

BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2009801
of 25 April 2019

Opponent : **Omega SA (Omega AG)**
 (Omega Ltd.)
 Jakob-Stämpfli-Strasse 96
 2502 Biel/Bienne
 Switzerland

Representative: **Lydian cvba**
 Tour & Taxis, Havenlaan 86C B113
 1000 Brussel
 Belgium

Invoked right: **International trademark**
 953967



against

Defendant: **Mustad Netherlands B.V.**
 Het Helmhout 12
 9206 AZ Drachten
 Netherlands

Representative: **Arnold & Siedsma**
 Postbus 18558
 2502 EN 's-Gravenhage
 Netherlands

**Contested
trademark:**


Benelux application 1283705



I. FACTS AND PROCEEDINGS

A. Facts

1. On 6 February 2014 the defendant filed a Benelux trademark application for the combined word and figurative trademark  for goods in Classes 6, 8 and 18. This application was processed under number 1283705 and was published on 19 February 2014.

2. On 19 April 2014 the opponent filed an opposition against this application. The opposition is based on the international registration 953967 for the combined word and figurative trademark , filed on 28 December 2007 and registered for the European Union on 30 September 2010 for goods in Class 18.

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

4. The opposition is directed against part of the goods in Class 18 of the contested application and is based on all the goods of the trademark invoked.

5. The grounds for opposition are those laid down in Article 2.14, 1 (a) Benelux Convention on Intellectual Property (hereinafter referred to as: "BCIP").

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 5 May 2014. During the administrative phase of the proceedings both parties filed arguments and the proceedings were suspended several times. All of the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 7 November 2018.

II. ARGUMENTS OF THE PARTIES

8. The opponent filed an opposition at the Office under Article 2.14, 1 BCIP, in accordance with the provisions of Article 2.2ter. 1 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant trademarks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. The opponent explains that it is a world renowned company founded in 1903 which designs, manufactures and sells inter alia horological and chronometric instruments, jewellery and fine leather goods. Its trademarks are registered in a great number of countries worldwide including in the Benelux for goods in the classes 14 and 18. The opponent has continuously and widely used its trademarks in the Benelux for the goods in class 14 for decades and for the goods in class 18 since 2009.

10. According to the opponent, the word components OMEGA and ΩMEGA dominate both trademarks. The contested sign imitates the essential and distinctive characteristics of the right invoked by copying four letters from the Latin alphabet (MEGA) and the specific graphic form of the Greek letter Ω (omega). The only differences between both signs are that the contested sign additionally contains the word HOOFCARE in much smaller characters beneath the main word components and that the first Latin letter O of the right invoked is replaced by the Greek letter Ω, which however also appears in a specific graphic form above the word component of the right invoked. These differences are not significant and will hardly be noticed by the consumer. The opponent is therefore of the opinion that the signs are aurally similar and visually highly similar.

11. From a conceptual point of view, both signs have a connection with the Greek letter Ω and therefore they are very similar, according to the opponent.

12. The goods against which the opposition is directed, horseshoes, are shoes for a horse composed of a narrow band in the form of a circular arc, which is usually metal but is sometimes made partially or wholly out of modern synthetic materials or even leather (for both therapeutic purposes and protection from wear) and nailed to a horse's hoof. The goods of the right invoked, such as leather goods, for instance for whips, harnesses and saddlery, are used in relation to horses and thus are targeted at the same public, and consequently may be manufactured by the same undertaking and found at the same points of sale, according to the opponent.

13. The opponent explains that its trademarks have been highly visible in equestrian events as it has provided sports measuring and signalling equipment and services, notably in relation to time-keeping at more than twenty Olympic Games since 1932. The opponent is indeed particularly involved in and well known worldwide for sponsoring activities with a major focus on sports, and is therefore also the owner of trademark registrations for the services in classes 35, 36 and 41, which are the appropriate classes for protecting the various aspects of their sponsoring activities. Since several equestrian sports take place during the Olympic Games, the opponent's trademarks have been seen in a context relating to horses which makes it highly likely that the average consumer will think that the trademarks originate from the same undertaking, making the risk of confusion very likely.

14. The opponent concludes that there exists a likelihood of confusion and therefore he requests that the Office declares the opposition well-founded and charges the defendant with the costs for this procedure.

B. Defendant's arguments

15. The defendant points out that, due to a partial cancellation procedure before the European Union intellectual property organisation (EUIPO), the situation has changed since the filing of this opposition. Indeed, as a result of the decision of EUIPO's annulment division, the international trademark invoked is now only protected within the EU for the goods *products made of these materials not included in other classes [leather and imitation leather], namely leatherware; umbrellas* in class 18.

16. According to the defendant, The TMclass system reveals that the scope of the wording *leatherware* is limited to products such as key cases, wallets, purses, key pouches, travelling bags, suitcases and briefcases.

17. Likewise, a Google search for *leatherware* (or the Dutch equivalent *lederwaren*) gives a good impression of the goods the public refers to as leather goods and which are sold by regular shops for leatherware. These shops do not sell products for the equine industry as horse-related products are sold in specialist shops aimed at horses and horse riders.

18. A horseshoe on the other hand is a shoe for a horse composed of a narrow band of iron in the form of an extended circular arc and secured to the hoof with nails. The goods applied for by the defendant are limited to those made of steel or metal.

