

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2011594**  
**of 4 January 2017**

**Opponent:** **Antonio Eulogio ANTON SEVILLA**  
C/ Moncada 20  
03230 Elche  
Spain

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

**Invoked right:** **EU trade mark 11370954**



*against*

**Defendant:** **JKT Advertising Limited**  
Regent Street 207 3rd floor  
W1B 3HH London  
Great Britain

**Representative:** -

**Contested trademark:** **Benelux application 1321315**


Kmb.

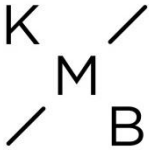
## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 17 November 2015 the defendant filed an application for a trademark in the Benelux for the word mark Kmb. for goods in classes 14, 18 and 25. This application was processed under number 1321315 and was published on 20 November 2015.

2. On 18 January 2016 the opponent filed an opposition against the registration of the application. The opposition was initially based on the following earlier trademarks:

- European registration 7262306 of the combined word/figurative mark , filed on 26 September 2008 and registered on 3 May 2010 for goods in classes 14, 18 and 25;

- European registration 11370954 of the combined word/figurative mark , filed on 23 November 2012 and registered on 29 April 2013 for goods and services in classes 18, 25 and 35.

3. During the proceedings the opponent requested the invoked rights to be limited to the second right invoked only (see paragraph 9).

4. According to the register the opponent is the actual holder of the remaining trademark invoked.

5. The opposition is directed against all the goods of the contested application and is based on all the goods in classes 18 and 25 of the (second) right invoked.

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

7. The language of the proceedings is English.

### B. Course of the proceedings

8. The opposition is admissible and was notified by the Benelux-Office for Intellectual Property (hereinafter: "the Office") to the parties on 20 January 2016, by which the Office informed the parties about a pending revocation action before the European Union Intellectual Property Office (hereinafter: EUIPO) against the first right invoked in the current proceedings. The proceedings were therefore suspended by the Office according to art. 2.16 para. 1 sub b. BCIP and the rule issued by the Director-General of 15 October 2007.

9. The opponent requested the Office to resume the proceedings solely based on the second right invoked by letter of 2 February 2016 (see paragraph 3). The Office informed both parties by letter of 4 February 2016.

10. 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 8 August 2016.

## **II. ARGUMENTS**

11. 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**

12. The opponent argues that the earlier trademark and the contested sign are at least highly similar from a visual point of view. The earlier trademark is wholly incorporated in the contested application and holds a prominent and clearly separate position therein. The element KMB is clearly a dominant element. When perceiving both signs, the public will focus on this dominant element and compare Kmb with KMB, according to the opponent.

13. As to the phonetic comparison of the invoked right and the contested sign, the opponent states that both consist of one word element, namely KMB and are therefore phonetically identical.

14. Conceptually, neither of the signs as a whole has a meaning in the official languages of the relevant territory. A conceptual comparison is therefore not applicable, according to the opponent.

15. The goods in classes 18 and 25 of the contested application should be considered identical or at least highly similar to the goods in classes 18 and 25 of the invoked right. Furthermore, the goods in class 14 of the contested sign should be considered similar to the goods of the invoked right since they are complementary. These goods share the same nature, purpose and distribution channels and are found in the same sections of shops and stores where they are offered to the average consumer, finds the opponent.

16. The opponent concludes that there is a likelihood of confusion between the earlier mark and the contested application.

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

17. Firstly, the defendant argues that the goods in classes 18 and 25 of both signs are not identical because they are sold in different outlets, are different of nature and serve a different purpose. As for the goods in class 14 of the contested sign, the defendant is of the opinion that they are not complementary as argued by the opponent.

18. Visually, the defendant is of the opinion that the signs differ significantly. The number of shared letters is negated by the fact that the graphical representation of the right invoked makes it highly stylized and visually dissimilar from the contested sign overall.

19. As to the phonetic comparison, the defendant states that both signs have the potential to be pronounced quite differently by the relevant public. The contested sign could be read as a single word "kmmbbb" whereas the right invoked would force the consumer to read the mark "letter-for-letter". The defendant concludes that there is no possibility that the signs could be found to be phonetically similar.

20. Conceptually, both signs do not refer to any concept, nor are they a clear acronym. Therefore a conceptual comparison is not possible, according to the defendant.

21. The signs are not identical nor similar and this conclusion is also applicable for the relevant goods, says the defendant.

22. The defendant concludes by stating that the opposition should be rejected in its entirety, the contested application should be registered and the opponent should bear the costs of the proceedings.

### **III. DECISION**

#### **A.1 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. 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:

Opposition based on:	Opposition directed against:
	Kmb.

#### *Visual comparison*

30. The invoked right consists of three letters KMB, placed diagonally from top left to lower right. A line crosses behind the letter M, from lower left to top right. The contested (word)mark consists of the (identical) three letters Kmb. The first letter –K is a capital, the letters –m and –b are in lower case. The three letters are followed by a full stop.

