



BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION

N° 2011522

3 July 2017

Opponent: **AMERICAN CAPITAL LTD.**
Two Bethesda Metro Center, 14th floor
20814 Bethesda (MD)
United States of America

Representative: **Gevers**
Holidaystraat 5
1831 Diegem
Belgium

Invoked right : **European registration 4179776**



against

Defendant: **European Capital Partners (Luxembourg) S.A. (Société anonyme)**
Avenue John F. Kennedy 35A
1855 Luxembourg
Luxembourg

Representative: **Office Freylinger S.A.**
route d'Arlon 234
8010 Strassen
Luxembourg

Contested trademark: **Benelux application 1319866**



I. FACTS AND PROCEEDINGS

A. Facts

1. On 27 October 2015 the defendant filed an application for a trademark in the Benelux for the combined

 **European Capital Partners**, for services in classes 35, 36, 41 and 45. This application was processed under number 1319866 and was published on 28 October 2015.

2. On 22 December 2015 the opponent filed an opposition against the registration of the application. The opposition is based on the European registration 4179776 of the combined figurative/word mark



, filed on 6 December 2004 and registered on 1 February 2006 for services in class 36.

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

4. The opposition is directed against all services relating to the contested application and is based on all services of the trademark invoked.

5. The grounds for opposition are those laid down in article 2.14, 1 (a) of 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 24 December 2015. 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 9 November 2016.

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 states that the word element 'EUROPEAN CAPITAL' contained in the trademark invoked is entirely included at the beginning of the contested sign. Furthermore, the opponent argues that the figurative elements do not have a very high impact, because these are simple geometrical shapes. However, the figurative elements also present a strong similarity as both images have a white delimitation in the middle. According to the opponent, the signs are visually highly similar. With regard to aural comparison, the opponent argues that the

identical element 'EUROPEAN CAPITAL' is the main element in both signs and for this reason the aural similarity is very strong. Furthermore, the opponent states that the signs are conceptually almost identical.

10. The opponent states that the services of the trademark invoked are partly identical and partly similar to the services of the contested sign.

11. The opponent concludes that there is a likelihood of confusion and requests that the Office rejects the contested sign and awards the costs to the opponent.

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

B. Defendant's arguments

13. With respect to the proof of use, the defendant states that the documents submitted by the opponent are insufficient to prove use for the relevant services in class 36. According to the defendant, the documents do not show for which services the trademark invoked has been used. Furthermore, the defendant states that some of the documents are internal presentations, which have no probative value.

14. The defendant also argues that the distinctive character of the trademark invoked is derived from its figurative element. According to the defendant, the word element 'EUROPEAN CAPITAL' is devoid of any distinctive character, because it is descriptive for the services in class 36. For this reason, the figurative element is the dominant element of the trademark invoked. With regard to the contested sign, the defendant argues that both the word 'PARTNERS', as well as the figurative element are its dominant elements.

15. According to the defendant, the figurative elements are totally different. The trademark invoked contains an image that consists of three triangles. However, the image of the contested sign consists of two semicircles. For this reason, the defendant argues that if the signs are compared globally, they differ in regard to their dominant elements. The signs are therefore sufficiently dissimilar to avoid any risk of confusion for the consumer.

16. The defendant also states that the services of the opponent are not similar to the services of the contested sign.

17. The defendant concludes that there is no risk of confusion and requests that the Office rejects the opposition and registers the contested sign.

III. DECISION

A. Likelihood of confusion

18. 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.

19. 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.”

20. 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

21. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	
	<p>CI 35 Advertising; business management; business administration; office functions; accounting services; business management assistance; business consultancy; business management and organisation consultancy; professional business consultancy; efficiency experts; business investigations; business enquiries; commercial business estimates; commercial or industrial management assistance; cost price analysis; marketing research and studies; economic forecasting; procurement services for third parties (acquisition of goods and services for others); tax preparation and consultancy relating thereto; accounting; drawing up statements of accounts; book-keeping; invoicing; administrative processing of orders; compilation and systemization of information, and collection of data in master files and in computer databases; computerized file management; data search in computer files for others; compilation, preparation and analysis of business statistics; preparing accounting and</p>

	<p>marketing reports, business reports, commercial reports, economic reports, and writing business project reports, in particular reports about business balances, about financial statements, about business management and about wealth management; business assistance, management and administrative services, including commercial intermediary services, commercial information and advice for customers, in particular in relation with asset management, business acquisitions, business transfers, business auditing, business mergers, business sales, business organization and business restructuring, and business participations; outsourcing (business assistance), in particular financial outsourcing, outsourcing of legal services, outsourcing of payroll services, outsourcing of insurance services; human resource management, in particular personnel selection, personnel placement, employee relocation services and temporary personnel services; strategic business planning, and business advice relating to strategic marketing; data transcription; data processing; database management; computerized data verification; data processing verification; administrative data processing; electronic data processing; advertising services for the promotion of e-commerce; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; providing business information via a website; on-line promotion of computer networks and websites; provision of spaces on websites for advertising financial and banking services and business management services.</p>
<p>CI 36 Financial services; capital investments; provision of venture capital; financial evaluation; financial consultancy; financial information; financial sponsorship; fiscal assessments; fund investments; issue of tokens of value; financial management; loans; securities brokerage; stock exchange quotations; stocks and bonds brokerage; surety services, trusteeships; fiscal valuations.</p>	<p>CI 36 Insurance; financial affairs; monetary affairs; real estate; real estate brokerage; estate agencies; real estate management; stock brokerage, stock exchange quotations; investment funds; financial services relating to wealth management; investment fund management; financial evaluation (insurance, banking, real estate) in the field of asset management and trusteeships; tax estimates in the field of asset management and trusteeships; real estate appraisal; property appraisal; tax expertise in the field of asset management and trusteeships;</p>

