

BENELUX-OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2013180

of 3 April 2019

Opponent : **Jaguar Land Rover Limited**
Abbey Road, Whitley
CV3 4LF Coventry Warwickshire
Great Britain

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

Invoked right 1: **EU trademark 15081565**
VELAR

Invoked right 2: **EU trademark 16508087**
VELAR

against

Defendant: **Fashion One (Europe) N.V.**
Leeuwenstraat 4
2000 Antwerpen
Belgium

Representative: **Trademarkers Merkenbureau C.V.**
Amersfoortsestraatweg 33b
1401 CV Bussum
Netherlands

Contested trademark: **Benelux application 1352334**
VELARTIS

I. FACTS AND PROCEEDINGS

A. Facts

1. On 19 April 2017 the defendant filed a Benelux trademark application for the word trademark VELARTIS for goods and services in classes 18, 25 and 35. This application was processed under number 1352334 and was published on 20 April 2017.
2. On 19 June 2017 the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:
 - European Union trademark 15081565 for the word trademark VELAR, filed on 5 February 2016 and registered on 3 February 2018 for goods and services in classes 9, 12, 18, 28, 35, 37 and 42;
 - European Union trademark 16508087 for the word trademark VELAR, filed on 25 March 2017 and registered on 24 July 2017 for goods and services in classes 14 and 25.
3. According to the register the opponent is the actual holder of the trademarks invoked.
4. The opposition is directed against the goods in classes 18 and 25 of the contested application and is based on some of the goods in classes 18 and 25 of the trademarks 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 20 June 2017. During the administrative phase of the proceedings both parties filed arguments. 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 18 October 2018.

II. ARGUMENTS OF THE PARTIES

8. The opponent filed an opposition at the Office under Article 2.14, 1 (a) BCIP, in accordance with the provisions of Article 2.3 (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. According to the opponent, most of the goods in class 18 are identical or are to be considered highly similar. The goods *whips, harnesses and saddlery* of the contested sign are in his opinion similar to the goods *leather leashes* covered by the first right invoked, for all these goods are used for horses. The goods in class 25 are identical or highly similar.
10. The opponent observes that the earlier trademarks are fully reproduced in the contested sign. Moreover, it is the first part of the sign that first catches the attention. Therefore, he concludes that the signs are visually highly similar.

11. The pronunciation of the signs coincides in the sound of the word VELAR, which forms the element with the strongest impact in the contested sign and therefore the signs are aurally similar, according to the opponent.

12. Conceptually, the signs have no concept in common. However, the opponent thinks that the contested sign could be perceived by the public as a serial mark belonging to him.

13. In view of the above, the opponent concludes that there exists a likelihood of confusion and therefore he requests that the Office grants the opposition.

B. Defendant's arguments

14. The defendant concedes that, when comparing the goods at hand, there are some similarities. But there are also differences. The goods of the contested sign in class 18 include *whips, harnesses and saddlery*, which are not present in the goods of the rights invoked. Furthermore, the goods of the rights invoked in class 25 are described very specifically, while the description of the goods of the contested sign is very general and open to be interpreted as inclusive of clothing items not contained in the earlier marks.

15. While the initial elements are identical, the signs differ in length by three letters, which completely transforms VELAR into something unrecognizable. Therefore, the defendant is of the opinion that the signs do not display a confusing degree of visual similarity.

16. Aurally, the defendant observes that the contested sign is clearly pronounced differently to the rights invoked. The latter consist of only two syllables, compared to the three of the contested sign. In addition, the rhythm of the signs differs considerably. The rights invoked are pronounced in an abrupt, short manner, whereas the contested sign is much more flowing and elongated. Therefore, the defendant concludes that the signs are not aurally similar.

17. Conceptually, as agreed by the opponent, the signs have no concept in common and as such, they are conceptually different, according to the defendant.

18. In the light of the above, the defendant requests that the opposition at hand be rejected in its entirety as unfounded and that the contested sign be granted protection. The defendant further requests that all costs and fees arising in connection with the proceedings be imposed on the opponent.

III. DECISION

A.1 Likelihood of confusion

19. 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 2.3 (a) and (b) BCIP.

20. Article 2.3 (a) and (b) BCIP stipulates that "*In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in: a. identical trademarks filed for identical goods or services; b. identical or similar trademarks filed for identical or similar goods or services, where a likelihood of confusion exists on the part of the public that includes the likelihood of association with the prior trademark.*"

21. 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, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs

22. The wording of Article 5, 1 (b) of the Directive (cf. Article 2.2ter, 1 (b) BCIP) “a likelihood of confusion exists on the part of the public” shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer usually perceives a mark as a whole and does not proceed to analyse its various details (CJEU, Sabel, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

23. Global assessment of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (CJEU, Sabel and Lloyd, already cited).

24. Both rights invoked are identical and can therefore be compared together with the contested sign. Hereinafter they will be referred to in the singular form. The signs to be compared are thus the following:

Opposition based on:	Opposition directed against:
VELAR	VELARTIS

Visual comparison

25. Both signs are purely verbal trademarks and consist of one word of five and eight letters respectively. The right invoked is included entirely in the contested sign, but has no independent role therein, as it is part of a larger, newly formed word.

26. The consumer usually attaches more importance to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). In the case at hand, the first five letters (out of eight) of the contested sign are identical to the right invoked and appear in exactly the same order. The only difference resides in the addition of the letters TIS at the end of the sign. This difference is insufficient to make the signs different in their overall impression.

27. Visually, the signs are similar in their overall impression.

Aural comparison

28. The right invoked numbers two syllables, the contested sign three. The first two syllables are pronounced identically, while the additional syllable –TIS in the contested sign is, of course, different. However, the Office is of the opinion that this difference does not entirely outweigh the similarities between the signs. As considered above, the public will attach more importance to the beginnings of the signs, which are identical.

