



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2011667

of 22 March 2017

Opponent: **NINA RICCI (Société à Responsabilité Limitée)**
39, Avenue Montaigne
75008 Paris
France

Representative: **Office Kirkpatrick S.A.**
Avenue Wolfers 32
1310 La Hulpe
Belgium

Invoked right 1: **European registration 8161770**

RICCI

Invoked right 2: **European registration 3540333**

NINA RICCI

against

Defendant: **VKO Farms Limited**
Regent Street 207 3rd Floor
W1B 3HH London
Great Britain

Representative: --

Contested trademark: **Benelux application 1322592**

Richie

I. FACTS AND PROCEEDINGS**A. Facts**

1. On 7 December 2015 the defendant filed an application for a trademark in the Benelux for the word mark Richie for goods and services in classes 18, 25 and 43. This application was processed under number 1322592 and was published on 9 December 2015.

2. On 5 February 2016 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- European registration 8161770 of the word mark RICCI, filed on 22 November 2007 and registered on 13 November 2009 for goods in classes 18 and 25.
- European registration 3540333 of the word mark NINA RICCI, filed on 31 October 2003 and registered 6 April 2005 for goods in classes 9, 14, 18 and 25.

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

4. The opposition was originally directed against classes 18 and 25 of the contested application. On 17 August 2016, after the filing of his arguments, the defendant requested that the Office deletes class 25 from the list of contested goods. Therefore, the opposition is directed against all goods in class 18 of the contested sign 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 10 February 2016. 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 17 August 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 excludes the phrase "and goods made of these materials and not included in other classes" in class 18 from the extent of this opposition, as well as the classes 9 and 14. The opponent states that the goods in classes 18 and 25 of the trademarks invoked are identical to the goods of the contested sign.

10. With regard to the first trademark invoked, the opponent states that the signs are visually similar because the signs have the same length, share 4 identical letters, which are in the same order, and begin with the letters RIC. Aurally, the opponent argues that the Benelux public is familiar with the pronunciation of Italian words including the double letter CC (as in GUCCI or cappuccino), as well as the pronunciation of the English word 'rich'. Therefore, the opponent states that the public will pronounce the word RICCI and RICHIE identically. The Benelux public could perceive both signs as family names and for this reason, according to the opponent, the signs are conceptually similar.

11. Regarding the second trademark invoked, the opponent only adds that the reference to a family name RICCI is reinforced by the common first name NINA. However, the opponent argues that the second part RICCI, constitutes the dominant part of the sign NINA RICCI, because family names have, in principle, a higher intrinsic value as badge of origin than first names.

12. The opponent argues that the trademarks invoked have a reputation and are therefore highly distinctive. To substantiate this argument, the opponent has filed evidence, including catalogues, sales figures, publications and marketing figures. The opponent also refers to prior opposition decisions from the European Union Intellectual Property Office (EUIPO) in which it was decided that the mark NINA RICCI possesses an elevated distinctive character.

13. The opponent concludes that there exists a likelihood of confusion and requests that the Office accepts the opposition and refuses the contested sign.

B. Defendant's arguments

14. The defendant argues that the goods are not similar, because these goods may be sold in different sales outlets, have a different purpose (for competitive sports versus fashion for example), are produced by different manufacturers or may be directed at different publics.

15. With regard to the first trademark invoked, the defendant argues that only three of the six letters are repeated in the contested sign. Further, the contested sign has an additional letter, which also creates a visual difference. According to the opponent, the 'ICCI' element of the trademark invoked is visually striking and will therefore remain in the minds of the relevant consumer.

16. The defendant disputes the opponent's argument that the public will use the Italian pronunciation for the word RICCI. The defendant argues that the Italian language is not widely spoken in the Benelux and that the signs will be pronounced according to the language rules of the consumer concerned. Therefore, the word RICCI will be pronounced as 'rickie', which is aurally different from the word 'richie', because, according to the defendant, the letter H in the contested sign will not be ignored by the public.

17. Conceptually, the defendant states that neither mark has a clear meaning in the languages of the Benelux. For this reason, no conceptual comparison will be made.

18. Regarding the second trademark invoked, the defendant argues that the additional element NINA clearly alters the visual appearance of the sign. Aurally, this element also completely alters the number and sequence of syllables and the rhythm and intonation of the sign. With regard to the conceptual comparison, the defendant argues that the trademark invoked will be perceived as a full name and the contested sign will only be perceived as a first name.

19. The defendant argues that the evidence submitted by the opponent does not show that the trademarks invoked have obtained an enhanced distinctiveness in the Benelux, mainly because most of the evidence is related to countries outside the Benelux. Furthermore, the defendant states that the opponent has not proven that the trademarks invoked are genuinely used in relation to all the specific goods and services concerned.

20. The defendant requests that the Office rejects the opposition and proceeds to register the contested sign.

III. DECISION

A.1 Likelihood of confusion

21. 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.

22. 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.”*

23. 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

24. 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).

25. 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).

26. The signs to be compared are the following:

Regarding European registration 8161770

Opposition based on:	Opposition directed against:
RICCI	Richie

Visual comparison

27. Both signs are purely verbal marks and consist of one word. The trademark invoked consists of the word RICCI and the contested sign consists of the word Richie. The trademark invoked is displayed in capital letters and in the contested sign, only the first letters is a capital letter. However the difference between the signs with regard to the use of capital letters or lowercase 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).