	<p>trusteeship services; financial consultancy relating to asset management; financial information relating to asset management; financial advice relating to assignments, mergers, acquisitions of property, transmissions and restructure of corporates; financial information relating to financial transactions; financial consolidation services; financial consolidation services, in particular bill consolidation services and consolidation services in relation with payments made online or by telephone or through websites; financial services and financial support in relation with business management and with strategic business management, in particular monitoring of investment performances, of portfolios' performances and of subsidiaries' performances, bill payment services, also electronic payment rendered online, by telephone or through websites; banking services; electronic banking services; online banking services; online financial transactions; financial services relating to bank and credit/ debit cards; funds transfers; electronic fund transfers; payment services provided via wireless telecommunication apparatus and devices.</p>
	<p>Cl 41 Education; providing of training; entertainment; sporting and cultural activities; providing and conducting formations, workshops and training courses in the field of computers; providing and conducting formations and training courses in the field of finance and banking; non downloadable electronic publications; providing online electronic publications; organization of competitions (education or entertainment); writing and publishing non publicity texts, brochures, magazines and articles, in particular in the field of finance and banking.</p>
	<p>Cl 45 Security services for the protection of property and individuals; legal services; legal advice; legal researches; legal services rendered in the frame of financial services, in the frame of accounting services and in the frame of wealth management and trusteeship; legal mediation services; litigation services, in particular litigation advice and litigation consultancy; arbitration and dispute resolution services, in particular in the</p>

	frame of family conflicts and of personal, financial and wealth management conflicts; mediation, in particular mediation in relation with wills or in legal procedures, in divorces, in wealth and properties management and distribution.
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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 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). 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 and El Charcutero Artesano, T-242/06, 13 December 2007).

25. 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).

26. Both signs are combined verbal/figurative marks. The trademark invoked consists of the words ‘EUROPEAN CAPITAL’, displayed in black letters. On the left of the word elements, the sign contains a black and white figure which is split into three squares, displaying an abstract image similar to a tower top. The contested sign consists of the words ‘EUROPEAN CAPITAL PARTNERS’, also displayed in black letters. On the left of the word elements, the sign contains a grey-coloured image of two semicircles, which are opposite each other and unequally sized.

27. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003). This is the case for the word element EUROPEAN CAPITAL, which both signs have in common. The word ‘capital’ is a general financial term which could indicate wealth in the form of money or other assets, as well as any other valuable resource of a particular kind (<https://en.oxforddictionaries.com/definition/capital>). The word ‘European’ means originating from or in Europe. Therefore, the indication EUROPEAN CAPITAL is descriptive, because it describes characteristics of the financial services mentioned in class 36 of the contested sign.

28. The Office is of the opinion that the public will not perceive the word ‘PARTNERS’ as a distinctive element of the contested sign, because it could refer to a business relationship between different companies.

29. In the light of the descriptiveness of the word elements, the public will attach more importance to the figurative elements, which are clearly different. Although both abstract images consist of geometric shapes, the signs differ in type of shape, composition and number of elements.

Conclusion

30. Taking into account the lack of distinctive character of the word elements regarding the services of the trademark invoked, the Office concludes that the differences between the signs, namely the figurative elements, are sufficient to neutralise the similarities. This means that the signs, considered as a whole, are not similar.

Comparison of the goods

31. As the overall impression of the signs is not similar, the Office will – for procedural reasons – not proceed with the comparison of the services. After all, likelihood of confusion cannot exist if there is no similarity between the signs (see Article 2.3 (b) BCIP, as well as EGC decisions, easyHotel, T-316/07, 22 January 2009 en YOKANA, T-103/06, 13 April 2010).

B. Conclusion

32. Based on the foregoing the Office is of the opinion that there is no likelihood of confusion. For this reason, it is not necessary that the Office conducts a comparison of the services, nor a substantive assessment of the proof of use.

IV. DECISION

33. The opposition with number 2011522 is rejected.

34. Benelux application with number 1319866 will be registered for all services for which it has been applied.

35. The opponent shall pay the defendant 1,000 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 Implementing Regulations, as the opposition is rejected in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 3 July 2017

Eline Schiebroek
(rapporteur)

Saskia Smits

Pieter Veeze

Administrative officer: Paul Vink