

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2012747
of 21 August 2018

Opponent: **LVMH SWISS MANUFACTURES SA**
Rue Louis-Joseph Chevrolet 6A
2300 La Chaux-de-Fonds
Switzerland

Representative: **Novagraaf Nederland B.V.**
Hoogoorddreef 5
1101 BA Amsterdam
Netherlands

Invoked right 1: **International registration 970668**

HEUER

Invoked right 2: **International registration 887465**

HEUER

Invoked right 3: **International registration 437738**



Invoked right 4: **International registration 499995**



against

Defendant: **CKL Holdings N.V.**

Leeuwenstraat 4
2000 Antwerpen
Belgium

Representative: **Trademarkers Merkenbureau C.V.**

Amersfoortsestraatweg 33b
1401 CV Bussum
Netherlands

Contested trademark: **Benelux application 1343201**

HEER

I. FACTS AND PROCEEDINGS

A. Facts

1. On 18 November 2016 the defendant filed an application for a trademark in the Benelux for the wordmark HEER for goods and services in classes 3, 9, 14, 16, 25 and 41. This application was processed under number 1343201 and was published on 22 November 2016.

2. On 19 January 2017 the opponent filed an opposition against the registration of the application. The opposition was initially based on the following earlier trademarks:

- International registration 970668, with designation European Union, of the wordmark HEUER, filed on 29 May 2008 and registered on 13 August 2009 for goods in classes 9 and 14;
- International registration 887465, with designation European Union, of the wordmark HEUER, filed on 6 June 2006 and registered on 26 July 2007 for goods in classes 18 and 25.

- International registration 437738, with designation Benelux, of the combined word/figurative mark





, filed on 17 May 1978 and registered for goods in classes 9, 10 and 14.

- International registration 499995, with designation Benelux, of the combined word/figurative mark



, filed on 13 January 1986 and registered for goods in classes 9, 14, 25 and 28.

-  , according to the opponent, a well-known trademark within the meaning of Article 6bis of the Paris Convention.

-  , according to the opponent, a well-known trademark within the meaning of Article 6bis of the Paris Convention.

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

4. The opposition was initially also based on the two well-known trademarks mentioned above. With his arguments, the opponent limits the scope of the opposition, indicating that the opposition will only be based on the four registered trademarks (see paragraph 9). The opposition is directed against all goods in classes 14 and 25 of the contested application and is based on all goods in classes 14 and 25 of the trademarks invoked. In his response to the proof of use, the defendant limits the list of contested goods by deleting all goods in class 14 and some of the goods in class 25 (see paragraph 22).

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 23 January 2017. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. 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 4 January 2018.

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. Firstly, the opponent indicates that the opposition is no longer based on the two well-known trademarks invoked (see paragraph 4).

10. The opponent argues that the contested goods in classes 14 and 25 are identical to the goods of the trademarks invoked.

11. The opponent further states that the wordmark HEUER and the contested sign HEER coincide in the letters 'HE.ER' and have four out of five letters in common. With regard to the figurative trademarks invoked, the opponent is of the opinion that the word elements are the dominant parts of these trademarks. According to the opponent, the signs are visually quite similar.

12. The wordmark HEUER and the contested sign begin with the same two letters 'HE-' and also end with the two identical letters '-ER'. Only the letter in the middle of the trademark invoked is different and will be pronounced differently. Therefore, according to the opponent, the signs are aurally similar.

13. With regard to the conceptual comparison, the opponent argues that the signs are not similar.

14. The opponent argues that the trademarks invoked have a reputation and are well known in the Benelux. To substantiate this argument, the opponent has also filed evidence. According to the opponent, in the light of this reputation, the trademarks invoked are highly distinctive.

15. The opponent also claims that the contested sign is filed in bad faith. In the light of the trademark filing history of (the affiliates of) the defendant, the opponent argues that the defendant has no real interest in using its trademarks, besides the purpose of obtaining domains.

