

BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2011570

of 31 July 2017

Opponent: **WOLVERINE OUTDOORS, INC.**
9341 Courtland Drive N.E.
Rockford, Michigan 49351
United States of America

Representative: **NLO Shieldmark B.V.**
New Babylon City Offices Anna van Buerenplein 21A
2595 Den Haag
Netherlands

Invoked right 1: **EU trade mark 2567469**

MERRELL

Invoked right 2: **EU trade mark 1632744**

MERRELL

Invoked right 3: **International registration 939252**

MERRELL

Invoked right 4: **Benelux registration 551542**

MERRELL

against

Defendant: **CKL Holdings N.V.**
Leeuwenstraat 4
2000 Antwerpen
Belgium

Representative: **Trademarkers Merkenbureau C.V.**
Amersfoortsestraatweg 33b
1401 CV Bussum
Netherlands

Contested trademark: **Benelux application 1320364**

Marielle

I. FACTS AND PROCEEDINGS

A. Facts

1. On 3 November 2015 the defendant filed an application for a trademark in the Benelux for the word mark Marielle for goods and services in classes 9, 25 and 38. This application was processed under number 1320364 and was published on 10 November 2015.

2. On 8 January 2016 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- EU trade mark 2567469 of the word mark MERRELL, filed on 7 February 2002 and registered on 4 September 2003 for goods in class 18.
- EU trade mark 1632744 of the word mark MERRELL, filed on 28 April 2000 and registered on 12 July 2001 for goods in class 25.
- International registration 939252 of the word mark MERRELL, filed on 17 September 2007 and registered on 7 April 2011 for services in class 35.
- Benelux registration 551542 of the word mark MERRELL, filed on 18 May 1994 for goods in classes 25 and 28.

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

4. The opposition is directed against all goods in class 25 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) of 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 12 January 2016. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. The defendant has not responded to the proof of use which was subsequently submitted. 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 9 December 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 argues that both signs start with the identical letter M and also contain the identical letters R-E-LL. According to the opponent, the letter I in the contested sign is not sufficient to cancel out the visual similarity between the signs.

10. Aurally, the opponent states that the signs share the same intonation and rhythm. According to the opponent, the MER/MAR sound at the beginning is highly similar and both signs share the identical ELL sound at the end. Again, the opponent argues that the extra 'l-sound' in the contested sign does not sufficiently change the aural similarity.

11. The opponent states that the signs are also conceptually identical, because both signs could refer to a name.

12. With regard to the comparison of the goods and services, the opponent argues that the goods of the contested sign are identical (and highly similar) to the goods and services for which the trademarks invoked are registered.

13. The opponent concludes that there is a risk of confusion. Furthermore, the goods concerned relate to fashion. For this reason, according to the opponent, the relevant public could perceive the contested sign as a new line of shoes or clothing of the MERRELL sign, specifically aimed at women.

14. The opponent request that the Office refuses the registration of the contested sign and orders the defendant to bear the costs incurred by the opponent.

B. Defendant's arguments

15. The defendant argues that it cannot be concluded that the goods in class 25 are similar, simply because the trademarks invoked are protected for a far-ranging specification of goods. Furthermore, the defendant states that the goods in class 25 are not similar to the goods and services mentioned in classes 18 and 35 of the trademarks invoked.

16. With regard to the visual comparison, the defendant states that the signs differ in length and in several letters. Furthermore, the first parts of the signs are not identical. For this reason the defendant argues that the signs are not visually similar.

17. Aurally, the signs are also different. The defendant points out that the difference in the second letter of the signs results in a totally dissimilar pronunciation. Furthermore, pronounced as a whole, the two signs differ in the number of syllables and the contested sign also contains the letter I in the middle of the word. According to the defendant, the public in the Benelux will have a strong pronunciation of the letter I and this causes a phonetic effect, because it breaks the word into three separate parts. Therefore, the defendant concludes that there is no aural similarity.

18. According to the defendant, the trademark invoked is an American family name and the contested sign is a French female name. For this reason, the defendant argues that the signs are not conceptually similar.

19. The defendant also requests that the opponent submits proof of use with regard to all the trademarks invoked.

20. The defendant concludes that there exists no likelihood of confusion and requests that the Office rejects the opposition and orders the opponent to bear all costs and fees arising in connection with the proceedings.

III. DECISION

A.1 Proof of use

21. 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. Given the fact that the trademarks invoked are registered more than five years prior to the publication date of the contested sign, the defendant's request to submit proof of use is legitimate.

22. The defendant has not responded to the proof of use submitted by the opponent. Rule 1.25, sub d IR stipulates that "*facts to which the other party did not respond will be deemed as undisputed*". In the light of the absence of response of the defendant, the Office will not assess the proof of use and concludes that the parties agree that the trademarks invoked have been genuinely used.

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 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: 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. Since the trademarks invoked are identical, these signs will be treated together. The signs to be compared are the following:

| Opposition based on: | Opposition directed against: |
|-----------------------------|-------------------------------------|
| MERRELL | Marielle |

Visual comparison

29. Both signs are purely verbal marks and consist of one word. The trademark invoked consists of the word MERRELL and the contested sign consists of the word Marielle. The trademark invoked is displayed in capital letters, while in the contested sign, only the first letter is capitalized. However the difference between the signs with regard to the use of capital letters or lower case letters is not relevant for the visual comparison between two word marks (reference is made to EGC case, Babilu, T-66/11, 31 January 2013).

