



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018343
of 16 November 2023

Opponent: **Trias Holding AG**
Baarerstrasse 88
6300 Zug
Switzerland

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

Invoked trademark 1: European Union trademark registration 11234028



Invoked trademark 2: International registration 1458080

MCM

Invoked trademark 3: European Union trademark registration 2667335

MCM

against

Defendant: **Ian Njuguna h.o.d.n. MCMXCIX**
Pisanostraat 368
5623 CN Eindhoven
The Netherlands

Representative: -

Contested sign: **Benelux trademark application 1467871**

MCMXCIX

I. FACTS AND PROCEEDINGS

A. Facts

1. On 23 July 2022, the defendant filed a Benelux trademark application for the wordmark MCMXCIX for goods in classes 14 and 25. This application was processed under the number 1467871 and was published on 5 August 2022.

2. On 4 October 2022, the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademark registrations:

- European Union registration 11234028 of the combined word/figurative trademark



- , filed on 2 October 2012 and registered on 1 March 2013 for goods in classes 3, 9, 14, 18 and 25 (hereinafter: invoked trademark 1);
- International registration 1458080, designating the European Union, of the wordmark MCM, registered on 22 May 2018 for goods and services in classes 3, 4, 14, 18 and 28 (hereinafter: invoked trademark 2);
- European Union registration 2667335 of the wordmark MCM, filed on 25 April 2002 and registered on 21 August 2003 for goods in classes 3, 14, 18 and 25 (hereinafter: invoked trademark 3).

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 was initially based on all goods and services of the trademarks invoked. In his arguments, opponent limited the goods and services on which the opposition is based to only the goods.

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 10 October 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 14 April 2023.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. 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 his own in accordance with Article 2.2ter BCIP.

8. The opponent claims that the contested sign should not be registered based on the following grounds:

- Article 2.2ter(1) BCIP, likelihood of confusion: *"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."*
- Article 2.2ter(3)(a) BCIP, reputation: *"a trademark shall, in case an opposition is filed, not be registered (...) where: a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark"*.

A. Opponent's arguments

8. The opponent explains that the prior word mark consists of one verbal element, MCM. This is automatically the dominant element for both prior word marks. In the prior word/figurative mark the figurative element is merely decorative. This together with the position and very large size of the word element leads to MCM being the dominant element in the marks.

9. The prior mark MCM is entirely included in the contested sign. This forms the first and dominant part of the contested sign as it first catches the attention of the reader. Also, the string of letters MCM is pronounced identically. Since the prior mark and the contested sign coincide in their first three letters, i.e. the dominant part, they are phonetically similar.

10. In the vast majority of cases, trademarks deemed aurally similar are also deemed visually similar. In this case, the same applies. The prior mark and the contested sign are visually similar because they coincide in the element MCM.

11. Both the prior mark and the contested sign consist of Roman numerals. Part of the relevant public will perceive the prior marks and the contested sign as such. In this case the prior marks will be perceived as the Roman numeral for 1900 and the contested sign will be perceived as the Roman numeral for 1999. It must be concluded that the prior marks and the contested sign are conceptually very close to each other. Part of the public will presumably not perceive the prior marks and the contested sign as Roman numerals. To them, both the prior mark and the contested sign consist of letters in an arbitrary sequence. In this case a conceptual comparison is not possible.

12. Opponent argues that the trademark MCM has no meaning in relation to the subject goods and services whatsoever. The level of distinctiveness is therefore at least average. However, in the present the prior marks enjoy an enhanced level of distinctiveness due to the fact that MCM is well-known. In order to support the reputation of MCM opponent submits several Annexes.

13. While comparing the goods opponent states that as both jewelry in class 14 and clothing in class 25 are identically contained in both the prior marks and the contested sign, all the contested goods are considered identical.

14. Since the goods are identical a low similarity of the marks would therefore be sufficient for the opposition to be upheld. However, the prior marks and the contested sign are similar too. This means that

consumers are likely to believe that defendant's goods originate from opponent or that there exists a commercial relationship between both parties. This is not the case and the likelihood of confusion is therefore undeniable in the present case. In fact, there exists an enhanced likelihood of confusion due to the fact that the prior mark is well-known.

15. Opponent argues that the opposition should also be upheld based on article 2.2ter(3)(a) BCIP. By using a very similar mark on identical goods defendant will free-ride upon the reputation of the MCM brand. Furthermore, the defendant's goods may be of lesser quality than opponent's luxury goods. This will be detrimental to the reputation of the prior mark. The coexistence of the prior marks and the contested sign will also be detrimental to the distinctiveness of the prior marks. As a result, the defendant runs the risk of trademark dilution.

16. Opponent request the Office to reject the contested sign for all goods and to fix the costs of the opposition proceedings to be paid by defendant.

B. Defendant's arguments

17. Defendant starts by giving a brand overview explaining that the target audience of the contested sign are men and women aged between 21-45. The brand was established in Eindhoven and has a global appeal. The brand focuses on people who can appreciate the craftsmanship of good products. Defendant mentions that he does not use his own name for his clothing brand like many do, but uses Roman numeral 1999. The brand name is universally intelligible and timeless. It is also the birthyear of defendant.

18. Defendant furthermore states that a quick search on the EUIPO's database shows that there are 224 trademarks corresponding with MCM. The defendant therefore assumed that it would not be a problem to register the contested sign as a trademark and therefore was unpleasantly surprised by the opposition.