31. The graphical representation of the right invoked is of such nature that the relevant public will, without any doubt, perceive the letters KMB as the dominant element. Furthermore, the Benelux consumer will, as a rule, perceive the sign from left to right, thereby maintaining the order of the letters mentioned in the right invoked. The graphical aspect of the right invoked can be qualified as rather marginal (see EGC, *Dieselit*, T-186/02, 30 June 2004). The difference in the use of capitals and lower-case letters is irrelevant for the purposes of a visual comparison of those marks (see EGC, *babulu*, T-66/11, 31 January 2013).

32. Because of the fact that both signs have the visually dominant element KMB in common, the Office is of the opinion that they are visually highly similar.

#### *Phonetic comparison*

33. 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).

34. Both signs will be pronounced as [ka-em-bee] or [ke-ɛm-bi]. The Office is of the opinion that the full stop in the contested sign will not be pronounced at all.

35. Phonetically the signs are identical.

*Conceptual comparison*

36. As both signs do not have a clear and precise meaning for the Benelux public, a conceptual comparison is not relevant.

*Conclusion*

37. The right invoked and the contested sign are highly similar in terms of visual perception. Phonetically they are identical. A conceptual comparison is not relevant.

**Comparison of the goods and services**

38. 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).

39. Regarding the remarks of the defendant as to the nature, purpose and sales outlets of the relevant goods (see paragraph 17) the Office would like to stress that with the comparison of the goods of the trademark invoked and the goods 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.

40. The goods to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
	CI 14 Precious metals; jewellery; precious stones; chronometric instruments
CI 18 Handbags, wallets, trunks and travelling bags; Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Umbrellas, Parasols, Walking sticks, whips, harness and saddlery, curried skins, coverings of skins, leather leads, linings of leather for footwear, yarns and threads of leather, leather straps, casings of leather, Purses, Attaches, Backpacks, Haversacks, Travelling bags, Shoulder straps, Traveling cases, Key cases, Purses, not of precious metal, Card holders (notecases), Travelling trunks, boxes of leather or of cardboard, school satchels, handbag frames, straps of leather.	CI 18 Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery.
CI 25 Footwear (except orthopaedic footwear), fittings of metal for footwear; Non-slipping devices for shoes; Welts for boots and shoes; Footwear uppers; Tips for footwear; Shoes; Esparto shoes or sandals; Boots; Boot uppers; Sabots; Slippers; Half-	CI 25 Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

boots; Sandals; Beach shoes; Bath slippers; Boots for sports; Gymnastics shoes; Football boots; Ski boots; Sports shoes; Heels; Soles for footwear; Inner soles; Belts.	
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#### Class 14

41. The goods "*precious metals; jewellery; precious stones; chronometric instruments*" are dissimilar to the opponent's goods in Classes 18 and 25. Their nature and main purpose are different. Although some of the contested goods, such as jewellery, are worn for personal adornment and some of the opponent's goods, such as handbags, in Class 18 and goods in Class 25 may also serve as a type of adornment, the main function of these goods is to carry things or dress the human body, rather than purely to decorate it. The goods under comparison do not have the same distribution channels and are not in competition; neither are they complementary in the sense that one is indispensable (essential) or important (significant) for the use of the other. Even though some fashion designers nowadays also sell fashion accessories (such as jewellery) and travel accessories under their marks, this is not the rule; it tends to apply only to (commercially) successful designers. Furthermore, such an aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products together (see to that effect EGC, Longines, T-505/12, 12 February 2015 and Emidio Tucci, T-357/09, 27 September 2012). That not being the case, the Office considers the goods dissimilar.

#### Class 18

42. The contested goods in Class 18 "*Leather; trunks; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery; suitcases*", the latter with a slight difference in wording, are identically contained in both lists of goods in Class 18. The goods are therefore identical.

#### Class 25

43. The contested goods "*footwear*" are identically contained in both lists of goods in Class 25 and are therefore identical.

44. The contested goods "*clothing; headgear; swimwear; sportswear; leisurewear*" and the goods "*footwear*" of the right invoked have the same purpose, namely to cover the (human) body for practical and aesthetic purposes. They can coincide in producer, end user and distribution channels. Therefore they are considered similar goods (see to that effect EGC, Leder & Schuh AG, T-32/03, 8 March 2005 and AVEX, T-115/02, 13 July 2004).

#### Conclusion

45. The goods are partly identical, partly similar and partly dissimilar.

### 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 relevant goods are average consumers goods. The level of attention of the consumer might therefore be qualified as 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. Based on the abovementioned circumstances and the high level of similarity of the signs, the Office is of the opinion that the relevant public might believe that the goods originate from the same undertaking or from economically-linked undertakings.

## **B. Conclusion**

51. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion for the goods which are considered identical or similar.

## **IV. DECISION**

52. The opposition with number 2011594 is partly justified.

53. Benelux application with number 1321315 is refused for the following goods:

- Class 18: (*all goods*).
- Class 25: (*all goods*).

54. Benelux application with number 1321315 is upheld the following goods:

- Class 14: (*all goods*).

55. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.32(3) IR, as the opposition is partly justified.



The Hague, 4 January 2017

Tomas Westenbroek  
(rapporteur)

Pieter Veeze

Willy Neys

Administrative officer:  
Jeanette Scheerhoorn