



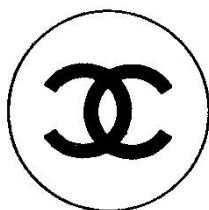
Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2015591
of 29 September 2022

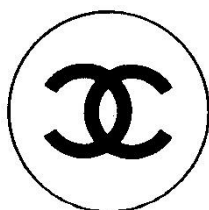
Opponent: **CHANEL, Société par Actions Simplifiée**
Avenue Charles de Gaulle 135
92200 NEUILLY-SUR-SEINE
France

Representative: **Lydian cvba**
Havenlaan 86 C B113
1000 Brussels
Belgium

Invoked trademark 1: International trademark registration 422481



Invoked trademark 2: International trademark registration 426432



against

Defendant: **PROMECO N.V.**
Doornikserijksweg 12
8510 Bellegem
Belgium

Representative: **BAP IP bv - Brantsandpatents**

Charles de Kerchovelaan 17
9000 Gent
Belgium

Contested sign: **Benelux trademark application 1400764**



I. FACTS AND PROCEEDINGS

A. Facts

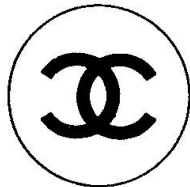
1. On 16 August 2019, the defendant filed a Benelux trademark application for the following combined figurative/word trademark for goods in the classes 9, 11 and 25:



This application was processed under the number 1400764 and was published on 19 August 2019.

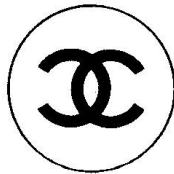
2. On 18 October 2019 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- International registration 422481, *inter alia* designating the Benelux, of the combined



word/figurative mark , filed on 30 March 1976 and registered for goods and services in classes 1, 2, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 15, 16, 17, 19, 20, 21, 22, 27, 28, 29, 30, 31, 32, 33 and 34;

- International registration 426432, *inter alia* designating the Benelux, of the combined



word/figurative mark , filed on 16 November 1976 and registered for goods in classes 14, 18, 23, 24, 25 and 26.

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

4. The opposition is directed against all the goods covered by the contested application and was initially based on all goods covered in classes 9 and 11 of the first trademark invoked and all goods covered by the second trademark invoked. During the proceedings the opponent limited the scope of the opposition to solely all the goods in class 25 of the second 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").

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 8 November 2019. Subsequently, the proceedings were

suspended at the request of the parties. During the administrative phase of the proceedings both parties filed arguments and, at the request of the defendant, proof of use was filed. Furthermore, as a consequence of a procedural error the Office gave the defendant the opportunity to send an additional response. 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 4 February 2021.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

8. 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.

9. The opponent claims that the contested sign should not be registered based on the following grounds:

- Article 2.2ter, 1 BCIP, likelihood of confusion: *"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."*

- Article 2.2ter, 3 (a) BCIP, reputation: *"a trademark shall, in case an opposition is filed, not be registered (...) where: a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark"*.

A. Opponent's arguments

10. The opponent states that the sign of Chanel is one of the most recognizable symbols in the fashion industry. Gabriel Chanel, the founder of the fashion house, designed the famous logo herself in 1925, finding inspiration from a geometric pattern of stained glass windows in a French chapel. According to the opponent, this logo is affixed on a multitude of pieces of clothing, which are also sold in the Benelux.

11. With regard to the similarity of the signs, the Opponent argues that both signs contain a figurative element formed by an combination of two arcs of a circle (or two letters 'C') that intersect each other and are placed one against the other in opposite directions, their opening facing outwards, all within a circle. According to the opponent, this part of the contested sign is almost identical to the trademarks invoked. Also, the size of the two letters 'C' in proportion to the circle in which it is placed, is almost identical as it fills up a large portion of the circle without touching its edges.

12. The opponent states that in the contested sign, the figurative element is the dominant element, because it is placed before the verbal elements and occupies a lot of space compared to the verbal element, 'xolarheat'. Therefore, despite the additional verbal element, the signs concerned still bear important visual similarities.

13. The opponent argues that as the trademarks invoked are purely figurative, it is not possible to compare them aurally with the contested sign.

