



**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**

**OPPOSITION DECISION**

**N° 2011934**

**of 6 April 2017**

**Opponent:** **Peek & Cloppenburg KG**  
Berliner Allee 2  
40212 Düsseldorf  
Germany

**Representative:** **Bird & Bird LLP**  
Zuid-Hollandplein 22  
2596 AW Den Haag  
Netherlands

**Invoked right:** **European registration 14522619**  
  
Jake\*s  
  
*against*

**Defendant:** **EAF Marketing Limited**  
Regent Street 207 3rd floor  
W1B 3HH London  
United Kingdom

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

**Contested trademark:** **Benelux application 1329206**  
  
Jake.com

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 23 March 2016 the defendant filed an application for a trademark in the Benelux for the word mark Jake.com for goods and services in classes 20, 25 and 43. This application was processed under number 1329206 and was published on 24 March 2016.

2. On 4 May 2016 the opponent filed an opposition against the registration of the application. The opposition is based on European registration 14522619 of the word mark Jake\*s, filed on 1 September 2015 and registered on 25 April 2016 for goods and services in classes 3, 9, 14, 18, 25 and 35.

3. According to the register the opponent is the actual holder of the trademark 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 trademark 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 9 May 2016. During the administrative phase of the proceedings both parties filed arguments. Furthermore, the defendant has limited the list of goods and services of the contested sign. 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 14 November 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 the identical element 'Jake' is the distinctive and dominant element in both signs. According to the opponent, the element '.com' merely refers to the top-level domain of a website and is therefore descriptive. This element will not catch the public's attention, but will be seen as a reference to the online business of the defendant, rather than information on origin of its goods and services. Furthermore, the opponent states that the element '\*s' will be perceived by the public as a possessive genitive indicating a relationship, usually possession or kinship.

10. According to the opponent, the differences between the signs are so insignificant that they will escape the attention of the relevant public. Even if the non-distinctive elements are taken into account, the opponent is of the opinion that the signs are highly similar.

11. The opponent argues that the first four letters of both signs are identical. For this reason, the signs are visually identical, or at least highly similar. The signs are also aurally highly similar. The opponent states that the differences at the end have little influence on the pronunciation. Furthermore, a mark consisting of multiple elements will generally be abbreviated to something that is easy to pronounce and according to the opponent, the emphasis in the trademark invoked and the contested sign lies on the identical element Jake, which has an independent, distinctive position in the disputed sign and is pronounced identically.

12. The opponent is of the opinion that the relevant public will perceive the word Jake as a boy's name. This perception is not changed by the additional elements '\*s' and '.com'. For this reason, according to the opponent, the signs are conceptually identical, or at least highly similar.

13. With regard to the comparison of the goods and services, the opponent states that the contested goods are identical, or at least highly similar to the goods mentioned in class 25 of the trademark invoked. In addition, the opponent argues that the contested goods are complementary to the other goods and services for which the trademark invoked has been registered.

14. The opponent concludes that there is a likelihood of confusion and requests that the Office allows the opposition, refuses the contested sign and orders the defendant to pay the costs of these proceedings.

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

15. The defendant argues that the goods and services are not similar, even though they coincide in parts of their specifications. According to the defendant, the goods of the contested sign are specified and this specification is clearly different from the broad category for which the trademark invoked is registered. To substantiate this point of view, the defendant refers to a decision of the General Court (hereinafter: "EGC") in the case MOBILIX (27 October 2005, T-336/03). Furthermore, the defendant states that there is no complementarity between the goods of the contested sign and goods and services of the trademark invoked.

16. With regard to the comparison of the signs, the defendant argues that the signs are visually different, because of their different endings. As both signs are relatively short, the public will notice and remember these differences.

17. The defendant argues that the signs differ in pronunciation. According to the defendant, the trademark invoked will be pronounced in two syllables: "Jake-stars", whereas the contested sign will be pronounced in three syllables: "Jake-dot-com". The defendant states that the rhythm and flow of the signs is so different that the public will not be confused. For this reason, the signs are not aurally similar.

18. The defendant argues that the additional element '.com' in the contested sign will alter the conceptual meaning of this sign, because the public will perceive it as a website. Furthermore, the added element '\*s' of the trademark invoked also causes a conceptual difference. For this reason, the defendant argues that there is no conceptual similarity.

19. The defendant requests that the Office rejects the opposition and orders the opponent to bear all costs and fees arising in connection with these proceedings.

### III. DECISION

#### A.1 Likelihood of confusion

20. 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.

21. 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.”*

22. According to case law of the Court of Justice of the European Union (hereinafter: “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**

23. 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).

24. 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).

25. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
Jake*s	Jake.com

*Visual comparison*

26. Both signs are purely verbal marks. The trademark invoked consists of the word JAKE, the typographical symbol 'asterisk', followed by the letter S. The Office is of the opinion that the public could visually perceive the asterisk as an apostrophe, because it is followed by the consonant S, which is used, often in combination with an apostrophe, to indicate a possessive case.

27. The contested sign also consists of the word JAKE, followed by the element '.COM'. This element is clearly a generic top-level domain and as such, it does not contribute to the distinctive character of the contested sign.

