



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2011094

of 21 September 2017

Opponent: **LAGARDERE SPORTS**
16-18 Rue du Dome
F-92100 Boulogne Billancourt
France

Representative: **NOVAGRAAF FRANCE**
2 rue Sarah Bernhardt - CS 90017 Bâtiment O2
92665 Asnieres-sur-Seine Cedex
France

Invoked right 1: **European registration 2489847**

SPORTFIVE

Invoked right 2: **European registration 2566552**



against

Defendant: **MYLAPS B.V.**
Zuiderhoutlaan 4
2012 PJ Haarlem
Netherlands

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwenveldseweg 12
1382 LX Weesp
Netherlands

Contested trademark: **Benelux application 1311247**

SPORTHIVE

I. FACTS AND PROCEEDINGS


A. Facts

1. On 29 May 2015 the defendant filed an application for a trademark in the Benelux for the word mark SPORTHIVE for goods and services in classes 9, 35, 38 and 41. This application was processed under number 1311247 and was published on 1 June 2015.

2. On 31 July 2015, the opponent introduced an opposition against this application. The opposition is based on the following trademarks:

- EU trademark registration 2489847 of the word mark SPORTFIVE, filed on 5 December 2001 and registered on 25 March 2003 for services in the classes 35, 41 and 42;



- EU trademark registration 2566552 of the combined word/figurative mark , filed on 6 February 2002 and registered on 19 October 2004 for services in the classes 35, 36, 41, 42 and 43.

3. The opposition was filed by SPORTFIVE. According to the European register the name of the opponent has been changed. The change of name was registered by EUIPO on 18 February 2016. According to the register the opponent is the actual holder of the invoked trademarks.

4. The opposition is directed against all the goods and services for which the contested sign is applied for and is based on all the services relating to the first right invoked and a part of the services relating to the second right invoked.

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

6. The language of the procedure 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 5 August 2015. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. 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 12 January 2017.

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 states that from a visual and aural perspective the first right invoked and the contested sign have the same length and rhythm with nine letters and two syllables. They share eight identical letters, placed in the same order, whereby only the sixth letter differs, SPORTFIVE versus SPORHIVE. Besides, these letters, namely the -F and -H are both square letters and the visual impact of this modification cannot be deemed substantial, according to the opponent. The same arguments can be held for the second right invoked. Although this trademark comprises an additional verbal element composed of the letter -S and the number -5, this does not minimize the presence of the verbal element SPORTFIVE, which is almost identical to the contested sign. The opponent considers the trademarks and the sign to be highly similar (i.e. almost identical) from a visual and phonetical point of view.

10. Conceptually, the opponent finds the contested sign to be a fancy word with no meaning taken as a whole. Nevertheless, it contains the word SPORT, also comprised in the rights invoked, which refers to the same field of activity.

11. As to the comparison of the goods and services, the opponent finds all goods and services to be identical or (highly) similar.

12. The opponent concludes that there exists a likelihood of confusion. He therefore requests that the Office rejects the registration of the contested sign.

13. At the request of the defendant, the opponent has also submitted proof of use regarding the trademarks invoked.

B. Defendant's arguments

14. The defendant argues that the proof of use submitted by the opponent does not substantiate the assertion that the trademark invoked has been put to genuine use in the relevant territory, which is the European Union. The defendant questions the documents submitted by the opponent and the scope of (possible) genuine use.

15. With regard to the visual comparison of the signs, the defendant admits that the rights invoked and the contested sign show some similarity. However, he thereby stresses the fact that the word element SPORT is to be considered descriptive and consequently the visual comparison emphasizes mainly the elements FIVE versus HIVE.

16. Aurally, the defendant finds the rights invoked and the contested sign to be similar.

17. Conceptually, both the rights invoked and the contested sign contain the word SPORT, which will be understood by the Benelux consumers. The suffix FIVE will be understood as the number 5 and the suffix HIVE of

the contested sign refers to bees in the sense of a “beehive”. Given the different meaning of the words FIVE and HIVE the rights invoked and the contested sign are not considered conceptually similar, according to the defendant.

18. The defendant is of the opinion that the conceptual difference outweighs the visual and aural similarity. Therefore, the rights invoked and the contested sign should not be considered similar.

19. Although (only) some of the goods and services may be deemed similar, according to the defendant, he stresses the fact that the opponent failed to prove genuine use for the services of the rights invoked.

20. The defendant finds the level of attention to be considered average, whereas the goods in class 9 are regular purchases intended for the public at large.

21. In conclusion, the defendant finds the rights invoked and the contested sign not to be considered similar and this also applies to the goods and services involved which are mostly dissimilar. He therefore asks the Office to accept the registration of the contested sign and have the opponent bear the costs.

III. DECISION

A.1 Proof of use

22. 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 a period of five years prior to the publication date of the sign against which the opposition is lodged.

23. Given the fact that the rights invoked are registered more than five years prior to the publication date of the contested sign, the defendant’s request that proof of use is submitted is justified.

