



Benelux Office for  
**Intellectual  
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2018192**  
**of 9 May 2023**

**Opponent:** **Scalpers Fashion, S.L.**  
C/ Isaac Newton n° 4, 6ª planta, Pabellón de Italia  
41092 Sevilla  
Spain

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

**Invoked trademark:** **EU trademark registration 015249345**



*against*

**Defendant:** **Dincer Kosovali**  
San Franciscostraat 66-68  
1175 RE Lijnden  
Netherlands

**Contested mark:** **Benelux trademark application 1464125**



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

1. On 9 May 2022 the defendant filed a Benelux trademark application for the combined



word/figurative mark **BONESMEN** for goods in class 25 and services in class 35. This application was processed under number 1464125 and was published on 18 May 2022.

2. On 18 July 2022 the opponent filed an opposition against the registration of the application. The opposition is based on:



- EU trademark registration 015249345 of the combined word/figurative mark filed on 21 March 2016 and registered on 6 September 2016 for goods in classes 9, 14, 18 and 25 and services in class 35.

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

4. The opposition is directed against all the goods and services covered by the contested application and is based on all of the goods and services covered by 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" or "BOIP") to the parties on 19 July 2022. During the administrative phase of the proceedings both parties filed arguments. 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 13 December 2022.

**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 starts by stating that the invoked trademark has been genuinely used and has a reputation and therefore enjoys a broader scope of protection. To this end the opponent submits a distribution agreement with the Benelux distributor, invoices to the Benelux distributor, invoices relating to sales through opponent's web shop to consumers in the Benelux, a summary of the sales through

opponent's web shop to consumers in the Benelux, prints from (social) networks, certificate from the 'National Association for the Defence of Trademarks', Well-known brand certificate from 'Leading Brands of Spain Forum' and a Certificate of brand recognition by the Chamber of Commerce of Seville as evidence.

9. The opponent argues that the invoked trademark was born in 2007, has become a benchmark in the sector and is a well-known fashion brand. The invoked trademark is characterized by its spirit of rebellion and symbolized the spirit of doing things differently.

10. According to the opponent the evidence shows that the invoked trademark has been genuinely used in the relevant period for the relevant goods and services. The evidence also shows that due to years of intensive and consistent use the invoked trademark enjoys a well-known status and reputation in the Benelux. Therefore, the mark enjoys a broader scope of protection.

11. In his arguments the opponent compares a selection of goods from class 25 of the invoked trademark with all the goods in class 25 of the contested sign and compares a selection of services from class 35 of the invoked trademark with all the services in class 35 of the contested sign.

12. Because the goods and services are identically contained in both lists, or because the opponent's goods and services include, are included in, or overlap with the contested goods and services, the relevant goods and services are identical or highly similar, according to the opponent.

13. The visual similarity between the signs is well above average. The skull and bones in the signs are very similar. Both signs include a verbal element below the graphic element. The font is very close, especially with regard to the letter 'S' and 'E', according to the opponent.

14. With respect to the phonetic comparison the opponent argues that the pronunciation of the verbal elements in the respective signs differ.

15. Two signs are deemed to be conceptually similar when they evoke the same idea or concept, according to the opponent. Both signs include a fanciful verbal element combined with very similar graphical representations of a skull and bones.

16. With regard to the comparison of the signs the opponent concludes that the similarity between the signs is well above average.

17. With regard to the relevant public and the degree of attention the opponent states that the relevant goods and services are directed at the public at large and the level of attention is average. An average degree of attention leads to an earlier finding of a likelihood of confusion.

18. As to the distinctiveness of the earlier mark, the opponent states that the signs have no meaning for any of the goods or services in question. The opponent also argues that the invoked trademark has obtained a reputation and well-known status and that consequently the distinctive power has only grown further. The invoked trademark enjoys a broader scope of protection.

19. The opponent concludes that a likelihood of confusion on the part of the public is evident. The opponent requests that the contested sign is refused in its entirety and requests an award of costs on the basis of the maximum rate.

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

20. The defendant starts by assessing the distinctiveness of the invoked trademark and notes that the word element 'SCALPERS' means "to cut or to tear the scalp from" and has no meaning in relation to the relevant goods and services in classes 25 and 35. The defendant also notes that a skull device is commonly used and can therefore not be dominant. The word element 'SCALPERS' is dominant.

21. That a skull device is commonly used can be easily proven by a short search in the EUIPO trademark register showing 17.974 results containing such a device, according to the defendant.

22. The documents submitted by the opponent do not show that the invoked trademark is well-known, according to the defendant. This claim should therefore be disregarded.

23. The defendant includes a table mentioning a selection of the goods and services from classes 25 and 35 of the invoked trademark and mentioning all the goods and services from the contested sign and states that the goods and services are the same or highly similar.

24. According to the defendant the public perceives the word element more than other elements. The word elements in both signs are distinctive and dominant and are different from each other. Therefore there is not any visual similarity between the signs.

25. The signs are pronounced as 'SKALPERS' and 'BOHNSMEN'. The defendant concludes that there is no phonetic similarity between the signs.

