

BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2010901

of 13 June 2016

Opponent: **TEDDY S.P.A.**
Via Coriano, 58 Gros Rimini
Blocco 97
47924 Rimini
Italy

Representative: **Novagraaf Belgium S.A./N.V.**
Terhulpesteenweg 187
1170 Brussels
Belgium

Invoked right: **European registration 1609312**

against

Defendant: **Bigfoot Properties (Europe) N.V.**
Leeuwenstraat 4
2000 Antwerp
Belgium

Representative: /

Contested trademark: **Benelux application 1306487**

KATANA

I. FACTS AND PROCEEDINGS

A. Facts

1. On 13 March 2015 the defendant filed an application for a trademark in the Benelux for the word mark KATANA for goods and services in classes 9, 25 and 38. This application was processed under number 1306487 and was published on 20 March 2015.

2. On 19 May 2015 the opponent filed an opposition against the registration of the application. The opposition is based on European registration 1609312 of the following combined word/figurative mark filed on 13 April 2000 and registered on 20 February 2002 for goods in class 25:



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

4. The opposition was initially directed against all of the goods and services relating to the contested application, but was limited by the opponent to the goods in class 25 at the time of the filing of his arguments (see paragraph 15). The opposition is based on all of the goods relating to 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. Chronological order of the proceedings

7. The opposition is admissible and was notified to the parties on 22 May 2015. 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 "IR"). The administrative phase was completed on 16 November 2015.

II. ARGUMENTS

8. The opponent filed an opposition at the Benelux Office for Intellectual Property (hereinafter: "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. Arguments of the opponent

9. The opponent considers the signs to be visually highly similar as they only differ in their second letter and in the additional figurative elements in the earlier sign. The small differences are clearly not sufficient to outweigh the strong resemblances. Aurally, there is also a high degree of similarity between the contested signs, according

to the opponent. Two out of three syllables are identical and the first syllables of the signs are similar. Furthermore the accent is on an identical syllable and consequently, the rhythm and intonation are similar. The signs only differ in their second syllable. This feature is however of minimal importance given the foregoing. In addition conceptually, the opponent is of the opinion that the majority of the relevant public will not perceive the meaning of the word KATANA, which describes a Japanese word. Therefore, an important part of the population will not be able to rely on a conceptual reference to distinguish the signs at issue and thus for them no conceptual comparison can be made. Only a part of the public will be able to perceive the meaning of KATANA. Even for this part of the public, this reference will not be sufficient to neutralise the important overall similarity of the signs at issue.

10. As far as the comparison of the goods is concerned, the opponent first of all limits the goods against which his opposition is directed to the goods in class 25. The opponent finds that the goods offered by the defendant are either identical or similar to opponent's goods.

11. The opponent states that the level of attention of the relevant public should be considered average as the goods relating to the trademark invoked are purchased by the average consumer. Furthermore, regarding the distinctive character of the trademark KITANA, the opponent argues that, as it is not descriptive of the products concerned, it has an inherently high distinctive character.

12. As the signs are visually and phonetically very similar, the goods are partly identical and partly similar and the trademark invoked has a high distinctive character, the opponent concludes that the contested Benelux application should not be registered for the goods opposed in class 25. Therefore, he requests that the Office should uphold the opposition, reject the Benelux application for the contested sign for the goods opposed and order the defendant to pay the official fees in favour of the opponent.

B. Arguments of the defendant

13. The defendant states that as far as the comparison of the goods is concerned, the goods offered by the defendant are specific in terms of their target customers, being workers and professionals. As a result the nature and purpose of the goods offered by the opponent, as well as their intended use is different from the goods offered by the defendant. Thus the defendant concludes that the goods relating to the conflicting trademarks are highly dissimilar.

