



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018065
of 25 July 2023

Opponent: **Aktieselskabet af 21. november 2001**
Fredskovvej 5
7330 Brande
Denmark

Representative: **Arnold + Siedsma (Amsterdam)**
Postbus 71720
1008 DE Amsterdam
Netherlands

Invoked trademark: **Benelux trademark registration 891342**

PIECES

against

Defendant: **Teni Dilara Yasar**
1.AKASYA SK. NO:15 K.5
0000 ÇATI KATI BESYOL Küçükçekmece Istanbul
Turkey

Representative: **ATLAN & BOKSENBAUM AVOCATS**
Rue Saint Didier 5
75116 Paris
France

Contested sign: **Benelux trademark application 1461761**

fifty
PIECES

I. FACTS AND PROCEEDINGS**A. Facts**

1. On 23 March 2022, the defendant filed an application for a trademark in the Benelux for the



combined/figurative mark , for goods and services in classes 25 and 35. This application was processed under the number 1461761 and was published on 25 March 2022.

2. On 18 May 2022 the opponent filed an opposition against the registration of the application. The opposition is based on Benelux registration 891342 of the word mark PIECES, filed on 23 November 2010 and registered on 10 February 2011 for goods and services in classes 9, 14, 18, 25 and 35.

3. According to the register the opponent is the actual holder of the trademark invoked.

4. The opposition is directed against all goods and services covered by the contested application and is based on all goods and services of the trademark 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 18 May 2022. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. The defendant did not respond to the proof of use 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 1 February 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 signs are highly similar because both contain the word PIECES, which is the only, and therefore the dominant, element in the trademark invoked. The opponent states that the contested sign consists of the verbal elements FIFTY PIECES, wherein FIFTY is depicted in a different font than PIECES. According to the opponent, the first element in the contested sign is not more dominant than the second element. Furthermore, the element FIFTY is inferior to the element PIECES, because it serves as a quantifying adjective which gives more information about the noun, in this case a defined number of

fifty pieces. The opponent also argues that the meaning of the word 'pieces' will be understood by the majority of the relevant public and both signs therefore evoke the concept of a number of pieces or articles.

9. In the light of the above, the opponent states that the signs are visually, aurally and conceptually similar.

10. The opponent further argues that the products of the PIECES brand are sold all over the Benelux and beyond. The opponent has several stores and also sells his products through online retailers such as Zalando. Therefore, the trademark invoked is well-known in the Benelux and the European Union and enjoys enhanced distinctiveness. According to the opponent, due to the well-known reputation of the prior mark, consumers are more likely to get confused in the present case.

11. With regard to the comparison of goods and services, the opponent states that the goods in class 25 are identical. According to the opponent, the term '*retail and wholesale services*' mentioned in class 35 of the contested sign is considered vague. The opponent additionally states that the services in class 35 of the trademark invoked also refer to retail services and for this reason, these services are identical.

12. Furthermore, the services '*provision of an online marketplace for buyers and sellers of goods and services*' are similar to the opponent's services mentioned in class 35, because they may target the same public and share the same purpose. The contested '*organization of exhibitions and trade fairs for commercial or advertising purposes*' are also similar to the prior services in class 35, because the contested services may also include retail services. According to the opponent, the remaining services in class 35 are all identical and similar to the goods and services of the trademark invoked because they are targeted towards the same consumers and they share the same purpose.

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.

14. At the request of the defendant, the opponent submits proof of use.

B. Defendant's arguments

15. The defendant states that it is not contested that the goods in class 25 are identical and that the services in class 35 are or could be similar or complementary.

16. According to the defendant, the two signs contain the element 'PIECES' which the relevant public will understand as parts of things, bits or pieces. The defendant argues that the meaning of the word 'pieces' has a close relationship with the relevant goods and services. For this reason, it cannot be said that it has a normal distinctive character. Due to the strong connection with the goods and services, this element is allusive and weakly distinctive.

