

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2013318**  
**of 27 February 2019**

**Opponent:** **RIMOWA GmbH**  
Richard-Byrd-Strasse 13  
50829 Köln  
Germany

**Representative:** **Arnold & Siedsma**  
Postbus 18558  
2502 EN The Hague  
The Netherlands

**1<sup>st</sup> right invoked:** **EU trademark 12027256**  
  
Rimowa

**2nd right invoked:** **well-known mark as referred to in Article 6bis of the Paris Convention**  
  
Rimowa  
  
*against*

**Defendant:** **Shenzhen Newmowa Digital Co.,Ltd.**  
Rm 203, No.2, Bldg.88, Longwangmiao Industrial Park Baishixia,  
Fuyong Street 2  
Bao'an Dist. Shenzhen Guangdong,  
China


**Representative:** **ABCOR BV**  
Postbus 2134  
2301 CC Leiden  
The Netherlands

**Contested trademark:** **Benelux application 1355108**

**Newmowa**

**I. FACTS AND PROCEEDINGS****A. Facts**

1. On 6 June 2017 the defendant filed an application for a trademark in the Benelux for the combined

word/figurative mark  for goods in class 9. This application was processed under number 1355108 and was published on 14 June 2017.

2. On 4 August 2017 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier rights:

- EU trademark 12027256 for the word mark Rimowa, filed 31 July 2013 and registered on 10 January 2014 for goods and services in classes 3, 6, 9, 14, 15, 16, 18, 20, 21, 25, 26, 28, 33, 34, 35, 37, 39, 41, 42 and 45;
- word mark Rimowa, a well-known mark as referred to in Article 6bis of the Paris Convention.

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

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

5. The grounds for opposition are those laid down in article 2.14, 1 (a) and (b) 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 7 August 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 28 February 2018.

**II. ARGUMENTS**

8. The opponent filed an opposition at the Office under article 2.14, 1 (a) and (b) 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 or which may give rise to confusion with its well-known trademark within the meaning of Article 6bis of the Paris Convention.

**A. Opponent's arguments**

9. The opponent stresses the fact that the mark RIMOWA does not have any meaning whatsoever and that its distinctiveness is therefore to be regarded as inherently strong. According to the opponent the mark has acquired and still enjoys a very well-known reputation in many jurisdictions, including the Benelux for goods and services in relation to suitcases, bags, protective cases and the like.

10. The opponent finds that the figurative element in the contested sign, being the stylized letter –O, should be disregarded. The public will link the styling to the “power on/off” symbol which is common and not distinctive. The public will refer to the contested sign as NEWMOWA, according to the opponent, who furthermore is of the opinion that the conceptual meaning of the word NEW is extremely likely to raise the impression that the contested sign is connected to the well-established and reputed mark of the opponent.

11. With regard to the visual comparison of the signs, the opponent argues that they share the latter part -MOWA. They differ in the letters RI- at the beginning of the trademark invoked and the letters NEW- at the beginning of the contested sign and the special styling of the letter –O. Both the word NEW and the special styling of the letter -O are unlikely to catch the specific attention of consumers (see paragraph 10). According to the opponent the right invoked and the contested sign are visually similar to an average degree.

12. Aurally, the marks in total come very close, as for both signs focus is particularly drawn to the last part –MOWA, as many consumers in the Benelux are likely to put emphasis on the second syllable. Considering the non-distinctive nature of the first part NEW- in the contested sign, both are to be considered aurally highly similar, according to the opponent.

13. The opponent is of the opinion that a conceptual comparison is without any effect, as neither mark will be associated with any relevant meaning.

14. The opponent finds that the contested goods are partly identical and partly highly similar to the goods and services of the trademark invoked.

15. Whereas the goods of the contested sign are directed to the public at large, the level of attention of the relevant consumer is considered to be as average or a bit above average, according to the opponent.

16. The opponent elaborates on the fact that the right invoked has an enhanced scope of protection due to the fact that the trademark RIMOWA has acquired an extremely well-established reputation on international level, including in the Benelux. The opponent mentions the fact that his trademark and trade name were launched almost 120 years ago. Opponent's high quality products are distributed in more than 65 countries via authorized dealers, company-owned shops and flagship stores. Actually there are more than 120 RIMOWA flag stores throughout the world, often in the most luxurious shopping areas of bigger cities such as Paris, London, Rome, Tokyo and New York. There are flag stores in Belgium and The Netherlands. Opponent emphasizes the widely known and well-established reputation of the mark by mentioning the fact that in 2017 the French luxury group LVMH acquired a 80% stake in the brand RIMOWA against an amount of 640 million euro. Total revenues under the brand RIMOWA amounted to 273 million euro in 2014 and 350 million in 2015, according to the opponent.

