

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018212
of 29 June 2023

Opponent: **BOOLE SERVER S.R.L.**
Via Melchiorre Gioia 112/A
20125 Milano
Italy

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

Invoked trademark 1: EU trademark registration 012728853



Invoked trademark 2: International trademark registration 1577936



against

Defendant: **Booleans B.V.**
Bolgerijsekade 19
4131 NT Vianen
Netherlands

Representative: **Novagraaf Nederland B.V.**
Hoogoorddreef 5
1101 BA Amsterdam
Netherlands

Contested mark: **Benelux trademark application 1465176**




I. FACTS AND PROCEEDINGS

A. Facts

1. On 31 May 2022 the defendant filed a Benelux trademark application for the combined

The logo for BOLEANS features the word "BOLEANS" in a bold, sans-serif font. The letter "O" is stylized with a blue and yellow circular graphic element.

word/figurative mark  true digital security for services in classes 41 and 42. This application was processed under number 1465176 and was published on 1 June 2022.

2. On 29 July 2022 the opponent filed an opposition against the registration of the application. The opposition is based on:



- EU trademark registration 012728853 of the word/figurative mark filed on 26 March 2014 and registered on 6 August 2014 for goods in classes 9 and 16 and services in class 42.
- International trademark registration 1577936, designating the European Union (hereinafter:



“EU”), of the word/figurative mark  boolebox filed on 30 October 2020, with priority date 27 October 2020, and registered on 26 July 2021 for goods in classes 9 and 16 and services in classes 35 and 42.

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

4. The opposition is directed against all the services covered by the contested application and is based on all the goods and services covered by the trademarks invoked. In his arguments, the opponent no longer relies on classes 16 and 35 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” or “BOIP”) to the parties on 1 August 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 24 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 starts by describing the history and activities under the invoked trademarks. The company was founded in 2011 and nowadays operates internationally in more than 25 countries. The opponent has 180 customers and 100.000 users worldwide. The opponent provides data protection services and is making intensive use of the invoked trademarks in Europe.

9. The opponent continues by comparing the goods and services and argues that the services in class 41 of the contested sign are similar and complementary to the goods in class 9 and the services in class 42 of the trademarks invoked. The services in class 42 of the contested sign are identical or at least highly similar to the services in class 42 of the trademarks invoked. Furthermore, the services in class 42 of the contested sign are (highly) similar and complementary to the goods in class 9 of the trademarks invoked, in the view of the opponent.

10. The opponent argues that all signs involved consist of one main word element. The first element "boole-" overlaps. The signs differ in their ending, being "-box", "-ANS" and the non-distinctive figurative elements. The consumer pays more attention to the beginning of a sign. Since the word element should be considered more distinctive, the figurative elements will not divert the consumer's attention from the overlapping word element "boole-". The word element "true digital security" from the contested application merely outlines the services, concerns a slogan to advertise the services, is underneath and is depicted in a smaller font which means that from a visual perspective the attention is mainly drawn to the upper and larger part "BOOLEANS" of the contested application. In oppositions at EUIPO where the first five letters were the same, one being an opposition against "BOOLE+", the signs were found to be visually similar. The opponent argues that these cases also apply to the current opposition and concludes that the involved signs are visually similar to a high degree.

11. The meaning of figurative elements is subject only to a visual and conceptual assessment. The phonetic comparison solely relies on the word elements, according to the opponent. The first five letters "boole-" will be pronounced identical or highly similar for both signs. The signs only differ in the sound of the last three letters, namely "-box" and "-ANS". The impact of these additional letters is of less relevance because the relevant public will focus on the first part of the signs. The slogan "true digital security" slogan does not detract from the above, considering the subsidiary character of this element. The opponent argues that the signs are phonetically similar to a high degree.

12. Since the words "boole", "boolebox" or "BOOLEANS" have no meaning, a conceptual comparison is not possible in the view of the opponent.

13. The goods and services in classes 9, 41 and 42 are directed at the public at large and at business customers with specific professional knowledge or expertise. In such case the likelihood of confusion must be assessed solely from the point of view of the general public. The opponent concludes that the level of attention may vary between average and higher than average, depending on the price, specialized nature or terms and conditions of the goods and services purchased.

