

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2016961
of 28 March 2023

Opponent: **Mercedes-Benz Group AG**

Mercedesstrasse 120
70372 Stuttgart
Germany

Representative: **Octrooibureau Vriesendorp & Gaade B.V.**

Koninginnegracht 19
2514 AB Den Haag
Netherlands

Invoked trademark: **International trademark registration 1089903**



against

Defendant: **Sany Group Co., Ltd**

Third Floor SANY Administrative Center SANY Industrial Park Econo
Changsha Hunan
China

Representative: **Novagraaf Nederland B.V.**

Hoogoorddreef 5
1101 BA Amsterdam
Netherlands

Contested sign: **International trademark application 1579818**



I. FACTS AND PROCEEDINGS

A. Facts

1. On 9 February 2021, the defendant filed an International trademark application, designating inter




alia the Benelux, for the figurative trademark , for goods in class 12. This application was processed under number 1579818 and was published on 11 March 2021.

2. On 11 May 2021, the opponent filed an opposition against the registration of the application. The opposition was initially based on the following earlier trademarks:

- International trademark registration 1089903, designating the European Union, of the figurative



trademark , filed on 25 October 2016 for goods in classes 1 until 34 and services in classes 35 until 45;

- European Union trademark registration 140277 of the figurative trademark  , filed on 1 April 1996 and registered on 2 December 1998 for goods in classes 1 until 34 and services in classes 35 until 42.

3. During the proceedings, the defendant asked for proof of use. In response, the opponent has withdrawn the second trademark invoked and indicated that the opposition is only based on the first trademark invoked, for which proof of use was not required.¹

4. Furthermore, the trademark register has shown that the earlier right is now in the name of Mercedes-Benz Group AG, thus this entity enters into the rights of Daimler AG, the applicant of the opposition. The opponent is therefore the actual holder of the trademark invoked as shown in the register.

5. The opposition is directed against all goods and services covered by the contested application and is based on all goods and services covered by the trademark invoked.

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 11 May 2021. During the administrative phase of the proceedings both parties filed arguments. As mentioned above, the defendant requested proof of use and the opponent subsequently withdrew the second trademark invoked (see paragraph 3). For the remainder

¹ Which is correct in accordance with Article 203 Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017, on the European Union trade mark, because the EU publication dates from less than 5 years before the start of this opposition, namely 20 September 2017.

the course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 14 March 2022.

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 trademark invoked consists of the three-pointed star, the so-called 'Mercedes star', which has been used since 1910. According to the opponent, the contested sign consists of a broken circle and a three pronged structure forming a three pointed star. The depiction of the three-pointed star in the signs concerned has no meaning in relation to the relevant goods and therefore has a normal distinctive character.

11. The opponent argues that in the contested sign the three pronged structure has evenly spaced, concentrically arranged spikes that regularly taper towards the outside. Furthermore, it is placed on a horizontal plane that runs between the end points of two of the three prongs, so that the third prong points vertically upwards. This creates a star-shaped form, which is similar to the trademark invoked. The opponent also argues that the fact that the circle of the contested sign is traversed by the ends of the three pronged structure does not change the overall impression of similarity.

12. According to the opponent, an aural comparison is not possible, because it concerns purely figurative signs. Furthermore, the signs share the same concept, because they both refer to a three pointed star.

13. With regard to the comparison of the goods, the opponent only compares the goods of the contested sign to the goods in class 12 for which the trademark invoked is registered. According to the opponent, the goods are partly identical and partly similar.

14. The opponent argues that Mercedes-Benz is one of the most famous automotive brands in the world. The opponent also submits evidence in order to substantiate the argument that the trademark invoked has a reputation. According to the opponent, the trademark invoked is a very well-known trademark due to its longstanding and intensive use. For this reason, the distinctive character of the trademark invoked is high and therefore, the trademark invoked has a broad scope of protection.

15. Furthermore, there is clearly a link between the signs, because the goods are mostly identical, the parties are competitors (they both manufacture trucks) and the three-pointed star of the opponent is very well-known.

16. In the light of the above, the opponent concludes there is a likelihood of confusion, as well as that the defendant takes unfair advantage of the distinctive character or the reputation of the trademark invoked.

17. The opponent requests that the Office refuses the contested sign and orders the defendant to bear the costs of the proceedings.

B. Defendant's arguments

18. The defendant argues that he together with its associated companies formed the Sany Group. The Sany Group, established in early 1989, is one of the Chinese leading multinational heavy equipment manufacturing companies, and is the sixth-largest heavy equipment manufacturer in the world. According to the defendant, the parties have been co-existing for a long time in many countries all over the world, including the Benelux.

