



**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**

**OPPOSITION DECISION**

**N° 2011370**

**of 22 May 2018**

**Opponent:** **United Parcel Service of America, Inc., Delaware corporation**  
Glenlake Parkway, NE 55  
Atlanta, Georgia GA 30328  
United States of America

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

**Invoked right 1:** **Benelux trademark 606517**  
UPS

**Invoked right 2:** **Benelux trademark 150688**  
UPS

**Invoked right 3:** **Benelux trademark 642208**  
UPS

*against*

**Defendant:** **Tjerk Homminga h.o.d.n. Multi-tier Consultancy**  
Desguinlei 166 b3  
2018 Antwerp  
Belgium

**Representative:** **Dirk Van Coppenolle, advocaat**  
Beverzakbroekweg 97  
3520 Zonhoven  
Belgium

**Contested trademark:** **Benelux application 1317636**  
DPS

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 24 September 2015 the defendant filed an application for a trademark in the Benelux for the word mark "DPS" for goods and services in classes 12, 35, 39 and 42. This application was processed under number 1317636 and was published on 22 October 2015.

2. On 12 November 2015 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier rights:

- Benelux trademark registration 606517 of the word mark "UPS", filed on 6 February 1997 and registered for goods and services in classes 9, 35 and 36;
- Benelux trademark registration 150688 of the word mark "UPS", filed on 6 January 1987 and registered for services in classes 38 and 39;
- Benelux trademark registration 642208 of the word mark "UPS", filed on 24 August 1998 and registered for services in class 42.

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

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

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

6. The language of the proceedings is English.

### **B. Course of the proceedings**

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 16 November 2015. 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 6 June 2016.

## **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 starts by comparing the activities of both parties.

10. He emphasizes the fact that his mark is listed number 29 of Interbrand's Best Global Brands 2015. With a brand value of 14,723 \$m, the opponent is of the opinion that the mark UPS has gained a high distinctive character over the years through very intensive use.

11. Regarding the signs to be compared, the opponent finds the opposed trademark DPS similar to the prior mark UPS as the last two letters are identical and visually the letter "U" and "D" are easily confused. Conceptually the marks are similar due to the fact that "PS" is known as an abbreviation of "Parcel Services". The U in UPS stands for "United", the D in DPS for "Delivery".

12. According to the opponent, the goods in class 12 are highly related to the services in class 39 of the trademark invoked. The services in class 35 of the contested sign are all part of the business administration services for which the trademark invoked is registered and used. The services in class 39 are identical or at least highly similar, as is the case for the services in class 42.

13. As the goods and services for which the mark is applied for are meant for the general public, the opponent is of the opinion that the level of attention must be deemed normal.

14. Based on the foregoing, in particular the high distinctive character of the rights invoked as well as the highly similar signs and partly identical and partly similar goods and services, the opponent concludes that there is a likelihood of confusion. He therefore requests the Office to allow the opposition entirely, to reject the Benelux trademark application and award payment of the costs by applicant to the opponent.

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

15. The defendant also starts by elaborating on his activities, as well as those of the opponent.

16. In response to the arguments of the opponent, the defendant states that the former did not prove that there is a likelihood of confusion.

17. With regard to the comparison of the signs, the defendant argues that the signs only exist of three letters of which the first letter – which draws the most attention of the public – is different. Based on this difference of 33% of the total sign, the defendant concludes that the sign are visually and aurally not identical or similar.

18. As regards the conceptual comparison, the defendant states that "PS" is known as an abbreviation of "Parcel Services". However, the fact that the description of the trademarks invoked both include the word "Parcel Services" does not necessarily give rise to a conceptual similarity. According to the defendant, it is generally known that in the logistics sector, most companies make use of marks existing of only a few letters, mostly abbreviation of the terms "Parcel(s)", "Distribution", "Logistics", "Services",... The public will not consider such descriptive element as the distinctive and dominant element. He therefore finds the signs conceptually not identical or similar.

19. The defendant argues that the opponent uses vague terms to describe the services offered, whereas he uses undeniably clear descriptions that limit the claimed protection to the services actually offered.

20. Regarding the goods in class 12, the defendant states that the description of the goods also relates to the scientific development of those vehicles and that he does not own nor operates any courier fleet, but just provides software solutions. The defendant argues that opponent's "business administration" does not allow to define which

specific services are referred to. Moreover, the final goal of the services provided to customers is different: UPS aims at the logistic services itself whilst the defendant aims at organising the logistic services without providing for physical transport. With regard to class 39, the defendant argues that his services all relate to the organisation of the transport and not the transport itself. As for the services in class 42, the defendant finds that they have a different purpose as his services are only focussed on developing the software solutions.

21. The defendant argues that the goods and services are considered to be aimed to meet a particular technological and professional need, and consequently the level of attention of the consumer will be higher than average. He aims its activities at a niche market in a geographically limited area. Opponent on the contrary aims its activities at a broad and general public.

22. The defendant concludes that there is no similarity between the signs. As far as the Office does accept some degree of similarity, this does not give rise to a likelihood of confusion, not in the least taking into account the fact that the relevant public has a high degree of attention. He therefore requests the Office to reject the opposition, register the application and award payment of the costs by opponent to the defendant.

### **III. DECISION**

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

23. 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.

24. 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.”*

25. 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, 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**

26. 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).

27. 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).

28. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
UPS	DPS

29. Visually, both signs are purely verbal marks. Both consists of a three letter acronym, coinciding in their last two letters, "PS". However, they differ in the first letters, namely "U" versus "D".

30. According to consistent case law it must be taken into account that the consumer normally attaches more importance to the first part of a sign (*EGC, Mundicor*, T-183/02 and T-184/02, 17 March 2004). Moreover, in short signs, small differences are more easily noticed by the public (reference is made to *EGC, COR/DOR*, T-342/05, 23 May 2007).

31. Aurally, the right invoked coincides with the contested sign in the sounds of the letters "PS", but they differ in their first letters ("U" vs "D").

32. Conceptually, although parties seem to agree that "PS" stands for "Parcel Service", both signs have no meaning.

33. The first letter, which in this case also attracts the most attention, differs in both signs. The letter "U" is visually clearly different when compared to the letter "D". Furthermore, the vowel U and the consonant D are pronounced completely different. Consequently, the fact that they coincide only in two letters and that the differing one is not phonetically or visually similar, does not lead to a finding of likelihood of confusion (see by analogy, *EGC, ELS*, T-388/00, 23 October 2002).

34. Therefore, there is no likelihood of confusion between these signs either, as the overall impression of the signs is clearly different.

#### ***Comparison of the goods and services***

35. For reasons of procedural economy, the Office will not conduct a comparison of the goods. This comparison would not influence the outcome of this decision. Even if the goods are identical, there would be no likelihood of confusion, because the signs are dissimilar. Only for the purpose of the readability and the scope of this opposition are the goods concerned listed below

36. Since the rights invoked are identical, the goods and services of the rights invoked are shown below in a consolidated manner. The goods and services to be compared are the following:

Opposition based on:	Opposition directed against:
<p>KI 9 Wetenschappelijke, zeevaarkundige, landmeetkundige en elektrische toestellen en instrumenten voor zover niet begrepen in andere klassen, fotografische, cinematografische, optische, weeg-, meet-, sein-, controle- (inspectie-), hulpverlenings- (reddings-) en onderwijstoestellen en -instrumenten; apparaten voor het opnemen, het overbrengen en het weergeven van geluid of beeld; magnetische gegevensdragers, schijfvormige geluidsdragers; verkoopautomaten en mechanismen voor apparaten met vooruitbetaling; kasregisters, rekenmachines, apparatuur voor het verwerken van gegevens, computers; brandblusapparaten.</p>	
	<p>CI 12 Driverless transporter vehicles; Driverless cars [autonomous cars]; Automatically guided [driverless] material handling trucks; Electrically operated vehicles; Electrically powered land vehicles; Electrically powered vehicles; Electrically operated theft prevention installations for vehicles.</p>
<p>KI 35 Reclame; beheer van commerciële zaken; zakelijke administratie; administratieve diensten.</p>	<p>CI 35 Provision of an on-line marketplace for buyers and sellers of goods and services; Computerised stock ordering; Computerized on-line ordering services; Automatic re-ordering service for business; Computerised stock management; Computerised point-of-sale data collection services for retailers; Organisation and management of customer loyalty programs; Supply chain management services.</p>
<p>KI 36 Verzekeringen; financiële zaken; monetaire zaken; makelaardij en handel in onroerende goederen.</p>	
<p>KI 38 Overbrengen van boodschappen, brieven, documenten en andere teksten via telex of via een andere al dan niet elektronische weg.</p>	
<p>KI 39 Transport van pakjes, brieven, documenten en andere stukken.</p>	<p>CI 39 Transport and freight brokerage services; Vehicle routing by computer on data networks; Providing transport and travel information; Cargo tracking services; Item allocation and vehicle routing by computer on data networks for the collection, storage, transport and delivering of cargo, goods (non-food and food), parcels and letters.</p>
<p>KI 42 Onderzoek op wetenschappelijk en industrieel gebied; computerprogramming.</p>	<p>CI 42 Design and development of computer software for logistics, supply chain management and e-business portals; Platform as a Service [PaaS]; Development and testing of computing methods, algorithms and software; Design and development of operating software for accessing and using a cloud computing network;</p>

	Constructing an internet platform for electronic commerce; Provision of geographical information.
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**B. Other factors**

37. It must be stated that the letter combinations “UPS” and “DPS” both possess a ‘normal’ degree of inherent distinctiveness.

38. 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). However, where there is no similarity between the earlier mark and the contested sign, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services respectively covered are identical or similar are not sufficient for it to be found that there is a likelihood of confusion between the marks at issue or that the relevant public makes a link between them (see, to that effect, ECJ, CK CREACIONES KENNYA, C-254/09 P, 2 September 2010 and TiMi KiNDERJOGHURT, C-552/09 P, 24 March 2011). Even assuming the earlier marks enjoying an enhanced distinctiveness due to extensive use, would not alter the outcome.. It is therefore not necessary to examine this argument.

**B. Conclusion**

39. Based on the foregoing the Office is of the opinion that the overall impression of the signs is different and therefore, there exists no likelihood of confusion.

**IV. DECISION**

40. The opposition with number 2011370 is rejected.

41. Benelux application with number 1317636 will be registered.

42. The opponent shall pay the defendant 1,030 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR as the opposition is rejected in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 22 May 2018

Diter Wuytens  
(rapporteur)

Camille Janssen

Tomas Westenbroek

Administrative officer: Loes Burger