14. Regarding the comparison of the signs, the defendant argues that visually the trademarks at issue differ in their entirety. The figurative element of a sphere within the earlier trademark is extremely distinctive when compared to the defendant's sign. In this regard the defendant refers to an opposition decision by the Office to support his claim. Aurally, the contested sign is clearly pronounced differently than the opponent's trademark. The defendant also points out that the opponent himself indicated that there is a difference in the syllables of the contested signs, KI-TA-NA vs. KA-TA-NA, which results in the different pronunciation of these signs. Conceptually, it is clear, according to the defendant, that no conceptual comparison can be made between the contested sign and the trademark invoked, as the relevant consumer is unlikely to confuse the two. The trademark does not have a meaning in any language, while the contested sign is a word that may have a meaning in foreign languages that are not generally spoken by the relevant public in the Benelux. A simple search of the word KATANA will provide results in Japanese. The defendant is of the opinion that in contemporary times, one does not need to be fluent in Japanese to understand the meaning of the word KATANA, which has become a common word to indicate its Japanese meaning. Thus the defendant concludes that the conflicting signs show no similarities.

15. The defendant concludes that due to the combination of figurative and word elements in the earlier trademark, the general dissimilarity between the contested signs is unavoidable. The relevant consumer is very unlikely to assume that the goods identified by the earlier mark, even if similar, stem from the same, or economically-linked, undertakings as the defendant. Therefore the defendant requests that the Office should reject the opposition in its entirety as unfounded, grant protection to the contested sign in the Benelux and order that the opponent shall bear the costs and fees arising from the opposition proceedings.

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 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; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003; Brussels, N-20060227-1, 27 February 2006).


Comparison of the 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).

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). 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 and El Charcutero Artesano, T-242/06, 13 December 2007).

22. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	KATANA

Visual comparison

23. The contested sign is a verbal mark, consisting of a single word of six letters, KATANA. The right invoked is a combined word/figurative mark, depicting in large black letters the six letter word KITANA. The letter K is twice as big as the rest of the letters. On top of the last letter A is the image of a stylized globe.

24. 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). The Office is of the opinion that the word KITANA is the dominant element in the right invoked. Given the size of the letter K, the fact that consumers read from left to right and that the image of the globe is quite small in comparison to the word element, the consumer's attention will first and foremost be drawn to the word KITANA. The globe only holds a secondary position and will be perceived as a decorative element.

25. The dominant element of the trademark invoked, KITANA, and the contested sign have five out of six letters in common, in the same position. They only differ in their second letter.

26. Visually the signs are highly similar.

Aural comparison

27. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level (EGC, PC WORKS, T-352/02, 25 May 2005 and Thai Silk, T-361/08, 21 April 2010).

28. The right invoked will be perceived and pronounced as KI-TA-NA. The contested sign will be pronounced as KA-TA-NA. Both the right and the sign are composed of three syllables of which the last two are identical, TA-NA, and the first both start with the same consonant K. The right invoked and the contested sign only differ in their

second letter, I vs. A. The Office considers that the pronunciation of the signs at issue will therefore have the same length, cadence and rhythm.

29. Aurally the signs are highly similar.

Conceptual comparison

30. The right invoked KITANA has no meaning. The Office considers that the contested sign KATANA might be perceived by a part of the public as the Japanese word for sword, however for most people this word will not have a meaning as this is a very specific term and not many people among the Benelux public are familiar with Japanese.

31. As both signs do not have a clear and precise meaning for the Benelux public, a conceptual comparison is not relevant here.

Conclusion

32. The right invoked and the contested sign are highly similar in terms of visual and aural perception. A conceptual comparison is not relevant.

Comparison of the goods

33. 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).

34. 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.

35. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Cl 25 Coats, skirts, trousers, skirts, jackets, overcoats, waterproof clothing, sweaters and pullovers, bomber jackets, hats, scarves, headscarves, stockings, gloves, belts, shoes, boots, sandals, clogs, slippers.	Cl 25 Clothing, footwear, headgear, overalls for workers, overalls for mechanics, dungarees for workers, trousers for workers, vests, sweaters, footwear for professional purposes, technical underwear.

36. The goods “*clothing*” offered by the defendant are identical to the goods “*coats, skirts, trousers, skirts, jackets, overcoats, waterproof clothing, sweaters and pullovers, bomber jackets*” offered by the opponent. The goods “*footwear*” offered by the defendant are identical to the goods “*shoes, boots, sandals, clogs, slippers*” offered by the opponent. Finally the goods “*headgear*” offered by the defendant are identical to the goods “*hats*” offered by the opponent. These goods offered by the defendant are broad, general categories that cover the

aforementioned specific articles of clothing, footwear and headgear offered by the opponent. Therefore they are considered to be identical (EGC, Metabiomax, T-281/13, 11 June 2014).

