



BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2011574
of 20 June 2017

Opponent: **Rodial Limited**
College House, Second Floor, Kings's Road 272
SW3 5AW London
Great Britain

Representative: **Arnold + Siedsma (Amsterdam)**
Postbus 71720
1008 DE Amsterdam
Netherlands

Invoked right 1: **RODIAL** (European Union trademark 5222146)
Invoked right 2: **RODIAL SKIN BLEACH** (European Union trademark 9937616)
Invoked right 3: **RODIAL MAKE UP WITH BENEFITS** (European Union trademark 11525681)

against

Defendant: **FNU Management Limited**
Regent Street 207 3rd floor
W1B 3HH London
Great Britain

Contested trademark: **RADIAL SKINCARE** (Benelux application 1321309)

I. FACTS AND PROCEEDINGS

A. Facts

1. On 17 November 2015 the defendant filed a Benelux trademark application for the word trademark RADIAL SKINCARE for goods in classes 3, 5 and 30. This application was processed under number 1321309 and was published on 24 November 2015.

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

- European Union trademark 5222146 for the word trademark RODIAL, filed on 7 July 2006 and registered on 26 July 2007 for goods in class 3;
- European Union trademark 9937616 for the word trademark RODIAL SKIN BLEACH, filed on 3 May 2011 and registered on 14 September 2011 for goods in class 3;
- European Union trademark 11525681 for the word trademark RODIAL MAKE UP WITH BENEFITS , filed on 29 January 2013 and registered on 11 June 2013 for goods in class 3.

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

4. The opposition is directed against the goods in class 3 of the contested application and is based on all the goods 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 13 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 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. Whereas the opposition was initially directed against all the goods of the contested sign, the opponent limits with his arguments the goods against which the opposition is directed to the goods in class 3. The opponent

finds that the goods offered by the defendant are either identical or highly similar to the opponent's goods. According to the opponent, the goods at issue are used on a daily basis, which means that the level of attention of the general public is very low.

10. The opponent observes that RODIAL is the dominant element in the rights invoked, since the elements SKIN BLEACH and MAKE UP WITH BENEFITS are descriptive and do not have any distinctive power with regard to the related goods in class 3. Likewise, RADIAL is obviously the dominant element in the contested sign, as the element SKINCARE is also descriptive and lacks any distinctive power with regard to the related goods in class 3.

11. From a visual point of view, the opponent finds that the signs are almost identical. The only difference, which lies in the second letter, will not be noticed by the average consumer. The same applies to the aural comparison as well and therefore, the signs are aurally highly similar.

12. Conceptually, the element RODIAL in the rights invoked has no meaning. Therefore it carries a very large distinctive power and, accordingly, a very broad scope of protection. The opponent points out that the element RADIAL in the contested sign means "spreading out from a central point". However, this is a very uncommon word and even though the average public speaks English, the vast majority will not be aware of this meaning. According to the opponent, the other elements of the signs should not be taken into consideration, as they are all descriptive with regard to the related goods. He concludes that no conceptual comparison can be made.

13. In consideration of the above, the opponent requests that the Office upholds the opposition and bars the contested application from maturing to registration.

B. Defendant's arguments

14. As the contested sign is applied for classes 3, 5 and 30, whereas the rights invoked are only registered for goods in class 3, the defendant holds it immediately clear that the goods at hand cannot be identical. Moreover, the defendant states that the similarity of the goods in classes 5 and 30 of the contested sign has not at all been substantiated by the opponent.

15. The goods in class 3 share some common specifications, but there are also some clear differences. Indeed, the majority of the goods of the contested sign is related to cosmetics, whereas the majority of the goods of the opponent are more in line with toiletries used in the care of the face or body for personal hygiene. The defendant concludes that the goods at hand are not similar.

16. The defendant is of the opinion that the marks are distinguishable on the basis of a lack of coinciding words and the use of different additional words. Moreover, there is a significant aural difference between the words RODIAL and RADIAL and between the other elements of the signs.

17. Conceptually, the word RADIAL means "of or arranged like rays or radii of a circle" and SKINCARE alludes to "the concept of care of the skin", whereas the first right invoked has no meaning at all. The words SKIN BLEACH in the second right invoked refers to a chemical process of lightening the skin colour. The third right invoked evokes the concept of make-up used to enhance or beautify the body.

18. The defendant concludes that no likelihood of confusion can be found, as any degree of similarity between the goods is offset by the dissimilarity between the marks at hand.

19. The defendant draws the Office's attention to the fact that the first right invoked has been registered for more than five years. Therefore he requests that the opponent bears the evidence of genuine use of this trademark.

20. The defendant requests that the opposition at hand be rejected in its entirety as unfounded and that the contested sign be granted protection.

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 rights 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.

22. Given the fact that the first right invoked was 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.

23. The contested sign was published on 24 November 2015. Therefore the opponent was required to show use of the right invoked, during the period from 24 November 2010 to 24 November 2015 ("the relevant period") for the goods on which the opposition is based.

24. 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.

25. 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 right invoked, because of the fact that the defendant did not question the proof of use furnished by the opponent.

