

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2015545
of 30 June 2023

Opponent: **FRANKIE MORELLO TRADEMARK S.R.L.**

Via Giovanni Boccaccio 29
20123 Milano
Italy

Representative: **Novagraaf Belgium S.A./N.V.**

Chaussée de la Hulpe 187
1170 Watermael-Boitsfort
Belgium

Invoked trademark: **European trademark registration 1642073**

FRANKIE MORELLO

against

Defendant: **FRANKIE4 IP 1 Pty Ltd**

46 Royston Street
Brookfield QLD 4069
Australia

Representative: **NLO Shieldmark B.V.**

PO-box 29720
2502 LS Den Haag
Netherlands

Contested sign: **International trademark application 1352036**

FRANKIE4

I. FACTS AND PROCEEDINGS

A. Facts

1. On 2 July 2019, the defendant filed an International application by subsequent designation for the Benelux, regarding the wordmark FRANKIE4, only for the goods 'footwear' in class 25.¹ This application was processed under the number 1352036 and was published on 25 July 2019.

2. On 25 September 2019 the opponent filed an opposition against the registration of the application. The opposition was initially based on the following earlier trademarks:

- European trademark registration 1642073, of the word mark FRANKIE MORELLO , filed on 5 May 2000 and registered on 30 October 2002 for goods in classes 3, 18 and 25;



- European trademark registration 12079083, of the combined word/figurative mark , filed on 21 August 2013 and registered 15 January 2014 for goods in classes 3, 9, 14, 18, 25 and services in class 35.

3. In his arguments, the opponent limited the scope of the proceedings, namely that the opposition is only based on the invoked word mark FRANKIE MORELLO (EU 1642073). According to the register the opponent is the actual holder of the trademark invoked.

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

5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 26 September 2019. After the opponent filed his arguments, the proceedings were suspended ex officio due to a revocation action against the earlier invoked word mark FRANKIE MORELLO (E1642073). The cancellation division of the European Union Intellectual Property Office (EUIPO) ruled on 18 August 2021 that the trademark invoked should be partially revoked, meaning that the word mark remained registered for a part of the goods in class 18 and all the goods in class 25. After this decision was final, the administrative phase of the proceedings continued and the defendant filed arguments and, at the request of the defendant, proof of use was filed. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 24 November 2022.

¹ The original registration concerned the goods 'clothing; headwear; footwear'.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. The opponent filed an opposition at the Office under article 2.14 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 and services concerned.

A. Opponent's arguments

8. The opponent requests that the Office no longer considers the EU trademark 12079083 as one of the invoked rights in this opposition.

9. With regard to the comparison of the signs, the opponent states that the identical verbal element FRANKIE is the distinctive and dominant element in the contested sign and a distinctive element in the trademark invoked.

10. The opponent argues that the signs are visually highly similar, due to the identical verbal element FRANKIE, which is placed at the beginning of both signs. In general, it is accepted that the consumer attaches greater importance to the first part of a word which means that the similarity or difference between the first part of the words is an important factor for assessment. The opponent therefore concludes that since the first seven letters of both trademarks are identical letters and placed in the same order at the beginning of each of the respective signs, the signs are visually highly similar.

11. The opponent states that the verbal element FRANKIE will be identically pronounced. For this reason, the opponent finds that there is a high degree of phonetic similarity between the two signs.

12. The opponent further argues that the trademark invoked is a sign comprising out of a common prename, namely FRANKIE, which can be seen as the diminutive form of the name FRANK, and a common Italian surname MORELLO. The contested sign also contains the name FRANKIE and the letter 4. Due to the identical meaning of FRANKIE the opponent states that both signs share a high degree of conceptual similarity.

13. With regard to the comparison of the goods, the opponent argues that the goods are either identical or similar. Furthermore, in the present case, all the goods found to be identical or similar are directed at the public at large. The opponent therefore argues that the degree of attention of the public at large in relation to the goods in question should be considered to vary from low to average.

14. The opponent states that the trademark invoked consists of the combination of a prename and a surname, both of which have no relation to the goods for which it has been registered. For this reason, the opponent argues that the trademark invoked has a normal degree of distinctiveness.

