



**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2011861**  
**of 27 February 2017**

**Opponent:** **TOTAL SA**  
2, Place Jean Millier, La Défense 6  
92400 Courbevoie  
France

**Representative:** **WIPLAW SPRL**  
Avenue Louise 523  
1050 Bruxelles  
Belgium

**Invoked right:** **European registration 9208638**

GENERA

*against*

**Defendant:** **Ralco Nutrition, Inc., Minnesota Corporation**  
1600 Hahn Road  
Marshall MN 56528  
United States of America

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

**Contested trademark:** **Benelux application 1328049**

GENERATE

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

1. On 4 March 2016 the defendant filed an application for a trademark in the Benelux for the word mark GENERATE for goods in class 1. This application was processed under number 1328049 and was published on 9 March 2016.

2. On 12 April 2016 the opponent filed an opposition against the registration of the application. The opposition is based on European registration 9208638 of the word mark GENERA, filed on 29 June 2010 and registered on 29 November 2012 for goods in classes 1 and 5.

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

4. The opposition is directed against all goods of the contested application and is based on all goods 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. 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 April 2016. 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 7 October 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 he is the world's fourth largest oil and gas company and second-largest solar energy operator, who operates worldwide in more than 130 countries, including those of Benelux. The company engages in all aspects of petroleum industry, including upstream and downstream operations and also produces petrochemicals and speciality chemicals for the industrial, agricultural and consumer markets. As such, the opponent has been supplying paraffin oils for crop protection for 30 years.

10. With regard to the comparison of the goods, the opponent states that the goods are partly identical and partly similar. Insofar as they are not identical, the goods belong to the same agrochemical and biotechnical industry and share the same purpose, distribution channels and points of sales.

11. The opponent argues that the right invoked is entirely reproduced in the contested sign. The contested sign differs only regarding its ending: -TE. Therefore the opponent is of the opinion that the signs are strongly similar on a visual level.

12. The contested sign is also strongly similar from an aural point of view. The first three syllables of the contested sign are identical to the three syllables of the right invoked. Only the fourth and last syllable differs, but it consists of a very short sound, according to the opponent.

13. Conceptually, both signs originate from the same Latin root "generare", meaning in English "to produce", "to generate" and therefore evoke equally the idea of agricultural production. The opponent concludes therefore that the signs are conceptually identical.

14. The opponent is of the opinion that there exists a high risk of confusion and he requests that the Office refuses the contested sign and orders the defendant to bear the costs of these proceedings.

#### **B. Defendant's arguments**

15. With regard to the comparison of the signs, the defendant argues that the signs are visually not similar. The first element of both the right invoked and the contested sign is GENE, which is a commonly used element to refer to "generic products". Furthermore, both signs differ in length, six versus eight letters, and in syllables, three versus four. Consequently, the defendant holds the signs not similar from a visual point of view.

16. Because of the aforementioned difference in length and syllables, the defendant is also of the opinion that the sign are not similar from a phonetic point of view. The last syllable is different, namely -RA versus -TE and the defendant finds that the right invoked has a French or Spanish "feeling" over it, while the contested sign is clearly an English word. Therefore, the signs are phonetically not similar.

17. As regards the conceptual comparison, the defendant states that the contested sign will be understood by the relevant public in the Benelux as an English word meaning "cause (something) to arise or come about" or "to produce or bring into being, create". The right invoked has no meaning in the languages of the relevant territory and will therefore be perceived as a creative word. Contrary to what the opponent says, the defendant is of the opinion that the average Benelux consumer would not be aware of the "same Latin root" of the word "generare". The signs do not share any conceptual similarity, according to the defendant.

18. The relevant goods are specialized goods aimed at a more professional public. The awareness of the professional public will be high, according to the defendant, who also stresses that opponent and defendant operate in very different markets. They have very different distributional channels and the purpose of the products is very different.

19. The defendant concludes that both signs are not similar and he requests that the Office rejects the opposition and orders the opponent to bear the cost of these proceedings.

### III. DECISION

#### A.1 Likelihood of confusion

20. 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.

21. 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.”*

22. According to case law of the Court of Justice of the European Union (hereinafter: “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**

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 signs to be compared are the following:

Opposition based on:	Opposition directed against:
GENERA	GENERATE

*Visual comparison*

26. Both signs are purely verbal marks and consist of one word. The trademark invoked consists of the six letter word GENERA and the contested sign consists of the eight letter word GENERATE.

27. According to consistent case-law 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). Both signs contain six identical letters which are also placed in the same order. The only difference being the two last added letters of the contested sign, namely –TE. The Office considers that these small differences are insufficient to evoke a different global visual impression.

