

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY  
OPPOSITION DECISION  
N° 2017394  
of 28 December 2023**

**Opponent:** **Amonis OFP, organisme voor de financiering van pensioenen**  
Place de Jamblinne de Meux 4  
1030 Bruxelles  
Belgium

**Representative:** **GEVERS**  
Holidaystraat 5  
1831 Diegem  
Belgium

**Invoked trademark:** **European trademark registration 10184844**

Amonis

*against*

**Defendant:** **Amaris Capital Ltd, Buitenlandse rechtsvorm: Private limited company  
(Verenigd Koninkrijk)**  
Goudkarpersingel 12  
2492 NE The Hague  
Netherlands

**Representative:** -

**Contested sign:** **Benelux trademark application 1445368**



Amaris Capital

## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 21 June 2021, the defendant filed an application for a trademark in the Benelux for the word mark Amaris Capital, for services in class 36. This application was processed under the number 1445368 and was published on 27 July 2021.

2. On 27 September 2021 the opponent filed an opposition against the registration of the application. The opposition was initially based on the following earlier registrations:

- European Union registration 2542645 of the combined word/figurative mark , filed on 21 January 2002 and registered on 25 September 2003 for services in classes 36 and 44;
- European Union registration 10184844 of the combined word/figurative mark , filed on 9 August 2011 and registered on 11 January 2012 for goods and services in classes 16, 36 and 44.

3. According to the register the opponent is the actual holder of the trademarks invoked. The register shows that the first trademark invoked expired on 21 January 2022 and the opponent has indicated that this trademark is no longer part of the proceedings (see point 14).

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

5. The language of the proceedings is English.

### B. Proceedings

6. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 28 September 2021. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. 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 23 January 2023.

## II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. The opponent filed an opposition at the Office under Article 2.14 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 and services concerned.

### A. Opponent's arguments

8. The opponent argues that the services in class 36 of the contested sign are identical or similar compared to the services in class 36 of the trademark invoked.

9. According to the opponent, the word element AMONIS is the most distinctive part of the trademark invoked, because the verbal element of the trademark invoked has a greater impact on the consumer than

the figurative element. With respect to the contested sign, the opponent states that the consumer will focus on the word element AMARIS, because it is the first element and the second element CAPITAL is descriptive.

10. According to the opponent, the consumer will realise that the element CAPITAL is not a distinctive element of the contested sign. Visually, the signs coincide in the presence of the letters "AM" appearing at the beginning and the letters "IS" appearing at the end. The opponent therefore states that the signs are visually similar to an average or high degree. The opponent further argues that the pronunciation of the signs is similar to a certain degree, because the first two and last two letters of the first word element are the same.

11. With regard to the conceptual comparison the opponent states that the elements AMONIS and AMARIS have no established meaning. Furthermore, the term CAPITAL is descriptive. Therefore, neither of the trademarks will be found to be referring to a certain concept. For this reason, a conceptual comparison is not possible.

12. The opponent also argues that the trademark invoked has a normal distinctiveness, because it is not descriptive for the services concerned.

13. The opponent concludes that there exists a likelihood of confusion and requests that the Office refuses the contested sign and orders that the costs be borne by the defendant.

#### *Proof of use*

14. At the request of the defendant, the opponent submits proof of use. The opponent states that the proof of use only concerns the second trademark invoked, because the first trademark invoked had expired.

15. The opponent explains that Amonis OFP is the largest Belgian pension fund for self-employed health care workers. The proof of use contains advertising brochures, news articles, management reports and press articles. The opponent also states that the economic activity of Amonis OFP does not only take place in Belgium but is also internationally oriented.

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

16. The defendant states that the signs are not identical. The trademark invoked is a figurative mark and contains the fanciful term AMONIS.

17. The signs differ in the number of letters and according to the defendant, the presence of the letters AM and IS in the contested sign AMARIS CAPITAL is insignificant. For this reason, there is no degree of visual similarity.

18. The contested sign contains two words and therefore, according to the defendant, there is no degree of aural similarity.

19. The defendant explains that the word AMARIS is derived from the letters of his family name and the names of his parents. Furthermore, the contested sign also contains the word CAPITAL. The trademark AMARIS CAPITAL represents the defendant's heritage, and it conveys the idea of the wholeness of a family and the business. For this reason there is no degree of conceptual similarity.

20. With regard to the services, the defendant states that these are not identical. According to the defendant, the services of the contested sign are overly complex in nature, intended to resolve a specific problem in the industry and target a niche market. The characteristics and circumstances of the contested

services are not identical to the opponent's services. Furthermore, the defendant argues that the fact that the services appear in the same class under the Nice Classification does not mean that these services are similar.

21. The defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition, registers the contested sign and orders the opponent to pay the costs.

#### *Proof of use*

22. The defendant states that the proof of use does not contain documents relating to the actual use of the trademark invoked for the registered goods and services. Furthermore, according to the defendant, a narrower specification of services in class 36 is applicable to the opponent.

### **III. DECISION**

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

23. In accordance with Article 2.16bis BCIP, the opponent, at the request of the defendant, shall furnish proof that the trademark invoked has been put to genuine use as provided for in Article 2.23bis BCIP or that proper reasons for non-use existed. The evidence must show genuine use in five years prior to the filing or priority date of the trademark against which the opposition is lodged.

24. The filing date of the contested trademark is 21 June 2021. Therefore, the opponent was required to show use of the invoked trademarks during the period from 21 June 2016 to 21 June 2021 ('the relevant period'). Given that the trademark invoked was registered for more than five years prior to the contested trademark's filing date, the defendant's request that proof of use is submitted is legitimate.