17. Furthermore the opponent is of the opinion that the applicant of the contested sign takes, without due cause, unfair advantage of the well-established reputation of the mark RIMOWA and that the use of the contested sign is likely to negatively affect the distinctive character or be detrimental to the reputation of the trademark RIMOWA. The opponent files evidence supporting the well-known reputation of the mark RIMOWA.

18. The opponent asks the Office to appreciate the fact that the trademark registers extending to the Benelux do not disclose any other three syllable marks comprising the word element –MOWA at the end, apart from EU registration FILMOWA and International registration TOMOWA.

19. The opponent asks the Office to accept the opposition in its entirety, to reject the contested Benelux application and to have the defendant compensate the costs made by the opponent.

## **B. Defendant's arguments**

20. The defendant points out that he is a Chinese manufacturer of high-quality batteries, battery chargers and other accessories for digital cameras. The company was founded in 2013 and aims to provide a full range of high-quality accessories for digital cameras to consumers around the world.

21. According to the defendant, both opponent and defendant direct their goods at the general public. Because of the fact that luggage, bags and suitcases as well as cameras are only bought on occasion, the consumer will make a careful assessment of the available products. The defendant finds that the degree of attentiveness will therefore be at least above average.

22. Visually, the invoked right and the contested sign differ in their prefixes RI- and NEW-. These elements are visually very different. They differ in the amount of letters, they do not share a single letter and the visual impression is very different. Both coincide in their final elements -MOWA, but the stylization of the letters M and O in the contested sign will not go unnoticed. The defendant is of the opinion that the visual differences outweigh their similarities. Therefore, the visual similarity between the signs is low, according to the defendant.

23. The defendant admits that there exists a certain degree of auditive similarity due to the shared final element -MOWA. However, the beginnings, RI- and NEW-, are pronounced very differently in all the languages commonly spoken in the Benelux. The phonetic difference is audible for every consumer and this will have a significant impact on the overall auditive impression. The defendant concludes that the phonetic similarity is low.

24. With regards to the conceptual similarity, the defendant states that neither the right invoked nor the contested sign have a meaning as a whole. However, the defendant is of the opinion that the contested sign would be perceived as consisting of the words NEW and MOWA. The element NEW has a clear meaning to all consumers in the Benelux, namely that of "recent, novel or modern". The right invoked lacks a similar meaning and therefore the consumer will perceive a conceptual difference between both, according to the defendant.

25. The defendant is of the opinion that some of the goods can be considered similar or similar to a low degree. The remainder of the goods are manifestly dissimilar, according to the defendant.

26. Insofar as the opposition is based on Article 6bis of the Paris Convention, the defendant is of the opinion that the evidence supplied by the opponent does not show that its brand RIMOWA enjoys high recognition in the Benelux, or indeed anywhere in the world. The evidence lacks market studies or evidence relating to marketing efforts, such as advertisements. Nor did the opponent supply any evidence of successful enforcement actions. Furthermore, the evidence filed, relates to general purpose luggage only and not to bags or cases specifically for cameras, bags or cases for accessories for cameras, or protective covers for electronics. These factors and the fact that the right invoked and the contested sign are visually and phonetically only similar to a low degree, and dissimilar in their conceptual content, results in the conclusion that the requirements to find a likelihood of confusion are absent. Consequently, the defendant states that the opposition should be rejected as far as it is based on Article 6bis of the Paris Convention.

27. The opponent claims that its mark RIMOWA enjoys a high degree of distinctiveness given that it has no meaning. According to the defendant, this reasoning cannot be accepted. The fact that a sign has no meaning, could only lead to the conclusion that it possesses the normal distinctive power that is required for any sign to function as a trademark. The opponent also claims that the high degree of distinctiveness is due to the extensive and long use of the mark. The defendant finds that the evidence of enhanced distinctiveness lacks in this case. Even though the defendant is aware of the fact that the mark RIMOWA has been used for a long time, he finds that no sufficient evidence was provided by the opponent to conclude that the mark enjoys high distinctiveness in the Benelux or the wider EU.