17. The defendant states that the public will clearly focus on the beginning of the sign when they encounter trademarks. Therefore, the element 'fifty' will catch the eye immediately, also because it is the most distinctive element, and because it is stylized and much bigger depicted than the word 'pieces'.

18. The element 'fifty' ensures that both signs show strong differences. Conceptually, this element refers to an arbitrary number, unexpected, original and meaningful.

19. In the light of the above, the defendant argues that the signs are visually, aurally and conceptually only similar to a low degree.

20. However, due to the allusive, weak distinctive character of the trademark invoked and possibly even descriptive nature and the high level of attention paid by the public, the defendant states that there is no likelihood of confusion.

21. The defendant requests that the Office rejects the opposition, registers the contested sign and orders the opponent to pay the costs.

22. The defendant does not respond to the proof of use submitted by the opponent.

III. DECISION

A.1 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. Given that the trademark invoked was registered over five years prior to the contested trademark's filing date, the defendant's request that proof of use is submitted is legitimate.

24. The defendant however did not respond to the proof of use submitted by the opponent. The Office will therefore not assess the proof of use. According to Rule 1.25(4) IR, the defendant may withdraw his request to provide proof of use or deem the evidence provided as adequate. In addition, Rule 1.21(d) IR provides that "facts to which the other party did not respond will be deemed as undisputed". The Office is of the view that, as the defendant has not addressed the proof of use submitted, the parties apparently agree that the trademark invoked has been put to genuine use.

A.2 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.*"¹

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.²

28. 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,

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).

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

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.⁴

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.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

31. 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.

32. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
PIECES	

Conceptual comparison

33. The word 'pieces' is part of the basic vocabulary of the English language and will undoubtedly be understood by the Benelux public as the plural form of the word 'piece', which means 'a part of something', as also argued by both parties (see paragraphs 8 and 16).

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

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) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

34. The contested sign also mentions a specific number of pieces, namely 'fifty'. However, this does not alter the overall conceptual similarity of the signs, since the meaning of the word 'pieces' is not changed by the addition of the number 'fifty'.

35. As both signs clearly refer to the concept 'pieces', the Office finds that the signs are conceptually similar.

Visual comparison

36. The trademark invoked is a purely verbal sign, that consists of one word of six letters: 'PIECES'. The contested sign is a combined word/figurative sign, containing two word elements: 'FIFTY PIECES'. The word 'fifty' is placed above the word 'pieces' and is displayed in a stylized font.

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 public will only perceive the stylization of the word 'fifty' as decoration. For this reason, the attention of the public will be focused on both word elements.

38. Both signs contain the word 'PIECES' and this means that the trademark invoked is entirely incorporated in the contested sign. On the other hand, the contested sign contains the word 'fifty' at the beginning, which is the part to which the public will pay most attention.⁸ However, the Office finds that the word 'PIECES' in the contested sign will not be overlooked by the public, because its presence stands out enough visually and the words 'fifty' and 'pieces' are connected, because the number 'fifty' refers to the next word 'pieces' (see paragraph 34).

39. In the light of above, the Office considers that trademark and sign are visually similar.

Phonetic comparison

40. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level.⁹

41. The trademark invoked consists of two syllables: PIE-CES and the contested sign consists of four syllables: FIF-TY-PIE-CES.

42. The two syllables of the trademark invoked and the last two syllables of the contested sign are pronounced identically. The signs differ in the pronunciation of the word 'fifty', which is the first part of the contested sign.

43. Although the public will pay more attention to the first part of a sign, the Office finds that due to the identical pronunciation of the word 'pieces', which word does not play a secondary role (see paragraphs 34 and 38) the signs are phonetically similar.

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).