14. The opponent claims an enhanced distinctiveness of the trademarks invoked and to this end submits evidence to show enhanced distinctiveness through extensive use.

15. According to the opponent the trademarks invoked are at least inherently distinctive in relation to the goods and services in classes 9 and 42. The word element "boole-" is not descriptive. Neither are any of the word elements associative or suggestive. In so far as the marks would allude to the goods and services, it is in any case so implicit that an additional mental step is required.

16. The opponent concludes that the signs may give rise to a likelihood of confusion. The opponent requests the office to declare the opposition well-founded, to refuse the registration of the application for all services and to order the defendant to pay the costs in accordance with Article 2.16 (5) BCIP.

B. Defendant's arguments

17. The defendant starts by providing some background information. The defendant was founded in February 2018 and has evolved into full-service digital security offering. The involved signs have been peacefully coexisting for five years already. An extract from the Dutch Chamber of Commerce concerning "Booleans B.V." has been submitted by the defendant.

18. Subsequently, the defendant comments on the evidence submitted by the opponent and starts by mentioning that the relevant period regarding evidence of use is between 31 May 2017 and 1 June 2022. Part of the evidence relates to signs not being the invoked trademarks, concern internal documents, is incomplete and/or undated and/or unsigned, is outside the relevant period or is not in the language of the proceedings. Parts of the submitted evidence should not be taken into account, according to the defendant.

19. The decision of EUIPO in the opposition against "BOOLE+" cannot be taken into account because it concerns a completely different case, according to the defendant.

20. The opposition cases from EUIPO, cited by the opponent, where the first five letters were the same, cannot be taken into account in the view of the defendant since they are all related to word marks and one stylized mark. Therefore these cases cannot be compared with the current opposition.

21. With regard to the visual comparison the defendant is of the opinion that the signs differ because the device elements are very different. The defendant concludes that the signs are visually different.

22. The defendant argues that, with regard to the phonetic comparison, the invoked trademarks have two syllables being "boole-box" and the contested sign has three syllables being "BOO-LE-ANS". Therefore the signs are phonetically different.

23. The defendant copies the statement of opponent that "the signs have no meaning and therefore a conceptual comparison is not possible".

24. The defendant states that he does not make an assessment on the similarity of the goods and services, since he is of the opinion that the signs are dissimilar.

25. In the view of the defendant, the opponent did not sufficiently prove that the invoked trademarks have acquired enhanced distinctiveness.

26. As the goods and services can be used for both professional and normal public, there is a low or, at large, medium level of attention in the opinion of the defendant.

27. The defendant concludes that the signs can be clearly distinguished and that their co-existence will not cause confusion. The contested sign should be fully accepted and the opponent should be ordered to pay the costs.

III. DECISION

A Likelihood of confusion

28. 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.

29. 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

30. 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

31. 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.³

Comparison of the signs

32. 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

¹ 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.

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 (Equivalenza) and the case-law mentioned there.



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

33. 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.⁵ 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.⁶

34. 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.

35. For reasons of procedural economy, the Office will continue by assessing the opposition on the basis of the second trademark invoked, namely International trademark registration 1577936, and has included this trademark in the overview below.

36. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

Visual comparison

37. The second invoked trademark concerns a combined word/figurative mark consisting of a device being a black circle with a white letter 'b' in the middle. The loop inside the letter 'b' is shaped as a keyhole in the colour black. Depicted underneath the device is the word element "boolebox" counting 8 letters.

38. The contested sign also concerns a combined word/figurative mark, consisting of the word element "BOOLEANS" containing two stylized letters 'o', one in the colour blue and one in the colour orange shaped as conversation clouds that interlock.

39. Where a sign 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 analyze the signs and often refers to the sign by using the verbal element.⁷ The figurative elements in the involved signs will however not go unnoticed because of their position at the top of the sign and their reasonable size. Nonetheless, the Office is of the view that the relevant public will perceive the word elements as being the dominant elements, making up the majority of the signs, with less attention being paid to the subtitle "true digital security" due to its smaller font and position at the bottom of the contested sign.

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); General Court (EU) 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 (Smarter Travel) and the case-law mentioned there.