28. The defendant points to an opposition procedure before the European Union Intellectual Property Office (hereafter: EUIPO) concerning signs identical to the ones in the present case. In that case, the EUIPO Opposition Division found that no likelihood of confusion existed.

29. All things considered, the defendant finds that the signs are not similar and that the relevant goods are dissimilar or weakly similar. Moreover, they are targeted at an audience that will generally display a high degree of attentiveness when preparing to make a purchase. Therefore, the consumer will not presume that the goods marketed under the sign NEWMOWA come from the opponent or from an undertaking that is economically linked to the opponent.

30. The argument of the opponent that the defendant may take unfair advantage of the reputation of the mark RIMOWA has no relevance for the present proceedings, according to the defendant.

31. The defendant requests that the Office rejects the opposition and awards costs against the opponent.

### **III. DECISION**

#### **A.1 Likelihood of confusion**

32. 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.

33. 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.”*

34. According to case law of the Court of Justice of the European Union (hereinafter: “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 goods and services**

35. 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).

36. With the comparison of the goods of the right 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 the goods for which genuine use has been proven on the one hand and the goods as indicated in the trademark application on the other hand.

37. The goods and services to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
Cl 3 Perfumery, soaps, cosmetics.	
Cl 6 Key locks, padlocks, combination locks, locks for luggage, tool chests and containers of metal.	
Cl 9 Notebook and laptop cases, camera cases of metal or of plastic or of fabric material or a combination of the aforesaid materials, cases adapted for portable computers, camera bags, protective covers adapted for electronic devices, glasses, sunglasses.	Cl 9 Smart cards [integrated circuit cards]; encoded identification bracelets, magnetic; electronic tags for goods; toner cartridges, unfilled, for printers and photocopiers; monitoring apparatus, electric; microphones; camcorders; close-up lenses; cameras [photography]; filters [photography]; tripods for cameras; flashlights [photography]; lens hoods; lenses for astrophotography; optical lenses; mirrors [optics]; alarms; anti-theft warning apparatus; smoke detectors; chargers for electric batteries; batteries, electric; headphones; regulating apparatus, electric; switches, electric; computer peripheral devices;

	tablet computers; relays, electric; remote control apparatus; divers' masks; locks, electric.
Cl 14 Jewelry cases [caskets], Key rings, Clocks and watches, Wristwatches, Containers of precious metal.	
Cl 15 Specially adapted bags or luggage containers for musical instruments, cases for string instruments, in particular guitars.	
Cl 16 Paper, cardboard and goods made from these materials, not included in other classes; Printed matter; Bookbinding material; Photographs; Stationery; Plastic materials for packaging (not included in other classes); Portfolios being stationery cases for holding documents, Stationery type portfolios, Writing instruments, Appointment books, Agenda books, Pencils, Pen, Cheque holders, Notebook cases.	
Cl 18 Luggage boxes, Travelling trunks, Valises, Travelling bags, Trolley cases, Vanity cases, not fitted, Attaché cases, Cases and parts therefor, included in class 18, in particular suitcase handles, telescopic handles for cases, case wheels; Briefcase; Backpacks, Money holders, Pocket wallets, Belt bags, Travelling sets [leatherware], Garment bags for travel, Bags for sports, Toiletry kits, Waist pouches, book bags, Leather and imitations of leather and articles made therefrom, not included in other classes; Luggage straps, luggage tags; Luggage and umbrellas.	
Cl 20 Containers made of plastic.	
21 Toilet utensil cases; Holders for wine bottles, household or kitchen containers, insulated containers and vessels.	
Cl 25 Clothing, Tee-shirts, Headgear for wear, Caps.	
Cl 26 Zip fastener devices, Zippers, Zippers for bags.	
Cl 28 Specially adapted bags or luggage containers for sporting equipment, Golf bags, with or without	