15. The opponent requests that the Office grants the opposition and orders that the costs be borne by the defendant.

16. At the request of the defendant, the opponent submits proof of use.

B. Defendant's arguments

17. The defendant argues that the submitted proof of use is not sufficient, because it only shows that the name FRANKIE MORELLO is used to indicate a company that sells clothing, however the trademark invoked is not registered for class 35 (retail services), but for class 25. According to the defendant the

clothing articles have different names such as Sweatshirt LENO and T-shirt TESSON, which are the (trade)marks.

18. According to the defendant, the name Frankie is a (well) known name around the world, and especially in the Benelux. The defendant refers to several other businesses named 'frankie'. The defendant argues that the trademark FRANKIE MORELLO is distinctive because of the combination of two words, namely Frankie and Morello. The element Frankie lacks all distinctiveness or has a very low degree of distinctiveness.

19. The defendant states that the relevant consumer will not be looking for FRANKIE, but always for FRANKIE MORELLO. Furthermore, the added element MORELLO creates a much larger trademark than only FRANKIE itself. With regard to the contested sign, the defendant argues that the combination of FRANKIE and the number '4' is dominant. According to the defendant, the number 4 plays a vital role in the brands marketing strategy. For this reason, the signs are visually similar to a very low degree.

20. With regard to the phonetic comparison, the defendant states that the contested sign will be pronounced as "FRANK-IE-FOUR". The trademark invoked however will be pronounced completely different, namely: FRANK-IE MO-REL-LO. In this case only two syllables are the similar and the defendant argues that the signs are phonetically similar to a very low degree.

21. According to the defendant, the signs have no meaning. For this reason, a conceptual comparison cannot be made.

22. The defendant states that the goods are identical, but this does not lead to the conclusion that there is a likelihood of confusion. According to the defendant, the signs are sufficiently different to create an overall impression of dissimilarity. Furthermore, the defendant points out that the signs will be used in a certain graphic stylization, so that it is clear to the consumer from which company the products originate.

23. The defendant requests that the Office rejects the opposition, accepts the contested sign and takes a decision on the costs in favour of the defendant.

III. DECISION

A.1 Proof of use

24. 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. The evidence must show genuine use in five years prior to the filing or priority date of the trademark against which the opposition is lodged.

25. The filing date of the contested trademark is 2 July 2019. Therefore, the opponent was required to show use of the invoked trademarks during the period from 2 July 2014 to 2 July 2019 ('the relevant period'). Given that the trademark invoked was registered over five years prior to the contested trademark's filing date, the defendant's request that proof of use is submitted is legitimate.

In general

26. 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.² 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.³ 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.⁴

27. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.⁵ 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.⁶

28. 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.⁷

29. 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.⁸ 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.⁹

30. 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

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

² 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).

³ 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).

⁴ 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).

⁵ 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).

⁶ General Court (EU) 4 April 2019, T-910/16 and T911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

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

⁸ 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).

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

1. Screen-prints and information regarding the websites www.frankiemorello.com and www.frankiemorello.it;
2. Invoices dated between 2015 – 2019 aimed at customers in, amongst others, Greece, Spain, Netherlands, Germany, and Belgium;
3. Company information;
4. News articles, dated between 2015 – 2019;
5. Copies of look books;
6. Cancellation decisions of EUIPO.

32. The Office is of the opinion that the invoices, news articles and look books demonstrate that during the relevant period the trademark invoked has been used as a trademark, however only for clothing, since the documents show no clear references to bags, footwear and headgear. The evidence clearly shows a variety of clothing articles that form part of several collections which are launched under the name FRANKIE MORELLO during the relevant period in the European Union. The invoices show that the volume of sales is not negligible in the light of the goods concerned and took place in several countries of the European Union. Therefore, contrary to what the defendant argues, the Office finds that the trademark invoked has been used as a trademark for 'clothing' in class 25. The fact that certain pieces of clothing that are part of a collection have their own name does not change that.

33. The Office concludes that the evidence of use, taken together, sufficiently demonstrates that the trademark invoked has been put to genuine use in the European Union for the goods 'clothing' in class 25.

A.2 Likelihood of confusion

34. 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.

35. 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.*"¹⁰

36. 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.¹¹

37. 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.¹²

¹⁰ 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.

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

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

Comparison of the signs

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

39. 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.¹⁴ 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.¹⁵

40. 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.

41. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
FRANKIE MORELLO	FRANKIE4

Conceptual comparison

42. The trademark invoked consists of two word elements, namely 'FRANKIE' and 'MORELLO', which will be perceived by the public in the Benelux as a full name (forename and surname). The contested sign contains the name 'FRANKIE' and the number '4'.

43. Both signs contain the first name 'FRANKIE'. However, according to established case-law, the fact that trademark and sign contain the same name does not imply that the trademarks are conceptually similar. A conceptual comparison is only possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.¹⁶ In the present case, it was not demonstrated that there is any concept with which the name 'Frankie' could be associated.

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

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

¹⁵ 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).

¹⁶ General Court (EU) 27 June 2019, T-268/18, ECLI:EU:T:2019:452, points 81-87 (Luciano).

44. Furthermore, although the contested sign refers to a number, the Office finds that in this case this reference will not be understood by the public in any clear and comprehensible meaning that creates a conceptual difference with the trademark invoked.

45. In the light of the above, a conceptual comparison is not possible.

Visual comparison

46. Both trademark and sign contain the element 'FRANKIE' at the beginning, which is the part to which the public will pay most attention.¹⁷

47. The signs differ in the additional word 'MORELLO' in the trademark invoked and in the additional number '4' in the contested sign.

48. For this reason the Office finds that the signs are similar to a certain extent.

Phonetic comparison

49. The trademark invoked consists of five syllables: FRAN-KIE-MO-REL-LO and the contested sign will be pronounced in three syllables: FRAN-KIE-FOUR.

50. The first two syllables are pronounced identically. As also mentioned with the visual comparison, the Office finds that the public will pay more attention to the first part of a sign.

51. The signs differ in the pronunciation of the additional elements, namely 'MORELLO' and 'FOUR' of the contested sign.

52. Therefore, the Office finds that the signs are phonetically similar to a certain degree.

Conclusion

53. The trademark invoked and the contested sign are visually and aurally similar to a certain extent. A conceptual comparison is not possible.

Comparison of the goods

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.¹⁸

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.¹⁹

56. Since the subsequent designation of the contested sign for the Benelux was limited to only 'footwear' (see paragraph 1) and proof of use was only demonstrated for 'clothing', the goods to be compared are the following:

¹⁷ General Court (EU), 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

¹⁸ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹⁹ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

Opposition based on:	Opposition directed against:
CI 25 Clothing	CI 25 Footwear

57. The defendant explicitly states that the goods in class 25 are identical, without any further explanation (see paragraph 22). The identity of these goods is therefore *in confesso*.

Conclusion

58. The goods are identical, which has not been disputed by the defendant.

Global assessment

59. 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.²⁰ 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.

60. The more distinctive the earlier trademark, the greater the risk of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a less distinctive character.²¹ In this context, the defendant argues that 'Frankie' is a very common first name in the Benelux and that this name alone is not distinctive enough (see paragraph 18). However, in this case, the Office is of the opinion that the trademark invoked as a whole, but also the element 'FRANKIE' alone, has a normal distinctiveness, as it is not descriptive for the goods concerned.

61. 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.²² In this case, the goods are identical and the signs are visually and aurally similar to a certain degree. Since it is common in the clothing sector for the same mark to be configured in various ways, the relevant public might also believe that the disputed sign is a sub-brand of the opponent.²³

62. On the basis of these factors 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 goods designated by the trademark invoked and the goods against which the

²⁰ CJEU 22 Juni 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

²¹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

²² CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there. (Equivalenza)

²³ General Court (EU) 6 October 2004, T 117/03 to T 119/03 and T 171/03, ECLI:EU:T:2004:293, point 51 (New Look).

opposition is directed originate from the same undertaking or, as the case may be, from undertakings which are economically linked.

B. Other factors

63. The defendant reference to the actual use of the signs (see paragraph 22) cannot be taken into account in opposition proceedings, as the comparison of the signs and goods and services is solely based on the trademark as registered and the sign as applied.

C. Conclusion

64. Based on the foregoing, the Office concludes that there is a likelihood of confusion.

IV. CONSEQUENCE

65. The opposition with number 2015545 is justified.

66. The International application with number 1352036 will be not registered.

67. 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. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 30 June 2023



Eline Schiebroek
(*rapporteur*)

Tomas Westenbroek

Saskia Smits

Administrative officer: Vincent Munier