

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2017589
of 20 February 2023**

Opponent: **German Sports IPCo GmbH**
Theodor-Althoff-Str. 2
45133 Essen
Germany

Representative: **Vondst Advocaten N.V.**
De Lairesestraat 111-115
1075 HH Amsterdam
The Netherlands

Invoked trademark 1: European Union trademark registration 4111076

ALEX

Invoked trademark 2: International registration 1451564



against

Defendant: **Alexandra Van Remortel**
Boterlaarbaan 30
2970 Schilde
Belgium

Representative: **BAKER & MCKENZIE CVBA**
Borsbeeksebrug 36 box 8
2600 Antwerpen
Belgium

Contested sign: **Benelux trademark application 1449838**

alex

by Alexandra Van Remortel

I. FACTS AND PROCEEDINGS

A. Facts

1. On 8 September 2021, the defendant filed a Benelux trademark application for the combined word/figurative trademark



, for goods in class 25. This application was processed under the number 1449838 and was published on 29 September 2021.

2. On 29 November 2021, the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademark registrations:

- European Union registration 4111076 of the wordmark ALEX, filed 8 November 2004 and registered on 21 October 2009 for goods in classes 18, 25 and 28 (hereinafter: the European registration);
- International registration 1451564, designating amongst others the European Union, of the combined word/figurative trademark



, filed on 1 October 2018 and registered on 26 July 2019 for goods and services in classes 5, 9, 12, 18, 21, 24, 25, 26, 28 and 32 (hereinafter: the International registration).

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

4. The opposition is directed against all goods covered by the contested application and is based on all goods in class 25 and "*gymnastic and sporting articles not included in other classes*" in class 28 of the European registration and "*swimming goggles*" in class 9 and all goods in classes 24, 25 and 28 of the International registration.

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 30 November 2021. At the joint request of the parties the opposition proceedings were suspended once. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use of the European registration was submitted by the opponent. 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 19 October 2022.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. The opponent filed his 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 of the goods or services concerned.

A. Opponent's arguments

8. The opponent explains that he is the holder of several intellectual property rights, including the ALEX trademarks invoked, which he licenses to other parties for the sale of inter alia sportswear and sporting articles, among which swimwear. Defendant sells (women's) swimwear and accessories under the contested sign on her website www.alexantwerp.com. Opponent and defendant therefore target the same public.

9. With regard to the comparison between the signs opponent argues that the signs share the same verbal element ALEX which will most likely be perceived as a(n) (abbreviated) forename and is distinctive with regard to the goods for which the trademarks invoked have been registered. The verbal element 'by' in the contested sign is a basic English word, which is commonly used in trademarks to provide additional information related to the manufacturer, designer or to a specific line of products. Therefore the relevant consumers will understand the words 'by Alexandra Van Remortel' as an indication that the goods in question originate from, were designed by or are a specific line by Ms Van Remortel. 'by Alexandra Van Remortel' is a clearly subordinate position and plays a secondary role in the overall comparison of the contested sign. The verbal element ALEX will, due to its size and central position, be the first element to attract the consumer's attention and therefore play a more important role in the overall composition of the contested sign. The signs fully coincide in their distinctive verbal element ALEX. Consequently, although the signs contain some differing verbal and/or figurative elements, the signs are visually and aurally similar to a high (or at least average) degree.

10. The coinciding verbal dominant element ALEX will (in both signs) be perceived as a(n) (abbreviation of the) name (Alexander / Alexandra). The signs thus have the same meaning and are conceptually identical or at least similar to a high degree.

11. The goods of the contested sign are identical to the goods of the trademarks invoked. They target the public at large, whose degree of attention is average. The trademarks invoked are distinctive in relation to the goods for which they have been registered.

12. Opponent mentions that it is common practice nowadays for companies to make small variations of their trademarks, for example by altering their typeface or colour, or adding some verbal or figurative elements, to denote new product lines, or to create a modernized version of the trademark. It is also common practice for companies to work together with another designer and add that name to the trademark when promoting the collaboration. Given that the contested sign reproduces ALEX, it is highly conceivable that the relevant consumers, when encountering the trademarks in the context of identical goods, may perceive the contested sign as a variation or newer version of the earlier trademark or an indication of a collaboration and be led to believe that the goods in question come from the same undertaking or economically linked undertakings. It is highly conceivable that the relevant consumer will perceive the contested sign as a sub-brand, a variation of the earlier trademarks.

13. The addition in the contested sign of the expression 'by Alexandra Van Remortel' is insufficient to exclude a likelihood of confusion, as the coinciding element ALEX retains an independent and distinctive role in the contested sign.