14. According to the opponent, the trademarks are conceptually similar since they reproduce the same concept, inserting two 'C's' in a circle.

15. The opponent argues that even though the trademarks invoked and the contested sign contain different elements, the overall impression is similar. To substantiate this argument, the opponent refers to two decisions of the European Union Intellectual Property Office (EUIPO) of which one case concerns an invalidity action against a Community design and not a trademark. The opponent also refers to several cases of the French Intellectual Property Office (INPI).

16. The opponent further states that the second trademark invoked is well known for the goods in class 25 and he refers to the submitted evidence in order to substantiate this argument. As a consequence, the average public will quickly recognize the two mirrored C's as Chanel's trademark due to its reputation.

17. In the light of the reputation of the second trademark invoked, the opponent argues that the registration of the contested sign is detrimental to the distinctive character of the trademarks invoked. Firstly, because the signs are visually and conceptually highly similar and secondly because given the international reputation of the second trademark invoked, it is reasonable to believe that the public is likely to establish a link between the signs. The opponent also states that this link could seriously impair the distinctiveness of the second trademark invoked and, at the same time, its economic attraction. The so called 'selling power' of the second trademark invoked could therefore be durably affected by the contested sign.

18. The opponent further argues that he has a reputation for producing only luxury products. However, the defendant develops mass-market sporting products. The representation of the contested sign on these type of products would have the consequence of damaging the reputation of the second trademark invoked. Furthermore, if the contested sign were affixed on goods of inferior value and quality, it would reduce the value of the products of the opponent and the attractiveness of the second trademark invoked would be diminished in the eyes of the relevant public. According to the opponent, this would harm the economic value of the second trademark invoked.

19. The opponent also argues that the trademark invoked is a historic sign that represents quality and elegance. By associating the products of the defendant with the trademark invoked, the defendant could also benefit from the opponent's reputation and he would exploit and free ride on the coattails of the trademark invoked.

20. Regarding the comparison of the goods, the opponent states that the goods of the trademarks invoked on which the opposition is based are similar to the goods of the contested sign.

21. According to the opponent, there is also a risk of confusion which is increased due to the reputation and the enhanced distinctiveness of the trademarks invoked.

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

23. At the request of the defendant, the opponent submits proof of use. The opponent states that the proof of use only refers to class 25 of the second trademark invoked (IR 426432).

B. Defendant's arguments

24. The defendant states that the opponent submitted evidence of use for only one of the trademarks invoked (IR n°426432) and only in class 25. The defendant therefore points out that the first trademark invoked (IR n°422481) is apparently not maintained as a basis for the opposition, and that, for the remaining trademark, the opponent does not claim that the mark was used for any other goods than those covered by class 25. Furthermore, the defendant argues that the submitted proof of use is not sufficient, because it only concerns magazine articles and several screenshots from Instagram and the website of the opponent. The defendant further states that, at most, these documents only show the use of the trademark invoked on a coat and on silk scarves. Hence, the proof of use does not provide evidence that shows genuine use for all the goods mentioned in class 25 of the trademark invoked.

25. With regard to the argument that the trademark invoked has a reputation, the defendant states that the evidence shows a reputation of the trademark invoked in relation to clothing and jewelry.

26. According to the defendant, the signs are only similar to the extent that they both contain a figurative element consisting of one letter or two letters in a circle. This use of letters in circles is obviously not distinctive enough to be protected by trademark law, as such. The defendant argues that the added word 'XOLARHEAT', which is written with an identical 'X', must be taken into account. For this reason, the defendant argues that the public will understand that the figurative element of the contested sign is the depiction of the letter 'X'. The public will also not be reminded of, or establish a visual link with, the trademark invoked when confronted with the contested sign.

27. The defendant points out that in all the previous case-law to which the opponent refers, the contested sign contained visual elements of overlapping letters, somewhat similar to the trademark invoked. However, this is absolutely not the case in the contested sign, which is clearly only one letter, namely an 'X'. Therefore, there is no visual similarity.

28. Aurally, the defendant states that the trademark invoked will not be pronounced. According to the defendant, the contested sign will be pronounced as "X XOLARHEAT", or more likely "XOLARHEAT". Therefore, the signs are aurally dissimilar.

