



Benelux Office for  
**Intellectual  
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2016040**  
**of 14 January 2022**

**Opponent:** **FONTAINE LIMITED**  
20 Farringdon Street  
EC4A 4AB LONDON  
United Kingdom

**Representative:** **Visean Brands Consult t.h.o.d.n. Weizmann Ariana**  
Bargelaan 200  
2333 CW Leiden  
Netherlands

**Invoked right:** **European Union trademark registration 18280720**

*against*

**Defendant:** **The Gillette Company LLC Delaware limited liability company**  
One Gillette Park  
02127 Boston Massachusetts  
United States of America

**Representative:** **Bakker & Verkuijl B.V.**  
Alexander Office Prinsenkade 9 D  
4811 VB Breda  
Netherlands

**Contested trademark:** **Benelux trademark application 1413044**


FREED

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 9 March 2020 the defendant filed a Benelux trademark application for the word mark "FREED" for goods in classes 3 and 8. This application was processed under number 1413044 and was published on 12 March 2020.

2. On 11 May 2020 the opponent filed an opposition against the registration of the application. The opposition is based on the European Union trademark registration 9077355 of the combined figurative/word

mark , filed on 20 April 2010 and registered on 22 August 2012 for goods in classes 3 and 25. Following a partial transfer of rights, the trademark invoked is divided and now concerns registration number 18280720, solely covering goods in class 3 and the opponent was substituted with the new right holder of said trademark registration.

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 covered by the contested application in class 3 and is based on all of the goods covered by 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").

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 13 May 2020. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant, the opponent filed documents to prove use of his trademark. 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 19 January 2021.

## **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 starts his arguments with a brief introduction of his company. He notes in that regard that the company was founded in 1760 and enjoys a long standing and global reputation as a high end perfume house, being worn by numerous popular personalities in different countries over the years. Furthermore the opponent also owns other trademarks formed around the denomination "CREED".

10. Visually comparing the trademarks in question, the opponent notes that both trademarks consist of short, 5 letter words, both differing only in their initial letter while the other 4, giving the sequence "REED", are identically present in both trademarks. While the opponent notes that the consumers generally pay more attention to the beginning of a trademark, the fact that the trademarks coincide in 4 out of their 5 letters still results in the trademarks being visually highly similar. Furthermore, the opponent notes that the consumers usually pay more attention to the verbal elements of a composed sign than to the figurative elements. Also, the contested application being a wordmark, it could be depicted in any visual representation, including the one used by the opponent. The consumer perceives a trademark as a whole and therefore the opponent notes that the relevant public will retain the coincidence of most of the letters, leading to the conclusion that the trademarks are visually similar to a high degree.

11. Comparing the trademarks phonetically the opponent argues that both signs share the same length of 5 letters, four of which are identical and placed in the same order. Furthermore both trademarks have their accent on the middle part of their word element, making the difference in the initial letter less phonetically obvious. As a result the opponent considers the trademarks aurally similar to a high degree.

12. Conceptually the opponent argues in the first place that, while the contested sign is the past tense of the verb "to free", the fact that the use of the word "FREED" in isolation is uncommon will make it so that the consumer in the Benelux will perceive it as an abstract word. As to the word "CREED", the opponent contends that, while the word does have a meaning in English, it is not a word used on an everyday basis, nor is it part of a basic English vocabulary. Thus the opponent holds that it will also be perceived as an abstract word with no meaning. In addition, the fact that the trademark is the family name of the opponent's undertaking which is consistent with the use made of the trademark, the trademark will be perceived as merely referring to a name and devoid of meaning. Thus, according to the opponent, since both trademarks will be considered devoid of meaning, a conceptual comparison is not possible.

13. Addressing the comparison of the goods covered by both trademarks, the opponent notes that they are identical in that they either fall within the broader subcategory of "cosmetics" covered by the invoked trademark or are identical in nature, purpose and distribution channels to the "perfumery" and "soap" products covered by the invoked trademark.

14. Furthermore, the opponent refers to the history of his undertaking and his reputation to claim that the invoked trademark enjoys a high degree of distinctiveness, further increasing the risk that the consumer might identify the products offered under the contested trademark as originating from the same company.