19. Conceptually the prior mark MCM is an acronym which stands for 'Modern Creation Munich'. Young professionals buying MCM products are well aware of this. MCMXCIX is in fact a Roman numeral for 1999. Therefore the prior mark and the contested sign are not conceptually similar.

20. With regard to the aural comparison defendant states that the string of letters MCM are pronounced identically. The fact still remains that there are four other dominant letters XCIX in the contested sign. In relation to the visual comparison the same applies.

21. Although the prior mark and the contested sign are active in the same field and produce goods in the same classes, they are visually, aurally and conceptually entirely different. The contested sign MCMXCIX must be given free rein to operate and conduct business as it pleases.

22. Defendant also mentions that he registered his brand in the KvK-register, before the BOIP registration, and that he is the rightful owner of internet domains containing the contested sign.

III. DECISION

A. Likelihood of confusion

23. 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

24. 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

25. 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

26. For reasons of procedural economy, the Office will first assess the opposition on the basis of the invoked trademark 3.

Comparison of the signs

27. 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

28. 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

29. 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.

30. The signs to be compared are the following:

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).

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).

Opposition based on:	Opposition directed against:
MCM	MCMXCIX

Visual comparison

31. The invoked trademark 3 is a wordmark consisting of three letters: MCM.
32. The contested sign is also a wordmark and consists of seven letters: MCMXCIX.
33. The three letters of the invoked trademark 3 appear in full and in identical order in the contested sign. This corresponding part of the signs will receive the most attention of the public in the contested sign. This is because the consumer normally attaches more importance to the first part of words.⁷ An obvious visual difference between the signs is that the contested sign is more than twice as long and contains the extra letters XCIX.
34. Based on the above the Office is of the opinion that the signs are visually similar to a certain degree.

Phonetic comparison

35. The invoked trademark 3 consists of three letters/syllables. The contested sign consists of seven letters/syllables. The first three letters, which will also aurally receive the most attention, are identical. Otherwise, the pronunciation of the signs is different. The pronunciation also differs in length and rhythm.
36. Given the above the Office is of the opinion that the signs are aurally similar to a certain degree.

Conceptual comparison

37. Defendant argues that MCM is an acronym which stands for 'Modern Creation Munich' (see above under 19). The Office is not convinced that the relevant public will know this meaning of MCM. Defendant did also not demonstrate that the relevant public is familiar with this acronym.
38. According to the Office the relevant Benelux public will recognize Roman numerals or a letter combination in both signs. However, the relevant public will not assign any specific meaning to the signs.
39. Consequently, a conceptual comparison is not possible.

Conclusion

40. The signs are visually and aurally similar to a certain degree. A conceptual comparison is not possible.

Comparison of the goods

41. 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

⁷ General Court (EU) 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

nature, their end-users and their method of use and whether they are in competition with each other or are complementary.⁸

42. 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.⁹

43. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Kl 3 Perfumery	
Kl 14 Jewellery, namely, key chains and charms.	Kl 14 Jewelry
Kl 18 Bags and wallets made of leather and imitations of leather and not included in other classes; travelling bags.	
Kl 25 Clothing, footwear, headgear.	Kl 25 Clothing.

Class 14

44. The "Jewelry" for which the contested sign is applied for in class 14 are identical to the "Jewellery" for which the invoked trademark 3 is registered in class 14. This is also *in confesso* between parties (see above under 13 and 21).

Class 25

45. The "Clothing" for which the contested sign is applied for in class 25 are identical to the "Clothing" for which the invoked trademark 3 is registered in class 25. This is also *in confesso* between parties (see above under 13 and 21).

Conclusion

46. The goods are identical.

Global assessment

47. 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.¹⁰ 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.

⁸ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁹ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

¹⁰ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

48. 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.¹¹ In the present case the invoked trademark 3 has to be considered as having normal distinctiveness for the goods concerned as it does not describe the characteristics of the goods in question. Opponent argues and substantiates that the invoked trademarks have an enhanced distinctiveness (see above under 12). The Office will however not consider this argument as it will not affect the outcome of these proceedings.

49. 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.¹²

50. In this case the signs are visually and aurally similar to a certain degree. 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 invoked trademark 3 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.

Other factors

51. Defendant refers to his reasons for filing the application (see above under 17). However, the rationale for making a particular application plays no role in assessing whether it might conflict with the rights of other trademark owners.

52. With regard to defendant's arguments regarding the trade name and domain name registrations (see above under 22), the Office notes that no other rights can be invoked in opposition proceedings in the Benelux other than those that are part of the proceedings, in this case: invoked trademarks 1, 2 and 3 and the contested sign.

B. Conclusion

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

54. Since the opposition is justified based on Article 2.2ter(1)(b) BCIP in respect of the invoked trademark 3, the Office shall not decide on the invoked trademarks 1 and 2 and the other ground invoked, namely Article 2.2ter(3)(a) BCIP (see article 1.14(1)(i) IR).

¹¹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹² CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there (Equivalenza).

IV. CONSEQUENCE

55. The opposition with number 2018343 is justified.

56. The Benelux application with number 1467871 will not be 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, 16 November 2023



Marjolein Bronneman
(*rapporteur*)

Camille Janssen

Yvonne Noorlander

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