



Benelux Office for
**Intellectual
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018585
of 6 February 2024**

Opponent: **Arnold & Siedsma B.V.**
Bezuidenhoutseweg 57
2594 AC Den Haag
The Netherlands

Representative: **Arnold & Siedsma**
Bezuidenhoutseweg 57
2594 AC Den Haag
The Netherlands

Invoked trademark 1: Benelux trademark registration 487841

ARNOLD & SIEDSMA

Invoked trademark 2: European Union trademark registration 14456925



Invoked trademark 3: European Union trademark registration 529347

A R N O L D  S I E D S M A

against

Defendant: **Arnold & Siedsma Amsterdam Trademarks B.V.**
Rembrandt Toren
Amstelplein 1
1096 HA Amsterdam
The Netherlands

Representative: **Arnold + Siedsma (Amsterdam)**

Postbus 71720
1008 DE Amsterdam
The Netherlands

Contested sign: **Benelux trademark application 1465054**

ARNOLD & SIEDSMA

I. FACTS AND PROCEEDINGS

A. Facts

1. On 27 May 2022, the defendant filed a Benelux trademark application for the word mark ARNOLD & SIEDSMA for goods and services in classes 9 and 41. This application was processed under the number 1465054 and was published on 11 January 2023.

2. On 18 January 2023, the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademark registrations:

- Benelux registration 487841 of the word mark ARNOLD & SIEDSMA, filed on 21 September 1990 and registered on 1 July 1991 for services in class 45 (hereinafter: invoked trademark 1);
- European Union registration 14456925 of the combined word/figurative trademark



, filed on 11 August 2015 and registered on 16 December 2015 for goods and services in classes 9, 16, 35, 38, 41 and 45 (hereinafter: invoked trademark 2);

- European Union registration 529347 of the combined word/figurative trademark

A R N O L D  S I E D S M A

, filed on 2 May 1997 and registered on 16 April 1999 for goods and services in classes 16, 35 and 42 (hereinafter: invoked trademark 3).

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

4. The opposition was initially directed against all goods and services covered by the contested application and based on all goods and services of the trademarks invoked. In his arguments, opponent limited the goods and services to which the opposition is directed to "*Entertainment services, namely, filing virtual trademark applications in a virtual environment*" in class 41.

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 23 January 2023. 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 22 June 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

9. Opponent explains that Arnold & Siedsma is a well-known IP firm that was founded in 1920. Over the past years, the firm has won several awards. The firm therefore has a very strong reputation within the IP community and is well known amongst lawyers and consumers of legal services. Accordingly, the prior mark enjoys enhanced distinctive character and the scope of protection of the Arnold & Siedsma trademark is very broad due to its reputation.

10. According to opponent, the contested sign is identical to the prior word mark and highly similar to the prior word & device marks.

11. The contested services "*Entertainment services, namely, filing virtual trademark applications in a virtual environment*" are similar to the opponent's legal services in class 45. Up to five (maybe ten) years ago, it would have been absolutely crazy to state that the contested services are similar to the prior legal services in class 45. However, times are changing. The Metaverse is about to change our lives and has in fact already changed the lives of many teenagers. As such, it only makes sense that services such as "*filing virtual trademark applications in a virtual environment*" in class 41 are similar to traditional legal services in class 45. Consumers will believe that these services originate from the same source. As such, they are similar. The opponent concludes that the contested services are similar to the prior services.

12. Given the above, consumers will assume that the contested services originate from the opponent or that there exists a commercial relationship between the parties. Hence, there exists a likelihood of confusion in the present case. Even if the Office would conclude that there does not exist a likelihood of confusion, the opposition should still be upheld based on Article 2.2ter(3) BCIP.

13. Subsequently, opponent argues that the conditions of Article 2.2ter(3) BCIP are met. The prior mark has a very strong reputation in Benelux and the rest of the EU. The prior marks and the contested sign are identical and similar. The consumers will establish a link between the prior mark and the contested sign. The opponent is a trusted IP advisor for many companies (large and small). It's unlikely that the defendant's services will be of the same quality as the opponent's services. Furthermore, the opponent, being a serious business, does not want to be associated with virtual entertainment services. This may harm the reputation of the prior mark. Given the link with the earlier reputed mark and the fact that the average consumer will associate the contested sign with the prior mark, the contested sign will take unfair advantage of the repute of the prior mark. The defendant will have to invest less in marketing. Consumers that are active in the Metaverse and in need of virtual trademark filings, will immediately think of the opponent's prior mark and reputation when they are offered these services in the virtual world. As such,

the defendant will free ride upon the opponent's reputation. The prior mark consists of two last names. These names have no meaning in relation to the prior services and are completely arbitrary. It is clear that use of the contested sign on the contested services will be detrimental to the distinctive character of the prior mark. The prior mark is currently unique in the traditional IP field and now an identical name will be used in the new virtual world.

14. Opponent concludes with the request to the Office to uphold the opposition and to bar the contested application from maturing to registration.

