



BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2012367
of 17 April 2018

Opponents : **CBM Creative Brands Marken GmbH**

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8045 Zürich
Switzerland

Minerva GmbH

Nordendstr. 12
80799 München
Germany

Representative: **Bird & Bird LLP**

Zuid-Hollandplein 22
2596 AW Den Haag
Netherlands

Invoked right 1: **FashionID** (European Union trademark 11287794)

Invoked right 2: **Fashion ID** (European Union trademark 10638658)

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: **i.d. fashion Smart** (Benelux application 1336783)

I. FACTS AND PROCEEDINGS

A. Facts

1. On 28 July 2016 the defendant filed a Benelux trademark application for the word trademark **i.d. fashion Smart** for goods in classes 21, 24 and 25. This application was processed under number 1336783 and was published on 1 August 2016.
2. On 1 October 2016 the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:
 - European Union trademark 11287794 for the word trademark **FashionID**, filed on 23 October 2012 and registered on 4 February 2016 for goods and services in classes 3, 9, 14, 18, 25, 35 and 36;
 - European Union trademark 10638658 for the word trademark **Fashion ID**, filed on 13 February 2012 and registered on 16 April 2016 for goods and services in classes 3, 9, 14, 18, 25, 35 and 36.
3. During the opposition proceedings, the second right invoked was transferred to a third party. Opponent's representative has informed the Office that both companies wish to be involved in this opposition.
4. The opposition is directed against all the goods 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 21 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. They consist of the identical elements FASHION and ID. The fact that the contested sign uses punctuation marks in the word I.D. does not alter the similarity. The signs differ solely in the addition of one word to the contested sign, namely SMART. This additional element however, is not sufficient 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 rights invoked.

10. Aurally, the signs consist of the identical elements FASHION and ID, which are pronounced identically. The sole addition of the word SMART to the contested sign is not sufficient to remove the similarity between the otherwise identical signs, as this difference is so insignificant that it will go unnoticed by the average consumer.

11. Conceptually, the signs completely coincide in their elements FASHION and ID (or I.D.), which refer to the same meanings (fashion and identification/identity). Therefore, according to the opponent, the signs are conceptually identical.

12. While the goods of the contested sign in classes 21 and 24 are not in the same classes as those of the rights invoked, the opponent nevertheless finds them similar to the goods in class 3, which are also goods for household use. Moreover the latter goods are used to clean the goods in class 21. The goods in class 24 on the other hand are similar to the goods clothing in their nature, use and purpose and their end users. Finally, according to the opponent, the goods in class 25 of the signs are identical.

13. 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.

14. 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

15. As a preliminary remark, the defendant notes that the second right invoked no longer belongs to the opponent and thus should be removed as a basis for the opposition.

16. According to the defendant, only some of the goods in class 25 are similar. In contrast to the opponent he sees no similarities at all nor any complementarity between the goods in classes 21 and 24 on the one hand and classes 3 and 25 on the other.

17. 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 interdependency cannot overcome the necessity for the similarity of the goods concerned to be established.

18. Given the different word order and the addition of the word SMART to the contested sign, the defendant is of the opinion that the signs are not similar.

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:

With regard to the first right invoked (European trademark 11287794):

Opposition based on:	Opposition directed against:
FashionID	i.d. fashion Smart

Conceptual comparison

27. None of the signs has an established meaning as a whole, but the average consumer in the Benelux will recognize and understand the common English words “fashion” and “ID” (or “i.d.”, for identity/identification). These words occur both in the right invoked and in the contested sign. The latter also comprises the word ‘Smart’, which the consumer could recognize as “clever” or “programmed so as to be capable of some independent action” (<https://en.oxforddictionaries.com/definition/smart>) like a smart phone, a smart watch and a smart TV. With regard to clothing and fashion however, “smart” also means “well dressed, fashionable, stylish, chic, elegant”. Therefore, in the context of the contested sign, the consumer will not pay more attention to this word than to the preceding two.

28. Overall, the signs are conceptually similar to a certain degree to the extent that they both refer to fashion and identity/identification.

Visual comparison

29. Both signs are purely verbal trademarks, the right invoked consisting of one word of nine letters, the contested sign consisting of the abbreviation “i.d.” followed by two words of respectively seven and five letters. The word “fashion” appears in both signs, albeit in the right invoked at the beginning and in the contested sign in the middle. Furthermore, both signs contain the letters “ID”, in the right invoked at the end and in the contested sign at the beginning and separated by dots. Finally, the contested sign has an additional word at the end, namely “Smart”, but given the above mentioned meaning of the word in this context, it will not be considered as predominant. Due to the identical word “fashion” and the recurring abbreviation “id”, the Office finds that the similarities somewhat outweigh the differences.

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

Aural comparison

31. Phonetically, the first two elements of the contested sign are pronounced in the same way as the right invoked, albeit in reverse order. The element “Smart” on the other hand is different.

32. Aurally, the signs are in their overall impression similar to a certain degree.

Conclusion

33. The signs are visually, aurally and conceptually similar to a certain degree.

Comparison of the goods and services

34. 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).

35. 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.