28. Both signs share the first three identical letters RIC. Furthermore, in both signs the fifth letter is also identical. The differences between the signs include the second letter C in the trademark invoked, as well as the letters H and E in the contested sign. However, 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).

29. For this reason, the Office is of the opinion that the trademark invoked and the contested sign are visually similar to a certain extent.

Aural comparison

30. The relevant public would pronounce the word Richie as 'ri-tsjj', as there are several public figures named 'Richie' (like Lionel Richie, Nicole Richie, Richie Sambora) which causes the public to be familiar with this pronunciation.

31. The Office is of the opinion that part of the public in the Benelux would pronounce the word RICCI as 'ri-tsjj', because this part of the public is familiar with other Italian words that include a 'cc', like focaccia, cappuccino, stracciatella, as well as other Italian trademarks such as 'Gucci'. In this case, the signs are pronounced identically. It is likely that the other part of the public, which is not familiar with the correct Italian pronunciation, would pronounce the trademark invoked as 'rik-ki'. In any case, the latter possible pronunciation is also strongly similar to the pronunciation of the contested sign, because it is identical at the beginning and the end. The Office considers that the small aural difference in the middle is insufficient to evoke a different global aural impression, especially because the first part of the signs are similar (Mundicor, already cited). The Office also points out that risk of confusion with part of the public is sufficient to justify the opposition (see EGC, Hai/Shark, T-33/03, 9 March 2005).

32. For this reason, aurally the signs are strongly similar.

Conceptual comparison

33. Both signs could be perceived as the (last) name of a person. However 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.

34. 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

35. Trademark and sign are visually similar to a certain extent and aurally strongly similar. A conceptual comparison is not under discussion.

Comparison of the goods and services

36. 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).

37. 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.

38. In his arguments, the opponent has limited the list of goods concerning class 18, by stating that the phrase '*and imitations of leather, and goods made of these materials and not included in other classes*' must be excluded (paragraph 9). Furthermore, the defendant has also limited his list of goods (paragraph 4). Therefore, the goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 18 Leather; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.	CI 18 Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery.
CI 25 Clothing, footwear, headgear.	

39. The goods "*leather, trunks, umbrellas, parasols, walking sticks, whips, harness and saddlery*" are mentioned *expressis verbis* in both lists of goods and are therefore identical.

40. The contested goods “*suitcases, travelling cases, handbags, purses, wallets*” are strongly similar to the goods “trunks and travelling bags” of the trademark invoked. All these goods are used by people for carrying different items, in order to take these items with them when they are travelling or ‘on their way’. Therefore, the nature and purpose is the same. Furthermore, these goods could be offered to the public by the same stores in various shapes and sizes, therefore the consumer could assume that these products originate from the same undertaking (reference is made to BOIP, opposition decision 2005550, Only, 9 December 2011).

Conclusion

41. The goods are partly identical and partly strongly similar.

A.2 Global assessment

42. 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.

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

44. 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).

45. 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 does not describe the goods concerned. The opponent also argues that the trademark invoked has a reputation and therefore possesses an enhanced distinctiveness (paragraph 12). However, it is not necessary to discuss this argument, because it has no influence on the outcome of these proceedings.

46. Account must also be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse 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 marks but must place his trust in the imperfect picture of them that he has kept in his mind.

47. In the light of the circumstances mentioned above, including the visual and aural similarity as well as the fact that the goods are either identical or strongly similar, the Office is of the opinion that the relevant public might believe that the goods in question come from the same undertaking or from economically-linked undertakings.

B. Other factors

48. Regarding the opponent's references to decisions from other trademark authorities with regard to opposition proceedings concerning the same signs (paragraph 12), the Office points out that it is obliged to render a decision based on regulation and case law applicable in the Benelux, as well as the arguments and evidence filed by the parties. The Office is not bound by decisions from other offices, whether they refer to similar cases or not (see, by analogy with, EGC decision, Curon, T- 353/04, 13 February 2007).

49. The defendant argues that the evidence, submitted by the opponent to substantiate the enhanced distinctiveness of the trademarks invoked, does not show that the trademarks invoked are genuinely used for all the goods concerned (paragraph 19). However, it must be recalled that a request for proof of use must be explicitly made by the defendant, according to Rule 1.17, paragraph 1 sub d, e and f IR. In the absence of such a request, the issue of genuine use is irrelevant in this case (reference is made to BOIP opposition decision 2001488, QOLEUM, 2 July 2010).

C. Conclusion

50. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

51. Since the opposition is already justified based on the first trademark invoked, it is not necessary to discuss the second trademark invoked.

IV. DECISION

52. The opposition with number 2011667 is justified.

53. Benelux application with number 1322592 will not be registered for the following goods:

- Class 18 (*all goods*)

54. Benelux application with number 1322592 will be registered for the following services against which the opposition was not directed:

- Class 43 (*all services*)

55. 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, 22 March 2017

Eline Schiebroek
(rapporteur)

Saskia Smits

Pieter Veeze

Administrative officer: Jeanette Scheerhoorn