B. Defendant's arguments

15. Defendant first of all agrees that the marks are identical and almost identical. Secondly, defendant agrees that the prior mark is well-known in the Benelux and the rest of the EU. However, defendant does not believe that there exists a likelihood of confusion. Even though the marks are identical and the prior mark is well-known, the goods and services are dissimilar. Hence, there does not exist a likelihood of confusion.

16. The prior mark covers legal services, whereas the application covers entertainment services. The entertainment services may be in the field of intellectual property, but that still does not make them similar to legal services in class 45. In fact, if the Office would follow opponent's reasoning all goods and services are similar to entertainment services in the field of said goods and services. This is obviously non-sense. Since the services are dissimilar, there automatically does not exist a likelihood of confusion.

17. Furthermore, it is hard to see how the opposition would be successful based on Article 2.2ter(3) BCIP. Again, defendant is not denying that the prior mark is well-known, but defendant fails to see how he would take unfair advantage of the reputation of the prior mark. Defendant's services will mainly be rendered in the Metaverse. The opponent may believe that people will start living their lives in the Metaverse parallel to their lives in the real world. But let's be realistic here: the Metaverse will probably mainly be popular amongst people playing videogames. Accordingly, the relevant consumers of the prior marks and the contested sign are different. Defendant therefore fails to see how the use of the contested sign would take unfair advantage of the repute of the prior marks or how it would be detrimental to the distinctive character of the prior marks.

18. Defendant concludes with the request to the Office to reject the opposition entirely and to allow the contested application to mature to registration.

III. DECISION

A. Likelihood of confusion

19. 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

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.

20. 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

21. 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

22. For reasons of procedural economy, the Office will first assess the opposition on the basis of the invoked trademark 1.

Comparison of the signs

23. 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

24. 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

25. 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.

26. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
ARNOLD & SIEDSMA	ARNOLD & SIEDSMA

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).

27. The signs are identical.

Comparison of the services

28. 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.⁷

29. 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.⁸

30. The services to be compared are the following:

Opposition based on:	Opposition directed against:
	Class 41 Entertainment services, namely, filing virtual trademark applications in a virtual environment
<p>Klasse 45 Diensten van octrooi-, merken- en modellengemachtigden, onder meer beheer van industriële en intellectuele eigendomsrechten, onderzoek (technisch en juridisch) inzake vraagstukken van bescherming van industriële en intellectuele eigendom; advisering inzake industriële en intellectuele eigendom, diensten in verband met de vestiging, instandhouding, vernieuwing, bewaking en bescherming van industriële en intellectuele eigendomsrechten.</p> <p><i>Class 45 Patent, trademark and design attorney services, including management of industrial and intellectual property rights, research (technical and legal) on issues of protection of industrial and intellectual property; consultancy on industrial and intellectual property, services related to the establishment, maintenance, renewal, monitoring and protection of industrial and intellectual property rights.</i></p>	
<p><i>NB. The goods and services list of this registration is in Dutch. The English translation is added solely for the purpose of readability of this decision.</i></p>	

⁷ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁸ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

31. The Office is of the opinion that the "*Entertainment services, namely, filing virtual trademark applications in a virtual environment*" for which the contested sign is applied for in class 41 are similar to a low degree to the intellectual property services for which the invoked trademark 1 is registered in class 45. Although the worlds (the real world versus the virtual world) and fields (legal/technical advice versus entertainment) in which the services are offered differ, the services all relate to the same specific topic, namely trademark applications. In addition, the relevant public of the services may overlap. Persons or companies who are interested in trademark law in the real world may also be interested in entertainment services based upon it, such as in this case "*filing virtual trademark applications in a virtual environment*".

Conclusion

32. The services are similar to a low degree.

Global assessment

33. 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.⁹ In the present case, the services involved are aimed at the general public with an average level of attention, namely persons or companies who are interested in intellectual property in the real and/or virtual world.

34. 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.¹⁰ In the present case parties agree that the invoked trademark 1 has an enhanced distinctiveness (see above under 13 and 15). The Office therefore assumes an enhanced distinctiveness of invoked trademark 1.

35. 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.¹¹

36. In this case the services are similar to a low degree. However, the signs are identical. On the basis of these and the other factors mentioned above, among which the enhanced distinctiveness of the invoked trademark 1, and considering their interdependence, the Office considers that there is a likelihood of confusion in the sense that the public may believe that the services designated by the invoked trademark 1 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.

⁹ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁰ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹¹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there (Equivalenza).

B. Conclusion

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

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

IV. CONSEQUENCE

39. The opposition with number 2018585 is justified.

40. The Benelux application with number 1465054 will not be registered for:

- Class 41: *"Entertainment services, namely, filing virtual trademark applications in a virtual environment"*

41. The Benelux application with number 1465054 will be registered for the following goods and services, to which the opposition was not directed:

- Class 9: (all goods)
- Class 41: *"Entertainment services, namely, virtual transport of virtual characters in a virtual environment; Entertainment services, namely, medical care of virtual characters in a virtual environment."*

42. 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, 6 February 2024



Marjolein Bronneman
(*rapporteur*)

Camille Janssen

Pieter Veeze

Administrative officer: Guy Abrams