40. The dominant words "boolebox" and "BOOLEANS" coincide in the first five letters "boole-", resulting in a certain degree of visual similarity of the signs as a whole.

Phonetic comparison

41. 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 aspects of the sign.⁸

42. As far as oral representation is concerned, given its subordinate position and small font, the text "true digital security" in the contested sign will be understood by the public as a subtitle and as such will not be involved in the pronunciation⁹. Also, a trademark consisting of several elements will generally be shortened to something easy to pronounce.¹⁰ The stylized letter 'b' on the top of the second invoked trademark is also unlikely to be pronounced, as it is a graphic representation of the first letter of the dominant element "boolebox". The first elements of the signs involved are practically identical. Taking the aforementioned into consideration, the Office finds that on a phonetic level, the signs are similar to a certain degree.

Conceptual comparison

43. The signs have no meaning, as also argued by both parties, following which a conceptual comparison cannot be made.

44. Thus, the Office concludes that a conceptual comparison cannot be made.

Conclusion

45. In view of the foregoing, the Office considers that the signs are visually and phonetically similar to a certain degree and that a conceptual comparison cannot be made.

Comparison of the goods and services

46. When assessing the similarity of the goods and services, all 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.¹¹

47. When 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.¹²

48. In the comparison of goods and services the opponent did not include the goods from class 16 nor services from class 35 of the invoked trademarks. The Office takes this as a limitation of the goods and

⁸ General Court (EU) 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

⁹ General Court (EU) 11 November 2009, T-162/08, ECLI:EU:T:2009:432, point 49 (GREEN by missako).

¹⁰ General Court (EU) 30 November 2006, T-43/05, ECLI:EU:T:2006:370, point 68 (Brothers by Camper).

¹¹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹² General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

services on which the opposition is based.¹³ These two classes are therefore not included in the table below and are not included in the following comparison of goods and services.

49. Having regard to the principle of hearing both sides, opposition proceedings are limited to the arguments, facts and evidence put forward by the parties.¹⁴

50. As a result, the goods and services to be compared are:

Opposition based on:	Opposition directed against:
<p>International trademark registration 1577936</p> <p>CI 9 Encoded key cards; laptop computers; data processing equipment; computers; interfaces for computers; calculating machines; computer operating programs, recorded; computer programs [downloadable software]; computer software; computer software for use in accessing, updating, manipulating, modifying, organizing, storing, synchronizing, transmitting and sharing data, documents, images, audio, video, multimedia content, electronic publications and other computer software; electronic devices that synchronize, replicate, store, back up and/or share data and information including but not limited to servers and other digital storage devices, computers, tablets, e-readers, televisions, monitors, cameras, telephones, printers, calculators, audio and visual recording and playback devices, security systems, displays, projectors, satellite and terrestrial communication devices; software; data and file management and database software; cloud computing software; cloud server software; application software for cloud computing services; downloadable cloud computing software; cloud network monitoring software; computer software for controlling and managing access server applications; computer software for wireless content delivery; software for processing images, graphics and text; computer game software; magnetic data carriers, recording discs; processors [central processing units]; computer peripheral devices; software for accessing information on a global computer network.</p>	

¹³ BenCJ 18 October 2022, C 2021/13/7, point 19 (Sitel).

¹⁴ Article 2.16 (1) BCIP and rule 1.21 IR.

