

BOIP



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2013239

16 November 2018

Opponent: **BRUE' S.p.A.**
Via De Gasperi, 9
63815 Monte San Pietrangeli (Fermo)
Italy

Representative: **Arnold & Siedsma**
Postbus 18558
2502 EN Den Haag
Netherlands

Invoked right: **EU trademark 91405**

Aldo Bruè

against

Defendant: **Brua Vennootschap Onder Firma**
Kees van Dongenhof 157 B
3024 NE Rotterdam
Netherlands

Representative: --


Contested trademark: **Benelux application 1353025**

Bruá


I. FACTS AND PROCEEDINGS

A. Facts

1. On 1 May 2017 the defendant filed an application for a trademark in the Benelux for the combined

word/figurative mark  for goods in classes 14, 18 and 25. This application was processed under number 1353025 and was published on 12 May 2017.

2. On 7 July 2017 the opponent filed an opposition against the registration of the application. The opposition

is based on EU trademark 91405 of the combined word/figurative mark , filed on 1 April 1996 and registered on 29 May 1998 for goods in classes 18 and 25.

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

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

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

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 11 July 2017. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 15 January 2018.

II. ARGUMENTS

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 marks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. The opponent argues that the font in which the letters of both signs are depicted is not distinctive or special. According to the opponent, the contested sign is visually highly similar to the second word of the trademark invoked, because three out of four characters are identical and in an identical order. For this reason, there is a high visual similarity. The opponent further states that there is a high aural similarity between the contested sign and the word BRUË, the second word of the trademark invoked. According to the opponent, the signs do not have any specific meaning.

10. With regard to the comparison of the goods the opponent argues that the goods are partially identical and partially highly similar.

11. The opponent concludes that there is a likelihood of confusion and requests that the Office upholds the opposition and rejects the contested trademark.

B. Defendant's arguments

12. The defendant argues that the word 'Bruá' is Papiamentu, a language spoken on the island of Curacao, and means 'confused' or 'bewildered'. This word is often used in combination with the word 'makaku', which means 'monkey'. According to the defendant, the relevant public for the goods of the contested trademark are familiar with this language. Furthermore, the contested sign is marketed accompanied by a logo, representing a stylized monkey figure.

13. With regard to the comparison of the signs, the defendant states that the signs differ in length, quantity of words and letters, as well as figurative elements. Furthermore, the beginning of the signs is different and, according to the defendant, the stylization of the contested signs is unique. The signs are also aurally different, because the trademark invoked consists of two words with four syllables and the contested sign consists of only one word with two syllables. Also, the last letters are pronounced differently. The defendant further states that the trademark invoked is an Italian name and that the contested sign is an actual word in Papiamentu.

14. The defendant argues that there is no confusion, because the contested sign is clearly visible on the goods concerned and is also accompanied by an image of a monkey with a golden tooth. Furthermore, the signs are not marketed for the same public. The defendant states that the goods of the opponent are high-end craftsmanship, whereas the goods of the contested sign are meant for a young public. Also, according to the defendant, the end users of the goods of the contested sign will be familiar with the link the sign has with the Caribbean. Furthermore, the goods are not sold through the same distribution channels.

15. The defendant concludes that the abovementioned differences are sufficient to assume that there is no confusion between the trademark invoked and the contested sign. The defendant therefore requests that the Office rejects the opposition and proceeds with the registration of the contested sign.

III. DECISION

A.1 Likelihood of confusion

16. 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 to be calculated from the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.3 (a) and (b) BCIP.

17. 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 there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark.”*

18. According to case law of the Court of Justice of the European Union (hereinafter: the “CJEU”) concerning the interpretation of Directive 2008/95/EG of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks (hereinafter: “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

19. The wording of Article 4, 1 (b) of the Directive (cf. article 2.3, (b) BCIP) “there exists a likelihood of confusion 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 normally 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).

20. 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).

21. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, Limonchello, C-334/05 P, 12 June 2007, ECLI:EU:C:2007:333). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, Matratzen, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and El Charcutero Artesano, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

22. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

Conceptual comparison

23. The Office considers that the trademark invoked refers to the name of a person. As confirmed by the EGC in the case ENZO FUSCO, it is possible that in a sign composed of a forename and a surname, the relevant public will perceive the surname as the distinctive element. However, this may vary from country to country within the European Union (see EGC, Enzo Fusco, T-185/03, 1 March 2005, ECLI:EU:T:2005:73). The Office is of the opinion that the relevant public in the Benelux will generally also perceive a surname as more distinctive than a first name (see BOIP opposition decision 2002674, 1 July 2009, Rachel).

24. According to the defendant, the contested sign has a clear meaning in Papiamentu (paragraph 12), a language spoken in the Caribbean. However, the Office finds the fact that the word 'Bruá' has a clear meaning in Papiamentu insufficient to neutralize the visual and aural similarities. After all, it is unlikely that the average Benelux consumer will know the meaning of the word 'Bruá', because Papiamentu is mostly spoken on the islands of Aruba and Curacao¹, which are constituent countries that form part of the Kingdom of the Netherlands, but are located in the Caribbean. Therefore, the contested sign has no meaning for the average Benelux public. For this reason, in this case, a conceptual comparison is not possible.

25. The Office also points out that risk of confusion with part of the public is sufficient to justify the opposition (see EGC, Hai/Shark, T-33/03, 9 March 2005, ECLI:EU:T:2010:152).

Visual comparison

26. Both signs are combined word/figurative marks depicted in a particular typeface. The trademark invoked consists of two words of four letters, 'Aldo Bruè'. The contested sign consists of one word of four letters, 'Bruá'. The contested sign also includes a stylized underlining.

27. Where a sign consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trademark (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). A graphic representation consisting of the reproduction in printed characters, which are depicted in a typeface that is not very unusual or out of the ordinary, of the word elements in both signs will not draw consumers' attention to any figurative components of the mark applied for other than the letters of which it consists (see EGC, Dieselit, T-186/02, 30 June 2004, ECLI:EU:T:2004:197). Furthermore, the other figurative aspect of the contested sign, the underlining, can be qualified as rather marginal. The Office finds that the public will therefore perceive the typeface and underlining only as decorative elements. For this reason, the dominant elements to be compared are the words 'Aldo Bruè' and 'Bruá'.

¹ <http://www.encyclo.nl/begrip/Papiamentu>

28. The second word of the trademark invoked is highly similar to the contested sign. Only the last letter is different, however these letters are vowels which are visually alike and both vowels contain a diacritical mark. Although the trademark invoked has a *grave* accent and the contested sign an acute accent, visually this does not make very much difference.

29. Although the consumer normally attaches more importance to the first part of words (EGC, MUNDICOR, T-183/02 en T-184/02, 17 March 2004, ECLI:EU:T:2004:79), that consideration cannot apply in every case (EGC, ALLTREK, T-158/05, 16 May 2007, ECLI:EU:T:2007:143). As indicated above (paragraph 23), the Office is of the opinion that it will be clear to the public that the trademark invoked refers to a forename/surname combination. Therefore, the second part of the trademark invoked is considered as more distinctive. For this reason, in this case, the word 'Bruè', which is almost identical to the contested sign, will also attract the attention of the public.

30. In the light of the above, the Office finds that the signs are visually similar to a certain extent.

Aural comparison

31. The trademark invoked consists of two words and four syllables, 'Al-do-Bru-è' and the contested sign consists of one word and two syllables, 'Bru-á'. The beginnings of the signs are different because of the word 'Aldo' in the trademark invoked. The Office finds that the second word of the trademark invoked is aurally similar to the contested sign. Although the last letter is pronounced differently, three of the four letters are identical. Furthermore, even though the acute and *grave* accents put emphasis on the last letters, these vowels 'è' and 'á' are aurally not very different. This small aural difference is therefore insufficient to evoke a different global aural impression between the contested sign and the second word of the trademark invoked.

