

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2017313
of 29 September 2022**

Opponent: **Newsha GmbH**
Elbestrasse 5-7
45478 Mülheim a.d. Ruhr
Germany

Representative: **Octroibureau Griebing B.V.**
Sportweg 10
5037 AC Tilburg
Netherlands

Invoked right: **International trademark registration 1158026**

NEWSHA

against

Defendant: **Jetharam Nemaram Gehlot**
101, Shree White Heights Apartment, Saraswati Nagar,
Hirawadi Road, Nashik
422003 Maharashtra
India

Representative: **Octroibureau Vriesendorp & Gaade B.V.**
Koninginnegracht 19
2514 AB The Hague
Netherlands

Contested sign: **Benelux trademark application 1443706**

NISHA

I. FACTS AND PROCEEDINGS

A. Facts

1. On 27 May 2021 the defendant filed a Benelux application for the wordmark NISHA for goods in class 3. This application was processed under the number 1443706 and was published on 5 July 2021.
2. On 3 September 2021 the opponent filed an opposition against the registration of the application. The opposition is based on the International trademark registration 1158026 designating the European Union of the wordmark "NEWSHA", filed on 31 January 2013 and registered for goods and services in class 3, 35 and 44 and with a priority date of 3 August 2012.
3. The invoked trademark was assigned from the opponent hair concepts GmbH to the current owner Newsha GmbH. In accordance with article 2.31 Benelux Convention on Intellectual Property (hereinafter: "BCIP") and article 3.1 Implementing Regulations (hereinafter "IR")¹ this means that the current owner is deemed to be acting in the rights of the original petitioner of the opposition.
4. According to the register the opponent is the actual holder of the trademark invoked.
5. The opposition is directed against all of the goods covered by the contested application and is based on all of the goods and services covered by the trademark invoked.
6. The grounds for opposition are those laid down in article 2.14, 2 (a) BCIP.
7. The language of the proceedings is English.

B. Course of the proceedings

8. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") to the parties on 6 September 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 IR. The administrative phase was completed on 16 March 2022.

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. The opponent starts with a comparison of the signs and argues that they are visually similar, as the signs at hand consist of almost the same number of letters, containing four letters in identical sequence with their beginnings and endings being characteristic and identical. Aurally, the signs to be compared have the same number of syllables and have the same pronunciation, rhythm and intonation. The average Dutch

¹ See article 4.4 Guidelines on Opposition.

person will pronounce the invoked trademark either as "neesja" or as "nijwsja", which is similar to "neesja" for the contested sign.

11. Conceptually, neither of the signs has a meaning in either of the languages of the Benelux and therefore a conceptual comparison is not possible.

12. In relation to the comparison of the goods, the opponent notes that the goods covered by the invoked trademark includes, as a broader category, the goods of the opposed trademark "henna; henna powders; black henna; hair colorants and hair dyes; cosmetics and toiletries; cosmetics; shampoos; hair lotions; hair gels; hair treatment preparations and hair conditioner: ammonia-based hair colorants", therewith being identical or at least highly similar due to the nature the goods.

13. The other remaining cosmetic and body related products for which the contested sign has been filed belong to the category of cosmetic goods, which are sold in identical sections of shops, and whose consumers and distributions channels are identical. These goods are therefore highly similar to the goods invoked. As for the remaining products: these all have the same nature, the same purpose, are intended for the same consumers, are produced and commercialized by the same entities and available in the market through the same distribution circuits and channels, and therefore highly similar.

14. The level of attention of the relevant public is low, as the goods are relatively low-priced, frequently purchased, and purchased without the help of a professional.

15. As a result of the above, the opponent considers that there exists a likelihood of misleading the consumer, or a likelihood of confusion for the consumer.

B. Defendant's arguments

16. The defendant starts with a short summary about the activities of both the opponent and the defendant. In relation to the latter, reference is made to the fact that the contested sign, that is in use since 1954, has built an enviable reputation in the market. According to the High Court of Nepal, the contested sign is a well-known trademark. The reputation of the trademark NISHA does therefore not extend to only India, but also trans-border. In order to export the goods under the contested sign, the defendant has also acquired statutory protection in more than 119 countries (52 countries in their designated IPR authorities & 67 countries through WIPO Registration) and has applied for registration of trademark NISHA in more than 35 Countries.

