



Benelux Office for
**Intellectual
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2015571
of 27 November 2020**

Opponent: **Aktieselskabet af 21. november 2001**
Fredskovvej 5
7330 Brande
Denmark

Representative: **Arnold + Siedsma (Amsterdam)**
Postbus 71720
1008 DE Amsterdam
The Netherlands

Invoked right: **European trademark registration 015574791**

ONLY

against

Defendant: **Chen Haihui**
Area C Zhengjia Village 9
Zeguo Town Wenling City Zhejiang Province
China

Representative: **KOB nv**
Pres. Kennedypark 31c,
8500 Kortrijk
Belgium

Contested trademark: International application 1482377



I. FACTS AND PROCEEDINGS**A. Facts**

1. On 9 July 2019 the defendant filed an international application for a trademark, also designating



the Benelux, for the combined word/figurative mark ONLYOU for goods in class 14. This application was processed under number 1482377 and was published in the Gazette 2019/31 on 15 August 2019.

2. On 10 October 2019 the opponent filed an opposition against the registration of the application. The opposition is based on the European registration 015574791 of the word mark ONLY, filed on 24 June 2016 and registered on 14 November 2016 for goods in class 14.

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 in class 14 of the contested application and is based on all of the goods in class 14 of the 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").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" or "BOIP") to the parties on 11 October 2019. 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 1 April 2020.

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.

A. Opponent's arguments

9. The opponent argues that the overall impression of both signs is highly similar resulting in a likelihood of confusion.

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.

10. With regards to the earlier trademark, the opponent notes that ONLY is its dominant element, considering it is also the only element of the trademark.

11. The opponent argues with regard to the opposed trademark consisting of a word element and a heart shaped device element, that it follows from case law that consumers pay more attention to word elements than to device elements. The opponent thus excludes that element of the sign in his following comparison.

12. Comparing both signs visually, the opponent notes that the word element of the earlier trademark is entirely included as the first 4 letters of said trademark application. The opponent further argues that consumers pay most attention to the first part of a sign, seen as they read from left to right. Thus he finds a high degree of visual similarity.

13. Phonetically, the word element of the applied sign would also, due to the high understanding of English by the consumers in the Benelux, be perceived as "ONLY-YOU" and thus pronounced accordingly, resulting in a high phonetic similarity of both signs.

14. Conceptually, the opponent considers that, since consumers in the Benelux know the meaning of the words "ONLY" and "YOU", both signs are conceptually similar as they contain the word "ONLY".

15. As concerns the goods and services applied for, the opponent notes that both trademarks cover jewelry and are in that regard identical.

16. According to the opponent, while the prior trademark does not cover watches, the goods covered are still similar as results from standard EUIPO practice, confirmed by the Office, to attribute a degree of similarity between watches and jewelry.

17. As a result, the opponent finds the goods identical and similar while also finding the signs highly similar, thus concluding to find a likelihood of confusion by consumers.

B. Defendant's arguments

18. The defendant argues that a comparison of both trademarks based on visual, phonetic and conceptual criteria reveals a lot of differences between both signs.

19. Firstly the defendant notes that the comparison must take into account the signs as a whole.

20. Thus the defendant argues that visually the application differs from the trademark in question, also in the fact that it contains a graphical element.

21. The defendant further argues that "ONLYYOU" is a fantasy word which is meaningless to the public. Indeed the defendant states that there is no reason why the public would dissect the word based on the fact that it contains the word "ONLY".

22. Furthermore the defendant concludes his visual comparison by noting that the earlier trademark constitutes merely half of the sign applied for. The latter being a complex trademark with a visual element and an invented word, thus it cannot be considered similar visually.

23. As regards an aural comparison, the defendant argues that the invented word "ONLYYOU" would not be pronounced as would the word "ONLY". Thus finding only a low to medium degree of similarity.

24. As to the conceptual comparison, the defendant notes that the opponents trademark has a meaning in English language, whereas the applicant's trademark does not, as it is a made up word. Based on this, the defendant concludes that there are conceptual, aural and phonetic differences between both signs.

25. As concerns the goods the defendant agrees that some of the goods, namely "jewelry charms, necklaces, jewelry" are similar.

26. The defendant brings forward the point that the earlier registration does not cover "watches" nor "watch cases" or "presentation boxes for watches", "watch cover pocket" resulting in a substantial difference between the goods covered.

27. In addition the defendant argues that, due to the large amount of trademark registrations for the word "ONLY" coexisting in the Benelux, the distinctiveness of the invoked sign would be clearly diminished. Furthermore, the consumer would as a result attribute less attention to that word further highlighting the differences between the signs.

28. As for the relevant public, the defendant finds that, the goods being luxury goods which are not purchased on a daily basis, the average consumer's level of attention would be higher than usual, thus, fairly high.

29. Finally, the defendant also draws on previous decisions where it was found that the fact that one sign being completely incorporated into another sign does not necessarily lead to likelihood of confusion.

30. In that regard and considering the arguments above, the defendant finds that there will be no risk of confusion when consumers are confronted with those trademarks.

III. DECISION

A.1 Likelihood of confusion

31. 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.