#### *In general*

25. In accordance with the case-law of the European Court of Justice ("CJEU") there is genuine use of a trademark if the mark, in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, is used in order to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.<sup>1</sup> When assessing whether use of the trade mark is genuine, regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.<sup>2</sup> In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly.<sup>3</sup>

26. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.<sup>4</sup> In interpreting the concept of genuine use, account should be taken of the

---

<sup>1</sup> CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis), and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

<sup>2</sup> CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:80, point 83 (Pandalis), and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

<sup>3</sup> General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

<sup>4</sup> General Court (EU) 8 July 2004, T-334/01, ECLI:EU:T:2004:223, point 36 (Hipoviton), and General Court (EU) 30 April 2008, T-131/06, ECLI:EU:T:2008:135, point 41 (Sonia Sonia Rykiel).

fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade mark protection to the case where large-scale commercial use has been made of the marks.<sup>5</sup>

27. Genuine use of a trademark cannot be proven by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.<sup>6</sup>

28. The trademark invoked is a trademark of the European Union. The use obligation is therefore governed by Article 18 of European Union Trade Mark Regulation 2017/1001, which provides that the EU-trademark must have been put to genuine use in the European Union. The territorial scope of use is not a separate requirement of genuine use, but one of the elements of genuine use that must be included in the overall analysis and examined together with its other elements. The wording "in the Union" in this context indicates the geographical reference market. An EU-trademark enjoys territorially broader protection than a national trademark, which also affects the territorial scope of the use obligation. As a result, an EU-trademark can reasonably be expected to be used in a wider territory than the territory of a single Member State, barring the (exceptional) case where the market for the goods or services in question is in practice territorially limited. This must be abstracted from the borders of the territories of the Member States. It is not possible to determine a priori and in the abstract what quantitative threshold should be chosen in order to determine whether use is genuine or not.<sup>7</sup>

29. The requirement of use is necessary in order to reduce the total number of trademarks registered and protected in the EU and, consequently, the number of conflicts which arise between them.<sup>8</sup> Trademarks that are not used may restrict the free movement of goods and the free provision of services.<sup>9</sup> In this context, it can also be noted that it is characteristic of trademark protection in the European Union that different protection regimes coexist.<sup>10</sup> The Office therefore finds that the territory of protection should ideally correspond as closely as possible to the territory where the trademark is economically used.

30. Following rule 1.41 io. 1.25 IR the proof of use should contain evidence of the place, duration, extent, and manner of use of the trademark invoked for the goods on which the opposition is based.

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

31. The opponent indicates that the proof of use only refers to the second trademark invoked, because the first trademark invoked has expired (see point 14). Therefore, the opponent needs to show proof of use for the following goods and services:

- *Class 16 Paper, cardboard and goods made from these materials, not included in other classes; Printed matter, magazines, periodicals, publications and journals.*
- *Class 36 Insurance; Financial affairs; Financing services; Brokerage agencies; Fund investment; Information and advice relating to finance and insurance; Financial evaluation (insurance).*
- *Class 44 Physicians' services.*

---

<sup>5</sup> General Court (EU) 4 April 2019, T-910/16 and T911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

<sup>6</sup> General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

<sup>7</sup> CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, points 36, 44, 50 and 55 (ONEL); Benelux Court of Justice (second chamber) 28 June 2023, C-2022/6, point 20 (Gillette/Fontaine).

<sup>8</sup> Recital 31 in the preamble to the Trademark Directive 2015/2436.

<sup>9</sup> CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 32 (ONEL)

<sup>10</sup> CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 26 (ONEL)

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

1. Information brochures including information about the pension fund offered by Amonis, dated September 2012 and September 2015 in Dutch and French;
2. News articles referring to numerous awards won by opponent during 2012, 2015, 2016, 2017 and 2020 at the 'World Finance global pension fund awards' and 'Investment & Pensions Europe awards';
3. Annual reports and overviews from Amonis between 2012 and 2021;
4. News articles concerning the results of Amonis, published in 2012, 2013 (laspecialiste.be); 2015, 2016, 2019 and 2020 (Investment & Pensions Europe and bfinance).

33. The Office finds that the content of the information brochures shows that the sign Amonis is used to offer pension services targeted at self-employed healthcare professionals (exhibit 1). However, the offering and provision of these services is only directed to the public in Belgium, which clearly follows from the brochures, news articles and annual reports (exhibits 1, 3 and 4).

34. The argument that Amonis is internationally known in the field of pension funds and maintains relations with pension funds abroad (see point 15), as well as the circumstance that it will not make investments purely in Belgium, does not demonstrate that the financial services for which the trademark is registered are also offered and provided to a public outside Belgium.

35. The public for pension services concerns the general public in the European Union and these services are not territorially limited. For this reason, the Office finds that the evidence does not demonstrate that the trademark invoked is used for the purpose of maintaining or creating market share within the European Union, since the services are only directed to the public in Belgium (see points 28 and 29).

36. In addition, the evidence does not (sufficiently) show that any of the other services in class 36 or the goods and services in class 16 and 44 have been offered or provided within the relevant period within the European Union. Therefore also for these goods and services, genuine use has not been proven.

## **B. Conclusion**

37. Based on the foregoing the Office concludes that the opponent did not provide proof that the trademark invoked has been used in the European Union within the relevant period, nor that there are proper reasons for non-use. For this reason, the opposition will be rejected.

## **IV. CONSEQUENCE**

38. The opposition with number 2017394 is rejected.

39. The Benelux application with number 1445368 will be registered.

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

The Hague, 28 December 2023



Eline Schiebroek  
(*rapporteur*)

Pieter Veeze

Camille Janssen

Administrative officer: Vincent Munier