29. According to the defendant, the trademark invoked will be seen as a combination of two letters 'C' in a circle. The contested sign will be perceived as an invented word 'XOLARHEAT', with an added figurative element showing the first letter of the word element in a circle, bearing no semantic content as such. The defendant argues that the public could understand that the contested sign refers to the element 'heat', which will be seen by the relevant public as suggestive towards the purpose of the goods, that may contain some type of heating element. The signs are therefore either conceptually dissimilar (because both signs have different meanings) or not conceptually similar (if it is considered that only one of the signs evokes a concept).

30. Considering the dissimilarity of the signs there is no chance that the relevant public will establish a link between them and accordingly the use of the contested sign will not take any unfair advantage from the reputation of the trademark invoked or be detrimental to its distinctiveness in any way. This lack of a link is especially true in consideration of the nature of the goods concerned. While there is some similarity between the goods in class 25, the goods in classes 9 and 11 from the contested sign are very different and therefore it is unlikely that this sign brings the trademark invoked to the mind of the relevant public.

31. The defendant states that all the goods concerned are aimed at the public in general. Accordingly, the degree of attention of the relevant public in the Benelux will be normal.

32. The defendant argues that there can be no risk of confusion with regard to the goods in class 9 and 11, because these goods are not similar to the goods of the trademark invoked. Furthermore, with regard to the goods in class 25 that are similar, there is also no risk of confusion, because of the differences between the signs, which evoke totally different impressions whether it is from a visual, aural or conceptual point of view.

33. In the light of the above, 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

34. 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 a period of five years prior to the filing or priority date of the trademark against which the opposition is lodged.

35. The filing date of the contested trademark is 16 August 2019. Therefore, the opponent was required to show use of the invoked trademarks during the period from 16 August 2014 to 16 August 2019 ('the relevant period'). Given the fact that the trademarks invoked were registered more than five years prior to the filing date of the contested trademark, the defendant's request that proof of use is submitted is legitimate.

In general

36. 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.¹ 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.² 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.³

37. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.⁴ In interpreting the concept of genuine use, account should be taken of the

¹ 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).

² 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).

³ 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).

⁴ 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).

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.⁵

38. 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.⁶

39. 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

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

1. Articles and advertisements in magazines, dated between 2015 – 2018;
2. Screen-prints from Instagram;
3. Screen-prints from websites.

41. With the submission of the proof of use, the opponent explicitly stated that the evidence is only related to the goods in class 25 of the second trademark invoked (see paragraph 23).

42. The Office finds that the overview of news articles and advertisements that are published in several high fashion magazines during the relevant period show that the trademark invoked is used as a trademark for clothing. One of the articles refers to the success of a fashion show during fashion week in Paris. Such an event with worldwide exposure clearly shows that the use of the trademark invoked is not sporadically. In the light of the time, effort and costs that must be invested in order to get to the position in which a trademark is displayed in high fashion magazines and during famous fashion events, it is logical to conclude that there is genuine use of this sign.

43. The Office concludes that the evidence of use, taken together, sufficiently demonstrates that the trademark invoked has been put to genuine use in the Benelux for the goods in class 25 of the second trademark invoked on which the opposition is based (see paragraph 4).

A.2 Likelihood of confusion

44. 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.

45. 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*

⁵ 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).

⁶ General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.”⁷

46. 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.⁸

47. 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.⁹

Comparison of the signs

48. 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.¹⁰

49. 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.¹¹ 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.¹²

50. 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.

51. The signs to be compared are the following:

⁷ 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.

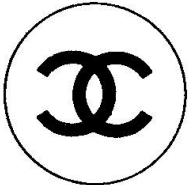

⁸ CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

⁹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 and the case-law mentioned there (Equivalenza).

¹⁰ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

¹¹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

¹² 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).

Opposition based on:	Opposition directed against:
	

Visual comparison

52. The trademark invoked is a combined word/figurative mark, depicting two letters 'C' that are interlocked creating a mirroring effect with an oval opening in the middle. The contested sign is also a combined word/figurative trademark consisting of the word 'xolarheat', depicted in grey stylized letters, and a red/pink (similar to magenta) figurative element to the left of this word. The figurative element is composed of two curved lines that depict the letter X, stylized the same way as the first letter in 'xolarheat', placed inside a circle.

