



BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2009300
of 24 August 2015

Opponent: **MBK INDUSTRIE**
Zone industrielle de Rouvroy
02100 SAINT-QUENTIN
France

Representative: **Office Kirkpatrick S.A.**
Avenue Wolfers 32
1310 La Hulpe
Belgium

Invoked right: **International registration 552255**

BOOSTER

against

Defendant: **Robert Bosch GmbH**
Wernerstraße 1
70469 Stuttgart
Germany

Representative: **V.O.**
Johan de Wittlaan 7
2517 JR Den Haag
The Netherlands

Contested trademark: **International registration 1173818**

iBooster

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

1. On 24 June 2013 the defendant made an international trademark application, having effect in the Benelux, for the word mark "iBooster" for goods in class 12. This application was processed under number 1173818 and was published on 19 September 2013 in the WIPO Gazette of International Marks 2013/35.

2. On 29 November 2013 the opponent filed an opposition against the registration. The opposition is based on the earlier international application 552255, having effect in the Benelux, for the word mark "BOOSTER", filed on 26 March 1990 for goods in class 12.

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

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

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

6. The language of the proceedings is English.

B. Chronological order of the proceedings

7. The opposition is admissible and was notified to the parties on 3 December 2013.

8. On 4 February 2014 V.O. informed the Office that they would represent the defendant in these opposition proceedings. The Office notified the intervention to the parties on 10 February 2014.

9. Following several joint requests to extend the cooling-off period the adversarial phase of the proceedings started on 4 June 2014. The Benelux Office for Intellectual Property (hereinafter: "the Office") sent the notification of the commencement of the proceedings on 5 June 2014 to the parties, giving the opponent the opportunity to substantiate the opposition by submitting supporting arguments and documents with a time limit up to and including 5 August 2014.

10. On 1 August 2014 the opponent submitted supporting arguments to substantiate the opposition. These arguments were sent by the Office to the defendant on 6 August 2014, giving the defendant the opportunity to submit a response with a time limit up to and including 6 October 2014.

11. On 2 September 2014 the defendant informed the Office that at this stage of the proceedings he did not want to respond to the opponent's arguments but requested proof of use regarding the right invoked.

12. On 23 September 2014 the Office requested that the opponent submit proof of use of the trademark on which the opposition is based with a time limit up to and including 23 November 2014.

13. On 24 November 2014 the opponent filed the proof of use requested. As the Office was closed on the last day of the time limit granted, the time limit was extended until the end of the next day on which this office was open in application of article 3.9, 3 of the Implementing Regulations under the Benelux Convention on Intellectual Property (hereinafter « IR »), here 24 November 2014. The Office sent this to the defendant on 26 November 2014, giving the defendant a time limit up to and including 26 January 2015 to submit a response to the proof of use as well as to the opponent's arguments.

14. The defendant filed a response on 26 January 2015. This response was sent by the Office to the opponent on 28 January 2015.

15. Each party filed its observations within the time limits imposed by the Office.

16. The Office has sufficient information to come to a decision on the opposition.

II. ARGUMENTS OF THE PARTIES

17. 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 trademarks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

18. The opponent first explains that the respective products of interest in this case, namely "scooters and their spare parts" and "automotive brakes", are similar as they are potentially competitive and at least complementary. In this respect the opponent refers to an opposition decision by the French Institute for Intellectual Property ("INPI") in which they decided, in line with the argumentation previously developed here, to uphold an opposition between the same parties regarding the same trademark registration.

19. As far as the comparison of the signs is concerned, the opponent considers that visually, both trademarks are word trademarks which are nearly identical, apart from the "i" at the beginning of the defendant's trademark which will hardly be noticed by the average consumer. Aurally, there is a high similarity between the respective signs. Conceptually, both trademarks refer to the alleged capacity of the product to "increase the effect of something". The conceptual identity between the trademarks will not be dismissed because of the "i" at the beginning of the defendant's sign, which, according to the opponent, has already been confirmed on a previous occasion by the Opposition Division of the Office for Harmonization in the Internal Market (hereinafter referred to as "OHIM").

20. Considering the foregoing, the opponent concludes that the average consumer with a normal degree of attention will certainly believe that the goods and services come from the same undertaking or from economically-linked undertakings. Consequently, the opponent asks the Office to reject the defendant's trademark application and to have the defendant bear all costs incurred by the opponent in filing this procedure.

21. At the request of the defendant, the opponent filed proof of use.

B. Defendant's arguments

22. The defendant is of the opinion that the opposition should be rejected as the evidence produced by the opponent is not only insufficient to prove genuine use, it also does not show use of the sign as registered. Even if the proof of use were to be deemed sufficient, the opposition should still be rejected since no likelihood of confusion exists here, according to the defendant.