28. Both signs contain four identical letters which are also placed in the same order. Although the signs are relatively short, the Office is of the opinion that in this case, the differences are very small, occur at the end of both signs and above all, also create a visual separation from the identical word JAKE. Therefore, these differences are insufficient to evoke a different global visual impression. Furthermore, the Office also considers that 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.

*Aural comparison*

30. The defendant states that the trademark invoked will be pronounced as "Jake-stars". Although the typographical symbol asterisk could be aurally referred to as "star", it is more likely that the public will pronounce the trademark invoked as "Jake's", due to the consonant S, which normally indicates a possessive case (see paragraph 26).

31. With regard to the contested sign, it is generally accepted in the Benelux that the element '.com' will be pronounced as "dotcom"<sup>1</sup> or in Dutch "puntcom", or in French "pointcom". However, it cannot be excluded that the average consumer, when referring to a trademark, will not pronounce this element (EGC, Green by Missako, T-162/08, 11 November 2009). A trademark consisting of a number of terms will generally be abbreviated in order to make it easier to pronounce (EGC, BROTHERS by CAMPER, T-43/05, 30 November 2006).

32. In any case, the signs still share the identical element JAKE, which causes an important aural similarity. In line with the visual comparison, the Office is of the opinion that the aural difference at the end of the trademark invoked does not alter the strong overall aural similarity. With regard to the aural comparison, it must also be taken into account that the consumer normally attaches more importance to the first part of a sign.

33. In light of the above, the signs are aurally strongly similar.

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<sup>1</sup> reference is made to the Van Dale Groot Woordenboek Engels-Nederlands, 4<sup>e</sup> edition.

*Conceptual comparison*

34. Although both signs refer to the name of a person, 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 (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.

35. According to the defendant, the '.COM' changes the conceptual perception of the contested sign (see paragraph 18). As mentioned above, the element '.COM' is a well-known top-level domain indication. This element is descriptive, because it indicates that the goods concerned are offered on a website. For this reason, the public will not consider this element as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003).

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

*Conclusion*

37. Trademark and sign are visually similar and aurally strongly similar. A conceptual comparison is not under discussion.

**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. With the comparison of the goods and services of the trademark invoked and the goods and services 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.

40. After the limitation of the list of goods and services made by the defendant (see paragraph 7), the goods and services to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
Cl 3 Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.	
Cl 9 Optical instruments, in particular spectacles, sunglasses, skiing goggles, correction spectacles, spectacle frames, spectacle lenses, spectacle cases.	

<p>CI 14 Precious metals and their alloys and goods in precious metals or coated therewith, namely statues and figurines, and statues and figurines consisting of precious stones, semi-precious stones, imitations thereof or imitations of precious metals and semi-precious metals, all of the aforesaid being coated with precious metals or their alloys; Decorations and ornaments, horological and chronometric instruments, jewellery of precious metals or semi-precious metals or stones or imitations thereof, or coated therewith; Jewellery, precious stones; Horological and chronometric instruments.</p>	
<p>CI 18 Luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather and imitations of leather, animal skins, hides and goods made of these materials, namely luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather straps, leather laces, bandoliers, sheets of imitation leather for further processing.</p>	
<p>CI 25 Clothing, footwear, headgear.</p>	<p>CI 25 Clothing; footwear; headgear; swimwear; leisurewear; all the aforementioned goods not related to the sport field and in particular excluding goods in the field of team sport.</p>
<p>CI 35 Advertising; Business management; Business administration; Office functions; Retailing, including via websites and teleshopping, in relation to clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments, luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather and imitations of leather, fur and pelts, and goods made therefrom, namely luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather thongs, leather laces, bandoliers, sheets of imitation leather for further processing; Arranging and conducting of advertising events and customer loyalty programmes.</p>	

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

42. With regard to the defendant's goods "*swimwear and 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 trademark invoked covers all clothing and is, therefore, identical to the defendant's goods "*swimwear; leisurewear*".

43. The addition "*all the aforementioned goods not related to the sport field and in particular excluding goods in the field of team sport*" in the contested sign does not have any effect on the similarity between the goods in class 25, because it does not alter the nature of these goods. Furthermore, the goods of the opponent are not limited and could refer to all sorts of clothing, footwear and headgear.

#### *Conclusion*

44. The contested goods are identical.

#### **A.2 Global assessment**

45. 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.

46. 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.

47. 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). In this case the signs are visually similar and aurally strongly similar and the contested goods are identical to the goods of the opponent.

48. 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 and services concerned.

49. 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.

50. For this reason, based on the abovementioned circumstances, 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**

51. With reference to the defendant's request that the opponent should bear all costs of the proceedings (see paragraph 19), 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**

52. Based on the foregoing the Office concludes that there exists a likelihood of confusion.

### **IV. DECISION**

53. The opposition with number 2011934 is justified.

54. Benelux application with number 1329206 will not be registered for the following goods:

- Class 25 (*all goods*)

55. Benelux application with number 1329206 will be registered for the following goods and services against which the opposition was not directed:

- Class 20 (*all goods*)
- Class 43 (*all services*)

56. 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, 6 April 2017

Eline Schiebroek  
(rapporteur)

Diter Wuytens

Camille Janssen

Administrative officer: François Veneri