



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2017201
of 21 July 2022

Opponent: **Palantir Technologies Inc. CA**
100 Hamilton Ave. Suite 300
94301 Palo Alto
United States of America

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwendseweg 12
1382 LX Weesp
Nederland

1st Invoked right: **European Union trademark registration 008110397**



2nd Invoked right: **European Union trademark registration 011251402**



against

Defendant: **MyHotelBike Worldwide B.V.**
Jan Evertsenstraat 579
1061 XZ Amsterdam
Nederland

Contested sign: **Benelux trademark application 1440622**



I. FACTS AND PROCEEDINGS

A. Facts

1. On 14 April 2021 the defendant filed a Benelux trademark application for the following figurative trademark for goods in classes 9 and 12:



This application was processed under the number 1440622 and was published on 25 May 2021.

2. On 26 July 2021 the opponent filed an opposition against the registration of the application. The opposition is based on:

- the European Union trademark 008110397 of the following figurative mark, filed on 18 February 2009 and registered on 12 January 2010 for goods in class 9:



- the European Union trademark 011251402 of the following figurative mark, filed on 9 October 2012 and registered on 8 May 2013 for services in classes 35, 38 and 42:



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

4. The opposition is directed against all of the goods in class 9 covered by the contested application and is based on all of the goods and services covered by the trademarks invoked.

5. During the course of the proceedings the defendant limited the goods in class 9 for which the contested sign was applied to *"Software exclusively developed for hotels to rent out bicycles, to report repairs, to gain insight in operational and financial results and to improve the workflow of renting out bicycles through hotels."*

6. The grounds for opposition are those laid down in article 2.14, (2)(a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

7. The language of the proceedings is English.

B. Proceedings

8. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 30 July 2021. 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 13 December 2021.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

9. 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

10. With respect to the comparison of the signs opponent argues that the signs are visually identical, or at least similar to a high degree. Both marks are a circle and a chevron. The only noticeable difference is that in the prior mark the chevron is positioned under the circle and in the younger mark above the circle. The trademarks are in fact each other's mirror image, making them identical when one of them is viewed upside down. The fact that the circle in the younger mark is slightly bolder than the earlier mark is a minor element that will not be noticed and/or remembered by consumers when they encounter the marks in the market for identical or similar goods. As both signs are purely figurative, it is not possible to compare them aurally. Conceptually, the signs are identical. The elements of a circle and a chevron, of which both marks exist, will be seen as such. Therefore the two figurative elements would be perceived as referring to the same concept.

11. The goods at issue in class 9 are identical, namely 'software'. The description of goods in class 9 of the opponent's invoked earlier mark is broad and includes all possible actions and purposes software could have, in relation to all possible kinds of data and information. The opponent's services in classes 35, 38 and 42 are all closely related to computer software and must therefore be considered highly similar to the applicant's goods in class 9.

12. Opponent notes that the figurative trademarks invoked do not have a meaning and are therefore distinctive for the goods and services for which they are registered. In the case at hand, the goods 'software' (of all kinds) are directed at the public at large and the level of attention is likely to be average.

13. Opponent concludes that because of the opposed mark's identity with, or similarity to, the opponent's earlier trademarks and the identity or similarity of the goods and/or services covered by the trademarks, there exists a likelihood of confusion on the part of the public. The opponent respectfully requests that the opposition is fully upheld with an award of the costs in favour of the opponent.

B. Defendant's arguments

14. Defendant notes that the trademarks of opponent are based on the (filmed) story 'The Lord of the Rings'. On the one hand, the logo of opponent depicts a dark black 'magical' round sphere (a Palantir – 'seeing stone' – from the Lord of the Rings) hovering above two supporting leaf-like elements. On the other hand the logo according to Palantir's logo designer, Gary Tan "can in fact be interpreted as a human head leaning over a book". Defendant mentions that the two elements in his logo represent a roof of a hotel and a wheel of a bicycle. Additional, notable differences between the signs are: (i) the logo of defendant is a lot thicker and (ii) the two elements that make up the trademark of defendant are completely reversed compared to opponent's logo. The logos are, thus, conceptually and visually different.

15. The defendant argues that the business activities of the parties are completely different. Opponent is an outsourcing company and focuses on analysing Big Data through, among other things applying Machine Learning and Artificial Intelligence. Palantir is primarily known for its business activities in counterterrorism, financial markets, healthcare and collaborations with US state/local governments.

Palantir does not rent bicycles through hotels, like defendant. Defendant is not an outsourcing company and focuses solely on the rental of bicycles through hotels, both operationally and digitally.

16. Defendant mentions that, on the request of opponent, he has limited his trademark application in class 9 to software *exclusively* developed for hotels to rent out bicycles, to report repairs, to gain insight in operational and financial results and to improve the workflow of renting out bicycles through hotels.

