



**BENELUX-OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2012366**  
**of 17 April 2018**

**Opponent :** **CBM Creative Brands Marken GmbH**  
Kalandergerasse 4  
8045 Zürich  
Switzerland

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

**Invoked right:** **Fashionnow** (European Union trademark 9779299)

*against*

**Defendant:** **Fashion One (Europe) N.V.**  
Leeuwenstraat 4  
2000 Antwerpen  
Belgium

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

**Contested trademark:** **Fashionow** (Benelux application 1336784)

## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 28 July 2016 the defendant filed a Benelux trademark application for the word trademark **Fashionow** for goods and services in classes 3, 18 and 38. This application was processed under number 1336784 and was published on 1 August 2016. In the course of the procedure, the defendant limited its goods and services by deletion of the services in class 38.

2. On 1 October 2016 the opponent filed an opposition against this application. The opposition is based on the European Union trademark 9779299 for the word trademark **Fashionnow**, filed on 2 March 2011 and registered on 12 June 2013 for goods and services in classes 3 and 38.

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

4. The opposition is directed against all the goods and services of the contested application and is based on all the goods and services of the trademark 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 24 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, it is evident that the signs are nearly identical. Both signs consist of the same structure of one word, the letters are placed in the same order and the signs solely differ in one letter, namely the additional letter N in the right invoked. However, such a small difference will go unnoticed by the average consumer and is therefore insufficient to remove the similarity between the otherwise identical signs. The opponent therefore concludes that the contested sign is visually identical or at least highly similar to the right invoked.

10. Aurally, the additional letter N in the right invoked does not alter the pronunciation. Furthermore, the signs will be pronounced with the same rhythm and intonation and are consequently identical or at least highly similar.

11. Conceptually, the signs completely coincide in their element FASHION, which is also placed in the same sequence and mirrors the same meaning. Therefore, according to the opponent, the signs are conceptually identical.

12. The opponent is of the opinion that the goods *perfumery, essential oils and cosmetics, make-up, eye make-up, eyeliners, blushers and lipsticks* of the contested sign are similar to the *cleaning preparations* of the right invoked as these goods have the same purpose, distribution channels, relevant public and producer/provider. In addition, *perfumery* and *essential oils* are, according to the opponent, complementary to the goods belonging to the right invoked as these goods are important ingredients for cleaning preparation products. Furthermore, *hair lotions* and *soaps* are to be considered similar to a high degree to *cleaning preparations*, as all these products are used for washing and cleaning and are made of the same ingredients.

13. The opponent observes that the *telecommunication services* of the contested sign are clearly identical to the *telecommunications* of the right invoked.

14. Insofar as it is relevant, the opponent remarks that a possibly lesser degree of similarity between the goods and services may be compensated by a high degree of similarity between the signs. In the case at hand, such a lesser degree of similarity between the goods and services would be compensated by the identity of the signs concerned.

15. The opponent concludes that there is unmistakably a likelihood of confusion. On these grounds, he requests that the Office upholds the opposition, refuses the contested sign and orders that the defendant pays the costs of these proceedings.

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

16. Together with his arguments, the defendant files a limitation of the goods and services by deleting all the services in class 38 and therefore he merely assesses the remaining goods in classes 3 and 18 which are, in his opinion, significantly different.

17. The defendant accepts that the signs are visually, aurally and conceptually similar, but due to the total lack of overlap between the specifications of the goods and services, there can be no likelihood of confusion.

18. It is true that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the signs, and vice versa, but this interdependence cannot overcome the necessity for the similarity of the goods concerned to be established.

19. According to the defendant, it has been shown that the conditions for likelihood of confusion are not met and in this light it is requested that the opposition at hand be rejected in its entirety as unfounded and that the contested sign be granted protection. It is further requested that all costs and fees arising in connection with these proceedings be imposed on the opponent.

## **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 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: 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, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; 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, ECLI:EU:C:1997:528).

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 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, ECLI:EU:C:2007:333). 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, ECLI:EU:T:2002:261 and El Charcutero Artesano, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

26. The signs to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
<b>Fashionnow</b>	<b>Fashionow</b>

### *Visual comparison*

27. Both signs are purely verbal trademarks and consist of one word of ten, respectively nine letters; except for one letter, they are thus of the same length. Moreover, the first seven letters are identical and appear exactly in the same order. This is far more than half of the signs.