24. The contested sign was published on 1 June 2015. Therefore the opponent was required to show use of the rights invoked, during the period from 1 June 2010 to 1 June 2015 (‘the relevant period’).

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

In general

26. 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).

27. 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).

28. In addition the EGC held that genuine use of a trademark cannot be proven 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).

29. The trademark invoked is an EU trademark, hence the obligation to use the trademark is administered by article 15 of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (hereinafter EUTMR). This article, entitled "Use of European Union trademarks", stipulates:

*"If, within a period of five years following registration, the proprietor has not put the European Union trade mark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the European Union trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for nonuse."*¹

30. In its decision of 19 December 2012 (case C-149/11, Onel), the ECJ has explained this provision. The ECJ considers regarding the concept "in the Community" that there is a difference between the territorial extent of the protection conferred on national trademarks and the extent of the protection conferred on EU trademarks. From a territorial point of view, an EU trademark enjoys a more extensive scope of protection than a national trademark. As a consequence it may reasonably be expected that an EU trademark can be used in a larger area, except for the (exceptional) case where the market of the goods and services at issue has been territorially restricted. Abstraction should be made here of the boundaries of the territory of the Member States. The ECJ concludes:

"A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

31. The threshold for genuine use of an EU trademark is therefore in principle higher than that for genuine use of a national (or Benelux) trademark. It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU and taking into account all relevant facts and circumstances.

Analysis of the proof of use

32. The opponent submitted the following exhibits in order to demonstrate the genuine use of the trademarks invoked in the European Union:

1. An excerpt of the 2015 business certificate of Sportfive Netherlands B.V, registered in December 1986;

¹ The EUTMR has been adapted by the Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015. This did not change the first paragraph of article 15, except for the replacement of the terms "Community trade mark" and "Community" by respectively "European Union trade mark" and "Union".

2. A certificate of insurance delivered to Sportfive Netherlands B.V. for 2014;
3. A sample of invoices from 2012 and 2013 to or from football clubs with respect to services in the field of sports;
4. Brochures and presentations from the football club FC Utrecht designed by the opponent;
5. Ticket box designs;
6. Sportfive – FC Utrecht staff cards.

33. With regard to the extract of the Netherlands Chamber of Commerce Commercial Register and the certificate of insurance (exhibits 1 and 2), the Office considers that these are merely proofs of evidence of a company registered in The Netherlands. However, these documents do not by itself substantiate any proof of use of the trademarks invoked.

34. The invoices mentioned (exhibits mentioned under 3) are precisely five invoices. Four of them are addressed to the opponent. Two of these originate from FC Utrecht Travel B.V. and concern two bus trips made by (employees from) Sportfive Netherlands B.V. One invoice concerns a due payment for an employee hired by the opponent through a company named Egregius and the fourth and last invoice is one for the payment of opponents membership of a regional business platform. It should be added in this regard that, in the present case, use of the addressee Sportfive Netherlands B.V. on invoices is considered use as a company name, which cannot be considered to constitute use of that word as a trademark for the purpose of identifying the services covered by the European registration (see, to that effect, HIWATT, para. 44, already referred to above). The only invoice originating from Sportfive Netherlands B.V. is one to FC Utrecht B.V. mentioning an agreement fee for the period of May 2012 for marketing activities. This invoice mentions the name as well as the logo of opponent. However, the invoice does not mention any amount nor is there any proof of earlier or later similar services rendered.

35. The presentations and brochures (exhibits under 4) mention the name and logo of the opponent. Only one reference is made to a specific date, namely October 2012. The presentations seem to have been aimed at (potential) sponsors for FC Utrecht. However, these pieces of evidence do not by itself constitute any proof of genuine use of the rights invoked. Without any supporting evidence the Office cannot even objectively conclude that these presentations actually took place. In general, further material is necessary to establish evidence of the extent of use (see to that effect: ECJ, VOGUE, T-382/08, 18 January 2011, para. 45).

36. The designs for ticket boxes and for Sportfive/FC Utrecht business cards (exhibits 5 and 6) do not prove any use of the trademarks invoked whatsoever.

37. When assessing whether certain use of the trademark is genuine, all the facts and circumstances relevant to establishing whether the commercial use of the mark is real in the course of trade must be taken into account. In particular it is of importance whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see ECJ, La Mer Technology, already referred to above). However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness (ECJ, VOGUE, mentioned above).

38. After careful analysis of the proof of use provided, the Office considers that the exhibits do not even remotely demonstrate the extent, duration and way in which the rights invoked have been used in the European Union.

C. Conclusion

39. 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 trademarks in the European Union during the relevant period. The opponent fails to file proof that substantiates the place, time or extent of the use, as required by article 1.29, 2 IR. As a result of the lack of sufficient proof of use, there is no need for the Office to examine the existence of a likelihood of confusion.

IV. DECISION

40. The opposition with number 2011094 is rejected.

41. Benelux application 1311247 will be registered for all the goods and services for which it was applied.

42. 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, 21 September 2017

Tomas Westenbroek
(*rapporteur*)

Saskia Smits

Diter Wuytens

Administrative officer: Guy Abrams