30. Both signs start with the letter M and also share the letters R and ELL, located in the same position. 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). However, the Office considers that the letter M is not the only letter that constitutes the beginning of the signs. In this case, the beginning of both signs contains a visual difference, because of the use of a different vowel after the letter M.

31. Furthermore, the trademark invoked displays the double letter RR in the middle and this causes a prominent difference. Also, the ending is different because the LL of the contested sign is followed by the letter E. Moreover, the contested sign contains the letter I in the middle. This also has an impact on the visual perception of the signs.

32. The Office is of the opinion that these differences will not be ignored by the public. For this reason, the signs are similar to a low degree.

Aural comparison

33. Aurally the trademark invoked is pronounced in two syllables: MER-RELL. The Office considers that part of the public, which speaks French, could pronounce the contested sign in three syllables, MA-RI-ELLE and the Dutch speaking public could pronounce the sign in four syllables, MA-RI-EL-LE.

34. Aurally the similarities between the signs are very limited. Firstly, the beginning is different, because of the different vowel that follows the letter M. Secondly, although the length of the signs only differs in one letter, the presence of the letter I in the contested sign causes a noticeable difference, because the vowels I and E will be pronounced separately. This changes the cadence and intonation of the pronunciation.

35. The Office considers that only the final syllable of the trademark invoked is similar to the final (or third) syllable of the contested sign.

36. For the reasons mentioned above, the Office concludes that the signs are aurally similar to a low degree.

Conceptual comparison

37. Even if the public thinks that both signs refer to a family name and/or to a first name, this does not in any way mean that the signs are conceptually similar. Nor does it mean that a sign that (partly) consists of a personal name has an established meaning (see BOIP, Rachel, opposition decision 2002674, 1 July 2009), except maybe when it concerns a very renowned name (ECJ, Picasso, C-361/04, 12 January 2006 en BOIP, Amadeus Fire, opposition decision 2002041, 30 July 2010). However, in the present case, this is not under discussion.

38. In the light of the foregoing, the trademark invoked and the contested sign have no established meaning and for this reason, a conceptual comparison is not possible.

Conclusion

39. Trademark and sign are visually and aurally similar to a low degree. A conceptual comparison is not under discussion.

Comparison of the goods and services

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 and services of the trademark invoked and the goods against which the opposition is filed, the goods and services are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

42. The goods and services to be compared are the following:

| Opposition based on: | Opposition directed against: |
|---|-------------------------------------|
| <p><i>EU trade mark 2567469</i> CI 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; bags, handbags, purses, pouches, satchels, briefcases, animal skins, hides; trunks and</p> | |

| | |
|---|--|
| travelling bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery. | |
| <i>EU trade mark 1632744</i> CI 25 Footwear, clothing and headwear. <i>Benelux registration 0551542</i> Bottes de randonnée, bottes d'alpinisme. <i>Hiking boots, Mountaineering boots.</i> | CI 25, Clothing, footwear and headgear; swimwear; sportswear; leisurewear. |
| <i>Benelux registration 0551542</i> CI 28 Skis et bottes pour le ski de fond. <i>Skis and boots for cross-country skiing.</i> | |
| <i>International registration 939252</i> CI 35 Retail store services featuring footwear, clothing, bags, and accessories. | |
| N.B. The original language of Benelux registration 0551542 is French. The translation is only added to improve the readability of this decision. | |

43. The goods “*clothing, footwear, headgear*” are mentioned *expressis verbis* in both lists of goods and services and are therefore identical.

44. With regard to the defendant’s goods “*swimwear; sportswear; leisurewear*”, the Office considers that according to established case law, if the goods and services of the earlier trademark also contain goods and services that are mentioned in the application for the contested sign, these goods and services are considered identical (see 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). The goods mentioned in class 25 of the second trademark invoked cover all clothing and these goods are therefore identical to the defendant’s goods “*swimwear; sportswear; leisurewear*”.

Conclusion

45. The contested goods are identical to the goods mentioned in class 25 of the second trademark invoked.

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 according to the category of goods or services in question. The present case concerns goods and services which are targeted at the public in general. For these goods and services 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 into 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. 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 distinctiveness, as it is not descriptive of the goods and services concerned.

50. The fact that the marks coincide in five identical letters is not enough to conclude that there is a sufficient similarity between them. As explained above, both signs contain striking visual and aural differences, especially because of the different vowels used at the beginning, the use of the RR in the trademark invoked and the presence of the letter I in the middle part of the contested sign.

51. 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).

52. Therefore, based on the abovementioned circumstances, the Office concludes that in this case the visual and aural differences between the signs are sufficient to outweigh the identity of the goods. As a consequence, the signs, considered as a whole, are not similar enough that there could exist a likelihood of confusion.

B. Other factors

53. With reference to the parties' requests regarding the costs of the proceedings (see paragraph 14 and 20), the Office considers that opposition proceedings with the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.16, 5 BCIP, as well as 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

54. Based on the foregoing the Office concludes that there is no likelihood of confusion.

IV. DECISION

55. The opposition with number 2011570 is rejected.

56. Benelux application with number 1320364 will be registered for all its goods and services.

57. The opponent shall pay the defendant 1,000 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, 31 July 2017

Eline Schiebroek
(*rapporteur*)

Camille Janssen

Diter Wuytens

Administrative officer: Raphaëlle Gérard