



BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2012898
of 26 June 2018

Opponent: **CARL ZEISS (AKTIENGESELLSCHAFT)**
Carl-Zeiss-Str. 22
73447 Oberkochen
Germany

Representative: **NLO Shieldmark B.V.**
New Babylon City Offices Anna van Buerenplein 21 A
2595 DA Den Haag
Netherlands

Invoked right: **EU trademark 15102742**



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 1345452**

Seiz

I. FACTS AND PROCEEDINGS

A. Facts

1. On 23 December 2016 the defendant filed an application for a trademark in the Benelux for the wordmark Seiz for goods and services in classes 9, 18 and 35. This application was processed under number 1345452 and was published on 13 January 2017.

2. On 10 March 2017 the opponent filed an opposition against the registration of the application. The



opposition is based on EU trademark 15102742 registration of the combined word/figurative mark , filed on 11 February 2016 and registered on 1 September 2016 for goods and services in classes 1, 3, 5, 9, 10, 21, 35, 36, 37 and 42.

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

4. The opposition is directed against all goods and services of the contested application and is based on all goods and services of the trademark invoked. Upon submission of his arguments, the defendant has limited the list of goods and services of the contested sign and as a consequence, the contested sign is now only applied to the goods mentioned in class 18.

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 14 March 2017. During the administrative phase of the proceedings both parties filed arguments. 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 21 September 2017.

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 goods and services of the trademark invoked are partly identical and partly similar to the goods and services of the contested sign. With regard to the goods mentioned in class 18 of the

contested sign, the opponent states that it is common to use these goods to protect the goods in class 9, or as an accessory.

10. With regard to the comparison of the signs, the opponent argues that his company has a strong reputation in the field of consumer goods, such as cameras, binoculars, lenses, projectors and virtual reality products. Consequently, according to the opponent, the trademark invoked enjoys an enhanced level of distinctiveness.

11. Visually, both signs contain the letters S, E, I and Z. Further, the opponent states that the letters E and I are placed in the same order and that the letters S and Z are visually similar. For this reason, the opponent concludes that the overall visual impression of the signs is similar to a significant degree.

12. The opponent argues that both signs consist of one syllable. Moreover, both signs have the vowels E and I in the same order, in the middle of the sign. The consonants S and Z are phonetically highly similar and in some cases even identical. According to the opponent, the signs are phonetically identical, or at least highly similar.

13. Regarding the conceptual comparison, the opponent argues that neither sign has a fixed meaning for the relevant public. Therefore, a conceptual comparison is not possible.

14. The opponent concludes that there exists a likelihood of confusion and he requests that the Office upholds the opposition and rejects the registration of the contested sign.

B. Defendant's arguments

15. The defendant acknowledges that the contested sign is confusingly similar to the trademark invoked with regard to the goods and services mentioned in classes 9 and 35. Therefore, the defendant limits the goods and services of the contested sign to the goods mentioned in class 18 (see paragraph 4). According to the defendant, these goods are not similar to any of the goods and services of the trademark invoked.

16. For this reason, the defendant concludes that there does not exist any likelihood of confusion and he requests that the Office rejects the opposition.

III. DECISION

A.1 Likelihood of confusion

17. 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.

18. 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."*

19. 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 goods and services

20. 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).

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

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

Opposition based on:	Opposition directed against:
Cl 1 Antifogging agent.	
Cl 3 Cleaning and bleaching agent; cleaning, polishing, scouring and abrasive preparations; soaps; liquid cleaner for optical products.	
Cl 5 Viscoelastic substances for eye surgery and intraocular surgery, pharmaceutical and veterinary products and preparations for health care; preparations and substances for medical and surgical purposes; sodium hyaluronate solution for use in eye surgery; preparations and substances for use in arthritis treatment.	
Cl 9 Scientific, photographic film, optical, weighing, measuring, signal, inspection and regulating apparatus and instruments; apparatus and instruments for conducting, switching, converting, saving, regulating and monitoring electricity; electrical, electro-technical and electronic apparatus and instruments (if included in class 9); devices for recording, transmitting and reproducing sound and images; magnetic recording media, data processing devices and computers; telescopes, binoculars,	