16. The opponent concludes that there exists a likelihood of confusion and requests that the Office upholds the opposition.

17. At the request of the defendant, the opponent filed proof of use.

B. Defendant's arguments

18. The defendant argues that the contested goods are not similar to the goods of the trademarks invoked.

19. With regard to the wordmark of the opponent, the defendant argues that only four of the five letters are the same. According to the defendant, the relevant consumer will instantly perceive the difference and therefore, the signs are visually different. Furthermore, the defendant argues that the signs will be pronounced differently by the Dutch speaking public in the Benelux. The defendant also states that the signs have a clear meaning in German. According to the defendant, the contested sign HEER means 'army' or 'host' and the trademark invoked HEUER means 'this year', 'pay', or 'get hired'. For this reason, the defendant concludes that there exists no likelihood of confusion between the signs. The defendant further points out the differences between the figurative trademarks invoked and contested sign and also concludes that these signs are not similar.

20. The defendant disputes the opponent's argument that the contested sign has been applied for in bad faith and points out that there is no evidence for this claim.

21. The defendant concludes that there exists no likelihood of confusion and requests that the Office rejects the opposition.

22. Furthermore, the defendant requested the opponent to submit proof of use with regard to all the trademarks invoked. In response to the proof of use submitted, the defendant limits the list of goods against which the opposition is directed (see paragraph 4). The response of the defendant does not contain any substantive arguments that dispute the proof of use submitted by the opponent.

III. DECISION

A.1 Proof of use

23. Articles 2.16, 3 (a) and 2.26, 2 (a) BCIP and rule 1.29 IR stipulate that the right invoked should be put to genuine use within the Benelux territory for a continuous period of five years prior to the publication date of the sign against which the opposition is lodged. Given the fact that the trademarks invoked were registered more than five years prior to the publication date of the contested sign, the defendant's request to submit proof of use is legitimate.

24. The defendant has not provided any substantive arguments in response to the proof of use submitted by the opponent (see paragraph 22). Rule 1.25, sub d IR stipulates that "facts to which the other party did not respond will be deemed as undisputed". In the light of the absence of response by the defendant, the Office will not assess the proof of use and concludes that the parties agree that the trademarks invoked have been genuinely used.

A.2 Likelihood of confusion

25. 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.

26. 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.”*

27. 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, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs

28. 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).

29. 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).

30. 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).

31. The Office will first compare the second trademark invoked (*IR 887465*) with the contested sign:

Opposition based on:	Opposition directed against:
HEUER	HEER

32. According to relevant case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, inter alia the visual, aural and conceptual aspects (reference is made to *Matratzen and Sabel*, already cited).

Visual comparison

33. Both signs are purely verbal marks containing one word. The trademark invoked consists of five letters and the contested sign consists of four letters. The signs only differ in one letter, which is the letter 'U' positioned in the middle of the trademark invoked. Although the signs are relatively short, the Office considers that there is only one small visual difference in the middle. On the other hand, the first and last parts of the signs are identical. Therefore, the difference is 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, ECLI:EU:T:2004:79*).

34. For this reason, the Office finds that the signs are visually similar.

Aural comparison

35. The trademark invoked consists of two syllables and will be pronounced by the German speaking public as ['høye] or [hoi-e]. In this case the final letter 'R' will not be pronounced. However, the Office considers that it cannot be excluded that part of the (Dutch speaking) public in the Benelux will pronounce the trademark invoked as ['hœr] or [hoi-er], in which case the final letter 'R' will also be pronounced. The contested sign consists of one syllable and will be pronounced as [her] and with regard to the Dutch speaking public, the pronunciation of the letter R sounds 'soft' and will be similar to the pronunciation of the letter R in the word HEUER. For part of the public, the pronunciation coincides in the identical letters 'H' at the beginning and 'R' at the end. The Office 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, ECLI:EU:T:2005:89*).