19. According to the defendant, these products differ from leatherware and umbrellas in their nature, material, purpose and methods of use, target group, distribution channels and points of sale. Furthermore, they are not likely to be produced by the same companies and they are neither complementary nor in competition with each other. Therefore, the defendant is of the opinion that these goods are completely dissimilar and that the public will not presume that these goods have the same or a related origin.

20. The defendant points out that the goods *whips, harnesses* and *saddlery* are no longer part of the claim for protection of the right invoked and that they do not belong to the definition of *leatherware*. Furthermore, the defendant is of the opinion that the reputation and the time-keeping instruments referred to by the opponent are not part of this opposition.

21. The defendant holds the opinion that there is only a very low similarity at most between the signs from the visual, oral and conceptual points of view.

22. The defendant concludes that there exists no likelihood of confusion and therefore he request that the Office rejects the opposition and grants registration of the contested sign.

III. DECISION

A.1 Likelihood of confusion

23. In accordance with Article 2.14, 1 BCIP, and within a period of two months which will be calculated from the publication of the application, the applicant or holder of a prior trademark may submit a written opposition to the Office against a trademark which in the order of priority, ranks after its own in accordance with Article 2.2ter,1 (b) BCIP.

24. Article 2.2ter,1 (b) BCIP stipulates that "A trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where: a. it is identical with an earlier trademark, and the goods or services for which the trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected; 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".

25. According to case law of the Court of Justice of the European Union (hereinafter referred to as: the "CJEU") concerning the interpretation of 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 (hereinafter referred to as: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in

question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003; Brussels, N-20060227-1, 27 February 2006).

Comparison of the goods

26. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with or complementary to each other (Canon, already cited).

27. With the comparison of the goods of the trademark invoked and those against which the opposition is filed, the goods are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

28. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Class 18 Products made of these materials not included in other classes [leather and imitation leather], namely leatherware; umbrellas.	Class 18 Horseshoes, made of steel or metal.

29. According to the opponent, *horseshoes* are sometimes made partially or wholly of leather (see point 12). The Office points out however that this is certainly not the case with the products of the contested sign, which are specified as being made of steel or metal.

30. Moreover, even horseshoes made, partially or wholly, of leather would not fall under the regular meaning of *leatherware* referred to by the right invoked.

31. According to the opponent, leather goods such as whips, harnesses and saddlery, are used in relation to horses just like the goods of the contested sign (see point 12). Again, the Office points out that these goods do not fall under the usual meaning of leather goods. Moreover, in its annulment decision, EUIPO has explicitly stated that no proof of use was delivered for these products. The defendant thus stated correctly that these goods are no longer part of the claim for protection of the right invoked (see point 20).

32. The Office judges that the goods of the right invoked, briefly referred to as *leatherware* and *umbrellas* and the goods against which the opposition is directed are dissimilar in their nature, material, purpose and methods of use, target group, distribution channels and points of sale. Furthermore, they are not likely to be produced by the same companies and they are neither complementary nor in competition with each other.

Conclusion

33. The goods at hand are dissimilar. Therefore there is no need to compare the signs. Indeed, if the goods are not at least similar, there is no likelihood of confusion, even if the signs are identical.

A.2 Global assessment

34. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the signs are important factors.

35. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be considered that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question. In the present case, the level of attention of the consumer may be higher than average for the goods of the contested sign. For the goods of the right invoked, the average level of attention of the public concerned may be deemed normal.

36. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors that have to be taken into account, particularly between the level of similarity of the signs and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

37. It should also be taken into consideration that the average consumer usually perceives a mark as a whole and does not proceed to an analysis of its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different trademarks and must place their trust in the imperfect picture of those that they have kept in mind.

B. Other factors

38. Other registrations referred to by the opponent (e.g. in classes 14, 35, 36 and 41, see points 9 and 13) such as its time-keeping and sponsoring activities at Olympic Games do not play any role in these proceedings as they are limited to the right invoked and the contested sign.

39. The opponent refers to the worldwide renown of its trademarks but doesn't substantiate this position. In any case, a possible renown of the right invoked could not have altered the outcome of this opposition. When the goods are not at least similar, there exists no likelihood of confusion, even with regard to well-known trademarks.

40. The opponent asks that the fees arising in connection with these proceedings be imposed on the defendant (see point 19). However, Rule 1.32 (3) IR clearly stipulates that the costs referred to in Article 2.16 (5) BCIP are determined at an amount equalling the basic opposition fee (in the case that the opposition is totally upheld or rejected). The defendant's request can therefore not be honoured.

C. Conclusion

41. On the basis of the foregoing, the Office comes to the conclusion that the contested goods are not similar to the goods of the right invoked. Therefore no likelihood of confusion could exist, even if the signs were identical (see TEU, YoKaNa, T-103/06, 13 April 2010, ECLI:EU:T:2010:137).

IV. DECISION

42. The opposition with number 2009801 is rejected.

43. The Benelux application with number 1283705 will be registered for all the goods it has been applied for.

44. The opponent is under obligation to pay the defendant EUR 1,045 in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is not justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 25 April 2019

Willy Neys
rapporteur

Eline Schiebroek

Tomas Westenbroek

Administrative officer:

Cees van Swieten