

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018104
of 6 April 2023**

Opponent: **COLLISTAR S.p.A.**
Via G.B. Pirelli 19
20124 Milano
Italy

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwendseweg 12
1382 LX Weesp
Netherlands

Invoked right: **European Union trademark registration 410787**

COLLISTAR

against

Defendant: **SCHON INTERNATIONAL KOZMETIK SANAYI VE TICARET ANONM
SIRKETI**
Karamehmet Mah. Avrupa
Serbest Bölgesi
Adnan Arisoy Bulvari 11/B02
Ergene Tekirdag
Turkey

Representative: **MargaretoIP**
Carrer de l'Almirali Cadarso 26
46005 Valencia
Spain

Contested sign: **International application 1653859**

Callista

I. FACTS AND PROCEEDINGS**A. Facts**

1. On 6 September 2021 the defendant filed an International trademark application designating the Benelux for the wordmark Callista for goods in class 3. This application was processed under the number 1653859 and was published on 7 April 2022.
2. On 2 June 2022 the opponent filed an opposition against the registration of the application. The opposition is based on the European Union trademark 410787 of the wordmark COLLISTAR, filed on 11 December 1996 and registered on 25 February 1999 for goods in class 3.
3. According to the register the opponent is the actual holder of the trademark invoked.
4. The opposition is directed against all goods covered by the contested application and is based on all goods covered by the trademarks invoked.
5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 2 June 2022. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 29 November 2022¹.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. The opponent filed an opposition at the Office under article 2.14, (2)(a) BCIP, in accordance with the provisions of article 2.2ter (1)(b) BCIP: the likelihood of confusion based on the identity or similarity of trademark and sign and the identity or similarity of the goods or services concerned.
8. In its arguments opponent also mentions article 2.2ter (1)(a) BCIP (double identity). However, given the wording and arguments used by the opponent, the Office understands that the opponent relies only on article 2.2ter (1)(b) BCIP.

A. Opponent's arguments

9. Opponent argues that the signs are visually clearly very similar. The contested sign is almost fully included in the trademark of opponent. The identical initial letter C, the shared double LL in the middle and the identical element ISTA give a very similar overall impression. Bearing in mind that the average consumer perceives the sign as a whole and does not analyse its various details too deeply, the public is likely to recall the similarities between the marks rather than their differences and therefore is more likely to remember the common element of the marks.

¹ The letter from the Office is wrongly dated 29 September 2022.

10. The signs are highly similar on the basis of a phonetic comparison. Both signs are pronounced very similar as they have the same rhythm (three vowels in the same place (O-I-A and A-I-A) preceded by the identical letter C) as well as the same sound. If the contested sign is pronounced in English, the element CALL will then be spoken out loud as COLL, in which case the contested sign is fully included in the trademark invoked. The last letter R of the trademark invoked is a rather 'silent consonant' which is not spoken out very explicitly, which gives the marks an even higher degree of similarity (COLLISTAR vs. CALLISTA).

11. A conceptual comparison is not possible since neither of the signs have any meaning or known definition and both signs can be considered distinctive marks.

12. The goods involved are nearly all identical and obviously similar.

13. Opponent argues that its trademark and company COLLISTAR is actively used since 1983 and is worldwide recognized for their business as a leading "beauty brand" for cosmetics, toiletries, make-up products and such. Opponent heavily invested in its trademark which has led to the reputation and brand awareness which COLLISTAR enjoys today in 45 countries, amongst which the Benelux market. This above-average degree of recognition (or even enhanced distinctiveness) of opponent's mark must be taken into account when assessing the likelihood of confusion.

14. Given the above the opponent submits that there is a clear likelihood of confusion between the signs and the contested sign should be rejected. The opponent furthermore requests that an award of all costs is made in its favour based on article 2.16 (5) BCIP.

B. Defendant's arguments

15. Defendant notes that there is no likelihood of confusion between the contested sign and the trademark invoked. From a conceptual point of view the signs do not share any resemblance or related connotation. The contested sign Callista has different meanings. Firstly, Callista is a person name for females and used by famous people (Callista Roy, Callista Clark, Callista Kay Flockhart). Secondly, it is the name of a flower specie. In the trademark invoked the consumers will identify the term STAR, which has an obvious meaning. Therefore, from a conceptual point of view there is no risk of confusion.

16. Visually and aurally the perception of the consumers is completely different. The number of letters is significantly different. The impact of the different beginnings, CA vs. CO, will create a completely different impression since the A and O are visually and phonetically different. The ending, A vs. AR, also makes a difference and is important to highlight. Consequently, from the conceptual, visual and phonetic point of view, the signs at stake cannot be regarded as similar.

17. The fact that the goods at stake are identical/similar is not a sufficient ground to uphold the opposition.

18. Defendant also notes that trademarks with a high degree of distinctiveness, enjoy a higher level of protection and that the applied application enjoys a high degree of distinctiveness.

19. According to defendant the signs at stake are dissimilar and therefore article 2.2ter (1) (b) BCIP is not applicable.

20. Defendant requests the Office to reject the opposition and continue with the registration of the contested sign. Defendant also requests to set the costs of the opposition to the opponent.

III. DECISION

A Likelihood of confusion

21. In accordance with article 2.14 BCIP, the 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 2.2ter BCIP.

22. Article 2.2ter (1) BCIP stipulates insofar as relevant that, *"A trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*²

23. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.³

24. According to settled case-law of the European Court of Justice (hereinafter: CJEU), the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.⁴

Comparison of the signs

25. To assess the degree of similarity between the conflicting signs, their visual, phonetic and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.⁵

26. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.⁶ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.⁷

² Art. 2.2ter (1)(b) BTIP implements art. 5 (1)(b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in art. 8 (1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

³ CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 and the case-law mentioned there (Equivalenza).

⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

⁶ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

⁷ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

27. The assessment of the similarity between the signs, regarding the visual, phonetic and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, inter alia, their distinctive and dominant components.

28. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
COLLISTAR	Callista

Visual and phonetic comparison

29. Given that the trademark and the sign applied for are wordmarks, the fact that the former is represented in capital letters, whereas the latter is represented in a capital letter and lower-case letters, is irrelevant for the purposes of a visual comparison of those marks. The protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics which that mark might possess.⁸

30. The trademark invoked consists of one word with nine letters, COLLISTAR. The contested sign consists of one word with eight letters, Callista. Seven letters match and are placed in the same order: C*LLISTA*. The signs differ in the second letter (O versus A) and in their respective endings (AR versus A).

31. Both signs consist of three syllables: COL-LI-STAR versus CAL-LIS-TA. The pronunciation of the signs matches in length and rhythm. However, the pronunciation of the last two syllables is different.

32. Considering the above, the Office finds the signs visually highly similar and phonetically similar.

Conceptual comparison

33. In the Office's view the relevant Benelux public will not perceive the trademark invoked, COLLISTAR, as referring to a 'star', as argued by defendant (see above under 15). This because 'star' will not be perceived as a separate word element in the trademark invoked. Based on the overall impression, the Benelux public will perceive the trademark invoked as a fantasy word and not assign any meaning to it.

34. According to the Office the relevant Benelux public will also not convey any specific meaning to the contested sign Callista. The Office is not convinced that the relevant public will recognize the contested sign as a person name and/or a flower specie, as argued by defendant (see above under 15). Defendant also did not substantiate this. The Office furthermore recalls that a name has no specific meaning. This is different only if the name in question has become a conceptual symbol, for example due to the familiarity of the character bearing that name, or if the name in question has a clear and immediately recognizable semantic content.⁹

⁸ General Court (EU) 31 January 2013, T-66/11, ECLI:EU:T:2013:48, point 57 (Badibu).

⁹ General Court (EU) 27 juni 2019, T-268/18, ECLI:EU:T:2019:452, points 85-90 (Luciano Sandrone) and 18 June 2021, T-386/20, ECLI:EU:T:2021:372, point 54 (Miley Cyrus).

35. Given the above the Office is of the opinion that a conceptual comparison is not possible

Conclusion

36. The signs are visually highly similar and phonetically similar. A conceptual comparison is not possible.

Comparison of the goods and services

37. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. 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.¹⁰

38. In comparing the goods and services, the goods and services shall be considered in the terms set out in the register, and not the actual or intended use.¹¹

39. The goods 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; Cotton sticks for cosmetic purposes; Cotton wool for cosmetic purposes; Eyelashes (False -); False nails; Shampoo; Toiletries; Adhesives for cosmetic purposes; Pumice stone; Bath salts, not for medical purposes.	Class 3 Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils; soaps; hair lotions; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations.

40. Opponent and defendant agree that the goods are identical/similar (see above under 12 and 17), but are unclear as to whether there is identity or similarity. The Office finds that the goods in question are identical.

41. The goods "*perfumery, essential oils; soaps; hair lotions; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations*" of the contested sign occur *expressis verbis* in the list of the trademark invoked and are therefore identical.

42. The goods "*Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices*" of the contested sign fall within the broader category of "*cosmetics*", "*Toiletries*" and "*Dentifrices*" for which the trademark invoked is registered. These goods are thus also considered to be identical.¹²

¹⁰ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹¹ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

¹² General Court (EU) 2 February 2022, T-694/20, ECLI:EU:T:2022:45, point 31 and the case-law mentioned there (Labello).

Conclusion

43. The goods concerned are identical.

Global assessment

44. The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.¹³ In the present case, the goods concerned are aimed at the public at large for which the level of attention is deemed to be normal.

45. The greater the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.¹⁴ In the present case the invoked trademark has to be considered as having normal distinctiveness for the goods concerned as it does not describe the characteristics of the goods in question. Opponent has argued that the trademark relied upon is well known and has enhanced distinctiveness (see above under 13), but has not demonstrated this. Therefore, the Office cannot take this into account.

46. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be taken into account and, in particular, between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.¹⁵

47. In this case the signs are visually highly similar and phonetically similar. The relevant goods are identical. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that there is a likelihood of confusion in the sense that the public may believe that the goods designated by the trademark relied on and those to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically linked.

Other factors

48. Defendant notes that the contested sign enjoys a high degree of distinctiveness (see above under 18). However, since it is established that the contested sign is younger than the trademark invoked, the defendant cannot rely on the high degree of distinctiveness (or reputation) of the contested sign for its claim that there is no likelihood of confusion.¹⁶

B. Conclusion

49. Based on the foregoing, the Office concludes that there is a likelihood of confusion.

¹³ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there (Equivalenza).

¹⁶ CJEU 3 September 2009, C-498/07 P, ECLI:EU:C:2009:503, point 84 (La Espanola).

IV. DECISION

50. The opposition with number 2018104 is justified.

51. The International application with number 1653859 will not be granted protection in the Benelux.

52. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16 (5) BCIP in conjunction with rule 1.28, 3 IR, as the opposition is justified. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.



The Hague, 6 April 2023

Marjolein Bronneman
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Pieter Veeze

Camille Janssen

Administrative officer: Vincent Munier