A.2 Likelihood of confusion

26. 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.

27. 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.*"

28. 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

29. 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).

30. 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).

31. The signs to be compared are the following:

With regard to the first right invoked (European Union trademark 5222 146):

Opposition based on:	Opposition directed against:
RODIAL	RADIAL SKINCARE

Conceptual comparison

32. The contested sign is composed by an adjective followed by a noun. The noun SKINCARE will, of course by the compound of the words SKIN and CARE, easily be understood as “care for the skin” (see also Webster’s Online Dictionary). RADIAL has several meanings, the most of them being technical, and also in the more “general” sense “arranged or having parts arranged like rays” (<https://www.merriam-webster.com/dictionary/radial>). The right invoked on the other hand has no meaning.

33. In general, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003). In the present case, the element SKINCARE is descriptive for the goods in class 3, as it indicates one of the characteristics of these goods, namely taking care for the skin. The Office holds that the common consumer not immediately recognizes the technical meanings of RADIAL, nor the more common, given above. Moreover, in combination with the word SKINCARE, it does not provide the sign an intelligible meaning as a whole.

34. The signs in their overall impression having no established meaning, a conceptual comparison is not possible.

Visual comparison

35. Both signs are word marks, the right invoked consisting of one word of six letters, the contested sign consisting of two words of respectively six and eight letters.

36. 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). In the case at hand, the first part of the contested sign is almost identical to the right invoked, only the second letter being different. The addition of a second, descriptive element does not annihilate the overall impression of visual similarity.

37. Visually, the trade mark and the sign are similar.

Aural comparison

38. From an aural point of view too, the consumer normally attaches more importance to the first part of a sign (case Mundicor, already cited). In the case at hand, five out of the six letters of the first part of the contested sign are identical and are placed in the same order as in the right invoked. Both this element and the right invoked count two syllables and only the end letter of the first syllable is pronounced differently. Moreover, it is not to be considered to be impossible that the consumer will not at all pronounce the second word of the sign, because this is descriptive and he won't consider it as being a part of the trademark.

39. Overall, the signs are aurally similar.

Conclusion

40. Visually and aurally, the signs are similar and a conceptual comparison is not under discussion.

Comparison of the goods

41. 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).

42. With the comparison of the goods of the trademark invoked 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.

43. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Class 3 Perfumes; bath preparations; non-medicated toilet preparations; cosmetic preparations; lotions, powders, creams and scrubbing preparations all for use on the skin; face	Class 3 Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.

moisturisers and toners; depilatory preparations; deodorants; toilet articles; lip balm; skin and hair masks; preparations for care of the hair; shampoos and hair conditioners; soaps; essential oils; massage preparations; preparations for care of the nails; cosmetics for sun screening; cotton wool and cotton wool buds for cosmetics and toilet use; emery boards.	
--	--

44. The goods *essential oils* and *soaps* appear *expressis verbis* in both lists and are thus identical.

45. The goods *perfumery* and *cosmetics* of the contested sign are identical to the goods *perfumes* and *cosmetic preparations* of the right invoked.

46. The goods *make-up*, *eye make-up*, *eyeliners*, *blushers* and *lipsticks* of the contested sign are all cosmetics (see also Webster's Online Dictionary) and therefore identical to the goods *cosmetic preparations* of the right invoked (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).

47. The goods *hair lotions* of the contested sign are included in the goods *preparations for care of the hair* of the right invoked and are thus identical to them.

Conclusion

48. The goods against which the opposition is filed are identical to the goods of the right invoked.

A.2 Global assessment

49. 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.

50. The goods at hand are average consumers goods. According to the opponent, this means that the level of attention of the general public is very low (see point 9). It should indeed 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. However, the Office points out that the average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). Therefore, the level of attention of the consumer must be qualified as normal.

51. 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).

52. 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.

53. 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). According to the opponent, the element RODIAL in the rights invoked enjoys a very broad scope of protection as it has no meaning (see point 12). However, the Office points out that a registered trademark must be distinctive by definition (see article 2.1 (1)) BCIP. Therefore, the trademark invoked has a normal level of distinctiveness, as it is not descriptive of the goods concerned.

54. The signs are visually and aurally similar, a conceptual comparison is not applicable and the goods concerned 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 the goods originate from the same undertaking or from economically-linked undertakings.

B. Other factors

55. According to the defendant, the opponent has not substantiated the similarity of the goods in classes 5 and 30 (see paragraph 14). However, such substantiation was not necessary, since the opposition was only directed against the goods in class 3.

C. Conclusion

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

57. Since the opposition is already justified based on the first right invoked, it is not necessary to discuss the other trademarks invoked.

IV. DECISION

58. The opposition with number 2011574 is justified .

59. The Benelux application with number 1321309 will not be registered for the following goods:

Class 3: all goods.

60. The Benelux application with number 1321309 will be registered for the following goods, because the opposition was not directed against them:

Class 5: all goods.

Class 30: all goods.

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

The Hague, 20 June 2017

Willy Neys
(*rapporteur*)

Camille Janssen

Tomas Westenbroek

Administrative officer: Jeanette Scheernhoorn