wheels.	
CI 33 Alcoholic beverages (except beers).	
CI 34 Tobacco, Smokers' articles, Cigar boxes (with humidor).	
CI 35 Business management; Business administration; Advertising; Publicity agencies, Development of advertising and marketing concepts, Publication of publicity texts, Organization of exhibitions for commercial or advertising purposes; Organization of trade fairs for commercial or advertising purposes; Market research and market analysis; Import and export agencies, flagship stores, consultancy regarding flagship stores, wholesaling and retailing, as well as online mail order, in the fields of leatherware, Suit cases, Trunks, Valises, Travelling bags, Trolley cases, Vanity cases (not fitted), Attaché cases, Suit cases and Parts thereof, In particular suitcase handles, telescopic handles for suitcases, rollers for suitcases, Briefcases, Rucksacks, Banknote holders, Wallets, Bumbags, Travel accessories (leather goods), Garment bags for travel, Sport bags, Toilet bags, Waist bags, book bags, Luggage belts, luggage tags, Luggage, Umbrellas.	
CI 37 Maintenance, repair of suitcases.	
CI 39 Travel services; Rental of suitcases.	
CI 41 Providing electronic non-downloadable publications online, providing online publications and online prospectuses.	
CI 42 Carrying out technical research, development and consultancy assignments, Design services, Engineering, Updating of Internet pages; Consultancy with regard to the design of homepages and Internet pages; Providing of computer programs in data networks; Graphic art design services, graphics, industrial and/or packaging design; Research and development; Creation of web pages; Webpage design; Providing of technical expertise (franchising).	
CI 45 Issuing licences for franchising concepts.	



### Class 9

38. The goods "*camcorders; cameras [photography]; computer peripheral devices; tablet computers*" of the contested sign are similar to "*notebook and laptop cases, camera cases of metal or of plastic or of fabric material or a combination of the aforesaid materials, cases adapted for portable computers, camera bags*" of the right invoked. After all, these goods of the right invoked are specifically adapted to the shape of the goods of the contested sign. Furthermore, they have the same relevant public, distribution channels and are often manufactured by the same companies.

39. The goods "*microphones; flashlights [photography]; headphones; remote control apparatus*" of the contested sign are similar to the opponent's "*protective covers adapted for electronic devices*". These covers are specifically adapted to the shape of the relevant electronic device. The aforementioned goods of the contested sign are all electronic devices, for which protective covers are fabricated (see paragraph 38).

40. The goods "*electronic tags for goods*" of the contested sign may include luggage tags. They are therefore similar to the goods "*luggage tags*" in class 18 of the right invoked. These goods coincide in their purpose and are in competition. Furthermore, their public and distribution channels are the same.

41. The goods "*optical lenses*" of the contested sign are highly similar to the goods "*glasses*" of the right invoked. Optical lenses encompass contact lenses. These goods are in competition, target the same public and are provided for by the same retailers (distribution channels), namely opticians.

42. The goods "*close-up lenses; filters [photography]; lens hoods; lenses for astrophotography; mirrors [optics] and divers' masks*" of the contested sign are similar to the goods "*glasses*" of the right invoked whereas these goods all contain "optical lenses".

43. The goods "*tripods for cameras*" of the contested sign are dissimilar to the goods and services of the right invoked. They differ in their nature and purpose and are generally fabricated by different manufacturers.

44. The remaining goods of the contested sign, namely "*smart cards [integrated circuit cards]; encoded identification bracelets, magnetic; toner cartridges, unfilled, for printers and photocopiers; monitoring apparatus, electric; alarms; anti-theft warning apparatus; smoke detectors; chargers for electric batteries; batteries, electric; regulating apparatus, electric; switches, electric; relays, electric; locks, electric*" do not have the same nature or purpose as the goods and services of the right invoked. They are neither in competition, nor are they complementary. They originate from different manufacturers. These goods are therefore dissimilar.

### Conclusion

45. The goods of the contested sign are partly (highly) similar and partly dissimilar to the goods and services of the right invoked.

**Comparison of the signs**

46. 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).

47. 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).

48. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
<b>Rimowa</b>	<b>Newmowa</b>

49. The right invoked is a purely verbal sign, consisting of the word “Rimowa”. The contested sign is a combined word/figurative sign, consisting of a word element “Newmowa” whereby the letter “o” is stylized. The stylization might be perceived as a ‘power on/off button’. Although the stylization of the letter “o” cannot be completely neglected, the Office is of the opinion that the public will refer to the contested sign as “Newmowa”.

*Conceptual comparison*

50. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd, already cited), the fact remains that, when perceiving a verbal sign, he will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him (European General Court (hereinafter: “EGC”), Respicur, T-256/04, 13 February 2007, ECLI:EU:T:2007:46; Aturion, T-146/06, 13 February 2008, ECLI:EU:T:2008:33; Galvalloy, T-189/05, 14 February 2008, ECLI:EU:T:2008:39 and Ecoblue, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). In view of the level of understanding of the English language amongst the relevant public in the Benelux, the Office is of the opinion that the (starting) element “New-” in the contested sign will be recognized as such. This element would therefore be interpreted by the public as non-distinctive, whereas it describes a characteristic of the relevant goods (namely indicating their newness). In that case, the dominant part of the contested sign would be “mowa”. This word element has no meaning whatsoever in the languages spoken in the Benelux.