26. With regard to the conceptual comparison the defendant states that 'SCALPERS' means "people who cut or tear the scalp from it" and 'BONESMEN' means "bone men" in English and "goodness" in Basque. The signs have very different meanings and have no similarities.

27. The level of attention of the relevant public should be average, according to the defendant.

28. With regard to the global assessment of likelihood of confusion the defendant argues that since there is no similarity between the signs, except for the goods and services, there can be no likelihood of confusion.

29. In conclusion, the defendant requests the opposition to be rejected and requests that the opponent bears the costs.

### **III. DECISION**

#### **A. Likelihood of confusion**

30. In accordance with article 2.14 (1) BCIP, the applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months following 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.

31. 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.*"<sup>1</sup>

32. 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.<sup>2</sup>

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

### **Comparison of the goods and services**

34. When assessing the similarity of the goods and services in question, all the relevant factors characterising the relationship between them must be taken into account. These include, inter alia, their nature, their end-users, their method of use and whether they are in competition with each other or are complementary.<sup>4</sup>

35. With the comparison of the goods and services of the earlier trademark invoked and the goods and services against which the opposition is filed, the goods and services are considered only on the basis of what is expressed in the register.

36. In his arguments, the opponent compares a selection of goods and services from classes 25 and 35 of the invoked trademark with the goods and services from the contested sign. Below, the Office adopts the selection of goods and services made by the opponent. The selected goods and services are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
CI 25 Ready-made clothing for men, women and children; Topcoats; Gabardines (clothing); Jerseys (clothing); Pullovers; Sweaters	CI 25 Clothing for men, women and children.
CI 35 Advertising; Retailing and wholesaling in shops, via global computer networks, via catalogues, via mail order, via telephone, via radio and television, and via other electronic media of common metals and their alloys, metal building materials, transportable	CI 35 Wholesale services in relation to clothing; Retail services in relation to clothing; Online retail store services in relation to clothing; Retail services connected with the sale of clothing and clothing accessories; Advertising, promotional and public relations services.

<sup>1</sup> Article 2.2ter (1) (b) BCIP implements article 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 article 8 (1) (b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

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

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

<sup>4</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

buildings of metal, materials of metal for railway tracks, non-electric cables and wires of common metal, ironmongery, small items of metal hardware, and pipes and tubes of metal; Retailing and wholesaling in shops, via global computer networks, via catalogues, via mail order, via telephone, via radio and television, and via other electronic media of safes, ores, and scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Retailing and wholesaling in shops, via global computer networks, via catalogues, via mail order, via telephone, via radio and television, and via other electronic media of apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, and magnetic data carriers; Retailing and wholesaling in shops, via global computer networks, via catalogues, via mail order, via telephone, via radio and television, and via other electronic media of recording discs, compact discs, DVDs and other digital recording media, mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment, computers, computer software and fire-extinguishing apparatus; Retailing and wholesaling in shops, via global computer networks, via catalogues, via mail order, via telephone, via radio and television, and via other electronic media of paper and cardboard, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paintbrushes, typewriters and office requisites (except furniture); Retailing and wholesaling in shops, via global computer networks, via catalogues, via mail order, via telephone, via radio and television, and via other electronic media of instructional and teaching material (except apparatus), plastic materials for packaging, printers' type, and printing blocks; Articles of clothing, Footwear, Headgear.

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37. Having regard to the principle of hearing both sides, opposition proceedings are limited to the arguments, facts and evidence put forward by the parties.<sup>5</sup> The opponent argues that all the goods and services from the contested sign are identical or at least similar to a selection of goods and services from the invoked trademark (see point 12), to which the defendant agrees (see point 23). The identity of the goods and services in question is thus manifestly in confesso, so that the Office need not examine it further.



### **Comparison of the signs**

38. 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.<sup>6</sup>

39. While the comparison must be based on the overall impression left by the signs in the memory of the relevant public, it must nevertheless be made in the light of the intrinsic qualities of the conflicting signs.<sup>7</sup> The overall impression created by a composite mark (word and figurative element) in the minds of the relevant public may, in certain circumstances, be dominated by one or more of its components. In assessing whether this is the case, particular account must be taken of the intrinsic qualities of each of those components by comparing them with the qualities of the other components. Moreover, it is possible to consider how the various components in the configuration of the composite mark relate to one other.<sup>8</sup>

40. In short, as regards the visual, phonetic and conceptual similarity of the marks, the assessment of their similarity should be based on the overall impression created by the marks, taking into account, inter alia, their distinctive and dominant components.

41. The signs to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
	

### *Visual comparison*

<sup>5</sup> Article 2.16 (1) BCIP and rule 1.21 IR.

<sup>6</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

<sup>7</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

<sup>8</sup> EGC 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).

42. The invoked mark is a combined word/figurative mark consisting of the word element 'SCALPERS' and above it a figurative element being a skull and two crossbones, crossing at the level of the upper half of the bones. Both the word and figurative elements are in the colour dark blue.

43. The contested sign is also a combined word/figurative mark consisting of the word element 'BONESMEN' and above it a figurative element being a skull with slightly visible brow ridges and two crossbones, crossing halfway the length of the bones. Both the word and figurative elements are in the colour black.

