



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2016362
of 10 March 2022

Opponent: Lifestyle Equities C.V.

Gondel 1
1186 MJ Amstelveen
Netherlands

Representative: HGF B.V.

Gedempt Hamerkanaal 147
1021 KP Amsterdam
Netherlands

Invoked right: European trademark registration 15737653



against

Defendant: Modevertrieb Sarnacchiaro GmbH

Luxemburger Str. 118
50354 Hürth
Germany

Representative: ARGYMARK

Boulevard de Sebastopol 52
75003 Paris
France

Contested trademark: International application 1542802



I. FACTS AND PROCEEDINGS

A. Facts

1. On 25 November 2019 the defendant filed an international application for a trademark, also



designating the Benelux, for the combined word/figurative mark for goods in classes 18, 24 and 25. This application was processed under the number 1542802 and was published in the Gazette 2020/29 on 30 July 2020.

2. On 11 September 2020 the opponent filed an opposition against the registration of the application. The opposition is based on the European registration 15737653 of the combined word/figurative mark



, filed on 10 August 2016 and registered on 9 January 2017 for goods in classes 3, 9, 14, 18, 21, 24 and 25.

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 and was initially based on all of the goods covered by the invoked trademark. Within his arguments the opponent limited his arguments to the goods covered by the invoked trademarks in classes 18, 24, and 25.

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 16 September 2020. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 20 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 by visually comparing the trademarks in question. The opponent notes that both trademarks contain polo players as their figurative elements in somewhat similar positions. Furthermore, the opponent observes that both trademarks also contain the word element "POLO CLUB" placed in the same relative position. According to the opponent, both trademarks also coincide in their circular shape. Finally, as regards the differences between the word elements of the trademarks, namely "BEVERLY HILLS" and "HARVEY MILLER", the opponent finds that these share a certain amount of letters in common and that, furthermore, the differences resulting from these elements are insufficient to significantly reduce the visual similarities between the trademarks.

10. Phonetically, since both trademarks contain the word element "POLO CLUB" they are, according to the opponent, aurally similar.

11. Conceptually, the opponent finds that both trademarks refer to the sport of polo, while the elements "BEVERLY HILLS" and "HARVEY MILLER" will merely be perceived as a location or a club name respectively. As a result, the opponent considers both trademarks conceptually nearly identical.

12. Comparing the goods covered by both trademarks, the opponent limits his comparison to the goods covered in classes 18, 24 and 25 of the invoked trademark. The opponent argues that part of the goods are identically covered by both trademarks. Furthermore, some goods may either be included in, or a broader category of, the goods covered by the invoked trademark and some goods are highly similar to the goods covered by the invoked trademark.

13. Referring to caselaw, the opponent argues that for products sold in self-service stores such as is the case for the goods concerned, the visual similarity will be more important than the aural similarity.

14. Regarding the opposition at hand and noting, the high level of similarity between the goods and the similarities between the trademarks, the opponent considers that there exists a likelihood of confusion. Thus, he asks the Office to grant the opposition, reject the trademark application and order that the costs be borne by the defendant.

B. Defendant's arguments

15. In the first place the defendant notes, as regards the comparison of the trademarks, that, while no element of the trademarks is to be considered more dominant, he argues that the representation of polo players and the verbal element "POLO CLUB" is of lower distinctiveness for the goods covered in class 25 as these goods could be used for playing the sport of polo and can thus not be monopolized by a single undertaking.

16. Visually the defendant argues that the figurative elements differ as well as the placement of the verbal elements "HARVEY MILLER" and "BEVERLY HILLS" respectively, rendering the overall impression of the signs different.

17. Aurally the defendant considers that due to the weak distinctiveness of the verbal element "POLO CLUB", previously established, it will not hold the consumer's attention whereas in particular the first and last syllable of the remaining verbal elements "BEVERLY HILLS" and "HAREY MILLER" differ completely.

18. For the conceptual comparison, the defendant finds that the reference to the sport of polo is, due to its widespread use for goods in class 25, a weak concept. In addition, the defendant argues that the depiction of a polo player on a horse is a common reference to the sport of polo much like the representation of a football player would symbolize the sport of football, drawing the attention of the consumer to the

other elements of the trademark which identify the name of the club or brand, in this case "HARVEY MILLER" and "BEVERLY HILLS" as a result. In the present case, these latter elements differ, according to the defendant as they refer to a place and a person respectively, rendering the trademarks conceptually different.

19. Addressing the comparison of the goods, the defendant disagrees with the opponent's assertion that the goods "boxes of leather or leatherboard" would be identical or similar to "business card cases" or "leather key chains". Furthermore, the defendant notes that the opponent did not justify his finding of identity or similarity for the goods "leather and imitations of leather" covered by the invoked trademark.