15. As a result, the opponent considers the high degree of similarity between the trademarks and the fact that they cover identical goods makes it so that there exists a likelihood of confusion for the consumer. Thus, he asks the Office not to register the contested trademark and to order that the costs be borne by the defendant.

16. Following the request by the defendant, the opponent submitted proof of use. In addition the opponent asks the Office to consider in this regard also the elements of proof submitted alongside his prior arguments.

## **B. Defendant's arguments**

17. In the first place the defendant asks the opponent to provide proof of use for his trademark.

18. In response to the proof of use the defendant notes that some of the invoices list products that are out of stock and thus not available for sale. Furthermore, he considers the use of the invoked trademark of

minimal scale at best and limited to perfumery products. As regards advertising the defendant notes that the materials provided in that regard are limited to the presentation of the products on his own and retailer's webpages.

19. In response to the opponent's arguments referring to a family of trademarks to which the invoked trademark belongs, the defendant notes that the opposition procedure is limited to consider only the trademarks in question.

20. Comparing the trademarks, the defendant notes that the trademark invoked can not be considered as merely the word "CREED". Indeed, the graphical representation of the trademark, namely the first and last letter taking the visual shape of two swords crossing, presents a dominant element of the trademark invoked and makes the first and last letter of said sign barely legible.

21. Concerning the aural comparison of the trademarks, the defendant notes that the consumer generally attaches more importance to the beginning of a trademark which differs in this case. Thus the defendant finds the trademarks aurally similar to a low degree at most. Furthermore, the defendant argues that, concerning luxury perfumes, aural comparison of trademarks has become less relevant as these products are usually purchased on sight and increasingly via e-commerce.

22. Visually the defendant notes that both trademarks are short, making the differences between them more obvious to the consumer. In addition, referring to the figurative element of the invoked trademark in the crossed swords as the dominant element of that trademark, the defendant finds that the trademarks differ in their overall visual presentation and are, as a whole, dissimilar.

23. In the conceptual comparison of the trademark, the defendant points out that the English word "creed" refers to "a system of religious belief" and would be understood as such by most of the consumers in the Benelux. Furthermore, according to the defendant the proximity of the word "creed" to the French word "credo" will mean that the consumers, not familiar with the English term would at least associate it with the French term. As to the contested trademark, the defendant notes that it is the past tense of the verb "to free" and as such has a completely different meaning, making it conceptually dissimilar to the invoked trademark.

24. Comparing the goods covered by the trademarks concerned, the defendant notes that "Shaving preparations, namely shaving creams, shaving gels, shaving lotions and shaving foams", "skin care preparations, namely skin moisturizers; non-medicated skin care preparations" and "antiperspirants and deodorants; body wash" are dissimilar from the opponent's perfumery products in that they have a different purpose. The "after shave splashes, lotions and balms; body sprays" and "Cologne", the defendant concedes, are similar to a low degree and similar respectively to the perfumery products of the opponent.

25. The defendant notes that, as the opponent mentioned, the goods, namely perfumes and eau de toilettes, of the opponent are high-end and expensive products for which the average level of attention of the consumer will be high. In that regard, the defendant points out that there is a substantial difference in comparison to the goods covered by the contested trademark which are sold at lower price ranges.

26. In that regard and considering the arguments above, the defendant finds that in light of the high level of attention of the relevant public there exists no risk of confusion for consumers due to the differences between the trademarks. Thus, he asks the Office to register the contested trademark.

### **III. DECISION**

#### **A.1 Proof of use**

27. 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 preceding the filing or priority date of the trademark against which the opposition is lodged.

28. The contested trademark was filed on 9 March 2020. Therefore, the opponent was required to show use of the invoked trademark during the period from 9 March 2015 to 9 March 2020 ('the relevant period'). Given the fact that the trademark invoked was 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*

29. In accordance with the decision of the European Court of Justice (hereinafter referred to as "ECJ") of 11 March 2003 (ECJ, 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).

30. 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).

31. In addition the EGC held that 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 (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, Sonia-Sonia Rykiel*, already referred to above).