17. In the defendant's view, the signs at hand are dissimilar. Both signs are plain word marks. It concerns short trademarks and each consists of a single word of two syllables, written in capital letters. The earlier mark consists of six letters and the contested sign of five. They coincide in the sequence of the last three letters SHA and differ in their beginning NI and NEW respectively. It can reasonably be argued that the consumer will pay particular attention to the beginning of the signs at hand, especially since the word "NEW" has a well-understood and familiar meaning in English, as also recognized by the General Court of the EU. As the first and vivid part of the signs at hand are fundamentally different, the signs at hand are visually different. In this respect, the defendant also refers to the case of the General Court of the EU in relation to the signs CAPOL and ARCOL, in which the court found that the mere coincide of the suffix "OL" cannot invalidate the fact that the signs are not visually similar at all.

18. The defendant also argues that the signs are phonetically dissimilar. Although the arrangement of the letters is the same, the addition of one letter being "W" changes the whole pronunciation of the word,

thus, making both the words phonetically dissimilar in look and pronunciation. The letter "W" in itself has a distinct pronunciation. The first syllable of the signs at hand are completely different.

19. In relation to the conceptual comparison, the defendant argues that although the signs being compared have no set meaning, the word 'new' is a common English word which will be understood by the relevant public. Therefore, notwithstanding the fact that the second syllable 'sha' has no meaning, the opponent's sign is to be associated with 'novelty' and it is that conceptual meaning which the consumer will give to it. The meaning of the word NISHA in the Indian language Hindi means 'night' or is also a widely used feminine name whereas the word NEWSHA has absolutely no meaning except for the fact that the word has been compiled to form a word. Therefore, the signs are conceptually dissimilar.

20. In relation to the comparison of the goods the defendant notes that part of the goods are identical/similar, namely '*hair colorant and hair dyes; shampoos; hair oils; hair lotions; hair gels; hair treatment preparations and hair conditioner; ammonia based hair colorants*'. The goods '*detergents; bleaching preparations and other substances for laundry use; polishing preparations; depilatory preparations; scouring preparations; abrasives*' have nothing in common with the hair care preparations of opponent. They differ in nature, producer and purpose. As for the remainder of the goods '*cosmetics; and toiletries*' etc. these are only similar to a very low degree. The nature of the goods is different, but they may coincide in points of sale and relevant public.

21. The majority of the parties' goods are aimed at a general public and will be primarily be purchased visually. There will be a reasonable level of attention during purchase.

22. Furthermore, the invoked trademark has low distinctiveness, as the first part of the trademark - NEW - will only be understood as a reference to novelty. The trademark therefore enjoys a limited scope of protection.

23. In light of the foregoing, the defendant finds that a likelihood of confusion does not exist and requests the Office to reject the opposition and to order the opponent to pay the costs of this procedure, pursuant to article 2.16 paragraph 5 BCIP.

III. DECISION

A Likelihood of confusion

24. 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.

25. 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

² 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.

26. 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

Comparison of the signs

27. 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

28. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
NEWSHA	NISHA

Visual comparison

29. Both the invoked trademark and the contested sign are wordmarks, consisting of 6 respectively 5 letters, four of those letters being identical, also in relation to their placement and order within the signs at hand.

30. Although the defendant is right in his assertion that consumers normally attach most weight to the beginning of signs,⁵ in the case at hand, this does not take away from the similarity between the signs. The difference within the first part of the signs – “NEW” versus “NI” - cannot take away from the fact that the signs consist of almost the same number of letters, with both the first of those letters being identical, as well as the last three. The signs at hand are therefore both of a similar length and a similar structure. The reference made to the CAPOL/ ARCOL case by the defendant is not of relevance. In the case at hand, it is not only the two-letter suffix that coincides.

31. In light of the foregoing, the Office finds the signs at hand to be visually similar.

Aural comparison

32. Both the trademark invoked and the contested sign consist of two syllables. The invoked trademark will be pronounced – by at least part of the relevant public - as “NIEW-SJAA”, whereas the contested sign will be pronounced as “NIE-SJAA”. Aurally speaking, the signs at hand are therefore of an almost identical length, with a similar structure. Only the sound of the letter “W” is different within the pronunciation of the signs at hand. Therefore, the Office finds the signs at hand to be aurally similar.

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 58 (Equivalenza) and the case-law mentioned there

⁵ General Court (EU), 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79 (Mundicor).

Conceptual comparison

33. Both parties agree that neither of the signs at hand has a set and clear meaning for the relevant public. This also means that neither of the signs at hand has a conceptual meaning. The argument of the defendant, that the relevant public will find that the invoked trademark refers to "novelty" because of the fact that the first syllable is the element "new", cannot be accepted. The conceptual meaning of a trademark must be derived from the trademark as a whole, and – as also stated by the defendant itself – the trademark as a whole does not have a set and clear meaning for the relevant public. It should also be noted that the defendant fails to show that the public will perceive of the trademark as having this meaning, as a result of which this claim must also be rejected since it is not substantiated.

