



BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2015759
of 27 January 2022

Opponent: **LANIKAI S.r.l.**
Via Francesco Nullo 1
24128 Bergamo
Italy

Representative: **Algemeen Octrooi- en Merkenbureau B.V.**
Professor Dr. Dorgelolaan 30
5613 AM Eindhoven
Netherlands

Invoked trademark 1: **International registration 1186868**


Invoked trademark 2: **International registration 1156166**


against

Defendant: **EK/servicegroup eG**
Elpke 109
33605 Bielefeld
Germany

Representative: **BOETERS & LIECK**
Oberanger 32
80331 München
Germany

Contested trademark: **International application 1005761**
St. Barth


I. FACTS AND PROCEEDINGS

A. Facts


1. On 18 February 2009 the defendant filed an international trademark application, designating the Benelux as of 11 September 2019, for the word trademark St. Barth for goods in classes 18, 24 and 25. This application was processed under number 1005761 and the subsequent designation for Benelux was published on 7 November 2019 in the WIPO Gazette of International Marks 2019/43.

2. On 2 January 2020 the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:

- International registration (with designation of Benelux) 1186868 for the combined word/figurative

trademark  , filed on 9 August 2013 and registered on 27 March 2014 for goods in class 25;

- International registration (with designation of Benelux) 1156166 for the combined word/figurative

trademark  , filed on 4 February 2013 and registered on 12 December 2013 for goods in class 25.

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

4. The opposition is directed against the goods in class 25 of the contested application and is based on all the goods of the trademarks invoked.

5. The grounds for opposition are those laid down in Article 2.14, 2 (a) Benelux Convention on Intellectual Property (hereinafter referred to as: "BCIP").

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 9 January 2020. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant, the opponent submitted proof of use. All the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 18 November 2020.

II. ARGUMENTS OF THE PARTIES

8. The opponent filed an opposition at the Office under Article 2.14, 2 (a) BCIP, in accordance with the provisions of Article 2.2ter, 1 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant trademarks and of the goods or services concerned.

A. Opponent's arguments

9. The opponent notes that the trademarks have the word "Barth" in common. Furthermore, the contested trademark begins with the letters "St.", which is commonly used as an abbreviation of the word "saint" in English and French and will be automatically read and perceived as the word "saint". The opponent concludes that the contested trademark is visually highly similar to the first trademark invoked and similar at least to an average degree to the second trademark invoked.

10. Aurally, the contested trademark is identical to the first trademark invoked and similar above average degree in relation to the second trademark invoked.

11. Conceptually, the trademarks will be associated with Saint Bartholomew (or Barthelemy), one of the apostles of Jesus according to the New Testament. The trademarks could also be associated with the name of an island in the Caribbean, which might have been named after the apostle. The opponent concludes that the trademarks SAINT BARTH and St. Barth are conceptually identical.

12. The goods *clothing, footwear, sportswear and sports footwear* of the contested trademark are identical to the goods of both earlier trademarks containing *clothing* and *footwear*. As for the good *headgear*, it is identical to the goods in the second trademark invoked which also contains *headgear* and similar to *clothing* and *footwear* in the first trademark invoked. According to the opponent, these findings are supported by ETMDN's similarity tool.

13. In view of the above, the contested trademark would most likely cause confusion to the public, which would believe the goods come from the same undertaking and that is what law intends to prevent. Consequently, the opponent requests the total rejection in Benelux of the contested trademark for the goods in class 25. He further requests the defendant to be ordered to bear the costs of this opposition procedure.

14. Upon request of the defendant, the opponent has provided proof of use of the trademarks invoked.

B. Defendant's arguments

15. The defendant has requested proof of use of the trademarks invoked.

16. According to the defendant, the opponent has provided quite a number of documents, but very little explanation of these documents. The defendant points out that it is not the duty of the examiner or the applicant to derive or conclude any use supporting facts from the documents provided if any statement of these facts which shall be proved by the documents, is missing. He finds that it is the sole duty of the opponent to state those facts in the first place, which then are to be supported by documents or other evidence. In the defendant's view, it is this first step which is totally missing with the opponent's arguments.

17. In addition, the defendant provides the following remarks relating to the documents provided by the opponent:

- The invoices carry the image of the second trademark invoked, but it is not evident that the image has the function of a trademark for the goods listed in the invoice; it could equally well be a symbol standing for the company. Furthermore, none of the invoices mentions a trademark in connection with the invoiced goods;
- Some documents are undated;

- Some documents do not show or otherwise indicate any goods;
- Some accompanying indications are in the Italian language, unlikely to have been used in the Benelux;
- Some documents show no place of distribution and thus do not inform about any use in Benelux.

18. In conclusion, the defendant requests that the opposition be refused because of lack of use of the trademarks invoked.

III. DECISION

A. Proof of use

19. In application of the provisions of Articles 2.16bis (1) and 2.23bis (1) of the BCIP and Rule 1.25 of the IR, the trademark relied upon must have been in genuine use during a period of five years preceding the date of filing of the younger trademark.