⁸ General Court EU 17 March 2004, T-183/02 en T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

⁹ General Court (EU) 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

Conclusion

44. The trademark invoked and the contested sign are conceptually, visually and aurally similar.

Comparison of the goods and services

45. 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

46. 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

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

Opposition based on:	Opposition directed against:
CI 9 Spectacles; Spectacle frames; Sunglasses and spectacle cases. <i>Brillen, brilmonturen, brillen met getint glas, zonnebrillen en brillenkokers.</i>	
CI 14 Jewellery of precious metal and gemstones; Paste jewellery; cuff links; tie pins; gemstones; paste gemstones, Chronoscopes; Time instruments; Key rings. <i>Juwelierswaren van edelmetaal en stenen; imitatie juwelierswaren; manchetknopen; dasspelden; edelstenen; imitatiestenen (bijouterieën); horloges; uurwerken; sleutelhangers.</i>	
CI 18 Boxes made of leather; sacks (covers, sleeves) made of leather, for packaging; trunks, suitcases, travel bags, travel sets, clothes bags (travel bags), beauty cases (empty), rucksacks, satchels, handbags, beach bags, shopping bags, shoulder bags, school bags, suitcases for clothes, canvas travelling bags, suitcases and travel bags (luggage), attaché cases, leather cases, briefcases Belts of leather; belts of imitation leather; purses, wallets, key holders and card holders of leather (wallets); umbrellas, sunshades, walking sticks, seat sticks.	

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).

<p><i>Dozen van leder; zakken (omslagen, hoezen) van leder, voor verpakking; handkoffers, koffers, reistassen, reissets (reistassen), kledinghoezen (reistassen), beauty cases (leeg), rugzakken, tassen, handtassen, strandtassen, boodschappentassen, schoudertassen, schooltassen, koffers voor kleding, reistassen van canvas, koffers en reistassen (bagage), attachékoffers, lederen koffers, aktetassen; riemen van leer; riemen van imitatieleer; beurzen, portefeuilles, portemonnees, sleuteletuis, kaartenhouders van leder (portefeuelles); paraplu's, parasols, wandelstokken, zitstokken.</i></p>	
<p>CI 25 Clothing, footwear and headgear. <i>Kledingstukken, schoeisel en hoofddeksels.</i></p>	<p>CI 25 Clothing; Underwear; Outerclotthing; Socks; Mufflers; Shawls; bandanas; scarves; belts [clothing]; Footwear; Shoes; Slippers; Sandals; Headgear; hats; caps with visors; berets; caps [headwear]; skull caps.</p>
<p>CI 35 The bringing together of a wide range of goods (excluding their transport), namely perfumery, essential oils, cosmetics, hair preparations and treatments, skin care and personal care products, namely beauty care preparations, soaps, deodorants and antiperspirants, hair removal and shaving preparations, dentifrices, makeup, nail polish, spectacles, spectacle frames, tinted lenses for spectacles and sunglasses, spectacle cases, flip covers and covers for tablets, flip covers and covers for smart phones, sleeves, bags and covers for laptops, covers for portable media players, holders, straps and cases for mobile phones, jewellery of precious metal and alloys of precious metal, imitation jewellery, cuff links, tiepins, precious stones and imitation stones, watches, clocks, jewellery boxes, boxes of leather, envelopes of leather for packaging, trunks, valises, traveling bags, traveling sets, garment bags for travel, vanity cases, rucksacks, bags, handbags, beach bags, shopping bags, shoulder bags, school bags, bags for sports, suit cases, canvas traveling sack, luggage, attaché-cases, leather cases, briefcases, pouches, pocket wallets, purses, key-holders, leather card holders, umbrellas, parasols, canes, walking-stick seats, clothing, footwear, headgear, hair ornaments, hair bands, hair fastening articles, false hair, hair</p>	<p>CI 35 Advertising; Marketing; public relations; organization of exhibitions and trade fairs for commercial or advertising purposes; Design of advertising materials; provision of an online marketplace for buyers and sellers of goods and services; Office functions; secretarial services; rental of office machines; systemization of information into computer databases; telephone answering for unavailable subscribers; business management; business administration; business consultancy; accounting; commercial consultancy services; personnel recruitment; personnel placement; employment agencies; import-export agencies; temporary personnel placement services; Auctioneering; Retail and wholesale services; Arranging newspaper subscriptions for others; Compilation of statistics.</p>

grips, hair barrettes, hair scrunchies, hair pins and clips, so that customers can easily view and buy those goods, either in shops and wholesalers or through electronic media.

