

BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2011541
of 29 November 2017

Opponent: **Shoe Branding Europe BVBA**
Meersbloem - Melden 42
9700 Oudenaarde
Belgium

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

Invoked right 1:  (international trademark 429187)

Invoked right 2:  (European Union trademark 6573307)

Invoked right 3:  (European Union trademark 8771933)

against

Defendant: **CKL Holdings N.V.**
Kaasrui 12
2000 Antwerpen
Belgium


Contested trademark: **Patrick** (Benelux application 1319611)


I. FACTS AND PROCEEDINGS


A. Facts

1. On 23 October 2015 the defendant filed a Benelux trademark application for the word trademark Patrick for goods and services in classes 9, 25 and 43. This application was processed under number 1319611 and was published on 26 October 2015.

2. On 26 December 2015 the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:

- International trademark indicating Benelux 429187 for the complex trademark , filed on 21 March 1977 and registered on 1 June 1977 for goods in classes 22, 25 and 28;

- European Union trademark 6573307 for the complex trademark , filed on 17 December 2007 and registered on 17 January 2011 for goods in classes 3, 9, 14, 18, 25 and 28;

- European Union trademark 8771933 for the complex trademark , filed on 21 December 2009 and registered on 22 June 2010 for goods in classes 18, 25 and 28.

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

4. The opposition is directed against the goods in class 25 of the contested application and is based on the goods in class 25 of the trademarks invoked.

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

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 30 December 2015. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed by the opponent. All of the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase of the procedure was completed on 2 December 2016.

II. ARGUMENTS OF THE PARTIES

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

A. Opponent's arguments

9. In the opponent's opinion, the signs at hand do not have any meaning and have a normal level of distinctiveness. According to him, it is obvious that they are very similar. The only difference is the stylized letter P of the rights invoked in front of the identical word PATRICK. Phonetically, this word will be pronounced the same way, either in Dutch, French or English. Furthermore, he finds that the relevant goods are identical.

10. The opponent is of the opinion that this comparison is sufficient to conclude that there exists a very apparent likelihood of confusion. He therefore requests that the Office upholds this opposition and rejects the contested sign for the goods in class 25.

B. Defendant's arguments

11. As the only classes shared by the trademarks at dispute are classes 9 and 25, the defendant holds it immediately clear that not all the goods and services at hand can be similar, let alone identical. Moreover, the defendant states that the similarity of the goods and services in classes 9 and 43 of the contested sign has not at all been substantiated by the opponent.

12. The goods of the rights invoked in class 25 consist mainly of the broad categories *clothing, footwear and headgear*. The goods of the contested sign at the other hand are partially specified to the more precise items *swimwear, sportswear and leisurewear*. As a result, it appears that the nature, purpose and intended use of the goods are different. Furthermore, according to the defendant, the respective goods would almost certainly be offered for sale in different outlets.

13. Regarding the comparison of the signs, the stylized letter P dominates the rights invoked, according to the defendant, as it is by far the largest element and is positioned centrally, above or in front of the other elements. Accordingly, this element will remain in the mind of the consumer.

14. The defendant further submits that the Office is not required to compare elements which are considered to be negligible. In fact, he states, the word PATRICK in the rights invoked is not noticeable at first sight and is positioned under or after the main element, in a much smaller typeface font. As a result, the general public would be very likely to disregard this element in its overall evaluation of the earlier trademarks. Comparing the distinctive elements of the signs, it would not be possible for the consumer to confuse the figurative letter P of the rights invoked with the seven-letter word of the contested sign. The defendant concludes that the signs are neither visually nor aurally similar.

15. Conceptually, the contested sign will be commonly understood as the first name Patrick whereas the rights invoked with the dominant figurative letter P have no real conceptual meaning. When only one of the signs evokes a concept, the outcome will be that the signs are not conceptually similar.

16. The defendant requests the opponent to prove that its earlier trademarks were genuinely used in commerce in the relevant territories for the relevant consumers and at the relevant time for an uninterrupted period of five years.

17. The defendant concludes that no likelihood of confusion can be found between the trademarks at dispute and therefore requests that the Office rejects the present opposition in its entirety due to its not being well founded.

III. DECISION

A.1 Proof of use

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

19. 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 legitimate.

20. The contested sign was published on 26 October 2015. Therefore, the opponent was required to show use of the rights invoked, during the period from 26 October 2010 to 26 October 2015 („the relevant period“) for the goods on which the opposition is based.

21. 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 on which the opposition is based.