20. The defendant further notes that one of the decisions referred to by the opponent, while it concerns the parties in the case at hand, is not relevant in this case as the trademarks were not similar to the ones in question.

21. In that regard and considering the arguments above, the defendant finds due to the low distinctiveness of the representation of a polo player and the word elements "POLO CLUB", at least for class 25, and considering the differences between the signs, there exists no risk of confusion for consumers confronted with these trademarks. Thus, he asks the Office to reject the opposition, register the contested trademark and to order that the costs be borne by the opponent.

III. DECISION

A.1 Likelihood of confusion

22. 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.

23. 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.*"

24. 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 goods

25. 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).

26. 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.

27. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 18: Luggage; hand bags; sport bags; beach bags; carry-on bags; clutch bags; trunks and travelling bags; school bags; shoulder bags; shopping bags; tote bags; rucksacks; backpacks; duffel bags; cosmetic bags, briefcases; suitcases; holdalls; purses; wallets; leather key chains; business card cases; umbrellas; parasols; walking sticks.	CI 18: Leather and imitations of leather; handbags; travel rucksacks; school bags; beach bags; travelling trunks; suitcases; valises; haversacks; business cases; briefcases; attaché cases; boxes of leather or leatherboard; key cases (leatherware); shoulder bags of leather; parasols; pocket wallets; backpacks; school satchels, purses and pouches.
CI 24: Towels; bath towels; hand towels; kitchen towels; Beach towels; bath linen; bed blankets; bed clothes; bed covers; bedspreads; duvet covers; bed linen; pillowcases; pillow covers; face towels of textile; handkerchiefs of textile; household linen; linen cloth; place mats, not of paper; sheets [textile]; tablecloths, not of paper; table linen, not of paper; tablemats, not of paper; table napkins of textile; textile material; towels of textile; curtains.	CI 24: Fabrics; bed covers; table covers; blankets; bath linen; household linen; curtains; bed linen; travelling rugs (lap robes); textile piece goods for making into the aforesaid goods; bed sheets; bedspreads; covers for cushions; pillow shams; placemats (textile articles); quilts; serviettes (textile articles); tablecloths; table linen; table runners; towels.
CI 25: Clothing; suits; tuxedos; blazers; vests; blouses; overalls; pullovers; sweaters; sweater vests; sweatpants; sweatshirts; T-shirts; shirts; polo-shirts; shirts and casual tops with long and short sleeves; halter tops; sleeveless shirts; sport shirts; tops for exercise; jeans; pants; trousers; shorts; skirts; coats; jackets (clothing); outerclothing; ponchos; raincoats; sport coats; bathing suits; swimsuits; bikinis; bikini tops; Bermuda shorts; beach clothes; bath robes; body linen (garments); underwear; undergarments; undershirts; bodysuits; boxer shorts; bras; bustiers; hosiery; stockings; lingerie; leggings; night clothes; nightgowns; nightshirts; pajamas; panties; dresses; dressing gowns; belts (clothing); socks; footwear; athletic shoes; beach shoes; booties; espadrilles; flip-flops; gym boots; heels; pumps; sandals; shoes; slippers; sporting and	CI 25: Clothing (including woven and knitwear), in particular casual sportswear and sports clothing; clothes of denim; shirts, in particular men's shirts, sports shirts, casual shirts, polo shirts, suit shirts, string vests, dress shirts; sweatshirts; overshirts; sweaters; jacket shirts; T-shirts; women's shirts; blouses; pullovers; suits; jackets (clothing); reversible jackets; shirt jackets; blousons; shirt blousons; anoraks; vests; coats; dresses; skirts; skirts for women; headscarves; scarves; shawls; trousers; shorts (clothing); sports trousers; jeans; denim trousers; denim dungarees; denim skirts; denim dresses; denim shirts; denim blouses; denim jackets; pocket squares; underwear; sports underwear; nightwear; dressing gowns; socks; stockings; neckties; gloves; headgear; sports jerseys; leotards; gym suits; tracksuits; tracksuit trousers; jogging suits; jogging trousers; jogging jackets; jogging pullovers; jogging blousons; tennis clothes;

gymnastic shoes; headwear; bandannas; baseball caps; caps; hats; headbands.	beachwear and swimwear; bathing trunks; bathing suits; bikinis; swimming shorts; beach shorts; Bermuda shorts; bath robes; beach dresses; beach wraps; clothing for surfing, water skiing and sailing; knitwear, namely pullovers, sweater vests, jackets (clothing), blousons, shirt blousons, vests, tank tops, sweaters, coats, dresses, blazers, skirts, trousers, shirts, blouses, caps (headwear), head scarves, shawls, neck scarves [mufflers], stockings, socks, neckties, gloves and bed jackets; belts for wear; footwear; slippers and sports shoes; headbands (clothing); all of the aforesaid goods being for women, men and/or children; neck scarves [mufflers].
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Class 18