Het samenbrengen van een breed scala aan goederen (uitgezonderd het transport ervan), namelijk parfumerieën, etherische oliën, cosmetische middelen, haarpreparaten en -behandelingen, huidverzorgings- en persoonlijke verzorgingsproducten, te weten preparaten voor schoonheidsverzorging, zepen, deodorantia en antitranspiratiemiddelen, middelen voor het verwijderen en scheren van het haar, tandreinigingsmiddelen, make-up, nagellak, brillen, brilmonturen, getinte lenzen voor brillen en zonnebrillen, zonnebrillen, brillenkokers, flipcovers en hoesjes voor tablets, flipcovers en hoesjes voor smartphones, hoezen, tassen en hoesjes voor laptops, hoesjes voor draagbare mediaspelers, houders, riemen en hoesjes voor mobiele telefoons, juwelen van edele metalen en legeringen van edele metalen, imitatiejuwelen, manchetknopen, dasspelden, edelstenen en imitatiestenen, horloges, klokken, juwelenkistjes, dozen van leer, enveloppen van leder voor verpakking, koffers, koffers, reistassen, reissets, kledingstukken reistassen, toilettassen, rugzakken, tassen, handtassen, strandtassen, boodschappentassen, schoudertassen, schooltassen, sporttassen, koffers, canvas reistassen, bagage, attachékoffers, leren etuis, aktetassen, buidels, zakportefeuilles, portemonnees, sleutelhouders, leren kaarthouders, paraplu's, parasols, wandelstokken, wandelstokstoelen, kledingstukken, schoeisel, hoofddeksels, haarversieringen, haarbanden, artikelen voor het vastmaken van haar, kunsthaar, haarklemmen, haarspeldjes, haarscrunchies, haarspelden en -clips, zodat klanten die goederen gemakkelijk kunnen bekijken en kopen, in winkels en groothandels of via elektronische media.

<p><i>N.B. The original classification language of the trademark invoked is Dutch. The translation has been added solely to improve the readability of the decision.</i></p>	
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48. Having regard to the principle of hearing both sides, opposition proceedings are limited to the arguments, facts and evidence put forward by the parties.¹² The defendant explicitly states not to dispute that the goods in class 25 are identical and the services in class 35 are similar (see paragraph 15). The identity or similarity of the goods and services in question is thus clearly *in confesso*, so that the Office need not examine it further.

Global assessment

49. 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 covered are aimed at the public at large for which the level of attention is deemed to be normal.

50. The more distinctive the earlier trademark, the greater the risk 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 less distinctive character.¹⁴

51. In this context, the defendant argues that the word 'pieces' is not distinctive. The Office is of the opinion that even though the term 'pieces' could refer to items of clothing, it is at most strongly allusive, but not necessarily devoid of any distinctive character. Furthermore, the opponent has stated and substantiated that the trademark invoked is well-known in the Benelux and therefore enjoys enhanced distinctiveness (see paragraph 10). This argument has not been disputed by the defendant and therefore the Office establishes that the trademark invoked, at the very least, has a normal distinctiveness.

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 In this case, the identity and similarity of the goods and services has not been disputed. Furthermore, the signs are conceptually, visually and aurally similar. 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 disputed sign is a sub-brand of the opponent.¹⁶

53. On the basis of these factors 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

¹² Article 2.16 (1) BCIP and Rule 1.21 IR.

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

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 to T 119/03 and T 171/03, ECLI:EU:T:2004:293, point 51 (New Look).

may believe that the goods and services designated by the trademark invoked and the goods and services against which the opposition is directed originate from the same undertaking or, as the case may be, from undertakings which are economically linked.

B. Conclusion

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

IV. CONSEQUENCE

55. The opposition with number 2018065 is justified.

56. The Benelux application with number 1461761 will be not registered.

57. 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, 25 July 2023



Eline Schiebroek
(*rapporteur*)

Camille Janssen

Pieter Veeze

Administrative officer: Monique Vrolijk