51. The right invoked will not be associated with any meaning. Since neither sign has a relevant meaning as a whole, a conceptual comparison is not possible.

*Visual comparison*

52. The right invoked consists of one word of six letters, Rimowa. The contested sign consists of one word of seven letters, Newmowa. Both share the last four letters, “-mowa” in an identical position. They differ in the first two letters of the right invoked, “Ri-“ and the first three letters of the contested sign, “New-“ and its stylized letter “o”.

53. Normally the consumer attaches more value to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). However, this analysis does not automatically apply, whereas the first part of a sign is found to be non-distinctive and therefore not dominant. In this particular case the first element of the contested sign consists of a non-distinctive word, “New” (see paragraph 50).

54. The Office finds that the right invoked and the contested sign are visually similar to a certain degree.

*Aural comparison*

55. The right invoked and the contested sign both consist of three syllables, Ri-mo-wa and New-mo-wa. The right invoked will be pronounced as [ri-mo-wa] and the contested sign as [niu-mo-wa]. The pronunciation coincides in the last two syllables “-mo-wa” and differs in the syllable at the beginning of the signs, “ri-” versus “new”.

56. The right invoked and the contested sign are aurally similar to a certain degree.

*Conclusion*

57. The right invoked and the contested sign are visually and aurally similar to a certain degree. A conceptual comparison is not possible.

**A.2 Global assessment**

58. 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.

59. 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 goods concerned are targeted at both the public in general as well as at business consumers with a specific professional knowledge. The assessment should be based on the lowest level of attention, which in case is an average level of attention.

60. 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).

61. 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). The opponent claims that the right invoked has an enhanced scope of protection due to the fact that the trademark RIMOWA has acquired an “extremely well-established reputation on international level, including in the Benelux” (see paragraph 16). The opponent filed the following pieces of evidence to support this statement:

- I. printouts from online publications and press clips from magazines published in various EU countries in 2016;
- II. information regarding the history of the company RIMOWA, including sales volume figures during the period 2010-2013;
- III. product catalogues during the period 1982-2016;
- IV. press releases and photographs concerning the opening of various RIMOWA stores in Europe;
- V. overview of RIMOWA’s trademark portfolio;
- VI. extract from Wikipedia and relevant pages of the financial report 2016 of the LVMH group, attesting the acquisition of RIMOWA business;
- VII. online extract of RIMOWA’s website providing information on the annual revenues over the years 2014-2015 and relevant pages from a company report of Samsonite (competitor) containing information about RIMOWA;
- VIII. an overview of trademarks consisting of three syllables, ending on the word –MOWA in Benelux.

62. The Office finds that the material provided shows that the trade mark RIMOWA has been used in recent years, supposedly at least dating back to 1982 (see: catalogues under III.). Information is also given about the history of the company in general (see II.). Evidence of use can also be deduced from various other sources such as advertisements as shown in online publications and press clips in leading fashion magazines in Europe (see I.) and the placement of (flagship) stores in the Benelux on “first-class” locations, such as the P.C. Hoofstraat in Amsterdam (since 2016) and the Leopoldstraat in Antwerp (since 2013) as shown in the material mentioned (see IV.). Finally, the mentioned turnover and the fact that the company has been acquired (for 80%) by the LVMH group (see VI.) could be seen as supportive evidence of use of the trademark in the market segment of luxury travel luggage.

63. However, the Office must conclude that the material provided does not provide sufficient evidence of the degree of recognition of the trade mark by the relevant public in the Benelux. A few advertisements are shown from magazines appearing on the Belgian and Dutch market and the (flagship) stores were recently (2013 and 2016) opened in Antwerp and Amsterdam. The material lacks “independent” evidence that informs the Office about the specific market for the relevant goods (‘luxury travel cases’) and the positioning of the opponent in that market, which could have been supported by specified turnover figures and information on marketing budgets for the Benelux. The degree of recognition of the trade mark in the Benelux could have been substantiated by market researches and/or surveys.