23. The defendant argues that, visually, the marks BOOSTER and iBooster show very little similarity. Phonetically, the sign BOOSTER is comprised of two syllables, whereas the sign iBooster is comprised of three. When pronouncing the words on the signs, there is a substantial difference in the fact that iBooster starts with an –i, which makes for a dissimilarity. Conceptually, the element “booster” in both signs is descriptive, and the signs at issue are similar in that way, but since “booster” is a directly descriptive element, this similarity cannot be held against the applicant. Furthermore the –i within iBooster refers to “Internet”, or “interactive” and gives a whole different meaning to the sign iBooster and therefore the defendant concludes that the signs are sufficiently different in terms of concept.

24. Regarding the comparison of the goods, the defendant is of the opinion that none of the proof of use provided is related to “spare parts” as claimed in the International registration 552255 for BOOSTER. Therefore the international registration should be considered not valid for these goods in the Benelux and as a consequence the only goods sold by the opponent to be taken into consideration here should be “scooters”. The defendant considers that there can be no similarity between “scooters” and “brakes for automobiles”. Even if the Office considered the mark BOOSTER as also valid for “spare parts”, there would still be no similarity with the goods “brakes for automobiles”.

25. The defendant further argues that the goods “brakes for automobiles” are used by mechanics who are specialist professionals in the field of automobile repair or assembly. These professionals have a higher level of attention and, as a result, this public will be able to distinguish the defendant's sign from the opponent's mark. Thus a likelihood of confusion will be out of the question.

26. The defendant states that the proof of use, as filed by the opponent, is not sufficient to demonstrate genuine use of the mark BOOSTER for spare parts for scooters during the relevant period. Some of the proof of use is dated 2008, which is outside of the scope of the relevant period. It is therefore not relevant and should not be taken into account. Furthermore part of the proof of use was not readable, according to the defendant. These materials should also not be taken into account. Besides it appears that the word mark BOOSTER as registered is only used on the scooters in the form of a device mark. This differs to such an extent from the word mark, that its use cannot be regarded as genuine use of the word mark BOOSTER. The defendant concludes from the above that the mark can therefore no longer be valid for these goods.

27. The defendant is of the opinion that the opposition has no ground and should be dismissed as the genuine use of the trademark has not been sufficiently demonstrated. Even if the Office considered that the proof of use was sufficient, the defendant would then argue that BOOSTER and iBooster cannot be deemed confusingly similar marks. Therefore the defendant requests that the Office reject the opposition, registers the International trademark application iBooster and orders the opponent to pay the costs of these proceedings.

III. DECISION

A.1 Proof of use

28. Articles 2.16, 3 (a) and 2.26, 2 (a) BCIP and rule 1.29 IR stipulate that the right invoked should be put to genuine use within the Benelux territory for a continuous period of five years prior to the publication date of the sign against which the opposition is lodged.

29. Given the fact that the right invoked is registered more than five years prior to the publication date of the contested sign, the defendant's request that proof of use is submitted that is legitimate.

30. The contested sign was published on 19 September 2013. Therefore the opponent was required to show use of the right invoked, during the period from 19 September 2008 to 19 September 2013 ('the relevant period') in the Benelux for "Scooters and their spare parts" in Class 12.

31. Following rule 1.29 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the earlier trademark for the goods and services on which the opposition is based.

In general

32. In accordance with the decision of the European Court of Justice (hereinafter referred to as "ECJ") of 11 March 2003 (ECJ, Ansul, C-40/01) there is genuine use of a trademark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered. This is done in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (see also General Court of the European Union (hereinafter referred to as "EGC"), Silk Cocoon, T-174/01, 12 March 2003; EGC, Vitafruit, T-203/02, 8 July 2004; EGC, Charlott, T-169/06, 8 November 2007).

33. The EGC held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (EGC, Hipoviton, T-334/01, 8 July 2004; EGC, Sonia-Sonia Rykiel, T-131/06, 30 April 2008). The purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trademark protection to the case where large-scale commercial use has been made of the mark (EGC, Vitafruit, already referred to above).

34. In addition the EGC held that genuine use of a trademark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned (see EGC, Hiwatt, T-39/01, 12 December 2002; EGC, Vitakraft, already referred to above and EGC, Sonia-Sonia Rykiel, already referred to above).