28. The defendant does not dispute that the goods "*handbags; travel rucksacks; school bags; beach bags; travelling trunks; suitcases; valises; haversacks; business cases; briefcases; attaché cases; key cases (leatherware); shoulder bags of leather; parasols; pocket wallets; backpacks; school satchels, purses and pouches*" covered by the contested mark are in part identical, in part highly similar to those covered by the invoked trademark.

29. As regards "*boxes of leather or leatherboard*" these can include receptacles used while moving, traveling or on a trip. As such they may serve the same nature, purpose and make use of the same distribution channels as the goods "*Luggage; hand bags; sport bags; beach bags; carry-on bags; clutch bags; trunks and travelling bags; school bags; shoulder bags; shopping bags; tote bags; rucksacks; backpacks; duffel bags; cosmetic bags, briefcases; suitcases; holdalls; purses; business card cases;*" covered by the invoked trademark and are thus similar to these.

30. The goods "*Leather and imitations of leather*" relate to the raw material and as such differ from the finished products covered by the invoked trademark in their nature, purpose and distribution channels. These goods are thus to be considered dissimilar.

Class 24 and 25

31. The defendant does not dispute that the goods covered by the contested mark in these classes are in part identical and in part highly similar to those covered by the invoked trademark in the same classes.

Conclusion

32. The goods "*Leather and imitations of leather*" covered by the invoked trademark are dissimilar to the goods covered by the invoked trademark.

33. The remaining goods covered by the contested trademark in classes 18, 24 and 25 are identical, highly similar or similar to the goods covered by the invoked trademark.



Comparison of the signs

34. The wording of Article 5, 1 (b) of the Directive (cf. article 2.2ter, 1 (b) BCIP) according to which "there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark" shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, Sabel, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

35. Global assessment of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (CJEU, Sabel and Lloyd, already cited).

36. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, Limonchello, C-334/05 P, 12 June 2007, ECLI:EU:C:2007:333). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, Matratzen, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and El Charcutero Artesano, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

37. The trademarks to be compared are the following:

Opposition based on:	Opposition directed against:
 <p>The logo for Beverly Hills Polo Club features a central illustration of a polo player on a horse, holding a mallet. Above the illustration, the words "BEVERLY HILLS" are written in a semi-circle, and below it, "POLO CLUB" is written in a straight horizontal line.</p>	 <p>The logo for Harvey Miller Polo Club features a central illustration of three polo players on horses, each holding a mallet. The words "HARVEY" and "MILLER" are written in large, bold, serif capital letters on either side of the illustration. Below the illustration, the words "POLO CLUB" are written in a smaller font.</p>

Visual comparison

38. The invoked trademark consists of the word elements "BEVERLY HILLS POLO CLUB" and a figurative element depicting a polo player on a horse holding a polo mallet in the air. The word elements "BEVERLY HILLS" are written in a semi-circle above the figurative element with the mallet of the polo player crossing the letters "LY" of the verbal element. The word elements "POLO CLUB" are written in a straight, horizontal line below the figurative element.

39. The contested trademark is composed of the word elements "HARVEY MILLER POLO CLUB" and a figurative element representing 3 polo players on horses wielding polo mallets. The word elements "HARVEY MILLER" are separated and placed on either side of the figurative element. The words "POLO CLUB" are written in a smaller font underneath the figurative element.

40. Where a trademark 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 element of the trademarks in this case would however not go unnoticed to the average customer.

41. While the trademarks in question differ in the word elements "BEVERLY HILLS" and "HARVEY MILLER" respectively, as well as in their specific depiction of the polo players and the number of them represented in the figurative elements, they nonetheless both contain the word elements "POLO CLUB" identically present and placed in both trademarks and a representation of polo players on a horse wielding a polo mallet. Furthermore, while the word elements "POLO CLUB" in the contested trademark are written in a smaller font, they will still attract the attention of the relevant public and will as such play a role in the overall impression of the trademark. As a result, while there are visual differences between the trademarks these are not sufficient to entirely detract from the visual similarities between the trademarks.

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

Aural comparison

43. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex trademark 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 trademark 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).

44. The trademarks consist of four verbal elements and are each composed of 7 syllables [BE] [VER] [LY] [HILLS] [PO] [LO] [CLUB] and [HAR] [VEY] [MIL] [LER] [PO] [LO] [CLUB]. It is worth noting that two of the 4 words present in each of the trademarks are identically present in both trademarks. In addition, the trademarks in this case are composed of the same number of syllables, resulting in both trademarks sharing the same rhythm and cadence in their pronunciation.