19. The defendant puts forward a list of visual differences between the signs. Firstly, the contested sign consists of an open circle containing the design of three "1" shapes which also look like three windmill blades, while the trademark invoked is composed of a closed ring connected with a three-pointed star inside. Furthermore, according to the defendant, the three "1" shapes are thick and short and the connection between them is also different from the three-pointed star image depicted in the trademark invoked. The signs also differ in colour and the trademark invoked also shows shadows along the star and the circle whereas the contested sign has no shadows.

20. With regard to the aural comparison, the defendant states that the contested sign is a figurative mark, which cannot be pronounced or perceived by the relevant consumers. Therefore, it is unnecessary to compare the two signs in their aural and conceptual respects. However, if the two trademarks may be pronounced and even perceived, the defendant argues that they shall be respectively pronounced and perceived as "Sany" and "Mercedes/Benz", since the two trademarks are the graphical representation of the two parties' respective commercial name. Therefore, the contested trademark is also aurally and conceptually dissimilar to the trademark invoked.

21. The defendant states that although the goods are in the same class, the contested goods differ in nature and purpose from the goods of the trademark invoked. The contested goods relate to heavy machineries such as excavators, hoists and road rollers trucks and all of them are sold to achieve construction purpose, whereas the trademark invoked relates to vehicles in the field of the luxury automobile manufacturing industry. Those goods are not produced by the same manufacturers, nor do they

share the same distribution channels, so that consumers cannot easily identify them as having a common origin. Finally, those goods are neither complementary nor competing.

22. According to the defendant, the degree of attention of the relevant public in this case is higher than average, because it concerns a specific field with goods of high value and which relate to personal safety. For this reason, the aforesaid obvious differences between the two trademarks are easily noticed by the relevant consumers.

23. The defendant points out that he is engaged in heavy machinery manufacturing industry, while the opponent is engaged in the luxury automobile manufacturing industry. Therefore, there is no overlap between the relevant consumers of the two trademarks and their co-existence will not lead to confusion. In addition, the defendant points out that in various jurisdictions, such as Ecuador, it was ruled that the signs are not similar.

24. Defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition and registers the contested sign.

III. DECISION

A. Likelihood of confusion

25. 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.

26. 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 of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*²

27. 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.³

28. According to settled case-law of the Court of Justice of the European Union (hereinafter: 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.⁴

² Art. 2.2ter (1)(b) BCIP 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.

³ CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

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



Comparison of the signs

29. 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.⁵

30. 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.⁶ 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.⁷

31. The assessment of the similarity between the signs, regarding the visual, phonetic 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.

32. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

Visual comparison

33. Both signs are purely figurative signs. The trademark invoked consists of a circle or ring, in which a three-pointed star is positioned. The ends of the star are connected with the inside of the circle. This figurative element is depicted in silver with several shadows. The contested signs also contains a circle, in which a triangular element is positioned that consists of three rectangular parts that are placed in such a way that in the middle a smaller circle is created. The triangular element also has three points that are in contact with the circle and slightly cross it. The contested figurative element is depicted in black.

34. The Office finds that the main features of the signs are similar. In both signs, it concerns a circle in which a 'tree-pointed' element is placed that resembles a star. The points are positioned at exactly the same place, namely one point in the middle at the top and two points parallel to each other below it.

⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

⁶ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

⁷ 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).

35. Although there are several differences, such as the colour, the thickness of the three 'corners' of the star and the fact that the circle of the contested sign is intersected by the points of the star, the comparison must be based on the overall impression in which the public does not engage in the analysis of every little detail.

36. In the opinion of the Office, based on the overall impression of the signs, the similarities outweigh the differences, because both trademark and sign contain a clear star-shaped appearance which is positioned within a circle in a similar way.

37. For this reason, the Office finds that the signs are visually highly similar.

Phonetic comparison

38. The Office agrees with the parties that a phonetic comparison is not relevant, because the signs concerned are purely figurative (see paragraphs 12 and 20). After all, a figurative trademark without word elements cannot, by definition, be pronounced.⁸

Conceptual comparison

39. The Office finds that the average consumer will not associate the signs with any clear and precise meaning. A conceptual comparison is thus also not possible.

Conclusion

40. The signs are visually similar. The aural and conceptual comparisons are not possible.

Comparison of the goods and services

41. 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.⁹

42. In comparing the goods and services, the goods and services shall be considered in the terms set out in the register and not the actual or intended use.¹⁰

43. In his arguments, the opponent explicitly only compares the goods in class 12 of the trademark invoked with the goods of the contested sign (see paragraph 13). Having regard to the principle of hearing both sides of the argument, the opposition proceedings are limited to the arguments, facts and evidence put forward by the parties.¹¹ For this reason, the Office will only assess the similarity between these goods.