53. 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.¹³ For this reason, and the fact that the figurative element emphasizes the first letter of the verbal element, the Office finds that the public will perceive the word 'xolarheat' as the dominant element in the contested sign. However, due to its position and size, the figurative element of the contested sign in this case would probably not go unnoticed to the average customer.¹⁴

54. The similarity lies within the fact that both signs contain a figurative element of one or two letters depicted in circle, and that they contain two curved shaped lines placed opposite each other.

55. However, the figurative elements in both signs are depicted in a different style. The trademark invoked consists of two 'C's' or circular shapes that are opened on their outer sides and which are interlocked in such a way that there is an oval opening in the middle. Such an opening in the middle is not present in the figurative element of the contested sign. According to the Office, this is a very notable difference. In addition, the outer sides of the figurative element in the contested sign are not bent towards each other, as is the case in the trademark invoked. Furthermore, the figurative element of the contested sign is in colour, while the trademark invoked is depicted in black. Both figures contain a circle, whereby the line of the circle of the contested sign is clearly much bolder.

56. In view of the foregoing, the Office considers that the signs are visually similar to a low degree.

Phonetic comparison

57. Parties agree that the trademark invoked will not be pronounced (see paragraphs 13 and 28). For this reason, a phonetic comparison is not relevant.¹⁵

¹³ General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 and the case-law mentioned there (Smarter Travel).

¹⁴ Appeal Court The Hague 11 September 2012, 200.105.827/0, ECLI:NL:GHSGR:2012:BX8916, point 9 (MOOVE-4MOVE).

¹⁵ General Court (EU) 12 December 2019, T-266/19, ECLI:EU:T:2019:854, points 38-39 and the case-law mentioned there (Gastivo).

Conceptual comparison

58. The opponent argues that the trademarks are conceptually similar since they reproduce the same concept, inserting two 'C's' in a circle (see paragraph 14). However, the Office finds that the relevant public will not associate the trademark invoked with any meaning. Furthermore, the public will not perceive the figurative element in the contested sign as two letters 'C', because it is more reminiscent of the letter 'X', which is strongly reinforced by the presence of the word 'xolarheat' of which the first letter 'X' is stylized in the exact same way.

59. In addition, although the word 'xolarheat' considered as a whole has no meaning, the relevant public is used to breaking down a verbal sign into word elements which suggest a specific meaning or which resemble words known to it, as confirmed by settled case-law.¹⁶ In this case, the public will recognize the word 'heat', which has an independent and clearly comprehensible meaning. Furthermore, the Office does not rule out the possibility that part of the public may think of 'solar' when confronted with the word 'xolarheat'. Therefore, the relevant public will perceive the contested sign as referring to heat and a part of the public may even perceive the contested sign as referring to 'solar heating', which means energy derived from the sun.

60. In the light of the above, the Office finds that trademark and sign are conceptually not similar.

Conclusion

61. The trademark invoked and the contested sign are visually similar to a low degree. Phonetically a comparison is not possible and conceptually the signs are not similar.

62. Since there is a low degree of visual similarity between the signs, an overall assessment of the likelihood of confusion in the light of the other relevant factors must be carried out.¹⁷

Comparison of the goods and services

63. 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

64. 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

65. The goods to be compared are the following:

¹⁶ General Court (EU) 13 February 2007, T-256/04, ECLI:EU:T:2007:46, point 57 (Respicur) and General Court (EU) 3 October 2019, T-500/18, ECLI:EU:T:2019:721, point 29 and the case-law mentioned there (GINMG).

¹⁷ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 60 and the case-law mentioned there (Equivalenza).

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 9 Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; devices for the storage of electricity; devices for charging electric accumulators; electric batteries; electrical conductors; electric cables; electronic control devices; devices for heat control; electrical wires; thermometers, not for medical purposes; thermostats.
	CI 11 Heating apparatus; electric heaters; heating systems for vehicles; heating elements; heating cushions [pads], electric, not for medical applications; blankets, electric, not for medical purposes; heat exchangers, not parts of machines; heating installations; electrically heated clothing; electronically heated gloves; electronically heated shoes; electronically heated soles; electronically heated stockings; electronically heated caps.
CI 25 All kinds of clothing, including boots, shoes and slippers.	CI 25 Clothing; footwear; headgear.