32. The trademark invoked is a trademark of the European union, hence the obligation to use the trademark is administered by article 18 of Regulation (EU) No 2017/1001 of the European Parliament and of the Council of 14 June 2017. This article, entitled "Use of an EU mark", stipulates: "*If, within a period of five years following registration, the proprietor has not put the EU trade mark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the EU trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.*"

33. In its decision of 19 December 2012 (case C-149/11, *Onel*, ECLI:EU:C:2012:816), the ECJ explained this provision<sup>1</sup>. The ECJ considers regarding the concept "in the Community" that there is a

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<sup>1</sup> Referring to the equivalent provision, article 15 in the previous Regulation No 2015/2424 of the European Parliament and of the Council.

difference between the territorial extent of the protection conferred on national trademarks and the extent of the protection conferred on EU trademarks. From a territorial point of view, an EU trademark enjoys a more extensive scope of protection than a national trademark. As a consequence it may reasonably be expected that an EU trademark be used in a larger area, except for the (exceptional) case where the market for the goods and services at issue has been territorially restricted. Abstraction should be made here of the boundaries of the territory of the Member States. The ECJ concludes: *"A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the 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."*

34. The threshold for genuine use of an EU trademark is therefore in principle higher than that for genuine use of a national (or Benelux) trademark. It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU and taking into account all relevant facts and circumstances.

#### *Analysis of the proof of use*

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

1. Screenshots of the opponent's webpage dated 22 May 2020 giving background and historical information about CREED as well as store locations.
2. Screenshots of online retailers, namely Bijenkorf, bol.com, skins.nl, creed.nl, notino.nl dated 22 May 2020 showing perfume products, bath gels, soaps, after shaves and body lotions offered for sale under the invoked trademark.
3. Screenshots dated 26 May 2020 of information available via the website whois.com about the ownership and registration of the domain names creedboutique.com and creedfragrances.com.
4. Screenshot dated 26 May 2020 of the Terms and Conditions issued by Creed Boutique LLC and affiliated companies on the access and use of the Website and Media channels.
5. Invoices from the relevant period issued by Creation Distribution Exclusive SARL and SPRL Royal Exclusive Distribution to retailers in France and Belgium for goods, namely perfumery products, soap, after shave, shower gel and deodorants.
6. Screenshots made via the tool "WAYBACK MACHINE" showing the sales offering of creed products on the website creedboutique.com during the relevant period, namely perfumes, soaps, after shaves and deodorants with the invoked trademark visible on these products.
7. Copies of a brochure showing perfume product lines carrying the invoked trademark dating from the relevant period.
8. Screenshots from the relevant period made via the tool "Wayback Machine" showing the webpages of the opponent and depicting the invoked trademarks on products, namely perfumes, deodorants, soaps, shower gels, grooming goods and perfume oils.
9. Extracts from magazines published during the relevant period depicting and mentioning the invoked trademark in relation to perfumery products.
10. Extracts from online articles published during the relevant period depicting and mentioning the invoked trademark in relation to perfumery products.
11. Screenshots dating from the relevant period showing perfume products with the trademark creed and a link to different retail platforms such as amazon or Ebay.

12. Two versions of a training guide comprising information on the opponent's company and information on perfume products offered, once in English, once in French.
13. A copy of an article published during the relevant period on the website Vogue.de in German naming the invoked trademark for cologne.
14. Screenshots from the relevant period made via the tool "Wayback Machine" showing products offered for sale on retailers webpages with the top level domain ".de". The websites are in German and show perfumery products, shower gel, after shave balm, soaps and body lotions offered for sale with the invoked trademark.
15. Invoices showing the sale of perfumery products, shower gel, soap, after shave, body lotion, perfumed oil and shaving soap to a company named NOBILIS GROUP GmbH in Germany.
16. Screenshots from the relevant period made via the tool "Wayback Machine" showing products offered for sale on retailers webpages namely "oger.nl" and "skins.nl". The websites are in Dutch and show perfumery products, shower gel, after shave, soaps, shaving soaps, bath gel and body lotion offered for sale with the invoked trademark.
17. Screenshots of third party videos published during the relevant period on the webpage youtube.com showing the invoked trademark in relation perfumery products.
18. Screenshots of posts from the relevant period on the webpages Facebook.com, Instagram.com and Twitter.com showing offers for sale and marketing material with the invoked trademark in relation to perfumery products, soaps, body lotion, shaving soap and bath products.
19. Screenshot from the webpage "tripadvisor.com" showing the location of a store with the invoked trademark in Paris.