⁸ General Court (EU) 12 December 2019, T-266/19, ECLI:EU:T:2019:854, points 38-39 and the case-law mentioned there (Gastivo).

⁹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹⁰ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

¹¹ Art. 2.16, paragraph 1 BCIP and Rule 1.21 IR.

44. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 12 Vehicles; apparatus for locomotion by land, air or water; wheelchairs; motors and engines for land vehicles; vehicle body parts and transmissions; parts for vehicles and engines included in this class; strollers, pushchairs and travel systems; safety and booster seats for children for use in vehicles; bicycles; motorbikes; (motor)-scooters; trikes; quads.	CI 12 Motor coaches; trucks; sport utility vehicles; cars; vehicle wheels; telpher railways [cable cars]; wheelchairs; horse drawn carriages; automobile tires; aerial conveyors; launches.

45. The goods '*Motor coaches; trucks; sport utility vehicles; cars*' are part of the broad category '*vehicles*' for which the trademark invoked is registered. Where the goods covered by the earlier trademark include the goods covered by the trademark application, those goods are considered to be identical.¹²

46. The goods '*vehicle wheels; automobile tires*' are highly similar to '*vehicle body parts*' and '*parts for vehicles*' mentioned in class 12 of the trademark invoked, because these goods also concern elements of a vehicle in order to make it function.

47. The goods '*telpher railways [cable cars]; horse drawn carriages; aerial conveyors; launches*' all fall under the general category of '*apparatus for locomotion by land, air or water*' for which the trademark invoked is registered and are therefore identical.

48. The goods '*wheelchairs*' are mentioned *expressis verbis* in in both lists of goods and are thus identical.

Conclusion

49. The goods are partly identical and partly highly similar.

Global assessment

50. 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.¹³ In the present case, the Office agrees with the defendant that the level of attention for the goods concerned will be enhanced (see paragraph 22), since it concerns goods that generally have a high purchase price and that will be used over a long(er) period of time. In addition, these goods are aimed at the transportation of people, animals or goods, in which safety will also play a role. For this reason the level of attention is higher than average.

¹² General Court (EU) 2 February 2022, T-694/20, ECLI:EU:T:2022:45, point 31 and the case-law mentioned there (Labello).

¹³ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

51. The higher the degree of distinctiveness of the earlier trademark, the greater the likelihood 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 weak distinctive character.¹⁴ In this context, the opponent argues that the trademark invoked has enhanced distinctiveness and he has submitted evidence in order to support this argument. This argument has not been disputed by the defendant. In the light of the opponent's substantiated claim, the Office finds that the trademark invoked has acquired enhanced distinctiveness for 'vehicles' mentioned in class 12 for which it is registered, as a result of intensive and frequent use. For the other goods, the Office finds that the trademark invoked has a normal distinctiveness, as it is not descriptive for the goods and services concerned.

52. 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.¹⁵

53. In this case, the relevant goods are identical or highly similar and the signs are visually similar. A phonetic and conceptual comparison is not possible. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that, notwithstanding the elevated level of attention of the public, there is a likelihood of confusion in the sense that the public may believe that the goods designated by the trademark relied on and the goods to which the contested sign relates originate from the same undertaking or, as the case may be, from undertakings which are economically linked. This applies all the more to those goods for which enhanced distinctiveness has been demonstrated.

B. Other factors

54. The defendant reference to the actual use of the signs (see paragraph 23) cannot be taken into account in opposition proceedings, as the comparison of the signs and goods and services is solely based on the trademark as registered and the sign as applied.

55. The defendant refers to case-law in similar cases that should be followed in the present proceedings (see paragraph 23). The Office points out that it is not bound by its own rulings, nor by rulings of other offices in similar or non-similar cases. The Office must consider each opposition on its own merits.

C. Conclusion

56. Based on the foregoing, the Office concludes that there is a likelihood of confusion.

57. Since the opposition is already justified based on the assessment of likelihood of confusion, there is no need to proceed to the assessment of the potential infringement of a trademark with a reputation based on Article 2.2ter, 3 (a) BCIP.

IV. CONSEQUENCE

58. The opposition with number 2016961 is justified.

59. The International application with number 1579818 will not be registered.

¹⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there. (Equivalenza)

60. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 28 March 2023



Eline Schiebroek
(*rapporteur*)

Marjolein Bronneman

Camille Janssen

Administrative officer: Vincent Munier