44. Where a trademark consists of both verbal and figurative elements, the former has, in principle, a greater impact on the consumer than the latter. The reason for this is that the public does not always analyse the signs and often refers to the sign by using the word element.<sup>9</sup> However, in the case at hand the figurative elements of the involved signs will not go unnoticed by the average consumer because of its top central position and considerable size.

45. While the signs differ in the word elements 'SCALPERS' and 'BONESMEN', they nonetheless are configured in a similar way and both contain noticeable and almost identical figurative elements being a skull and two crossbones. In addition, the font used in both signs shows similarities. While there are visual differences between the signs, these are not sufficient to detract from the visual similarities between the signs.

46. Consequently, the signs are visually similar.

#### *Phonetic comparison*

47. As regards the phonetic comparison, it must be borne in mind that, strictly speaking, the phonetic representation of a combined word/figurative mark is the same as that of its word elements, irrespective of the graphical characteristics of those components, which are more subject to examination in the context of the visual aspect of the sign.<sup>10</sup>

48. The invoked trademark consists of the word element 'SCALPERS'. The contested sign consists of the word element 'BONESMEN'. The pronunciation of the word elements is different. This is also confirmed by the opponent (see point 14).

49. In view of the foregoing, the Office finds that the signs are phonetically dissimilar.

#### *Conceptual comparison*

50. The English word 'SCALPERS' in the invoked trademark means 'one who removes scalps'. The English word 'BONESMEN' in the contested sign is a contraction of the words 'BONES', meaning 'any of the pieces of hard whitish tissue making up the skeleton in vertebrates', and 'MEN', meaning 'adult male human beings'. According to the defendant 'BONESMEN' also means 'goodness' in Basque (see point 26). In general, Benelux consumers have a good knowledge of the English language.<sup>11</sup> However, the words 'SCALPERS' and 'BONESMEN' as a whole are not necessarily everyday words. Insofar as they are being recognized and there is a connotation, the elements 'scalp' and 'bones' both refer to parts of the skeleton.

<sup>9</sup> EGC 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 (Smarter Travel) and the case-law mentioned there.

<sup>10</sup> EGC 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

<sup>11</sup> BCJ 18 October 2019, C-2018/7, point 45 (THINS).



This is also the case for the figurative elements, being a skull and crossbones, both evoking a similar connotation namely parts of a skeleton.

51. Therefore, the signs are conceptually similar to a certain degree.

#### *Conclusion*

52. In view of the foregoing, the Office considers that the signs are visually similar, phonetically dissimilar and conceptually similar to some degree.

### **B. Global assessment**

53. 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.<sup>12</sup> In the present case, the goods and services covered are, in short, clothes and related retail and wholesale services. Such goods and services are aimed at the public at large, for which the level of attention is deemed to be average. This is also confirmed by the opponent as well as the defendant (see points 17 and 27).

54. 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.<sup>13</sup> The opponent claims that the invoked trademark has acquired enhanced distinctiveness as a consequence of its reputation gained by use (see points 8, 10 and 18). The evidence submitted by the opponent concerning an acquired higher level of distinctiveness do not need to be examined considering that such a finding would not alter the outcome of the decision. Since the invoked trademark as a whole has no meaning for any of the goods and services, its inherent distinctiveness is normal.

55. 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.<sup>14</sup>

56. In this case the signs are visually similar, phonetically dissimilar and conceptually similar to some degree. The identity of goods and services is in confesso. The near identity of the figurative elements is striking and cannot be ignored, causing the overall impression of the signs to be similar. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that there is indeed a likelihood of confusion in the sense that the public may believe that the goods and services designated by the trademark relied on and the goods and services to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically link.

### **B. Other factors**

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<sup>12</sup> CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

<sup>13</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

<sup>14</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 (Equivalenza) and the case-law mentioned there.

57. The opponent argues that the invoked trademark has been genuinely used (see points 8 and 10) and in this respect refers to the same evidence as submitted with regard to the claimed enhanced distinctiveness of the invoked trademark. However, the defendant does not argue the genuine use of the invoked trademark, nor requests proof, nor responds to the submitted proof. Following the above there is no need for the Office to assess the submitted proof to ascertain if the invoked trademark has indeed been put to genuine use.

58. The defendant requests that the opponent bears the costs (see point 29). In an opposition procedure there is no question of the other party being ordered to bear the costs incurred. Only a referral of the costs set at the established opposition fee, in case the opposition is totally justified (or rejected), is provided for.<sup>15</sup>

### **C. Conclusion**

59. Based on the foregoing the Office is of the opinion that there is a likelihood of confusion.

### **IV. DECISION**

60. The opposition with number 2018192 is justified.

61. The Benelux application with number 1464125 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, 9 May 2023



Yvonne Noorlander  
(*rapporteur*)

Pieter Veeze

Eline Schiebroek

Administrative officer: Raphaëlle Gerard

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<sup>15</sup> Article 2.16 (5) BCIP and rule 1.32 (3) IR.