32. 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."*

33. 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 signs

34. 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).

35. 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).

36. 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).

37. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
ONLY	

Conceptual comparison

38. The trademark invoked will be understood by the relevant public as an English word referencing exclusivity. This word is part of the basic knowledge and English vocabulary of the Benelux public.

39. Part of the public will perceive the contested trademark as a word with no meaning. Another part of the public will recognise that it contains both the words ONLY and YOU. The fact that the letter Y is shared between those two words is not a sufficient departure as to render the association with these words by a significant portion of the Benelux public less obvious. This link is rather likely to be made given the word in question can hardly be read or pronounced differently than "Only you".

40. 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).

41. Nonetheless it remains that, conceptually, the signs are either deemed similar as the essential element of both signs is the word "ONLY" expressing a sense of exclusivity, or a conceptual comparison is not relevant as no meaning is attributed to the contested trademark.

Visual comparison

42. The trademark invoked is a word mark consisting of one word of four letters ONLY. The contested trademark is a combined word/figurative mark consisting of one word ONLYOU written in a wider font. Above the word is a figurative element situated, with two shapes together forming a heart shape.

43. 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, SELENIUM-ACE, T-312/03, 14 July 2005, ECLI:EU:T:2005:289).

44. The figurative element of the contested trademark in this case would probably not go unnoticed to the average customer. Nonetheless, the Office is of the opinion that the relevant public will without any doubt perceive the verbal element ONLYOU as the dominant element of the contested trademark.

45. 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 identically reproduced at the beginning of the contested trademark. The contested trademark differs because of the addition of the letters OU and the use of a graphical/figurative element.

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

Aural comparison

47. The trademark invoked is pronounced in two syllables as /'əʊnli/. The contested trademark will be pronounced in three syllables as /'əʊnli/ - /ju/- when the public recognizes the English words. If the contested trademark is perceived as a non-existent word, it will rather be pronounced in three syllables as ON-LY-OU. Yet due to the proximity of both pronunciations and the general understanding of these English words by the Benelux public, a large part of the public would recognize the English words, at the latest when trying to pronounce the word ONLYOU. The pronunciation of the first four letters (the first two syllables) of the trademarks is highly similar, if not identical. The pronunciation of the signs differs as regards the letters YOU in the contested trademark.

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

Conclusion

49. Conceptually, the signs are similar or a comparison is not relevant. Visually and aurally the signs are similar to a certain degree.

Comparison of the goods

50. 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).

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

52. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 14: Jewellery of precious metals and precious stones, paste jewellery, costume jewellery, cuff links, tie pins, precious stones, non-precious stones.	CI 14: Jewelry charms; necklaces; jewelry; clocks; wristwatches; straps for wristwatches; watch chains; watch cases [parts of watches]; presentation boxes for watches; watch pocket (cover).

53. The goods "Jewelry charms; necklaces; jewelry" listed in the opposed trademark and the goods "Jewellery of precious metals and precious stones, paste jewellery, costume jewellery" are identical.

54. With regards to "clocks; wristwatches; straps for wristwatches; watch chains; watch cases [parts of watches]; presentation boxes for watches; watch pocket (cover)", the Office observes that it is not uncommon for these items to carry mainly an aesthetic function. In that sense there is a degree of similarity with "Jewellery of precious metals and precious stones" as both can be purchased in the same shops, produced by the same manufacturers and be addressed at the same public (see also BOIP, Opposition Decision 2002990, Fossy, 6 April 2010 and EGC decision T-292/08, 13 September 2010, name - ECLI).

Conclusion

55. The goods of the defendant are partly identical and partly similar to the goods of the opponent.

A.2 Global assessment

56. 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.

57. 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 case at hand, concerning jewellery products, as well as wholesale and retail services relating to them, these may be exclusive and very expensive jewellery or cheaper imitation jewellery, thus the lowest level of attention must be taken into account. The level of attention of the eligible public can therefore be considered normal. (see also BOIP, Opposition Decision 2001718, Mi Amor, 30 September 2009).

58. 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 signs 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).

59. 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 distinctiveness, as it is not descriptive of the goods and services concerned.

60. 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.

61. Based on the abovementioned circumstances, especially the fact that the goods are partly identical and partly similar and the level of similarity of the signs, the Office is of the opinion that the relevant public, even assuming that there is a higher level of attention for certain goods, might believe that the goods in question come from the same undertaking or from economically-linked undertakings.

B. Other factors

62. Regarding the defendant's observation concerning the saturation of the relevant registers with trademarks that are comparable to the trademark invoked (point 27), the Office recalls 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, the defendant has duly demonstrated that such coexistence was 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, T-57/06, 7 November 2007, ECLI:EU:T:2007:333 and LIFE BLOG, T-460/07, 20 January 2010, ECLI:EU:T:2010:18). In this case, however, no such evidence has been provided by the defendant.

C. Conclusion

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

IV. DECISION

64. The opposition with number 2015571 is justified.

65. The international application with number 1482377 will not be registered in the Benelux.

66. 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, 27 November 2020

François Châtellier
(rapporteur)

Pieter Veeze

Diter Wuytens



Administrative officer: Gerda Veltman