	<p>CI 41 Training and coaching services in the field of identity and access management; publishing services relating to identity and access management.</p>
<p>International trademark registration 1577936</p> <p>CI 42 Computer software consultancy; computer software design; computer system analysis; computer system design; computer virus protection services; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; conversion of computer programs and data, other than physical conversion; design and development of computer hardware and software; digitization of documents [scanning]; duplication of computer programs; electronic storage services for archiving databases, images and other electronic data; hosting computer sites [web sites]; information technology [IT] consultancy; industrial analysis and research services; installation of computer software; maintenance of computer software; monitoring of computer systems by remote access; online data storage; providing search engines for the internet; providing non-downloadable software on a global computer network; providing temporary use of non-downloadable software; recovery of computer data; rental of computer software; rental of web servers; research and development of new products for others; server hosting; technological services and research relating thereto; software as a service [SaaS]; technical project studies; technical research; updating of computer software; web site design consultancy.</p>	<p>CI 42 Automation services. IT consulting relating to identity and access management; engineering services relating to identity and access management; technical consulting relating to identity and access management; designing of data processing systems relating to identity and access management; computer programming relating to identity and access management; technical data analysis relating to identity and access management; data security consulting relating to identity and access management; database development services relating to identity and access management; hosting of databases relating to identity and access management; monitoring of computer systems by remote access relating to identity and access management; computer system integration services relating to identity and access management; software as a service [SaaS] services featuring software for data productization, data analysis, data processing and data sharing in the field of identity and access management; technical support services relating to computer software and applications in the field of identity and access management; information technology support services relating to identity and access management. Software as a service (SAAS). IT consulting in the field of application security; IT consulting in the field of devops and devsecops; IT consulting in assessment of security maturity of software development processes; research and design in the field of cyber security test automation; training in the field of application security and devsecops practices; software as a service (SAAS) featuring computer software platforms used for assessing application security; IT consulting in the field of security test automation; computer consultation in the field of cyber security,</p>

	namely, providing approvals that minimum security levels have been achieved in the field of cyber security vulnerability testing of applications; technical support services in the field of security scanning integration.
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Classes 41 and 42

51. The defendant does not dispute the similarity of the goods and services argued by opponent. The similarity of the goods and services is thus manifestly *in confesso* so that the Office need not examine it further.

B. 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.¹⁵ According to the opponent the goods and services are directed at the public at large and at business customers with specific professional knowledge or expertise (see point 13). According to the defendant the goods and services are directed at both the professional and normal public (see point 26). In case the public consists of different categories of consumers, the consumers with the lowest level of attention should be considered.¹⁶ The Office therefore assumes the level of attention in this case to be normal.

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.¹⁷ In the present case, the Office notes that for the goods and services the invoked trademarks are registered for, the second invoked trademark has a normal inherent distinctiveness as it is not descriptive for any of the goods and services. The opponent's statement that the trademark invoked has an acquired higher level of distinctiveness and submitted evidence does not need to be addressed because the outcome of this assessment would not alter the outcome of the present decision. Thus, the Office considers that the invoked trademarks have a normal distinctiveness. The defendant does not contest the argument of the opponent that the invoked trademarks are at least inherently distinctive.

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.¹⁸

55. In this case the signs are visually and phonetically similar to a certain degree. A conceptual comparison cannot be made. The similarity of the respective goods and services is *in confesso*. On the basis

¹⁵ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁶ BenCJ 18 April 2023, C-2021/19, point 26 (ZM Zo mooi).

¹⁷ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

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

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 trademarks invoked and the services to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically linked.

B. Other factors

56. In so far as the defendant intended to argue genuine use of the invoked trademarks or intended to request proof of genuine use (see point 18), the Office notes that the second trademark invoked was not yet registered for five years when the contested sign was applied for trademark registration.¹⁹

57. The opponent refers to opposition decisions in similar cases that should be followed in the present proceedings (see point 10). 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 assess each opposition on its own merits.

58. The fact that the opponent, for whatever reason, did not act earlier against the use of the sign (see point 19), is irrelevant in the context of the present opposition. After all, the opponent is free to file an opposition against a trademark registration that is younger than his trademarks, if he considers that this could cause a likelihood of confusion on the part of the public.

59. The defendant argues that the opponent should be ordered to pay the costs (see point 27). 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 rejected (or justified) is provided for.²⁰

C. Conclusion

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

61. If an opposition, based on several earlier trademarks, is upheld on the basis of one of those marks, the Office will not take a decision with regard to the other trademarks invoked.²¹ The opposition is already upheld on the basis of the second invoked trademark, namely International trademark registration 1577936.

¹⁹ Article 2.16bis juncto 2.23 bis (1) BCIP.

²⁰ Article 2.16 (5) BCIP and rule 1.28 (3) IR.

²¹ Rule 1.14 (1) (i) IR.

IV. DECISION

62. The opposition with number 2018212 is justified.

63. The Benelux application with number 1465176 will not be registered.

64. 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, 29 June 2023



Yvonne Noorlander
(*rapporteur*)

Eline Schiebroek

Pieter Veeze

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