64. Lastly, the Office finds that the material provided does solely concern certain goods in class 18, in particular (luxury) travel luggage. Even if the Office should conclude that the trademark RIMOWA enjoys a level of recognition, which justifies the conclusion that it has an enhanced distinctiveness or reputation, this would only apply to the aforementioned goods, namely (luxury) travel luggage. Whereas the similarity found between the goods and services of the right invoked and the goods of the contested sign does not involve these particular goods, the Office will proceed with the global assessment of the risk of confusion, taking into account a normal (average) level of distinctiveness of the right invoked, as it is not descriptive of the goods and services concerned.

65. The contested goods are partly similar and partly dissimilar to the goods and services of the right invoked. The signs are visually and aurally similar to a certain degree. A conceptual comparison is not relevant. The level of attention of the relevant public is average and the right invoked has a normal degree of distinctiveness.

66. Based on the aforementioned circumstances, the Office is of the opinion that there exists a risk of confusion for the contested goods which were found to be similar to the goods of the right invoked. The public might be led to believe that these goods originate from the same or economically linked undertakings. To this conclusion might be added the fact that the non-distinctive (first) element of the contested sign, "New", might result in leading the public to believe that the contested sign represents a "new" product line of the opponent (see also paragraph 50).

#### *Conclusion*

67. Considering all the above, the Office finds that there exists a likelihood of confusion regarding the goods which were found to be similar.

#### **B. Other factors**

68. The opposition is also based on the well-known mark as referred to in Article 6bis of the Paris Convention "Rimowa". In opposition proceedings the scope of protection of a well-known mark as referred to in Article 6bis of the Paris Convention is limited to situations where likelihood of confusion has been established. This is explicitly stated in Article 2.14, paragraph 1, (b). BCIP in conjunction with Article 6bis of the Paris Convention and WIPO's Joint Recommendations. As a consequence, oppositions in the Benelux which are based on a non-registered trade mark will be assessed in the same way as oppositions based on registered trademarks. The Office has concluded that the material provided (see paragraph 64) is limited to (a part of) the goods in class 18. Even in the case that the Office would find the trademark "Rimowa" to be a well-known mark as referred to in Article 6bis of the Paris Convention, the scope of the opposition would not extend the scope of protection based on the first right invoked. The Office shall therefore leave this examination out of account.

69. Furthermore, the opponent is of the opinion that the applicant of the contested sign takes, without due cause, unfair advantage of the well-established reputation of the mark RIMOWA and that the use of the contested sign is likely to negatively affect the distinctive character or be detrimental to the reputation of the trademark RIMOWA (see paragraph 17). The Office would like to point out to the fact that an opposition based on Article 2.14, paragraph 1, (a) in conjunction with Article 2.3. (c) BCIP (trademarks with a reputation) can only be introduced as of 1 June 2018. Since the current opposition was filed on 4 August 2017 the aforementioned ground cannot be withheld.

70. The defendant points to an opposition procedure before the EUIPO concerning signs identical to the ones in the present case. In that case, the EUIPO Opposition Division found that no likelihood of confusion existed (see paragraph 28). The Office would like to point out that it is not bound by other and/or its previous decisions. Each case has to be dealt with separately and with regard to its particularities. For the sake of completeness, the Office would like to point out the fact that the Boards of Appeal have recently annulled the aforementioned decision (see: EUIPO Fourth Board of Appeal 23 October 2018, Case R 51/2018-4).

**C. Conclusion**

71. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion for the goods which are found to be similar.

**IV. DECISION**

72. The opposition with number 2013318 is partially upheld.

73. Benelux application with number 1355108 will not be registered for the following goods:

- Class 9: *Electronic tags for goods; microphones; camcorders; close-up lenses; cameras [photography]; filters [photography]; flashlights [photography]; lens hoods; lenses for astrophotography; optical lenses; mirrors [optics]; headphones; computer peripheral devices; tablet computers; remote control apparatus; divers' masks.*

74. Benelux application with number 1355108 will be registered for the following goods, which were found to be dissimilar:

- Class 9: *Smart cards [integrated circuit cards]; encoded identification bracelets, magnetic; toner cartridges, unfilled, for printers and photocopiers; monitoring apparatus, electric; tripods for cameras; alarms; anti-theft warning apparatus; smoke detectors; chargers for electric batteries; batteries, electric; regulating apparatus, electric; switches, electric; relays, electric; locks, electric.*

75. 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, 27 February 2019

Tomas Westenbroek  
(*rapporteur*)

Pieter Veeze

Diter Wuytens

Administrative officer: Rudolf Wiersinga