32. For the abovementioned reasons, the Office finds that the signs are aurally similar to a certain extent.

Conclusion

33. A conceptual comparison is not possible. Trademark and sign are visually and aurally similar to a certain extent.

Comparison of the goods and services

34. 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 each other or are complementary (Canon, already cited).

35. With the comparison of the goods of the trademark invoked and the goods 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.

36. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
	CI 14 Jewellery; precious stones; chronoscopes; stopwatches; clothing ornaments of precious metals; action figures (decorative -) of precious metal; chronometric apparatus and instruments; watches.
CI 18 Articles made of leather and imitation of leather; trunks and suit-cases; bags, ladies and gentlemen's hand-bags; small leather goods.	CI 18 Travel cases; suitcases; luggage; handbags; holdalls; backpacks; portfolio cases [briefcases]; travelling sets [leatherwear]; toiletry cases sold empty; vanity cases, not fitted; shopping bags; wheeled shopping bags; bags for sports; satchels; book bags; beach bags; weekend bags; garment bags for travel; wallets; wallets, not of precious metal; card cases [notecases]; business card cases; key-cases; leather key cases; credit card holders; umbrellas; walking sticks.
CI 25 Shoes, boots, slippers and footwear in general.	CI 25 Clothing; footwear; headwear; sweatshirts; jogging suits; jeans; pants; shorts; tank tops; rainwear; skirts; blouses; dresses; sweaters; jackets; coats; raincoats; snowsuits; ties; hats; caps; sun visors; scarves; sleepwear; pyjamas; lingerie; underwear; boots; shoes; sneakers; sandals; beachwear; trousers; socks; slippers; children's clothing; t-shirts; shirts; polo shirts; belts [clothing]; ladies' clothing; aprons [clothing]; clothing for babies; menswear.

Class 14

37. The goods "*Jewellery; precious stones; chronoscopes; stopwatches; clothing ornaments of precious metals; action figures (decorative -) of precious metal; chronometric apparatus and instruments; watches*" are dissimilar to the opponent's goods in Classes 18 and 25. Their nature and main purpose are different. Although some of the contested goods, such as jewellery, are worn for personal adornment and some of the opponent's goods, such as handbags, in Class 18 and goods in Class 25 may also serve as a type of adornment, the main function of these goods is to carry things or dress the human body, rather than purely to decorate it. The goods under comparison do not have the same distribution channels and are not in competition; nor are they complementary in the sense that one is indispensable (essential) or important (significant) for the use of the other. Even though some fashion designers nowadays also sell fashion accessories (such as jewellery) and travel accessories under their marks, this is not the rule; it tends to apply only to (commercially) successful designers. Furthermore, such an aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see to that effect EGC, Longines, T-505/12, 12 February 2015, ECLI:EU:T:2015:95 and Emidio Tucci, T-357/09, 27 September 2012, ECLI:EU:T:2012:499). That not being the case, the Office considers the goods not similar.

Class 18

38. The contested goods "*Travel cases; suitcases; luggage; handbags; holdalls; backpacks; portfolio cases [briefcases]; travelling sets [leatherwear]; toiletry cases sold empty; vanity cases, not fitted; shopping bags; wheeled shopping bags; bags for sports; satchels; book bags; beach bags; weekend bags; garment bags for travel*" are identical or at least highly similar to the goods "trunks and suit-cases; bags, ladies and gentlemen's hand-bags" mentioned in Class 18 of the trademark invoked. All these goods are used by people for carrying different items, in order to take these items with them when they are travelling from one place to another. Therefore, their nature and purpose are the same. Furthermore, these goods could be offered to the public by the same stores, thus the consumer could assume that these products originate from the same undertaking (BOIP, opposition decision 2005550, Only, 9 December 2011).

39. The contested goods "*wallets; wallets, not of precious metal; card cases [notecases]; business card cases; key-cases; leather key cases; credit card holders*" are similar to the goods "bags and handbags" of the trademark invoked. These goods have the same general purpose, namely to carry personal items. They can have the same distribution channels, for example special stores for bags and accessories. They also target the same public and are likely to be manufactured by the same producers.