36. Therefore, the Office finds that the signs are aurally similar to a certain degree.

Conceptual comparison

37. The word HEUER means 'seafarer's pay' or 'this year' in German.¹ The word HEER, inter alia, means 'army' in German and 'gentleman' in Dutch.² Therefore, the Dutch and German speaking public will perceive the signs as conceptually different, however, this does not apply for the French speaking public in the Benelux.

38. As a result, for part of the public the signs have no meaning and a conceptual comparison is not possible. For the other part of the public, the signs are conceptually different.

¹ <http://www.mijnwoordenboek.nl/vertaal/DE/EN/heuer>

² <http://www.mijnwoordenboek.nl/vertaal/DE/EN/heer>; <http://www.mijnwoordenboek.nl/vertaal/NL/EN/heer>

Conclusion

39. Trademark and sign are visually similar and aurally similar to a certain degree. With regard to the conceptual comparison, the signs are either different or a comparison is not possible.

Comparison of the goods

40. 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).

41. 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.

42. After the limitation of the list of goods made by the defendant (see paragraph 4 and 22), the goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 25 Clothing, footwear, headgear.	CI 25 Footwear; swimwear.

43. The goods “*footwear*” are mentioned *expressis verbis* in both lists of goods and are therefore identical.

44. With regard to the defendant's goods “*swimwear*”, 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, 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). The trademark invoked covers all clothing and is, therefore, identical to the defendant's goods “*swimwear*”.

Conclusion

45. The contested goods are identical to the goods mentioned in class 25 of the second trademark invoked.

A.2 Global assessment

46. 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.

47. 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.

48. 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).

49. 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. The opponent also refers to the reputation of the trademarks invoked, which has not been disputed by the defendant.

50. 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.

51. The signs at issue will often be used in writing due to the nature of the goods (clothing, footwear, headgear, etc.), for example imprinted on these articles of clothing, footwear and headgear, but also in publicity folders, on websites, etc. As a consequence, the visual aspect will play a more important role. Furthermore, an oral reference to the signs is very likely – for example when asking for information at a point of sale – and thus the phonetic similarity is also significant here (BOIP, opposition decision LOTTE, 2000155, 20 July 2007). For this reason, the Office finds that the possible conceptual difference between the signs, which is, moreover, only relevant for a part of the relevant public (see paragraph 37), is not sufficient to neutralize the visual and aural similarities.

52. Based on the abovementioned circumstances, especially the fact that the goods are identical and that the signs are visually similar and phonetically similar to a certain degree, the Office finds that in this case the differences between the signs are not sufficient to outweigh the similarities. Therefore, the Office concludes that the relevant public might be led to believe that the goods concerned come from the same undertaking or from economically-linked undertakings.

B. Other factors

53. The opponent states that the defendant has filed the contested sign in bad faith (see paragraph 15). Such an argument cannot play a role in these proceedings. Opposition proceedings with the Office are intended to resolve conflicts between trademark owners in a fast and uncomplicated manner. These proceedings are therefore limited to specific grounds, stipulated in articles 2.14 jo 2.3 par. 1 sub a and b BCIP. The application of these articles is solely judged based on the information as it appears in the trademark register. Other possible grounds of defence or objection against a trademark application cannot play a role in opposition proceedings. To that end the parties should file legal proceedings before a court.

C. Conclusion

54. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.
55. Since the opposition is already justified based on one of the trademarks invoked, it is not necessary to discuss the others.

IV. DECISION

56. The opposition with number 2012747 is justified.
57. Benelux application with number 1343201 will not be registered for the following goods:
- CI 25 (*all goods*)
58. Benelux application with number 1343201 will be registered for the following goods and services against which the opposition was not directed:
- CI 3 (*all goods*)
 - CI 9 (*all goods*)
 - CI 16 (*all goods*)
 - CI 41 (*all services*)
59. The defendant shall pay the opponent 1,030 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, 21 August 2018

Eline Schiebroek
(rapporteur)

Tomas Westenbroek

Pieter Veeze

Administrative officer: Ellen van Holst