22. The defendant has not responded to the proof of use furnished by the opponent. Therefore, the Office will not proceed to the examination of the proof of use. Indeed, in accordance with rule 1.29 (4) IR, the defendant may withdraw his request to provide proof of use or deem the evidence provided as adequate. Rule 1.25 (d) IR stipulates that facts to which the other party did not respond will be deemed undisputed. The Office holds that both parties obviously agree on the genuine use of the rights invoked, because of the fact that the defendant did not question the proof of use furnished by the opponent.

A.2 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 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: 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


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 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).

29. The signs to be compared are the following:

With regard to the third right invoked (European Union trademark 8771933):

Opposition based on:	Opposition directed against:
	Patrick

Visual comparison

30. The right invoked is a complex trade mark, comprising a stylized italic capital letter P, which is followed by the word PATRICK in bold black letters. The contested sign is a word mark, solely consisting of the word Patrick.

31. 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 or services in question by quoting their name than by describing the figurative elements of the trademark (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). In the case at hand, the figurative element is situated at the beginning of the right invoked, on which in general the consumer’s mind is focused (see CJEU, Mundicor, T-183/02 and T-184/02, 17 March 2004). On the other hand, the figurative aspect of that element merely consists of one stylized letter P, the same letter as the initial of the following word, whereas the second element of the trademark consists of a word of seven letters, which therefore constitutes the largest and most dominant part of the right invoked.

32. Taking into account that the difference in the use of capitals and lower-case letters is irrelevant for the purposes of a visual comparison of the signs (see EGC, *babilu*, T-66/11, 31 January 2013) the contested sign is visually identical to this latter element, PATRICK. As a result of the identity of these (largest and therefore dominant) parts of the signs, the overall impression leads to a high degree of visual similarity.

33. Visually, the trade mark and the sign are similar to a high degree.

Aural comparison

34. 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).

35. Phonetically, the largest part of the right invoked is identical to the contested sign. It is even possible that the stylized letter P will not be pronounced at all by the relevant public, because it sees this letter merely as the initial of the following word. In this case, the signs are phonetically identical. Even if the initial letter P would be pronounced separately, the pronunciation of the identical element PATRICK would lead to a high degree of aural similarity.

36. Overall, the signs are aurally similar to a high degree.

Conceptual comparison

37. Although both signs refer to a first name, this does not in any way mean that the signs are conceptually similar. Neither does it mean that a sign that (partly) consists of a personal name has an established meaning, except maybe when it concerns a very renowned name (ECJ, *Picasso*, C-361/04, 12 January 2006).

38. Neither of the signs has an established meaning and for this reason a conceptual comparison is not possible.

Conclusion

39. The signs are visually and aurally similar in a high degree. A conceptual comparison is not under discussion.

Comparison of the goods

40. 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).

41. With the comparison of the goods on which the opposition is based and these 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.

42. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Class 25 Clothing, footwear, headgear. (The registration does not cover dresses).	Class 25 Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

43. The goods *clothing*, *footwear* and *headgear* of the contested sign appear *expressis verbis* in both lists and are thus identical.

44. The goods *swimwear*, *sportswear* and *leisurewear* of the contested sign are included in the goods *clothing*, *footwear* and *headgear* of the right invoked and are therefore identical to them (see also EGC, Fifties, T-104/01, 23 October 2002; Arthur et Félicie, T-346/04, 24 November 2005 and Prazol, T-95/07, 21 October 2008).

Conclusion

45. The goods against which the opposition is directed are identical to the goods on which the opposition is based.

A.2 Global assessment

46. 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.

47. 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 present case concerns goods which are targeted at the public in general. For these goods the average level of attention of the public concerned may be deemed normal.

48. 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).

49. 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.

50. 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.

51. The signs are visually and aurally similar to a high degree. A conceptual comparison is not relevant. The goods at issue are identical. Based on these grounds, and given the interdependence between all the circumstances to take into account, the Office finds that the relevant public might be led to believe that these goods originate from the same undertaking or from economically linked undertakings.

B. Other factors

52. According to the defendant, the opponent has not substantiated the similarity of the goods and services in classes 9 and 43 of the contested sign (see paragraph 11). However, such substantiation was not necessary, since the opposition was only directed against the goods in class 25.

C. Conclusion

53. The Office holds that there exists a likelihood of confusion.

IV. DECISION

54. The opposition with number 2011541 is upheld.

55. The Benelux application with number 1319611 will not be registered for the following goods:

Class 25: all goods.

56. The Benelux application with number 1319611 will be registered for the following goods and services, because de opposition was not directed against them:

Class 9: all goods.

Class 43: all services.

57. 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, 29 November 2017

Willy Neys
(*rapporteur*)

Camille Janssen

Tomas Westenbroek

Administrative officer: Raphaëlle Gérard