

BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2012364
of 23 March 2018

Opponent : **Fadi Khalil**
Jadestraat 113
9743 HC Groningen
Netherlands

Representative: **Arnold & Siedsma**
Postbus 18558
2502 EN Den Haag
Netherlands

Invoked right 1: Benelux trademark 985613
XPOSE

Invoked right 2: Benelux trademark 993795



against

Defendant: **ETP Technologies Limited**
Regent Street 207 3rd floor
W1B 3HH London
Great Britain

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

Contested trademark: Benelux application 1336970
EXPOSÉ

I. FACTS AND PROCEEDINGS


A. Facts

1. On 1 August 2016, the defendant filed a Benelux trademark application for the word trademark **EXPOSÉ** for goods and services in classes 9, 38 and 42. This application was processed under number 1336970 and was published on 8 August 2016.

2. On 3 October 2016, the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:

- Benelux trademark 985613 for the word trademark **XPOSE**, filed on 16 November 2015 and registered on 21 March 2016 for goods and services in classes 9, 38 and 42;



- Benelux trademark 993795 for the complex trademark , filed on 8 April 2016 and registered on 23 June 2016 for goods and services in classes 9, 38 and 42.

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

4. The opposition is directed against all the goods and services in classes 9 and 38 and against some of the services in class 42 of the contested application and is based on all the goods and services 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 6 October 2016. During the administrative phase of the proceedings both parties filed arguments. 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 12 April 2017.

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. According to the opponent, the contested sign comes visually extremely close to the rights invoked, so much so that the trademarks are in his opinion as good as identical. The rights invoked are entirely encompassed in the contested sign, the only visual difference being the single letter E in the prefix EX and the acute accent on the last letter.

10. Phonetically, the difference between the prefix X and the prefix EX is completely unnoticeable. The acute accent on the last letter in the contested sign forms the only aural difference, if not overlooked. Therefore, according to the opponent, the trademarks are also phonetically highly similar.

11. Conceptually, the signs at hand carry the same semantic meaning, for the consumers in the Benelux will directly recognize EXPOSÉ as French for “exposed”. This conceptual identity completely annihilates the meagre visual and phonetic differences between the trademarks.

12. The contested goods and services in classes 9 and 38 overlap those covered by the rights invoked. The services in class 42 against which the opposition is directed are identical or highly similar to the services covered by the rights invoked.

13. The opponent concludes that there is a serious risk of confusion between the signs at hand. Therefore, he requests that the Office accepts the opposition and rejects the contested sign for the goods and services against which the opposition is directed.

B. Defendant’s arguments

14. According to the defendant, the signs are not visually similar, because of the initial letter E and the accent on the last letter in the contested sign. Moreover, the figurative elements of the second right invoked are very different.

15. Aurally, the rights invoked will be pronounced as [ekspoz]. In contrast, the contested sign will be read as [ekspozzey], due to the accent on the last letter of the sign. Therefore, the signs are aurally dissimilar, according to the defendant.

16. Conceptually, the rights invoked are a variation of the word “expose”, which is defined by the Oxford English Living Dictionary as “make (something) visible by uncovering it”. In contrast, EXPOSÉ is a “report in the media that reveals something discreditable”. Moreover, the defendant observes that the rights invoked are verbs, whilst the contested sign is a noun. Considering all this, he concludes that the signs are conceptually dissimilar.

17. The defendant acknowledges that there are some similarities in the specifications of the goods and services. On the other hand, there are some clear differences between the specifications, such as the hardware in class 9 of the contested sign and the fact that the services in class 38 of the rights invoked regard telecommunication services in situations of panic or emergency. Finally, with respect to class 42, the defendant accepts that the earlier rights and the contested sign are somewhat similar, disregarding certain services.

18. In conclusion, the defendant states that the opponent has failed to provide evidence of a likelihood of confusion and therefore it is requested that the opposition at hand be rejected as unfounded and that the contested sign be granted protection. It is further requested that the opponent shall bear all costs and fees arising in connection with these proceedings.

III. DECISION

A.1 Likelihood of confusion

19. 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.

20. 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.*”

21. 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

22. 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).

23. 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).

24. The signs to be compared are the following:

With regard to the first right invoked (Benelux trademark 985613):

Opposition based on:	Opposition directed against:
XPOSE	EXPOSÉ

Visual comparison

25. Both signs are purely verbal trademarks, consisting of one word of five and six letters respectively, five of which are identical and appear in the same order. The only differences are the initial letter E and the accent on the last letter of the contested sign. However, the Office is of the opinion that these small differences do not outweigh the many similarities between the signs.

26. Visually, the signs are similar in their overall impression.

Aural comparison

27. Phonetically, the first syllables of the signs are identical, as the common consumer will pronounce the letter X as [ex]. The accent on the last letter in the contested sign causes an aural difference, but not in such a way that it completely changes the pronunciation: [expose] on the one hand and [exposee] on the other.

28. Overall, the signs are aurally similar.

Conceptual comparison

29. Conceptually, the meaning of the word exposé already given by both parties can be confirmed with <https://www.collinsdictionary.com/dictionary/english/expose>. In British English, it is “an article, book, or statement that discloses a scandal, crime, etc.”, in American English it is “a public disclosure of a scandal, crime, etc”. The Office is of the opinion that this meaning is closely related to that of expose in the sense of “to bring to public notice; disclose; reveal”, regardless of whether the one is a noun and the other a verb.

30. Conceptually, the signs are similar.

Conclusion

31. The signs are visually, aurally and conceptually similar.

Comparison of the goods and services

32. 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).

33. With the comparison of the goods and services of the trademark invoked and those 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.

