



BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2011511
of 4 January 2017

Opponent: **blue office consulting AG**
Turbistrasse 10
Blocco 97
6280 Hochdorf
Switzerland

Representative: **deJuristen B.V.**
Johan Huizingalaan 763A D36
1066 VH Amsterdam
The Netherlands

Invoked right: **European registration 10691541**

blue office 

against

Defendant: **CKL Holdings N.V.**
Kaasrui 12
2000 Antwerp
Belgium

Contested trademark: **Benelux application 1319687**

Blue

I. FACTS AND PROCEEDINGS

A. Facts

1. On 26 October 2015 the defendant filed an application for a trademark in the Benelux for the word mark "Blue" for goods and services in classes 9, 36 and 38. This application was processed under number 1319687 and was published on 26 October 2015.

2. On 18 December 2015 the opponent filed an opposition against the registration of the application. The opposition is based on European registration 10691541 of the following combined word/figurative mark filed on 2 March 2012 and registered on 22 June 2012 for goods and services in classes 9 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 in class 9 of the contested application and is based on all of the goods and services of the trademark invoked.

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. Chronological order of the proceedings

7. The opposition is admissible and was notified to the parties on 28 December 2015. 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 was completed on 1 July 2016.

II. ARGUMENTS

8. The opponent filed an opposition at the Benelux Office for Intellectual Property (hereinafter: "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. Arguments of the opponent

9. The opponent considers that the contested sign identically repeats the dominant word element of the trademark invoked. Although the additional word element and the graphic element do not appear in the contested sign the element "blue" functions nonetheless as the independent distinctive element within both signs. This is especially the case now that the word "office" is purely descriptive for the goods software and that the graphic

element remains in the background of the earlier trademark. Therefore the opponent is of the opinion that there is a high degree of visual similarity between the two signs. From an aural perspective the first word element is identical for both signs and thus a high degree of aural similarity exists between the two signs.

10. The opponent argues that the public will presumably be confused by the identical use of the distinctive element "blue" due to the high visual and aural similarity and since the goods and services concerned are identical. Since the word "blue" is a catchword for the opponent's software company, blue office A.G., the sign is generally understood to be the main signifier for this specific company. The public will therefore easily assume an economic link between the parties if the defendant uses the catchphrase "blue" as a trademark for software too. The present case concerns goods and services that aim to meet a technological need of professional parties. The level of attention of the relevant public may therefore be deemed normal.

11. Based on the above, the opponent finds that there is a clear likelihood of confusion if the signs should be used together. He therefore requests that the Office grants the opposition and that the contested sign is not registered. Furthermore he also requests that the Office orders the defendant to pay the costs of these proceedings.

B. Arguments of the defendant

12. The defendant states that the goods of the defendant are highly dissimilar to the goods and services of the opponent. As to the comparison of the signs, the defendant finds that visually the signs at issue differ significantly. The design, font and colours used in the earlier trademark make the trademark highly stylized overall. Further only four of the ten letters are the same and the structure of the signs differs in that the earlier trademark consists of three separate and distinct elements. The design is particularly unique and unusual. It is not merely a commonplace or banal element and, as such it immediately draws the attention of the consumer and will remain in their memory. Even if the clear stylization of the earlier trademark was to be ignored, with only the words being compared, the signs would still remain dissimilar, according to the defendant. The contested sign is a one-word trademark of four letters, whereas the earlier trademark is a two-word trademark of ten letters. These differences in themselves are sufficient to differentiate the signs visually. Aurally the number of syllables and the rhythm of the signs differ significantly. Therefore there is no possibility that the signs could be found aurally similar. Conceptually, the defendant finds that the signs are totally different in their nature. The contested sign will be understood as the colour blue. In contrast, the earlier trademark will evoke images of an office which is of the colour blue, rather than simply the colour itself, as is the case for the contested sign.

13. The defendant concludes that the signs are not similar. No likelihood of confusion can be found between the signs, as the vast differences in the goods and services offered offset any potential similarities between the signs at hand. Even if the Office were to conclude that there are similarities between the goods offered, the dissimilarities between the signs themselves are such that the requirement of a likelihood of confusion under article 2.3 BCIP cannot be met. Therefore the defendant requests that the Office rejects the opposition in its entirety as unfounded, registers the contested sign and orders the opponent to pay the costs of these proceedings.

III. DECISION

A.1 Likelihood of confusion

14. 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.

15. 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.”*

16. 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 goods and services

17. 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).

18. In the comparison of the goods and services 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.

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

Opposition based on:	Opposition directed against:
CI 9 Computer software (recorded).	CI 9 Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts.
CI 42 Computer programming and Computer programming; Renting out hardware and software; Computer software technical support services;	

Software design and software development; Software installation; Creation, maintenance and adaptation of software; Development of software solutions for Internet providers and Internet users; Design and development of computer hardware, software and databases.	
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20. The goods “*computer software*” are mentioned in both lists and are thus identical.