40. However, with regard to the goods "*Umbrella's and walking sticks*", the Office finds that these goods are of a different nature and that their method of use is different from the goods for which the trademark invoked is registered. Furthermore, these goods are not in competition with each other, nor are they complementary. Therefore, these goods are not similar to the goods on which the opposition is based.

Class 25

41. The goods "*footwear*" of the contested sign are mentioned *expressis verbis* in both lists of goods and are therefore identical.

42. With regard to the goods "*clothing; headwear; sweatshirts; jogging suits; jeans; pants; shorts; tank tops; rainwear; skirts; blouses; dresses; sweaters; jackets; coats; raincoats; snowsuits; ties; hats; caps; sun visors; scarves; sleepwear; pyjamas; lingerie; underwear; boots; shoes; sneakers; sandals; beachwear; trousers; socks; slippers; children's clothing; t-shirts; shirts; polo shirts; belts [clothing]; ladies' clothing; aprons [clothing]; clothing for babies; menswear*", the Office considers that these goods are similar to the goods "Shoes, boots, slippers and footwear in general" mentioned in Class 25 of the trademark invoked. All of these goods are worn by people in order to cover and protect the body. Furthermore, these goods are often commercialized by the same distribution channels and clothing, shoes and hats are often introduced to the market under the same trademark. The Office is of the opinion that the consumer is aware of this and will assume that these products originate from the same undertaking (BOIP, Nano, opposition decision 2002033, 25 May 2009).

Conclusion

43. The goods are partly identical, partly similar and partly not similar.

A.2 Global assessment

44. 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.

45. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary according to 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.

46. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors 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).

47. The more distinctive the earlier trademark, the greater is 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 trademark invoked has a normal distinctiveness, as it is not descriptive of the goods concerned.

48. Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.

49. In the light of the circumstances mentioned above, including the visual and aural similarity as well as the fact that the goods are either identical or strongly similar, the Office is of the opinion that the relevant public might believe that the identical and similar goods come from the same undertaking or from economically-linked undertakings.

B. Other factors

50. The defendant states that there can be no likelihood of confusion, because the contested sign is always accompanied by an image of a monkey (paragraph 12 and 14). Furthermore, according to the defendant, the parties operate in very different markets. They have very different distributional channels and the goods are intended for a different public (paragraph 12 and 14). However, the Office points out that the opposition procedure leaves no room for considerations concerning the actual use of the signs. The comparison of the signs is solely based on the information in the register and the contested sign does not depict any image of a monkey. Furthermore, since the particular circumstances in which the goods covered by the signs are marketed may vary in time and depend on the wishes of the proprietor of a trademark, these circumstances play no role in opposition proceedings (see to that effect: CJEU, Quantum, C-171/06, 15 March 2007, ECLI:EU:C:2007:171, O2 Holdings Limited, C-533/06, 12 June 2008, ECLI:EU:C:2008:339 and EGC, Ferromix e.a., T-305/06-T-307/06, 15 October 2008, ECLI:EU:T:2008:444).

C. Conclusion

51. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion for the goods which are considered identical or similar.

IV. DECISION

52. The opposition with number 2013239 is partly justified.

53. Benelux application with number 1353025 will not be registered for the following goods which are identical or similar:

- Class 18 Travel cases; suitcases; luggage; handbags; holdalls; backpacks; portfolio cases [briefcases]; travelling sets [leatherwear]; toiletry cases sold empty; vanity cases, not fitted; shopping bags; wheeled shopping bags; bags for sports; satchels; book bags; beach bags; weekend bags; garment bags for travel; wallets; wallets, not of precious metal; card cases [notecases]; business card cases; key-cases; leather key cases; credit card holders.
- Class 25 (*all goods*)

54. Benelux application with number 1353025 will be registered for the following goods which are not similar:

- Class 14 (*all goods*)
- Class 18 Umbrellas; walking sticks.

55. 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, 16 November 2018

Eline Schiebroek
(rapporteur)

Saskia Smits

Pieter Veeze

Administrative officer: Ellen van Holst