28. The Office is of the opinion that the trademark invoked and the contested sign are visually highly similar.

#### *Aural comparison*

29. Aurally the right invoked is pronounced in three syllables, GE-NE-RA. The contested sign is pronounced in four syllables, GE-NE-RA-TE. The second, clearly being an English word, would be pronounced as [dʒɛnəret], the former could be pronounced as [dʒɛnərə], as [ʎe:nɛra:] or [ʒɛnɛra:].

30. The Office considers, in line with the visual comparison, that the limited aural difference is insufficient to evoke a different global aural impression, especially because the similarity occurs in the first part of the signs (Mundicor, already cited). Although the right invoked could be pronounced differently within the Benelux territory, the Office is of the opinion that even considering that fact, there exists an aural similarity between the right invoked and the contested sign.

31. The Office holds the signs to be aurally similar.

#### *Conceptual comparison*

32. The trademark invoked is the plural form of the noun genus, which means “a principal taxonomic category that ranks above species and below family” or “a class of things which have common characteristics and which can be divided into subordinate kinds”.<sup>1</sup> The contested sign is an English noun which means “(to) produce, create or bring into existence”.<sup>2</sup> Even though both words have a different meaning in the strict sense, the Office is of the opinion that the relevant public will not be aware of that, because of the fact that the meaning of the word GENERA is not understood by the Benelux consumer. Given the strong syntactic similarity between both words the Office does not rule out that this resemblance will be noticed by the Benelux consumer.

33. In the light of the foregoing, the Office is of the opinion that the conceptual meaning of the contested sign is insufficient to neutralize the strong visual similarity and aural similarity.

#### *Conclusion*

34. The right invoked and the contested sign are visually strongly similar and aurally similar. The conceptual meaning of the contested sign does not suffice to neutralize the similarities between the signs.

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<sup>1</sup> <https://en.oxforddictionaries.com/definition/genera>.

<sup>2</sup> <https://en.oxforddictionaries.com/definition/generate> and <https://www.merriam-webster.com/dictionary/generate>.

**Comparison of the goods and services**

35. 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).

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

37. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Cl 1 Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; solvents, adjuvants and additives for herbicides, insecticides and fungicides.	Cl 1 Plant growth nutrients.
Cl 5 Preparations for destroying vermin; fungicides, herbicides and insecticides.	

38. The goods "*plant growth nutrients*" of the contested sign are a species of the genus "*chemicals used in agriculture, horticulture and forestry*" and are therefore considered to be identical goods.

39. Additionally, the Office stipulates that the goods of the contested sign and the goods "*preparations for destroying vermin; fungicides, herbicides and insecticides*" of the right invoked are generally sold at the same points of sales, such as garden centers and flower shops. Thus, the Office finds that these goods are similar because they serve the same purpose, namely supporting the growth of plants, including eliminating factors which could be detrimental to this growth. Both are made available to the same consumer by the same distribution channels.

**Conclusion**

40. The goods of the contested sign are identical to the goods of the right invoked.

**A.2 Global assessment**

41. 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.

42. 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 according to the category of goods or services in question. The relevant goods are aimed at both the professional and the general public. Therefore the lowest level of attention must be taken into account. The general public is deemed to have a normal level of attention.

43. 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).

44. 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 distinctiveness, as it does not describe the relevant goods.

45. 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.

46. Based on the abovementioned circumstances, the Office finds that, given the interdependence between the identical goods and the (high) visual and aural similarity of the signs, the relevant public might be led to believe that the goods in question originate from the same undertaking or from economically-linked undertakings.

#### **B. Other factors**

47. The defendant is of the opinion that “the opponent and the defendant operate in very different markets. They have very different distributional channels and the purpose of the products is very different” (see paragraph 18). The Office would like to point out that the opposition procedure leaves no room for considerations concerning the actual use of the signs. The comparison of the signs is solely based on the goods as mentioned in the registration (see to that effect: CJEU, Quantum, C-171/06, 15 March 2007, O2 Holdings Limited, C-533/06, 12 June 2008 and EGC, Ferromix e.a., T-305/06-T-307/06, 15 October 2008).

#### **C. Conclusion**

48. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

#### **IV. DECISION**

49. The opposition with number 2011861 is justified.

50. Benelux application with number 1328049 will not be registered.

51. The defendant shall pay the opponent 1,000 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, 27 February 2017

Tomas Westenbroek  
(rapporteur)

Diter Wuytens

Pieter Veeze

Administrative officer: Jeanette Scheerhoorn