Class 9

66. The goods in class 9 are not similar to the goods in class 25. These goods are of different nature, are sold in different outlets, and serve different purposes compared to the opponent's clothing.

Class 11

67. With regard to the goods '*Heating apparatus; electric heaters; heating systems for vehicles; heating elements; heating cushions [pads], electric, not for medical applications; blankets, electric, not for medical purposes; heat exchangers, not parts of machines; heating installations*' the Office also finds that these goods are not similar to the goods in class 25, due to a different nature, purpose and means of fabrication and distribution.

68. The goods '*electrically heated clothing; electronically heated gloves; electronically heated shoes; electronically heated soles; electronically heated stockings; electronically heated caps*' also concern 'clothing' and 'footwear' for which the trademark invoked is registered. Although the goods of the defendant contain an additional 'heating' function, this is in line with the general purpose of clothing and footwear, which is to protect the human body against the elements. Furthermore, these goods can be produced by the same manufacturers and sold through the same channels. These goods are therefore identical.²⁰

²⁰ General Court (EU) 23 October 2002, T-104/01, ECLI:EU:T:2008:399, point 33 (Fifties) and General Court (EU) 24 November 2005, T-346/04, ECLI:EU:T:2005:420, points 36-39 (Arthur et Félicie).

Class 25

69. The defendant does not contest that the goods in class 25 are identical. The identity of these goods is therefore *in confesso*.

Conclusion

70. The goods of the defendant are partly identical and partly not similar to the goods of the opponent.

71. Since there is no similarity as regards to the goods in class 9 and part of the goods in class 11, the opposition in so far as directed against these goods and based on article 2.2ter, 1 BCIP cannot succeed. There can be no likelihood of confusion if there is no similarity between the goods. As regards the other goods, the Office will proceed below to an overall assessment of the likelihood of confusion.

Global assessment

72. 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.²¹ 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.

73. 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.²² According to the opponent, the trademark invoked enjoys a higher level of distinctiveness, due to its reputation, which he has substantiated with evidence and which was not disputed by the defendant (see paragraphs 21 and 25).

74. 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.²³

75. The signs are visually similar to a low degree, while a phonetic comparison is not possible and conceptually the signs are not similar. The relevant goods are partly identical and partly dissimilar.

76. The Office finds that in this case the signs show striking visual and conceptual differences including the fact that the figurative element of the contested sign will surely be perceived as the letter 'X' because of the identical graphical representation of the additional word element 'xolarheat' and therefore not simply as two interlocked arcs having a mirroring effect. This notable difference combined with other visual differences between the trademark and sign (see paragraph 55) is sufficient to conclude that the relevant public would not assume that the identical goods bearing the disputed sign originate from the same or from economically-linked undertakings. Even when taking into account the enhanced degree of distinctiveness of the trademark invoked, the Office finds that the overall differences between the trademark invoked and

²¹ CJEU 22 Juni 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

²² CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

²³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there. (Equivalenza)

the disputed sign are so clearly perceivable and sufficient as to exclude any likelihood of confusion between them.

Conclusion likelihood of confusion

77. Based on the foregoing, the Office concludes that there is no likelihood of confusion.

B. Reputation

78. The opponent has also stated that the trademark invoked has a reputation and that the opposition is also based on article 2.2ter paragraph 3 (a) BCIP.

Legal framework

79. Article 2.2ter paragraph 3 (a) BCIP is only applicable when the following conditions are met:

- i. the signs are either identical or similar;
- ii. the earlier trademark has a reputation;
- iii. the use of the contested sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;
- iv. there is no due cause for the use of the later trademark.

