark concerned is French. The English translation of the list of goods and services has been added to increase the readability of this decision).</i></p>	

42. 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.

43. 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 (see to that effect EGC, O STORE, T-116/06, 24 September 2008, ECLI:EU:T:2008:399).

44. The goods covered by the contested trademark fall within the broader categories of goods subject to the retail services of the invoked trademark. More specifically "*retailing services for a variety of products in the fields of hygiene, beauty, cleaning, office and household goods*", encompass, all of the products covered by the contested trademark. Those goods and services are therefore so closely linked that the public may think that the same undertaking (a retail company) is offering such goods using its own trademark. For that reason, the Office considers that those services are similar to a certain degree to the goods of the contested trademark.

Conclusion

45. The goods covered by the contested trademark are similar to a certain degree to the services covered by the trademark invoked.

A.2 Global assessment

46. 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.

47. 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. In the present case, the goods which are found to be similar to a certain degree (paragraph 45) are directed at the public at large. As pointed out in the arguments of the defendant (paragraph 18), with regards to some of these products, in particular as they relate to perfumes, these may be exclusive and very expensive products or cheaper products for everyday use, thus the lowest level of attention must be taken into account. The level of attention of the eligible public can therefore be considered normal.

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 they cover. A lesser degree of similarity between the relevant goods can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

49. 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, despite the possibly lower level of distinctiveness of the word "cactus" for products in class 3 as argued by the defendant (paragraphs 19 and 23), the Office notes that for the registered services of the invoked trademark, namely services in class 35, the earlier mark has normal inherent distinctiveness as it does not describe any of these services. It is worth mentioning in this regard that, even in the presence of an earlier trademark of weak distinctive character, there may be a likelihood of confusion, in particular, because of a similarity between the signs and the goods or services referred to (see EU Court of Justice, Yellow Pages judgment, T-134/06, 13 December 2007, ECLI:EU:T:2007:387). The elements submitted by the opponent concerning an acquired higher level of distinctiveness are irrelevant considering that such a finding would not alter the outcome of the present decision. Thus, the Office considers that the earlier trademark has a normal distinctiveness, as it is not descriptive of the services concerned.

50. 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.

51. Based on the abovementioned circumstances, the Office finds that due to both trademarks being similar, the relevant public might believe that the goods and services which are similar to a certain degree would come from the same undertaking or from economically-linked undertakings.

B. Other factors

52. Insofar as the defendant, in arguing that the opponent's services are vague (see paragraph 17), intends to refer to the IP Translator decision², it should be noted that "*a description of goods and services is sufficiently clear and precise when the scope of protection can be understood from its natural and usual meaning*"³. Specifically as regards the registration of a trademark for retail services, it is not necessary to

² CJEU, IP Translator, C-307/10, 19 June 2012, ECLI:EU:C:2012:361

³ See Common Communication on the common practice on the Acceptability of Classification terms of 20 February 2014 (<https://www.boip.int/en/document/common-communication-ipt3>) as well as Communication from the Director

specify in detail the service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate which is the case for the invoked trademark (CJEU, Praktiker Bau, C-418/02, 7 July 2005, ECLI:EU:C:2005:425). The Office considers that this is the case here⁴.

53. With regard to the defendant's argument that the trademark invoked is weak, since it is also part of several other trademark registrations in relation to the services in class 35 (paragraph 23), the Office considers that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between the two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings before the Office, the defendant has duly demonstrated that such coexistence is based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC Top iX, Case T-57/06, 7 November 2007, ECLI:EU:T:2007:333 and Life Blog, already cited). However, in this case the evidence that coexisting registrations on the market were identical has not been submitted. Furthermore, the defendant has not shown that any coexistence was based on the absence of a likelihood of confusion.

54. In an opposition procedure there is no question of the other party being ordered to bear the costs incurred (see paragraphs 15 and 24). Only a referral of the costs set at the established opposition fee in case the opposition is totally rejected (or justified) is provided for.

C. Conclusion

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

IV. DECISION

56. The opposition with number 2014714 is justified.

57. The Benelux application with number 1383777 will not be registered.

58. 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.



General regarding classification: insufficiently clear and precise terms in class headings of 20 November 2013 (<https://www.boip.int/en/document/communication-regarding-classification-insufficiently-clear-and-precise-terms-in-class>).

⁴ Furthermore, it should be noted that the opponent's services are not included in the list of 11 terms considered not to be sufficiently clear and precise by the network of trade mark offices of the European Union in the above-mentioned joint communication.

The Hague, 9 November 2021

François Châtellier
(*rapporteur*)

Pieter Veeze

Eline Schiebroek

Administrative officer: Gerda Veltman