14. Opponent concludes that there exists a likelihood of confusion and requests the Office to declare the opposition valid, to refuse the contested sign and to order the defendant to bear the costs of the proceedings.

15. On the request of defendant opponent filed proof of genuine use of the invoked European registration (Annexes 1-12).

B. Defendant's arguments

16. Defendant starts by explaining that the evidence of use submitted by the opponent is insufficient to prove genuine use of the European trademark registration.

17. In response to opponent's arguments on likelihood of confusion defendant argues that the comparison of the goods involved should only take into account the part of the goods for which the opponent was able to prove genuine use.

18. Regarding the comparison of the signs defendant acknowledges that the signs coincide visually in the word element ALEX. However, the International Registration is written in a specific font in uppercase letters and comes after a striking figurative element that resembles a double mirrored A. The contested sign is written in lowercase letters in a highly stylized font, which is completely different from the font of the International Registration and is supplemented by the name of defendant 'by Alexandra Van Remortel'. This makes the signs visually dissimilar overall, in spite of the fact that they share the word ALEX. In support of this defendant refers to several decisions in which signs were considered visually dissimilar because the word in the figurative mark was highly stylized.

19. The signs are aurally dissimilar overall because the earlier trademarks are pronounced as one word consisting of two syllables with the emphasis on the first syllable, while the contested sign will be pronounced as five words consisting of 11 syllables with a very different rhythm and intonation.

20. A name as such does not convey any particular concept beyond the fact that it is a name. This means that a conceptual comparison is not possible. In any event, the element 'by Alexandra Van Remortel' in the contested sign is likely to accentuate the conceptual difference between the signs at issue, since the relevant public will perceive that element as an indication of origin of the goods at issue. The fact that ALEX has a greater size in relation to the word elements 'by Alexandra Van Remortel' does not necessarily make it the dominant element. Indeed, the word elements 'by Alexandra Van Remortel' refer to the designer and source of her products, which is likely to play a more important role for the relevant public and will be perceived as the mark of the house, whilst the element ALEX will be perceived as the sign identifying a particular line of goods or services amongst a wider range of goods and services offered by the defendant. Therefore, the conflicting signs in their overall impression are to be considered as dissimilar.

21. According to defendant the trademarks invoked are distinctive to a (very) low degree. Defendant mentions that in the EU there are more than 800 active registrations in class 25 of trademarks that consist of, or include, the word element ALEX. Also in the market, there are many fashion brands containing the word ALEX that co-exist peacefully in the market.

22. According to defendant, the level of attention of the relevant public is average.

23. Defendant also refers to case law stating that whenever two signs share the same first name and one of them also contains a surname, in general, there will be no likelihood of confusion. In the case at hand consumers will merely see the earlier marks as a very common name and the contested sign as

referring to a specific person. The word elements 'by Alexandra Van Remortel' are likely to play a more important role for the relevant public in spite of their smaller size and lower position in relation to the word ALEX.

24. Defendant concludes that the differences between the signs taken as a whole are substantial enough to safely exclude a likelihood of confusion in spite of the identity or high similarity of the goods. Defendant argues that the signs can coexist peacefully in the market.

25. In view of the foregoing the defendant requests the Office to declare the opposition unfounded, approve the contested sign for all goods in class 25 and to order opponent to pay the costs.

III. DECISION

A. Likelihood of confusion

26. 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.

27. 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

28. 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

29. 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.³

30. For reasons of procedural economy, the Office will first will assess the opposition on the basis of the International registration.

Comparison of the signs

31. 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

¹ 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.

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 and the case-law mentioned there (Equivalenza).

role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.⁴

32. 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.⁵ 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.⁶

33. The assessment of the similarity between the signs, regarding the visual, aural 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.

34. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

Visual comparison

35. The International registration invoked is a combined word-/figurative trademark consisting of the word ALEX in bold black stylized letters, with a figurative element of a black circle containing mirrored white letters A in front of it.

36. The contested sign is also a combined word-/figurative trademark consisting of the word ALEX in bold black stylized letters with the caption 'by Alexandra Van Remortel' underneath in smaller black stylized letters.

37. Where a sign 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.⁷ In this case, the figurative elements in the signs will not go unnoticed to the average customer. However due to the position and size, the attention of the public will particularly be focused on the word

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

⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

⁶ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) and 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

⁷ General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 and the case-law mentioned there (Smarter Travel).

ALEX in both signs. In the opinion of the Office the consumer will pay less attention to the caption 'by Alexandra Van Remortel' in the contested sign given the smaller font and the position of these word elements.

38. The dominant element ALEX in both signs is identical. In addition the element ALEX is in both signs shown in black bold letters. Other than that, the signs are different.