29. Aurally, the signs are similar.

Conceptual comparison

30. Neither of the signs has an established meaning and therefore a conceptual comparison is not possible.

Conclusion

31. Visually and aurally, the signs are similar and a conceptual comparison does not apply.

Comparison of the goods

32. 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).

33. With the comparison of the goods of the trademarks 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.

34. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
<p><u>E15081565</u></p> <p>Class 18 Leather; imitation leather; leather and imitation leather bags; pouches of leather for packaging; leather key holders; leather leashes; traveling bags; vanity cases sold empty; attache cases; document cases; suitcases; bags; wallets; purses; handbags; parasols; umbrellas; walking sticks; umbrella sticks; rucksacks; business card cases.</p>	<p>Class 18 Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harnesses; saddlery.</p>
<p><u>E16508087</u></p> <p>Class 25 Clothing, footwear, headgear; outerwear; leisurewear; T-shirts, tops, polo shirts, sweatshirts, hooded tops, hooded pullovers, shirts, fleece pullovers, fleece jackets, sweaters; suits, coats,</p>	<p>Class 25 Clothing; footwear; headgear; swimwear; sportswear; leisurewear.</p>

<p>dresses, skirts, jackets, vests, blazers, anoraks; sweatpants, trousers, shorts; overalls, coveralls, uniforms, smocks; underclothing, pajamas, sleep masks, pocket squares, swimwear, bathing suits, bathing trunks; scarves, bandanas, sashes for wear; hosiery, socks, stockings; cloth bibs; costumes; fancy dress costumes; aprons; belts; gloves, mittens, driving gloves; ties; headgear, hats, caps, head scarves, head wraps, headbands, visors, ear muffs, knitted beanies; footwear, shoes, boots, slippers, drivers shoes, sandals; children's clothes; babies clothes; sports teams club shirts; sports teams scarves; sports teams training kit; sports teams replica kit; sports teams supporters clothing, headgear and footwear.</p>	
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Class 18

35. The goods *leather, suitcases, handbags, purses, wallets, umbrellas, parasols* and *walking sticks* are mentioned *expressis verbis* in both lists of goods and are therefore identical.

36. The goods *trunks* and *travelling cases* of the contested sign are all a certain type of *suitcase* and thus identical to it. Indeed, according to established case law, if the goods of the earlier trademark also contain goods that are mentioned in the application for the contested sign, these goods are considered identical (see EGC, Fifties, T-104/01, 23 October 2002, ECLI:EU:T:2002:262; Arthur et Félicie, T-346/04, 24 November 2005, ECLI:EU:T:2005:420 and Prazol, T-95/07, 21 October 2008, ECLI:EU:T:2008:455).

37. The goods *harnesses* of the contested sign are similar to a certain degree to the goods *leather leashes* of the right invoked. They have the same purpose and method of use, namely leading an animal in an orderly way and comfortably, without hurting it.

38. The goods *whips* and *saddlery* of the contested sign are not similar to any of the goods of the right invoked. They have a different nature, purpose, distribution channels and producers. Moreover, these goods are not complementary nor in competition with each other. The opponent is of the opinion that these goods are similar to the goods *leather leashes*, as all these goods are used for horses (see point 9). Firstly, this is not quite true, as whips and leather leashes can also be used for other animals. Secondly, the fact that goods are used for horses is not sufficient to suppose these goods to be similar.

Class 25

39. The goods *clothing, footwear headgear, leisurewear and swimwear* are mentioned *expressis verbis* in both lists of goods and are therefore identical.

40. The goods *sportswear* of the contested sign are covered by the goods *clothing* of the right invoked and are therefore identical to them.

Conclusion

41. The goods of the contested sign are partly identical, partly similar and partly dissimilar to the goods of the right invoked.

A.3 Global assessment

42. 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.

43. 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 level of attention of the consumer is likely to vary in accordance with the category of goods or services in question. The present case concerns goods which are targeted at the public in general. For these goods the average level of attention of the public concerned may be deemed normal.

44. 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).

45. 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 rarely has the chance to make a direct comparison between the different trademarks and must place their trust in the imperfect picture of them that he/she has kept in mind.

46. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). In the present case, the trademarks invoked have a normal level of distinctiveness, as they are not descriptive of the goods concerned.

47. The signs are visually and aurally similar whereas a conceptual comparison does not apply. The goods concerned are partly identical, partly similar and partly dissimilar. Based on these grounds, and given the interdependence between all the circumstances that have to be taken into account, the Office finds that the relevant public might believe that the identical and similar goods originate from the same undertaking or from economically-linked undertakings.

B. Other factors

48. The defendant asks that the fees arising in connection with these proceedings be imposed on the opponent (see point 18). 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

49. The Office holds that a likelihood of confusion for the identical and similar goods exists.

IV. DECISION

50. The opposition with number 2013180 is partially upheld.

51. The Benelux application with number 1352334 will not be registered for the following goods:

Class 18 Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; harnesses.

Class 25 All goods.

52. The Benelux application with number 1352334 will be registered for the following goods and services, either because they were found to be dissimilar, or because the opposition was not directed against them:

Class 18 Whips; saddlery.

Class 35 All services.

53. Neither of the parties shall pay the costs in accordance with Article 2.16(5) BCIP in conjunction with Rule 1.32(3) IR, as the opposition is partly justified.

The Hague, 3 April 2019

Willy Neys
rapporteur

Eline Schiebroek

Tineke Van Hoey

Administrative officer:

Jeanette Scheerhoorn