80. According to the Court, the types of injury mentioned in this article, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them.²⁴

81. The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition based on Article 2.2ter (3)(a) BCIP.

i) Similarity of the signs

82. The Office has already concluded that the signs concerned are only visually similar to a low degree (see paragraphs 52-56). They are conceptually dissimilar and a phonetic comparison is not possible.

ii) Reputation of the trademark invoked

83. The defendant does not dispute the (substantiated) claim of the opponent that the trademark invoked has a reputation for the goods in class 25 (see paragraph 25). For this reason, the reputation of the trademark invoked for these goods is *in confesso*.

iii) Unfair advantage of or detriment to the distinctive character or reputation

84. According to the opponent the trademark invoked will be brought to the mind of the public when confronted with the contested sign. The opponent also states that given the reputation of the trademark invoked and similarity between the signs, there is a serious risk that use of the contested sign would take

²⁴ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 66 (Intel).

unfair advantage of and is detrimental to the distinctive character or reputation of the trademark invoked (see paragraphs 17 and 18).

85. The holder of the earlier mark who invokes article 2.2ter(3)(a) BCIP is obliged to prove that the use of the contested sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trademark. To this end, the holder of the trademark is not required to demonstrate actual and present injury. However, the holder of the mark must prove that there are elements on the basis of which it may be concluded that there is a serious risk that such an injury will occur in the future²⁵ or, with other words, submit elements from which it can be prima facie concluded that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future.²⁶

The link between the signs

86. As indicated above (see paragraph 80), in order to establish the existence of a risk of injury, it is necessary to demonstrate that the relevant public will establish a link (or association) between the signs. In the absence of such a link in the mind of the public, the use of the contested sign is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.²⁷

87. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case.²⁸ Possible factors include:

- the degree of similarity between the conflicting signs;
- the nature of the goods or services for which the conflicting signs were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances.

88. In the present case, the Office finds that such a link does not exist, because the degree of similarity between the signs is very low (see paragraphs 52-56) and there is no likelihood of confusion (see paragraph 76). Furthermore, even if (a part of) the public for the relevant goods would recall the trademark invoked when confronted with the contested sign, because of the strength of the reputation of the earlier mark and/or the identity of certain goods, the Office finds that there is no unfair advantage of the distinctive character or reputation of the trademark invoked. Given the prominent use of the verbal element 'xolarheat' it would be clear to the public that the defendant does not seek to ride on the coat-tails of the trademark invoked. Opponent also did not substantiate any unfair advantage or any kind of exploitation of the fame of the trademark invoked.

89. Furthermore, the opponent has not sufficiently substantiated that there is a serious risk of detriment to the distinctive character or the reputation of the trademark invoked. The opponent's mere allegations that the contested sign would cause such detriment, because it would concern mass-market

²⁵ General Court (EU) 22 May 2012, T-570/10, ECLI:EU:T:2012:250, point 52 (Wolf).

²⁶ General Court (EU), 7 October 2015, T-534/13, ECLI:EU:T:2015:751, point 76 (Krispy Kreme DOUGHNUTS).

²⁷ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 31 (Intel).

²⁸ CJEU 23 October 2003, C-408/01, ECLI:EU:C:2003:582, point 30 (Adidas/Fitnessworld) and CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 42 (Intel).

products and these products could be of inferior quality (see paragraph 18), without submitting any evidence to substantiate this claim, does not suffice to reach such a conclusion.

Conclusion unfair advantage of or detriment to the distinctive character or reputation

90. For the abovementioned reasons, the Office concludes that the use of the contested sign does not take unfair advantage of or is detrimental to the distinctive character or repute of the trademark invoked. Consequently, one of the (necessary) conditions laid down in Article 2.2ter (3)(a) BCIP has not been fulfilled and the opposition must also be rejected on this ground.

C. Conclusion

91. Based on the foregoing the Office concludes that there is no likelihood of confusion.

92. Furthermore, it has not been established that the contested sign takes unfair advantage of or is detrimental to the distinctive character or repute of the trademark invoked.

IV. CONSEQUENCE

93. The opposition with number 2015591 is rejected.

94. The Benelux application with number 1400764 will be registered for all the goods for which it has been applied.

95. The opponent shall pay the defendant 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is not justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 29 September 2022



Eline Schiebroek
(*rapporteur*)

Tomas Westenbroek

Marjolein Bronneman

Administrative officer: François Veneri