<p>telescopic spectacles, hunting binoculars, hunting riflescopes, opera glasses, riflescopes; eyeglass frames, eyeglass lenses, polarization eyeglasses, snow goggles, contact lenses, magnifiers, magnifying spectacles, protective eye wear, also laser safety goggles; length measuring equipment, center thickness measuring device (dial gauges), coordinate measuring machines, rotary tables, differential height gauges, distance meters, also laser distance meters, angle meters, optical lasers; illumination equipment for microscopes, microscopes, also stereo microscope, discussion bridges for microscopes, rotary stages for microscopes, darkfield equipment for microscopes, interference equipment for microscopes, condensers for microscopes, coobservation devices for microscopes, drawing apparatus for microscopes; aspheric and astronomical instruments; atom absorption devices; autocollimators; diffraction gratings; diffraction optics (if included in class 9); celostats; computer programs, computer software; refractors; electron microscopes; prisms; spectrometers; tachymeters; technoscopes; extinction meters and slides; photometers; stereoscopes; filters for optical devices; fluorometers; gratings for X-ray monochromators; glass scales, glass gauges; planetariums, projectors for planetariums; rotary encoders; interferometers; invertoscopes; polarization and interference filters; polarimeters; crystal components and synthetic crystals for optical lenses; perimeters; colorimeters; laser safety filters, lasers for industrial purposes; meridian circles; spectroscopes; microhardness testers; microscope cameras; monochromators; night sight devices; eyepieces; optical crystals, optical plummets, optical mirrors; orthoprojectors; surface testers; diffraction gratings; reflectors; profilometers; X-ray cameras, X-ray optics (if included in class 9); focimeters; sun guiding tubes, sun simulators; strain testers; spectral lamps; stereopantometers; star sensors, star simulators; space optics (if included in class 9); laser rods; parts of the aforementioned devices.</p>	
<p>Cl 10 Surgical, medical, dental and veterinary apparatus and instruments; surgical and medical lasers, surgical and medical microscopes, ceiling mounts and ceiling tracks for operation microscopes, stands for operation microscopes,</p>	

<p>wallmounts for examination and operation microscopes; interpupillometer, eye mirrors, ophthalmoscopes, slit lamps; instrument tables for ophthalmological equipment, near visual acuity testers, ophthalmometers, vision testing equipment, refractioning units, skiascopes, skiascopy discs, stereophoto equipment for ophthalmological instruments, refractometers, fundus cameras, tonometers, instrument tables, intraocular lenses, biometers for intraocular lenses, retina cameras; ophthalmic workstations, ophthalmological diagnostic equipment, ophthalmological diagnostic sets, ophthalmological illuminators; ophthalmological magnifiers, scleral lamps, ceratometers, colposcopes, coronographs, intraocular lenses, syringes for surgical purposes for procedures in or on the eye, in particular for the injection of viscoelastic substances, special containers and packaging for viscoelastic substances for intraocular surgery, special containers and packaging for syringes for surgical procedures on or in the eye for the injection of viscoelastic substances; phoropters, devices for the destruction of crystalline lenses, parts of the aforesaid goods.</p>	
	<p>Cl 18 Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery.</p>
<p>Cl 21 Cleaning cloths, microfiber cloths</p>	
<p>Cl 35 Advertising; business management; business administration; office functions.</p>	
<p>Cl 36 Insurance; financial affairs; monetary affairs; real estate affairs.</p>	