39. Based on the above the Office is of the opinion that the signs are visually similar to a high degree.

Phonetic comparison

40. The International registration invoked consists of one word of two syllables (A-LEX).

41. The contested sign will also be pronounced as one word of two syllables (A-LEX). In the Office's view the caption 'by Alexandra Van Remortel' will not be pronounced, because the average consumer will tend to abbreviate the sign given the length of it.⁸

42. Given the above the Office is of the opinion that the signs are aurally identical.

Conceptual comparison

43. In the opinion of the Office, the relevant Benelux public will recognize the common first name ALEX in both signs. In principle, however, a name has no specific meaning. This is different only if the name in question has become a conceptual symbol, for example due to the familiarity of the character bearing that name, or if the name in question has a clear and immediately recognizable semantic content.⁹ That situation does not occur in this case. Also the caption 'by Alexandra Van Remortel' in the contested sign nor the figurative element in the International registration have a clear meaning.

44. Given the above the Office is of the opinion that a conceptual comparison is not possible.

Conclusion

45. The signs are visually similar to a high degree and aurally identical. A conceptual comparison is not possible.

Comparison of the goods and services

46. 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.¹⁰

47. 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.¹¹

48. The goods to be compared are the following:

⁸ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 95 (Equivalenza).

⁹ General Court (EU) 27 juni 2019, T-268/18, ECLI:EU:T:2019:452, points 85-90 (Luciano Sandrone) and 18 June 2021, T-386/20, ECLI:EU:T:2021:372, point 54 (Miley Cyrus).

¹⁰ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹¹ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

Opposition based on:	Opposition directed against:
Cl. 9 Swimming goggles	
Cl. 24 Towels; Bath towels; washcloths.	
Cl. 25 Clothing, in particular sports and functional clothing; Footwear; headgear.	Cl. 25 Swimwear; beachwear; clothing; sportswear; underwear; nightwear; footwear; headgear.
Cl. 28 Pieces of sports equipment; Sports articles and equipment.	

49. The "clothing", "footwear" and "headgear" for which the contested sign is applied for in class 25 are identical to the "Clothing", "Footwear" and "headgear" for which the International registration is registered in class 25.

50. The "Swimwear", "beachwear", "sportswear", "underwear" and "nightwear" of the contested sign in class 25 are part of the more general category covered by the International registration in class 25, namely "clothing, in particular sports and functional clothing". The goods are thus considered to be identical.¹²

Conclusion

51. The goods are identical.

Global assessment

52. 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 goods involved are aimed at the public at large for which the level of attention is deemed to be normal.

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).

53. 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.¹⁴ In the present case the International registration of the combined word/figurative 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.

54. 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.¹⁵

55. In this case the signs are visually similar to a high degree. Aurally the signs are identical. 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. Since it is common in the clothing sector for the same mark to be configured in various ways, the relevant public might also believe that the contested sign is a sub-brand of opponent.¹⁶

Other factors

56. Defendant refers to case-law in similar cases that should be followed in the present proceedings (see paragraphs 18 and 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.

57. Defendant argues that there are many fashion brands containing the word ALEX that co-exist peacefully in the market (see paragraph 21). To the extent defendant intends to argue that this removes any likelihood of confusion, the Office notes that it is true that it is not impossible that such co-existence may possibly reduce the likelihood of confusion. Nevertheless, such a situation can be taken into consideration only if, at the very least, during the proceedings before the Office, the defendant has duly shown that that co-existence was based on an absence of likelihood of confusion in the mind of the relevant public between the other fashion brands containing the word ALEX and the trademarks invoked and that the trademarks are identical.¹⁷ In the present case, such evidence has not been provided.

B. Conclusion

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

59. Since the opposition is justified based on likelihood of confusion in respect of the International registration, the Office does not need to carry out an assessment on the basis of the European registration. Therefore, it also does not have to assess the proof of use filed with respect to the European registration.

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).

¹⁶ General Court (EU) 6 October 2004, T-117/03 up to and including T-119/03 and T-171/03, ECLI:EU:T:2004:293, point 51 (NLSPORT).

¹⁷ General Court (EU) 20 January 2010, T-460/07, ECLI:EU:T:2010:18, point 68 (LIFE BLOG) and 7 November 2007, T-57/06, ECLI:EU:T:2007:333, point 97 and the case-law mentioned there (Top iX).

IV. CONSEQUENCE

60. The opposition with number 2017589 is justified.

61. The Benelux application with number 1449838 will not be registered.

62. 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, 20 February 2023



Marjolein Bronneman
(*rapporteur*)

Tineke Van Hoey

Pieter Veeze

Administrative officer: Vincent Munier