34. In light of the foregoing, neither of the signs at hand have a meaning, so that a conceptual comparison is not possible.

Conclusion

35. The trademarks in question are visually and aurally similar. A conceptual comparison is not possible.

Comparison of the goods and services

36. 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

37. 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

38. The goods and services to be compared are the following:

Opposition based on:	Opposition directed against:
CL 3 Hair care preparations, hair dyes, hairspray, hair mousse, hair tonic, cosmetics for hair, hair setting preparations, hair lotion, hair smoothing preparations, shampoos for hair, volumizing preparations for hair.	CI 3 Henna; henna powders; black henna; hair colorants and hair dyes; detergents; bleaching preparations and other substances for laundry use; cosmetics and toiletries; cleaning preparations; cosmetics; polishing preparations; depilatory preparations; scouring preparations; abrasives; perfumery; essential oils; skin care preparations; facial cream; eye cream; shaving cream; shower cream; body cream; night cream; anti-aging cream; sunscreen cream; anti-wrinkle cream; skin whitening

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).

	<p>lotion; shaving lotion; shower lotion; body lotion; sunscreen lotion; moisturiser; soaps; shampoos; hair oils; hair lotions; hair gels; bath oils other than for medical use; deodorants and anti-perspirants for personal use; teeth cleaning [preparations for-]; hand cleaning preparations; face cleaning preparations; hair treatment preparations and hair conditioner; ammonia based hair colorants.</p>
<p>CL 35 Retail trade services in conjunction with the sale and Internet sale of goods of a hair care preparation business; retail trade services relating to hair care preparations; providing contracts for third parties also via the Internet in relation to the purchase and sale of goods, in particular hair care preparations; assembling goods for third parties for presentation and sales purposes including on the Internet, in particular hair care preparations; acquisition of customers and customer care by mail-shot advertising; mannequin services for advertising and sales promoting purposes for hair care preparations; marketing [market research]; online advertising for hair care preparations on a computer network; organising and carrying out advertising events for hair care preparations; personnel recruitment; bill-posting; planning of advertising schemes for hair care preparations; presentation of companies on the Internet and other media; presentation of hair care preparations in communication media for the retail trade; radio advertising; mail-shot advertising; distribution of advertising media; advertising on the Internet for third parties; advertising for hair care preparations; consultation in matters of business management and organisation and operation of retail trade businesses in conjunction with the sale of goods, in particular hair care preparations.</p>	
<p>CL 44 Health and beauty care, hairdressing salon services, beauty salon services.</p>	

39. Both opponent and defendant find that the goods "*hair colorant and hair dyes; shampoos; hair oils; hair lotions; hair gels; hair treatment preparations and hair conditioner; ammonia based hair colorants*" are identical or similar. In light of the principle of hearing both sides as in article 2.16(1) BCIP in conjunction

with article 1.21 IR, the examination of the opposition will be limited to the arguments, facts and evidence submitted by the parties. Therefore, the goods "*hair colorant and hair dyes; shampoos; hair oils; hair lotions; hair gels; hair treatment preparations and hair conditioner; ammonia based hair colorants*" for which the contested sign has been filed are deemed to be identical and/or similar.

40. In relation to the goods "*henna; henna powders; black henna*", the opponent finds that these are identical to those of class 3 of the invoked trademark. The defendant does not contest this finding, or discusses these goods in any way. Therefore, given the principle of hearing both sides as discussed in point 39, the Office finds that these goods are identical.

41. In relation to the remaining goods, parties have a difference of opinion about the (degree of) similarity. The Office finds that the goods "*cosmetics and toiletries, cosmetics; depilatory preparations; perfumery; essential oils; skin care preparations; facial cream; eye cream; shaving cream; shower cream; body cream; night cream; antiaging cream; sunscreen cream; anti-wrinkle cream; skin whitening lotion; shaving lotion; shower lotion; body lotion; sunscreen lotion; moisturiser; soaps; bath oils other than for medical use; deodorants and anti-perspirants for personal use; teeth cleaning [preparations for-]; hand cleaning preparations; face cleaning preparations*" of the contested sign are similar to a certain extent to the goods in class 3 of the invoked trademark, as these goods, although in relation to different parts of the body (parts of the body such as hands versus products for hair) are all meant to serve the same purpose, namely beautifying and/or taking care of (parts of the body of) the person using those products, to take care of their looks. The goods are also being sold via the same outlets (such as drugstores).