36. As regards the geographical scope of use, an EU trademark is put to genuine use when it is used in accordance with its essential function and with a view to maintaining or creating market share in the EU for the goods concerned. The invoices provided (exhibits 5 and 15) in conjunction with the screenshots on retailer's webpages displaying the products sold under the invoked trademark (exhibits 2, 6, 14 and 16), show that the opponent is active with the invoked trademark in several Member States, namely the Netherlands, France, Belgium and Germany. All in all, the documents provided cover the entirety of the relevant period.

37. The invoices provided show a considerable amount of products sold. While the largest part is made out of perfumery products, products such as soap, shower gel, also show up on numerous of the invoices. The amounts of individual invoices range from 1'000 EURO up to more than 10'000 EUROS which, considering the amount of invoices submitted, tolls up to show a substantial amount of commercial activity as regards these products, despite the fact that on some invoices, some of the products are marked with an indication of stock shortage and thus were not actually traded (paragraph 18).

38. The marketing material submitted (exhibits 1, 7, 9, 10, 12, 13, 17, 18 and 19) confirm the scope of the activity and international outreach outlined by the invoices, showing numerous marketing materials covering especially perfumery products but also soaps, body lotion, shaving soap and bath products. The Office considers that these materials show that the trademark is used outwardly and publicly in relation to these products in several Member States of the European union.

39. It should be noted that the evidence submitted relates mostly to perfumery products and soaps. While perfume oils appear in some of the material provided, the evidence submitted with regards to these products is insufficient to establish with certainty any meaningful use of the invoked trademark with regards to the "essential oils, cosmetics, hair lotions" which the invoked trademark covers. Therefore, genuine use of the mark cannot be established for these goods.

40. Thus, after careful analysis of all of the proof of use provided, the Office concludes that the evidence submitted, shows genuine use for the following goods mentioned in class 3 of the invoked trademark namely "soap, perfumery". For this reason, the Office will continue with the assessment of the likelihood of confusion considering solely these goods for which the opponent has proven genuine use of his invoked trademark.

## **A.2 Likelihood of confusion**

41. 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.

42. 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.*"

43. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

### **Comparison of the trademarks**

44. 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).

45. 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).


46. 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).

47. In general, two trademarks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (EU TUE, MATRATZEN, T-6/01, 23 October 2002, ECLI:EU:T:2002:261), namely the visual, aural and conceptual aspects are relevant.

48. The trademarks to be compared are the following:

Opposition based on:	Opposition directed against:
	FREED

#### *Visual comparison*

49. The invoked trademark consists of the stylized word element "CREED" composed of 5 letters with a figurative element emanating from the letters "C" and "D" and resembling two blades crossing below the verbal element. The contested trademark consists of the word element "FREED" composed of 5 letters.

50. 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). The figurative elements of the invoked 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 perceive the verbal element as the dominant element of the invoked trademark.

51. The Office notes that the signs in question are short, making the differences between them more apparent to the consumer. Furthermore, 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). Nonetheless, the Office observes that both signs are composed of the same number of letters, namely 5, 4 of which are identically present in the same sequence for both of the trademarks concerned resulting in the overall visual impression of the trademarks being similar to some degree.

52. The trademarks are visually similar to a certain degree.

#### *Aural comparison*

53. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level (EGC, PC WORKS, T-352/02, 25 May 2005, ECLI:EU:T:2005:176 and Thai Silk, T-361/08, 21 April 2010, ECLI:EU:T:2010:152).

54. The invoked trademarks consist of a single word element, composed of 1 syllable. Indeed the syllable of which both trademarks are composed is highly similar in that it coincides not only in its vowel but also in 2 out of 3 of the consonants present in the trademarks. Indeed, both trademarks merely differ in their first consonant, but are identical in all other aspects including their rhythm and cadence. As a result the overall phonetic impression of the trademarks is highly similar.

55. Thus, the Office considers the trademarks to be aurally highly similar.

#### *Conceptual comparison*

56. The invoked trademark's verbal element "CREED" stems from the English language and refers to "a statement of the basic beliefs of a religion" or "an idea or set of beliefs that guides the actions of a person or group".<sup>2</sup> While the invoked trademark does bear some resemblance to the french word "credo", it is not a word that sees frequent use in everyday language. Furthermore, considering that English is not an official language in the Benelux, it can not be expected that the relevant public would immediately grasp the concept and meaning evoked by this sign.