28. 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, not only the seven first letters are identical, but the three last letters are as well. The only difference resides in the additional letter N in the middle of the right invoked, but this is far insufficient to make the signs different in their overall impression.

29. Visually, the trademark and the sign are similar to a high degree in their overall impression.

*Aural comparison*

30. As the signs are approximately of the same length, their rhythm and intonation are the same.

31. The only difference between the signs being the double letter N in the middle of the right invoked, this will hardly alter the pronunciation.

32. Aurally, the signs are nearly identical.

*Conceptual comparison*

33. The first element in both the right invoked and the contested sign, FASHION, is very commonly used and will be understood by the average consumer in the Benelux. Most of the relevant public will probably also understand the basic English word NOW.

34. Overall, the signs are conceptually similar to the extent that they both contain the word FASHION and the reference to the word NOW.

*Conclusion*

35. Visually, the signs are similar to a high degree, aurally they are almost identical and conceptually they are similar.

**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 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.

38. As stated above (see point 16), the defendant has withdrawn the services in class 38. Although the opponent did involve these services in the comparison, the goods and services to be compared are now the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
Class 3 Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations.	Class 3 Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.

	Class 18 Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery.
Class 38 Telecommunications.	

### Class 3

39. The goods *perfumery, essential oils, cosmetics, make-up, eye make-up, eyeliners, blushers, lipsticks*, and *hair lotions* of the contested sign can be either beauty and personal hygiene products or products used with the purpose of giving a pleasant fragrance to the body. In contrast to the opponent, the Office is of the opinion that these products do not have the same function as the products of the right invoked. They can all be used for hygiene purposes but the goods of the contested sign are used in relation with the human body while the goods of the right invoked are used for domestic purposes. Furthermore, they are not manufactured by the same companies nor are they sold in the same sales outlets or in the same departments of department stores. Finally, and in contrast to the opinion of the opponent, the Office finds that these products are not substantially made of the same ingredients (see point 12). For these reasons, these goods have to be considered as dissimilar.

40. The goods *soaps* of the contested sign on the other hand have a dual function: they are used to wash the body and give it an agreeable scent or aspect, but they can also be used as housekeeping products. In that respect they are comparable to the *bleaching preparations and other substances for laundry use and cleaning, polishing, scouring and abrasive preparations* belonging to the right invoked. Therefore, these goods are similar.

### Class 18

41. The goods of the contested sign in this class have a completely different nature and use to the goods of the right invoked. Furthermore, these goods target a different public, they are not distributed through the same channels, nor do they have the same producers. Finally, these goods are not complementary and not in competition with each other. Apart from that, the opponent did not substantiate, nor did he even allege why these goods should be considered similar.

### Conclusion

42. Only the goods *soaps* of the contested sign are similar to the goods of the right invoked, the remaining goods are dissimilar.

## 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 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.

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). According to the opponent, in the case at hand, such a lesser degree of similarity between the goods and services would be compensated by the identity of the signs concerned (see point 14). However, if the goods and services are not similar at all, such a compensation cannot occur. Indeed, a likelihood of confusion presupposes both that the two marks are identical or similar and that the goods or services which they cover are identical or similar. These conditions are cumulative (see, to that effect, EGC, easyHotel, T-316/07, 22 January 2009, ECLI:EU:T:2009:14 and YOKANA, T-103/06, 13 April 2010, ECLI:EU:T:2010:137).

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 and 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 similar to a high degree, aurally nearly identical and conceptually they are similar. Only part of the goods of the contested sign are similar to the goods of the right invoked. 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 similar goods originate from the same undertaking or from economically-linked undertakings.

#### **B. Other factors**

49. Both parties ask that all the costs of these proceedings be borne by the opposing party (see above points 12 and 20). 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 requests of the parties can therefore not be honoured.

#### **C. Conclusion**

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

#### **IV. DECISION**

51. The opposition with number 2012366 is partially upheld.

52. The Benelux application with number 1336784 will not be registered for the following goods:

Class 3 Soaps.

53. The Benelux application with number 1336784 will be registered for the following goods, which were found not to be similar:

Class 3 Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions.

Class 18 All goods.

54. 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, 17 April 2018

Willy Neys  
*Rapporteur*

Tineke van Hoey

Diter Wuytens

Administrative officer:

François Veneri