42. In relation to the remaining goods of the contested sign, namely '*detergents; bleaching preparations and other substances for laundry use; cleaning preparations; polishing preparations; scouring preparations; abrasives*', these goods are not similar to the goods and services of the invoked trademark. These goods do not serve the same purpose (cleaning (rather aggressively) of goods versus beautifying one's hair) and cannot be used in combination with one another. Even though these goods may be sold via the same outlets (drugstores), the nature of the goods is too different from the goods and services of the invoked trademark to come to a finding of similarity.

Conclusion

43. The goods discussed in paragraphs 39, 40 and 41 are identical or similar.

44. The goods '*cleaning preparations, detergents; bleaching preparations and other substances for laundry use; polishing preparations; scouring preparations; abrasives*' for which the contested sign has been filed are, as discussed in paragraph 42, not similar to the goods and/or services from the invoked trademark. Therefore, to the extent that the opposition is directed against these goods, the opposition cannot be granted as there can be no likelihood of confusion if there is no similarity between the goods and services. As regards the goods that are similar, the Office proceeds below to a global assessment of the likelihood of confusion.

A.3 Global assessment

45. 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.⁸ In the present case, the goods and services in question are products aimed at the public at large, as also stated by both parties. Given the fact that the goods are meant to “beautify” those purchasing the goods, which are meant to positively affect their appearance, with ingredients potentially affecting one’s health (such as ammonia), the Office does not agree with the opponent’s statement that the level of attention will be low. However, given the fact that the goods at hand will be used relatively frequently and are not expensive, the Office finds that the level of attention must be deemed to be normal.

46. The more distinctive the earlier trademark, the greater the likelihood of confusion. Trademarks 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.⁹ The defendant claims that the invoked trademark is descriptive, as it refers to “novelty”. However, the invoked mark as a whole has no established meaning for the relevant public, nor is it a common name and the Office therefore finds that the invoked trademark is of normal distinctive character

47. 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.¹⁰

48. Based on the abovementioned circumstances, and considering their interdependence, the Office finds that due to the similarities between the signs both visually and aurally, the relevant public may believe that the identical and similar goods involved come from the same undertaking or from economically-linked undertakings.

B. Other factors

49. The defendant points out that the contested sign has gained a reputation in not only India, but cross-border as well and has even been deemed to be a well-known trademark by the high court of Nepal (see paragraph 16). Although the defendant does not (explicitly) refer to this alleged fact in relation to the (absence of the) existence of a likelihood of confusion, for the sake of completeness, the Office points out that if this had been the case, this would not have made a difference, as a defendant cannot appeal to the reputation of the trademark filed by the defendant.¹¹

C. Conclusion

50. Based on the foregoing the Office is of the opinion that a likelihood of confusion exists in relation to the goods mentioned in paragraphs 40 and 41.

51. A likelihood of confusion does not exist in relation to the goods mentioned in paragraph 42.

IV. DECISION

52. The opposition with number 2017313 is partially granted.

⁸ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

⁹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon)

¹⁰ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, punt 59 (Equivalenza) and the case-law mentioned there.

¹¹ CJEU 3 September 2009, C-498/07 P, ECLI:EU:C:2009:503 (La Española).

53. Benelux application number 1443706 will not be registered for the following goods in class 3:

"Henna; henna powders; black henna; hair colorants and hair dyes; cosmetics and toiletries; cosmetics; depilatory preparations; perfumery; essential oils; skin care preparations; facial cream; eye cream; shaving cream; shower cream; body cream; night cream; anti aging cream; sunscreen cream; anti-wrinkle cream; skin whitening lotion; shaving lotion; shower lotion; body lotion; sunscreen lotion; moisturiser; soaps; shampoos; hair oils; hair lotions; hair gels; bath oils other than for medical use; deodorants and anti-perspirants for personal use; teeth cleaning [preparations for-]; hand cleaning preparations; face cleaning preparations; hair treatment preparations and hair conditioner; ammonia based hair colorants."

54. Benelux application number 1443706 will be upheld for the following goods in class 3:

"Detergents; bleaching preparations and other substances for laundry use; cleaning preparations; polishing preparations; scouring preparations; abrasives".

55. Neither party shall be ordered to pay the costs pursuant to Article 2.16(5) BCIP in conjunction with Rule 1.28(3) IR, as the opposition is granted in part.



The Hague, 29 september 2022

Pieter Veeze
(rapporteur)

Camille Janssen

Marjolein Bronneman

Administrative officer: Monique Vrolijk