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

Opposition based on:	Opposition directed against:
Class 3 Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.	
Class 9 Encoded magnetic and credit cards, visually readable and/or machine-readable data carriers, in particular those suitable for booking bonus transactions, including data carriers with integrated payment and/or telecommunications functions; Data reading apparatus for reading the aforesaid data media; Software for customer loyalty programmes and reading devices; Optical instruments, in particular spectacles, sunglasses, skiing goggles, correction spectacles, spectacle frames, spectacle lenses, spectacle cases.	
Class 14 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; Jewellery, precious stones; Horological and chronometric instruments.	
Class 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, rucksacks, bags; Umbrellas, parasols, and walking sticks; Whips, harness and saddlery.	
	Class 21 Household utensils; household containers; glassware for household purposes; tableware of porcelain; earthenware; bone china tableware [other than cutlery].
	Class 24 Textile goods, and substitutes for textile goods; bed covers; table covers.
Class 25 Clothing, footwear, headgear.	Class 25 Clothing; footwear; headgear; swimwear; sportswear; leisurewear.
Class 35 Advertising; Business management; Business administration; Office functions; Retail services, 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 and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, bags, handbags, wallets, purses, key cases, rucksacks, pouches, umbrellas, parasols and walking sticks, whips, harness and saddlery; Organisation, construction, support and conducting of advertising events and customer loyalty programmes (in particular incentive schemes, bonus schemes); Merchandising (sales promotion); Business consultancy with regard to customer loyalty systems, professional business and organisation consultancy with regard to customer loyalty systems, customer loyalty marketing, presentation of goods and services; Providing online information via marketing, marketing research, bonus, publicity, customer loyalty and/or reward programmes;	

Compilation, updating and storing of data in databases; Maintaining databases; Data storage.	
Class 36 Insurance; Financial affairs; Monetary affairs; Real estate affairs; Services in the field of payment transactions, electronic banking; Issuing of credit cards, cheque cards and identification cards for the payment of goods and/or services; Issuing data carriers for entering bonus and reward transactions (included in class 36); Providing of services in connection with the issued data carriers, credit card, Cheque cards and/or Identity cards; Design, organisation and promotion of customer loyalty systems with regard to financial aspects (included in class 36).	

Class 21

37. Although it is true that the goods in class 3 of the right invoked can be used in housekeeping, as stated by the opponent (see point 12), they are of a completely different nature and use to the household goods in class 21 of the contested sign. The fact that the products in class 3 can serve to clean the goods in class 21 does not mean that these goods are similar. Otherwise, all goods that can be cleaned would be similar to the products in class 3. Beside this different nature and use, these products also target different consumers and have other producers and other distribution channels. These products are therefore dissimilar. The same applies to the other goods and services of the rights invoked.

Class 24

38. According to the opponent, the goods in class 24 of the contested sign are similar to the goods *clothing* (see point 12). The Office on the other hand is of the opinion that the only thing these goods have in common is that clothing is usually made of textile material. However, this is not enough to justify a finding of similarity. The goods serve completely different purposes: clothing (and footwear and headgear) are meant to be worn by people, for protection and/or fashion, whereas textile goods are mainly for household purposes and interior decoration. Therefore, their method of use is different. Moreover, they have different distribution channels and sales outlets and are not usually manufactured by the same undertaking. The same reasoning fully applies to the other goods and services of the right invoked.

Class 25

39. The goods *clothing*, *footwear* and *headgear* are identically contained in the lists of both marks and these goods are therefore identical. *Swimwear*, *sportswear* and *leisurewear* of the contested sign are all different types of clothing. Accordingly, they are included in the broader category of clothing of the right invoked and are therefore identical (see EGC, *Fifties*, T-104/01, 23 October 2002, ECLI:EU:T:2002:262; Arthur et Félicie, T-346/04, 24 November 2005, ECLI:EU:T:2005:420 and Prazol, T-95/07, 21 October 2008, ECLI:EU:T:2008:455).

Conclusion

40. The goods at issue are partly identical and partly dissimilar.

A.2 Global assessment

41. 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.

42. 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.

43. 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 13). 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).

44. 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.

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

46. The signs are visually, aurally and conceptually similar to a certain degree. Some goods of the contested sign are identical to the goods of the right invoked, while others are dissimilar. Based on the aforementioned, 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 goods originate from the same undertaking or from economically-linked undertakings.

B. Other factors

47. Both parties ask that all the costs of these proceedings be borne by the opposing party (see above points 14 and 19). 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.

48. The defendant observes that the second right invoked has been transferred to a third party which is apparently not involved in the present opposition procedure (see point 15). However, as this transfer was effectuated in the course of the opposition procedure, the new trademark holder can participate in this procedure. As stated above, both opponents have indeed informed the Office that they wished to be involved in this opposition (see point 3).

C. Conclusion

49. The Office holds that there exists a likelihood of confusion for the identical goods.

50. Since the goods and services of the second right invoked are identical to those of the first, there is no need to examine the likelihood of confusion with regard to that trademark.

IV. DECISION

51. The opposition with number 2012367 is partially upheld.

52. The Benelux application with number 1336783 will not be registered for the following goods:

Class 25 All goods.

53. The Benelux application with number 1336783 will be registered for the following goods:

Class 21 All goods.

Class 24 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