Cl 37 Building construction, repair, installation services of scientific, photographic film, optical, weighing, measuring, signal, inspection and regulating apparatus and instruments, apparatus and instruments for conducting, switching, converting, saving, regulating and monitoring electricity, electrical, electro-technical and electronic apparatus and instruments (if included in class 9), devices for recording, transmitting and reproducing sound and images, magnetic recording media, data processing devices and computers, telescopes, binoculars, telescopic spectacles, hunting binoculars, hunting riflescopes, opera glasses, riflescopes, eyeglass frames, eyeglass lenses, polarization eyeglasses, snow goggles, contact lenses, magnifiers, magnifying spectacles, protective eye wear, also laser safety goggles, length measuring equipment, center thickness measuring device (dial gauges), coordinate measuring machines, rotary tables, differential height gauges, distance meters, also laser distance meters, angle meters, optical lasers, illumination equipment for microscopes, microscopes, also stereo microscope, discussion bridges for microscopes, rotary stages for microscopes, darkfield equipment for microscopes, interference equipment for microscopes, condensers for microscopes, coobservation devices for microscopes, drawing apparatus for microscopes, aspheric and astronomical instruments, atom absorption devices, autocollimators, diffraction gratings, diffraction optics (if included in class 9), celostats, computer programs, computer software, refractors, electron microscopes, prisms, spectrometers, tachymeters, technoscopes, extinction meters and slides, photometers, stereoscopes, filters for optical devices, fluorometers, gratings for X-ray monochromators, glass scales, glass gauges, planetariums, projectors for planetariums, rotary encoders, interferometers, invertoscopes, polarization and interference filters, polarimeters, crystal components and synthetic crystals for optical lenses, perimeters, colorimeters, laser safety filters, lasers for industrial purposes, meridian circles, spectroscopes, microhardness testers, microscope cameras, monochromators, night sight devices, eyepieces, optical crystals, optical plummets, optical mirrors, orthoprojectors, surface testers,

<p>diffraction gratings, reflectors, profilometers, X-ray cameras, X-ray optics (if included in class 9), focimeters, sun guiding tubes, sun simulators, strain testers, spectral lamps, stereopantometers, star sensors, star simulators, space optics (if included in class 9), laser rods, parts of the aforementioned devices, surgical, medical, dental and veterinary apparatus and instruments, surgical and medical lasers, surgical and medical microscopes, ceiling mounts and ceiling tracks for operation microscopes, stands for operation microscopes, wallmounts for examination and operation microscopes, interpupillometer, eye mirrors, ophthalmoscopes, slit lamps, instrument tables for ophthalmological equipment, near visual acuity testers, ophthalmometers, vision testing equipment, refractioning units, skiascopes, skiascopy discs, stereophoto equipment for ophthalmological instruments, refractometers, fundus cameras, tonometers, instrument tables, intraocular lenses, biometers for intraocular lenses, retina cameras, ophthalmic workstations, ophthalmological diagnostic equipment, ophthalmological diagnostic sets, ophthalmological illuminators, ophthalmological magnifiers, scleral lamps, ceratometers, colposcopes, coronographs, intraocular lenses, syringes for surgical purposes for procedures in or on the eye, in particular for the injection of viscoelastic substances, special containers and packaging for viscoelastic substances for intraocular surgery, special containers and packaging for syringes for surgical procedures on or in the eye for the injection of viscoelastic substances, phoropters, devices for the destruction of crystalline lenses, parts of the aforesaid goods.</p>	
<p>Cl 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.</p>	

23. The contested goods in class 18 are not similar to any of the goods and services of the trademark invoked. Although several contested goods (such as a suitcase) could be used to carry and protect certain items mentioned in the list of goods of the trademark invoked, the mere fact that the goods can be used together does not render them similar. These goods have a different nature, purpose and method of use and they have different producers and distribution channels. Furthermore, they are neither complementary nor in competition. Therefore, they are not similar.

Conclusion

24. The goods of the contested sign are not similar to the goods and services of the trademark invoked.

C. Conclusion

25. Based on the foregoing the Office concludes that there is no likelihood of confusion. For this reason, it is not necessary that the Office conducts a comparison of the signs. After all, there could not exist a likelihood of confusion if the goods and services were not similar, even if the signs were to be found to be identical (see EGC decisions, easyHotel, T-316/07, 22 January 2009 en YOKANA, T-103/06, 13 April 2010).

IV. DECISION

26. The opposition with number 2012898 is rejected.

27. Benelux application with number 1345452 will be registered for all its goods in class 18.

28. The opponent shall pay the defendant 1,030 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is rejected in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 26 June 2018

Eline Schiebroek
(*rapporteur*)

Camille Janssen

Diter Wuytens

Administrative officer: Raphaëlle Gérard