20. The contested trademark was filed for Benelux on 11 September 2019. Thus, the period to be considered - the relevant period - is from 11 September 2014 to 11 September 2019.

21. In accordance with the decision of the Court of Justice of the European Union (hereinafter referred to as "CJUE") of 11 March 2003 (CJUE, *Ansul*, C-40/01, ECLI:EU:C:2003:145) there is genuine use of a trademark where the mark is used 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. This is done in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. 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 (see also General Court of the European Union (hereinafter referred to as "EGC"), *Silk Cocoon*, T-174/01, 12 March 2003, ECLI:EU:T:2003:68; *EGC, Vitafruit*, T-203/02, 8 July 2004, ECLI:EU:T:2004:225; *EGC, Charlott*, T-169/06, 8 November 2007, ECLI:EU:T:2007:337).

22. The EGC held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (*EGC, Hipoviton*, T-334/01, 8 July 2004, ECLI:EU:T:2004:223; *EGC, Sonia-Sonia Rykiel*, T-131/06, 30 April 2008, ECLI:EU:T:2008:135). The purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trademark protection to the cases where large-scale commercial use has been made of the mark (*EGC, Vitafruit*, already referred to above).

23. In addition the EGC held that genuine use of a trademark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark in the market concerned (see *EGC, Hiwatt*, T-39/01, 12 December 2002, ECLI:EU:T:2002:316; *EGC, Vitakraft*, T-356/02, 6 October 2004, ECLI:EU:T:2004:292 and *EGC, SoniaSonia Rykiel*, already referred to above).

24. Following Rule 1.25 IR the proof of use should contain evidence of the place, duration, extent, and manner of use of the earlier trademark for the goods for which it is registered and on which the opposition is based.

Analysis of the proof of use

25. The opponent requests to treat the submission of the documents confidentially. The opponent submitted the following exhibits to demonstrate genuine use of the trademarks invoked:

- 1) Invoices to clients in the Netherlands, Belgium and Luxemburg;
- 2) Label and packaging for bikini;
- 3) Front pages of catalogues 2014-2019;
- 4) List of agents in the Netherlands and Belgium;
- 5) Prints of webpages;
- 6) Ad published on Instagram;
- 7) Pages in catalogue;
- 8) Pages on Instagram;
- 9) Labels and tags.

26. The (48) invoices to clients in the Netherlands, Belgium, and Luxemburg (see point 1 above) list swimwear, shorts, shirts, headgear and beach shoes. They cover the years 2014-2018, which is most of the relevant period. On the top left is the second trademark invoked. According to the defendant, this does not show the use of this logo as a trademark, as it could just as well be the logo of the opponent's trade name. In this regard, however, it should be noted that a logo cannot function as a trade name.

27. However, all the invoices were addressed to resellers in Belgium, the Netherlands and Luxembourg, sometimes more than once to the same company. In view of the confidential nature of the invoices, the Office will not mention any monetary amounts, but it can be established in any case that the volumes involved are rather low, averaging 70 items. In any case, these invoices do not provide proof that the products under the trademarks invoked were actually delivered to end consumers (see in this sense EGC, VOGUE, T-382/08, 18 January 2011, ECLI:EU:T:2011:9). Consequently, the invoices contain no evidence of the place, duration, extent and manner of use of the trademarks invoked towards the end consumers for the goods for which they are registered and on which the opposition is based.

28. The label and packaging for bikini (2 above) and the other labels and tags (9) contain the trademarks invoked but give no information concerning the place, duration, extent and manner of their use.

29. The front pages of catalogues (3), the prints of webpages (5), the advertisement on Instagram (6), the pages in the catalogues (7) and the pages on Instagram (8) contain pictures of various items of clothing, whether or not labelled with the trademarks invoked. Furthermore, they contain descriptions such as *camicie di lino*, *scarpe in canvas bluette*, *Bermuda di lino color denim* or English terms but, even if it is clear what products are concerned, none of these documents give any insight into the place, duration, extent and manner of use of the trademarks invoked.

30. The list of agents in the Netherlands and Belgium (4) contains five names of companies but does not provide any information regarding the place, duration, extent and manner of use of the trademarks invoked.

Conclusion

31. The evidence of use, considered as a whole and in relation to each other, does not sufficiently demonstrate that, during the relevant period, the trademarks invoked were actually used in Benelux for the goods on which the opposition is based. It is therefore not appropriate to assess the likelihood of confusion.

B. Conclusion

32. Since proof of genuine use of the trademark invoked has not been provided, the opposition should be rejected without assessing the likelihood of confusion.

IV. CONSEQUENCE

33. The opposition with number 2015759 is not justified.

34. The international application with number 1005761 will be registered in Benelux for all the goods applied for.

35. 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, 27 January 2022



Willy Neys
rapporteur

Camille Janssen

Pieter Veeze

Administrative officer:

Gerda Veltman