17. Defendant also argues that opponent's company is listed and is much larger, in terms of annual sales, equity, assets and number of employees than defendant's company. According to defendant, there is no overlap in business activities. Therefore the relevant public attention level is null. After all, they are not two publicly known, relatively large parties.

18. Defendant concludes that there is no likelihood of confusion.

III. DECISION

A Likelihood of confusion

19. 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.

20. 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.*"¹

21. 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.²

22. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.³

23. The Office will first proceed below to assess the likelihood of confusion based on the invoked European Union trademark 008110397.

¹ Art. 2.2ter (1)(b) BTIP implements art. 5 (1)(b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in art. 8 (1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.



² CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

Comparison of the signs

24. 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.⁴

25. The signs to be compared are the following:

| Opposition based on: | Opposition directed against: |
|---|--|
|  |  |

Visual comparison

26. The trademark applied for is a figurative trademark consisting of a black circle with a black chevron pointing downwards underneath. The trademark applied for is also a figurative trademark. It consists of a black circle with a black chevron pointing upwards above it. The trademark applied for is the mirror image of the trademark relied upon. Another difference is that the lines of the trademark applied for are slightly thicker than those of the trademark invoked. In the opinion of the Office, based on the overall impression of the signs, the similarities outweigh the differences.

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

Phonetic comparison

28. If a comparison is made between a figurative trademark without word elements and another trademark, a phonetic comparison is not relevant. After all, a figurative trademark without word elements cannot, by definition, be pronounced.⁵ The Office is of the opinion that the trademark relied upon will not be perceived by the average consumer as a word element. Hence, as one of the signs is purely figurative, a phonetic comparison is not possible.

Conceptual comparison

29. According to the Office, the average consumer will not associate the signs with any meaning. A conceptual comparison is thus also not possible.

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

⁵ General Court (EU) 12 December 2019, T-266/19, ECLI:EU:T:2019:854, points 38-39 (Gastivo) and the case-law mentioned there.

Conclusion

30. The signs are visually similar to a high degree. A phonetic and conceptual comparison is not possible.

Comparison of the goods and services

31. 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.⁶

32. 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.⁷

33. The goods to be compared are the following:

| Opposition based on: | Opposition directed against: |
|--|--|
| Class 9 Computer software for collection, editing, analysis, viewing, organization, modification, book marking, transmission, storage, exchange, sharing, querying, auditing, and tracking of data and information. | Class 9 Software exclusively developed for hotels to rent out bicycles, to report repairs, to gain insight in operational and financial results and to improve the workflow of renting out bicycles through hotels. |

34. Where the goods covered by the earlier trademark include the goods covered by the trademark application, those goods are considered to be identical.⁸ In this case the goods for which the earlier trademark was filed are part of a more general category covered by the trademark application, namely software. The goods are thus considered to be identical.

Global assessment

35. 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.⁹ In the present case, the goods covered are aimed at the public at large for which the level of attention is deemed to be normal.

36. The greater 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.¹⁰ In

⁶ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁷ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

⁸ General Court (EU) 2 februari 2022, T-694/20, ECLI:EU:T:2022:45, point 31 (Labello) and the case-law mentioned there.

⁹ CJEU 22 juni 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁰ CJEU 29 september 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

the present case the invoked trademark has to be considered as having normal distinctiveness for the goods concerned as it does not describe the characteristics of the goods in question.

37. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be taken into account 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.¹¹

38. In this case the signs are visually similar to a high degree. A phonetic and conceptual comparison is not possible. The relevant goods are identical. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that there is a likelihood of confusion in the sense that the public may believe that the goods designated by the trademark relied on and those to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically linked.

Other factors

39. Defendant argues that the business activities of the parties are completely different. However, actual use cannot be taken into account in opposition proceedings, as the comparison of the signs and goods and services is solely based on the trademark and sign as registered. Thus, matters such as marketing and sales formulas, which can also change over time, play no role in the context of an opposition.¹²

B. Conclusion

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

41. Since the opposition is justified based on likelihood of confusion in respect of the European Union trademark 008110397, the Office does not need to carry out an assessment in respect of the European Union trademark 011251402 relied upon.

IV. DECISION

42. The opposition with number 2017201 is justified.

43. The Benelux application with number 1440622 will not be registered for the following goods:

- class 9 (all goods).

44. The Benelux application with number 1440622 will be registered for the following goods, since this opposition was not directed against it:

- class 12 (all goods).

¹¹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, punt 59 (Equivalenza) and the case-law mentioned there.

¹² CJEU 15 March 2007, C-171/06 P, ECLI:EU:C:2007:171, point 59 (Quantum).

45. 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, 21 July 2022



Marjolein Bronneman
(*rapporteur*)

Camille Janssen

Eline Schiebroek

Administrative officer: Gerda Veltman