Analysis of the proof of use

35. The opponent submitted the following exhibits in order to demonstrate the genuine use of the invoked right:

1. Promotion brochure MBK, dated 2011, referring to Booster scooters
2. Two MBK price lists, dated 2009 and 2012, mentioning prices for the Booster scooter series

3. Extract from an MBK catalogue, dated 2008, featuring a scooter of the Booster series
4. Extract from the MBK catalogue, dated 2010, featuring a scooter of the Booster series
5. Extract from the MBK catalogue, dated 2010, featuring 50 CC scooter models, amongst which different models of the Booster series
6. Extract from the MBK catalogue, dated 2011, featuring 50 CC scooter models, amongst which different models of the Booster series
7. Extract from the MBK catalogue, dated 2012, featuring a Booster scooter
8. MBK catalogue, dated 2014, featuring scooters from the Booster series
9. Extract from the mbk.be website, dated 2014, featuring scooters from the Booster series
10. Extract from dns.be, dated 2014, submitted as evidence for the registration of the mbk.be website with the Belgian association for Domain Name Registration called "DNS"

36. The defendant argues that some of the proof of use submitted falls outside the scope of the relevant period (see point 26). The Office finds that exhibits 8 and 9 are indeed dated outside of the relevant period. It should be noted here however that the mere fact that some of the proof of use dates outside of the relevant period, does not necessarily mean that these exhibits cannot be taken into consideration. They can still serve to support other proof that was submitted or can contribute to a better analysis of the scope of the use of the invoked right in the relevant period (see ECJ, La Mer Technology, C-259/02, 27 January 2004; ECJ, Alcon, C-192/03 P, 5 October 2004 and the case law referred to there and ECJ, Aire Limpio, T-168/04, 7 September 2006).

37. Exhibits 3, 4 and 7, are all extracts from an MBK catalogue. They show photos and technical information about MBK scooter models from a series named BOOSTER. However there is no clear indication that these catalogues were used within the territory of the Benelux. Therefore the Office deems that these cannot be considered as valid proof of use.

38. Exhibit 10 is an extract from the DNS website showing the registration of the domain name mbk.be. Apart from the fact that this extract dates from outside the relevant period, it does not mention the right invoked BOOSTER. This exhibit can therefore not be taken into account here.

39. The only exhibits that date from within the relevant period, are exhibits 1, 2 (MBK promotion brochure, pricelists for MBK Scooters, type 'BOOSTER') and 5 and 6 (extracts from the MBK catalogue which show different scooter models that MBK is offering, amongst which the BOOSTER series).

40. After careful analysis of all of the proof of use provided, the Office concludes that the submitted proof does not sufficiently demonstrate that the right invoked has been put to genuine use within the Benelux territory within a continuous period of five years prior to the publication date of the contested sign. As indicated above, some of the proof cannot be taken into consideration. The other exhibits do not sufficiently demonstrate the extent, duration and way in which the right invoked has been used. Exhibits 1, 2, 5, 6, 8 and 9 show scooters carrying the name "BOOSTER", but none of the evidence provided mentions the right invoked in relation to spare parts for scooters. The Office finds that it is not apparent from the evidence at hand that the opponent actually marketed the scooters, let alone their spare parts, bearing the earlier mark. For example no invoices or sales figures have been produced in this respect. The exhibits mentioned above only indicate that the scooters displayed bear the earlier mark, but not that the use of the right invoked actually serves a commercial purpose (see in this respect EGC, VOGUE, T-382/08, 18 January 2011). Therefore the opponent fails to file proof that substantiates the place, time or extent of the use, as required by article 1.29, 2 IR.

Conclusion

41. It follows from the foregoing that the evidence the opponent filed with the Office, even when assessed overall, does not meet the requisite legal standard regarding the genuine use of the earlier trade mark in the Benelux during the relevant period. Because of the lack of sufficient proof of use, the Office will not proceed to an analysis of the likelihood of confusion in the case at hand.

B. Other factors

42. As regards the opponent's reference to, in his opinion similar, decisions by other national and European institutions which the Office should follow (see points 18 and 19), the Office points out that it is not bound to follow decisions by other institutions whether the cases are similar or not. The Office has to decide on the opposition independently, based on the applicable Benelux legislation and case law (EGC, T- 353/04, CURON, 13 February 2007).

43. The opposition proceedings with the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.16, 5 BCIP and rule 1.32, 3 IR only stipulates in this respect that an amount equaling the basic opposition fee shall be borne by the losing party.

C. Conclusion

44. Now that the proof of use of the right invoked is deemed insufficient, there is no need for the Office to examine the existence of a likelihood of confusion.

IV. DECISION

45. The opposition with number 2009300 is rejected.

46. The international registration with number 1173818, having effect in the Benelux, is registered for all the goods in Class 12.

47. The opponent is under obligation to pay the defendant 1.000 euro 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, 24 August 2015

Tineke Van Hoey
(*rapporteur*)

Saskia Smits

Diter Wuytens

Administrative officer: Raphaëlle Gérard