21. The goods “*computer hardware; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts*” of the defendant are similar to the goods “*computer software (recorded)*” of the opponent. All of the defendant’s goods concern physical equipment and components that constitute a computer or are intended to be operated in conjunction with one. The opponent’s computer software is that part of a computer system that consists of encoded information or computer instructions.¹ The defendant’s goods are directed by software to execute a command or instruction. A combination of the goods of the defendant and the opponent can form a usable computing system.² The goods of the defendant thus require the goods of the opponent and vice versa as they cannot be used on their own. They share the same manufacturers, the same distribution channels and target the same public. Therefore, they are deemed to be similar. Besides, the goods of the defendant can also be considered as similar to the “*design and development of computer hardware*” in class 42 of the opponent.

Conclusion

22. The goods at issue are identical or similar.

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).


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). 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).

¹ <https://en.wikipedia.org/wiki/Software>.

² https://en.wikipedia.org/wiki/Computer_hardware.

26. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	<p style="text-align: center;">Blue</p>

Visual comparison

27. The right invoked is a combined word/figurative mark. It depicts two words “blue” and “office”, consisting respectively of four and six letters, in bold blue letters. These two words are followed by an abstract figurative element in the same blue colour as the two preceding words. The contested sign is a verbal mark, consisting of a single word of four letters, “Blue”.

28. Where a sign consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trademark (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). The Office finds that, although the figurative element at the end of the right invoked will not be overlooked (see Gerechtshof’s Gravenhage, MOOVE-4MOVE, 200.105.827/0, 11 September 2012), it is rather abstract and liable to various interpretations so that it is unlikely to be the dominant element of the sign in the minds of the relevant public. In any event, the verbal element “blue office” is clearly perceptible, it constitutes a significant part of the sign as compared to the figurative element and will therefore catch the eye at least as much as the latter.

29. 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). In this case the first word of the right invoked “blue” is identical to the contested sign and thus the contested sign is contained fully in the right invoked. The signs differ because of the addition of the word “office” and a figurative element in the right invoked.

30. Visually the signs are similar to a certain degree.

Aural comparison

31. In the strict sense, the aural reproduction of a complex sign corresponds to that of all of its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level (EGC, PC WORKS, T-352/02, 25 May 2005 and Thai Silk, T-361/08, 21 April 2010).

32. The right invoked consists of three syllables and will be pronounced as BLUE OF-FICE. The contested sign consists of one syllable and will be pronounced as BLUE. Aurally, the consumer normally also attaches more importance to the first part of a sign (EGC, Mundicor, already cited). The pronunciation of the signs coincides in the sound of the word “blue”, present identically at the beginning of both signs, and to that extent the signs are aurally similar. The pronunciation differs in the sound of the word “office” in the right invoked, which has no counterpart in the contested sign.

33. Aurally the signs are similar to a certain degree.

Conceptual comparison

34. The right invoked “blue office” consists of two English words. “blue” refers to the colour blue. The word “office” refers to a room, a set of rooms, or a building used as a place of business for work. As a whole the right invoked can be perceived as a blue place of business for work. The contested sign will be understood as the English word for the colour blue. The Office considers that the Benelux public has sufficient knowledge of the English language to understand the meaning of these basic words.

35. As the element “office” does not appear in the contested sign, it is considered that the element “blue”, which both signs have in common, refers to the same concept and therefore the signs are conceptually similar to a certain degree.

36. Conceptually the signs are similar to a certain degree.

Conclusion

37. The right invoked and the contested sign are visually, aurally and conceptually similar to a certain degree.

A.2 Global assessment

38. 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.

39. 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 goods at issue are intended for the public at large with an average level of attention.

40. 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).

41. 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 but must place his trust in the imperfect picture of them that he has kept in his mind.

42. 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.

43. Based on the circumstances mentioned above, the Office finds, given the interdependence between the identity and similarity of the goods and the certain visual, aural and conceptual similarity of the signs, that the relevant public might believe that the goods in question originate from the same undertaking or from economically-linked undertakings.

B. Conclusion

44. Based on the foregoing the Office concludes that there exists a likelihood of confusion.

IV. DECISION

45. The opposition with number 2011511 is justified.

46. Benelux application with number 1319687 will not be registered for all of the goods in class 9.

47. Benelux application with number 1319687 will be registered for the services against which the opposition was not directed, being the services in classes 36 and 38.

48. The defendant shall pay the opponent 1,000 euros in accordance with article 2.16 (5) BCIP in conjunction with rule 1.32 (3) IR, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.

The Hague, 4 January 2017

Tineke Van Hoey
(*rapporteur*)

Saskia Smits

Pieter Veeze

Administrative officer: Jeanette Scheerhoorn