57. The contested trademark "FREED" refers to the past tense of the verb "to free" meaning "to cause to be free", "to relieve or rid of what restrains, confines, restricts or embarrasses" or "disentangle, clear"<sup>3</sup>. Considering his knowledge of English as previously established (paragraph 56), the Benelux consumer would not generally perceive the word "FREED" taken in isolation and without context as the past tense of an English verb but rather as a fantasy word devoid of meaning.

58. The figurative elements of the invoked trademark representing two blades crossing, would probably be perceived as a vague ornamental element, which, in light of its positioning, serves to underline the verbal element.

59. As a result, both trademarks do not have a conceptual meaning for the Benelux consumer, making a conceptual comparison of the trademarks irrelevant.

#### *Conclusion*

60. The trademarks in question are visually similar to some degree, phonetically highly similar and a conceptual comparison is irrelevant.

#### **Comparison of the goods**

61. 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).

62. 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 in as far as genuine proof of use was provided.

63. The goods to be compared are the following:

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<sup>2</sup> Marriam Webster online dictionary: <https://www.merriam-webster.com/dictionary/creed>

<sup>3</sup> Marriam Webster online dictionary: <https://www.merriam-webster.com/dictionary/freed>

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
CI 3: Soaps; perfumery	CI 3 Shaving preparations, namely shaving creams, shaving gels, shaving lotions and shaving foams; after shave splashes, lotions and balms; pre-shave facial washes and scrubs; skin care preparations, namely skin moisturizers; non-medicated skin care preparations; body sprays; cologne; antiperspirants and deodorants; body wash.

64. The goods "*body wash*" of the contested trademark fall within the broader category of "*soaps*" covered by the invoked trademark and are identical to the latter.

65. The goods "*body sprays; cologne*" are identical to the "*perfumery*" goods as they have the same nature, method of use and purpose, use the same distribution channels and can be produced by the same undertakings.

66. The goods "*Shaving preparations, namely shaving creams, shaving gels, shaving lotions and shaving foams; pre-shave facial washes and scrubs;*" are highly similar to the "*soaps*" covered by the invoked trademark as the latter includes goods which can be used as substitutes and have the same purpose. Furthermore, these goods are sold via the same distribution channels and consumers could expect them to be produced by the same undertakings.

67. The goods "*after shave splashes, lotions and balms; skin care preparations, namely skin moisturizers; non-medicated skin care preparations; antiperspirants and deodorants*" covered by the contested trademark are similar to the "*Soaps*" of the invoked trademark in that they coincide in their relevant public, distribution channels and producers. Furthermore, these goods coincide to some extent in their purpose in that they seek to improve the appearance of the consumer's body and his smell or skin texture.

#### *Conclusion*

68. The goods covered by the contested trademark are respectively identical, highly similar or similar to the goods covered by the trademark invoked.

### **A.3 Global assessment**

69. 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.

70. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question. In the present case, the goods concerned are directed at the public at large. As pointed out in the arguments of the defendant (paragraph 25), with regards to some of these goods, in particular as they relate to perfumes, these may be exclusive and very expensive goods or cheaper goods for everyday use, in that regard the lowest level

of attention must be taken into account. The level of attention of the eligible public can therefore be considered normal.

71. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken into account, particularly between the level of similarity of the trademarks and of the goods they cover. A lesser degree of similarity between the relevant goods can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

72. 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 earlier mark has normal inherent distinctiveness as it does not describe any of these goods. Furthermore, the elements submitted by the opponent concerning an acquired higher level of distinctiveness (paragraph 14) do not need to be examined in the present case considering that such a finding would not alter the outcome of the decision. Thus, the Office considers that the earlier trademark has a normal distinctiveness, as it is not descriptive of the goods concerned.

73. 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.

74. Based on the abovementioned circumstances, the Office finds that due to both trademarks being visually similar to some degree, phonetically highly similar and a conceptual comparison being irrelevant, the relevant public might believe that the goods which are at least similar would come from the same undertaking or from economically-linked undertakings.

#### **B. Other factors**

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

#### **C. Conclusion**

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

#### **IV. DECISION**

77. The opposition with number 2016040 is justified.

78. The Benelux application with number 1413044 will not be registered in the Benelux.

79. 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 not justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.



The Hague, 14 January 2022

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*Eline Schiebroek*

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