37. The goods “*overalls for workers, overalls for mechanics, dungarees for workers, trousers for workers*” offered by the defendant are similar to the goods “*trousers*” offered by the opponent. The goods overalls and dungarees offered by the defendant are one piece garments consisting of a pair of trousers with an extra piece attached that either covers the chest and has straps that go over the shoulders (dungarees) or that covers the chest and the back and has sleeves (overalls)¹. All of the goods offered by the defendant are thus trousers or at least consist of trousers. These goods are all clothing articles so that they have an identical nature. They serve the same purpose which is to protect the body from physical discomfort, whether in the course of everyday life or during work activities. They can be sold through the same retail outlets, mainly clothing stores. Besides, trousers can also be targeted at workers. These goods are therefore similar.

38. The goods “*vests, sweaters*” offered by the defendant are identical or at least highly similar to the goods “*jackets, sweaters and pullovers*” offered by the opponent.

39. The goods “*footwear for professional purposes*” offered by the defendant are identical to the goods “*shoes*” offered by the opponent. Where the goods covered by the earlier mark include the goods covered by the trade mark application, these goods are considered to be identical (EGC, Hell, 522/10, 17 January 2012). As the goods shoes offered by the opponent are defined so broadly, they can also include footwear for specific purposes, here professional purposes.

40. The goods “*technical underwear*” offered by the defendant are similar to the goods “*stockings*” offered by the opponent. When comparing the opponent’s goods with the defendant’s technical underwear, it is clear that they share the same general purpose since they are all articles of clothing. Both can also be worn together. They can be sold in the same retail outlets, e.g. clothing shops and department stores and in particular specialty clothing stores that offer technical underwear and stockings. Furthermore these goods can also be manufactured by similar kinds of undertakings active within the clothing industry. Stockings can also have a technical nature giving them certain insulation and durability properties for example. Therefore the Office considers these goods to be similar.

Conclusion

41. The goods at issue are identical, highly similar or similar.

A.2 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 borne in mind that the average consumer’s level of attention is likely to vary in accordance with the category of goods or services in question. The goods at issue are intended for the public at large with an average level of attention.

¹ See also <http://www.merriam-webster.com/dictionary/overall>.

44. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken in 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 here that normally, the average consumer perceives a mark as a whole and does not proceed to an analysis of its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different trademarks but must place his trust in the imperfect picture of them that he has kept in his 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 trademark invoked has a normal level of distinctiveness, as it is not descriptive of the goods concerned. The Office will not take into consideration the opponent's argument that the trademark invoked KITANA has an inherently high distinctive character as it is not descriptive for the products concerned (see point 11). According to article 2.1, 1 BCIP a sign should by definition be distinctive in order for it to be able to constitute a trademark (see also the decision of the Court of appeal The Hague, Roxstar, 200.044.463/01, 30 March 2010).

47. The signs at issue will often be used in writing due to the nature of the goods (clothing, footwear, headgear, etc.), for example imprinted on these articles of clothing, footwear and headgear, but also in publicity folders, on websites, etc. As a consequence the visual aspect will play a more important role. Furthermore, an oral reference to the signs is very likely – for example when asking for information at a point of sale – and thus the phonetic similarity is also significant here (BOIP, opposition decision LOTTE, 2000155, 20 July 2007).

48. Based on the abovementioned circumstances, the Office finds, given the interdependence between the identity, high similarity and similarity of the goods and the high visual and aural similarity of the signs, that the relevant public might believe that the goods in question originate from the same undertaking or from economically-linked undertakings.

B. Conclusion

49. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

IV. DECISION

50. The opposition with number 2010901 is justified.

51. Benelux application with number 1306487 will not be registered.

52. The defendant shall pay the opponent 1,000 euros in accordance with article 2.16 (5) BCIP in conjunction with rule 1.32 (3) IR, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.

The Hague, 13 June 2016

Tineke Van Hoey
(*rapporteur*)

Diter Wuytens

Camille Janssen

Administrative officer: Cees Van Swieten