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

Opposition based on:	Opposition directed against:
Class 9 Application software for recording, storing and streaming of sound and images in panic and emergency situations via mobile phones, tablets and internet; application software for recording, storing and streaming of sound and images for purposes of social networking via mobile phones, tablets and internet; application software accommodating payments and donations to others via mobile phones, tablets and internet; audio and video recording apparatus, also in combination with chargers for mobile phones; buttons for use in panic and emergency situations, also in combination with chargers for mobile phones; emergency transmitters.	Class 9 Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data- carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; microprocessors; keyboards; video films.
Class 38 Video and audio streaming services; communication via internet and mobile telephony focused on panic and emergency situations; sending of emergency messages via the mobile network and the Internet; audio, video and multimedia broadcasting	Class 38 Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global

via internet and other communications related to panic and emergency situations.	computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.
Class 42 Services of a software application service provider (ASP); development and maintenance of a software application for streaming audio and video in panic and emergency situations; hosting a website with information and audio and video recordings on emergency situations; development and maintenance of a software application and website that gives users the ability to see, follow and review images, audio and video content of other users in panic or emergency situations or simply for the purpose of social networking; development and maintenance of a software application and website enabling users to make payments or donations to others.	Class 42 Technical design and planning of telecommunications equipment; technical research services; computer software technical support services; technical consultancy relating to the application and use of computer software; creating and maintaining web sites.

Class 9

35. The goods *computer software* of the contested sign are a broad, general category that covers the several items of *application software* of the right invoked. Therefore they are considered to be identical (EGC, Metabiomax, T-281/13, 11 June 2014), which is also in confesso (see point 17).

36. The goods *computer hardware, electronic data processing equipment and computer networking and data communications equipment* of the contested sign are similar to the *application software* of the right invoked. Indeed, the latter is indispensable for the functioning of the first goods and therefore these goods are complementary. Furthermore, these goods will often be delivered by the same kinds of undertaking.

37. The other goods of the contested sign in this class, namely *computer peripherals, computer components and parts, electronic memory devices, electronic control apparatus, programmed-data-carrying electronic circuits, wires for communication, electrodes, telephones, aerials, batteries, microprocessors, keyboards and video films* differ from those covered by the right invoked, as they are of a different nature, have different purposes and end-users and are not provided through the same distribution channels. Therefore, these goods are not similar.

Class 38

38. All the services of the right invoked in this class are covered by the broad category *telecommunication services* of the contested sign, and therefore these services are considered to be identical. As a matter of fact, all other services of the contested sign are a specified kind of telecommunication service and are thus identical or at least similar to a high degree to the services of the right invoked. To give some examples: *transmission of data* and *transmission of data, audio, video and multimedia files* are identical to *video and audio streaming services* and *video and multimedia broadcasting via internet*. The fact that some services of the right invoked are specified to be *focused on (or related to) panic and emergency situations* does not change this, as this does not influence the nature of the services.

Class 42

39. The services *technical research services, computer software technical support services and technical consultancy relating to the application and use of computer software* of the contested sign all fall within the

broader category of the *services of a software application service provider (ASP)* covered by the right invoked and thus must be considered to be identical to them (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), which is also in confesso (see point 17).

40. The services *creating and maintaining web sites* of the contested sign are identical to the services *development and maintenance of a website* of the right invoked.

41. Finally, the service *technical design and planning of telecommunications equipment* of the contested sign has to do with equipment, whereas all the services of the right invoked are related to software. These services are therefore not similar, as they have a different subject, a different kind of know-how and are targeted at a different public.

Conclusion

42. The goods and services of the contested sign are partially identical, partially similar and partially not similar to the goods and services of the right invoked.

A.2 Global assessment

43. 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.

44. 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 in accordance with the category of goods or services in question. The goods and services at hand are intended for a professional public with either an average or above average level of attention, depending on the goods and services in question.

45. 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).

46. 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/her trust in the imperfect picture of them that he/she has kept in his/her mind.

47. 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 level of distinctiveness, as it is not descriptive of the goods and services concerned.

48. The signs are visually, aurally and conceptually similar. Some of the goods and services concerned are identical or similar and some are not similar. Based on these grounds, and given the interdependence between all the circumstances to be taken into account, the Office finds that the relevant public might believe that the identical and similar goods and services originate from the same undertaking or from economically-linked undertakings.

B. Other factors

49. The defendant asks that all the costs of these proceedings be borne by the opposing party (see above point 18). However, rule 1.32 (3) IR clearly stipulates that the costs referred to in article 2.16 (5) BCIP are determined at an amount equalling the basic opposition fee (in the case that the opposition is totally upheld or rejected). The request of the defendant can therefore not be honoured.

C. Conclusion

50. The Office holds that there exists a likelihood of confusion for the identical and similar goods and services.

51. The opposition partly succeeds based on the first right invoked. Since the goods and services pertaining to the second right invoked are identical, there is no need to examine the likelihood of confusion with regard to it.

IV. DECISION

52. The opposition with number 2012364 is partially upheld.

53. The Benelux application with number 1336970 will not be registered for the following goods and services:

Class 9 Computer software; computer hardware; electronic data processing equipment; computer networking and data communications equipment.

Class 38 All services.

Class 42 Technical research services; computer software technical support services; technical consultancy relating to the application and use of computer software; creating and maintaining web sites.

54. The Benelux application with number 1336970 will be registered for the following goods and services, either because the opposition was not directed against them, either because they were not found to be similar:

Class 9 Computer peripherals; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data- carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; microprocessors; keyboards; video films.

Class 42 Technical design and planning of telecommunications equipment; technical assessments relating to design; graphic design services; fashion design.

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, 23 March 2018

Willy Neys
rapporteur

Camille Janssen

Pieter Veeze

Administrative officer:

Raphaëlle Gérard