45. While the consumer normally attaches more importance to the first part of a trademark (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79), in the case at hand, the fact that the trademarks differ in the first two out of the four words which compose them will not entirely counteract the overall phonetic similarity of the trademarks resulting from their shared components.

46. Thus, the Office considers the trademarks to be aurally similar to a certain degree.

Conceptual comparison

47. The invoked trademark's word elements "BEVERLY HILLS" refer to a well-known location in the United States of America and the words "POLO CLUB" refer to a club for practicing the sport of polo. The latter meaning of the trademark is further reinforced by the figurative element of the trademark depicting a polo player.

48. The contested trademarks word elements "HARVEY MILLER" will be perceived as a name and surname and "POLO CLUB" as referring to a club for practicing the sport of polo. Here also, the latter meaning of the trademark is further reinforced by the figurative element of the trademark depicting three polo players.

49. Both trademarks coincide insofar as their word elements "POLO CLUB" as well as their figurative elements both refer to the sport of polo.

50. As a result, trademarks are conceptually similar.

Conclusion

51. The trademarks in question are conceptually similar and visually and phonetically similar to a certain degree.

A.2 Global assessment

52. 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 trademarks are important factors.

53. 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 whose level of attention is to be considered normal.

54. 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).

55. 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 lesser distinctive character (Canon, Sabel and Lloyd, already cited). In the present case, the trademark invoked refers to the sport of polo and to a location in the United States of America (see paragraph 47). It is argued by the defendant that the reference to the sport of polo in the invoked trademark resulting from the figurative elements and the word elements "POLO CLUB" has a low distinctive character for the goods in class 25 as these could be used for playing polo. However, it should be born in mind that, referring to several other decisions, including the decision invoked by the defendant in his argument, the General court held that the image of the polo player has a normal level of distinctiveness for the goods concerned (EGC, Royal County of Berkshire POLO CLUB, T-581/13, 26 March 2015, ECLI:EU:T:2015:192). Furthermore, as the trademark invoked consists in a registered trademark of the European Union, it is necessary to acknowledge a certain degree of distinctiveness (CJEU Formula One C-196/11 14 Mai 2012, ECLI:EU:C:2012:314). Finally, it is important to note that in the context of assessing a likelihood of confusion, following established European case law, the distinctiveness of a trademark is only one element among others involved in this assessment. Thus, even in the presence of an earlier trade mark of low distinctiveness, there may be a likelihood of confusion, in particular, because of the similarity of the signs and the goods or services referred to (see ECJ, Pages Jaunes judgment, T-134/06, 13 December 2007, ECLI:EU:T:2007:387).

56. 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.

57. Based on the abovementioned circumstances, the Office finds that for the goods which are identical, highly similar or similar, considering that the trademarks are conceptually similar and visually and phonetically similar to a certain degree, the relevant public might believe that these goods would come from the same undertaking or from economically-linked undertakings.

B. Other factors

58. Regarding the defendant's observation concerning the saturation of the relevant registers with trademarks that are comparable to the trademark invoked (paragraph 18), the Office recalls that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between the two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings, the defendant has duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC, Top iX, T-57/06, 7 November 2007, ECLI:EU:T:2007:333 and LIFE BLOG, T-460/07, 20 January 2010, ECLI:EU:T:2010:18). In this case, however, no such evidence has been provided by the defendant.

59. In an opposition procedure there is no question of the other party being ordered to bear the costs incurred (see paragraphs 14 and 21). Only a referral of the costs set at the established opposition fee in case the opposition is totally rejected (or justified) is provided for.

C. Conclusion

60. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion between both trademarks for the goods which are at least similar.

IV. DECISION

61. The opposition with number 2016362 is partially justified.

62. The international application with number 1542802 will not be registered in the Benelux for:

Class 18: handbags; travel rucksacks; school bags; beach bags; travelling trunks; suitcases; valises; haversacks; business cases; briefcases; attaché cases; boxes of leather or leatherboard; key cases (leatherware); shoulder bags of leather; parasols; pocket wallets; backpacks; school satchels, purses and pouches.

Class 24: All goods

Class 25: All goods

63. The international application with number 1542802 will be registered in the Benelux for:

Class 18: Leather and imitations of leather

64. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.28(3) IR, as the opposition is partly justified.

The Hague, 10 March 2022



François Châtellier
(rapporteur)

Pieter Veeze

Eline Schiebroek

Administrative officer: Rémy Kohlsaat