



**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**

**OPPOSITION DECISION**

**N° 2012560**

**of 30 July 2018**

**Opponent:** **Yello Strom GmbH**  
Siegburger Straße (Torhaus) 229  
50679 Köln  
Germany

**Representative:** **Arnold + Siedsma (Amsterdam)**  
Postbus 71720  
1008 DE Amsterdam  
The Netherlands

**Invoked right 1:** **EU trademark 6404057**

yello

**Invoked right 2:** **EU trademark 2782944**

yello

*against*

**Defendant:** **Technolution BV**  
Burgemeester Jamessingel 1  
2803 WV Gouda  
The Netherlands

**Contested trademark:** **Benelux application 1340100**

JelloPrime

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 28 September 2016 the defendant filed an application for a trademark in the Benelux for the word mark 'JelloPrime' for goods and services in classes 9, 38 and 42. This application was processed under number 1340100 and was published on 12 October 2016.

2. On 8 December 2016 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- EU trademark 6404057 of the word mark 'yello' filed on 23 June 1999 and registered on 6 November 2012 for goods and services in classes 7, 9, 12, 16, 28, 35, 36, 37, 38, 39, 41 and 42;
- EU trademark 2782944 'yello' filed on 19 July 2002 and registered on 16 November 2012 for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 15, 16, 17, 18, 22, 23, 24, 26, 27, 28, 29, 30, 31, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.

3. According to the register the opponent is the actual holder of the trademarks 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 trademarks 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 9 December 2016. 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"). In addition, the proceedings were suspended once at the request of the parties. The administrative phase was completed on 3 October 2017.

## **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. First of all, the opponent states that the dominant element for the rights invoked is 'yello'. For the contested sign it is the element 'Jello' as it appears first and is emphasized by the fact that the letters J and P are capitalized and therefore separating the elements 'Jello' and 'Prime'. Furthermore 'Prime' is a laudatory term which lacks distinctive character, according to the opponent. Hence a comparison of the signs should be made in particular between 'Yello' and 'Jello'.

10. Visually, the contested sign and the right invoked are almost identical. The only difference is the first letter, Y vs J. Therefore, the signs are highly similar. Aurally, both the signs will be pronounced identically. Conceptually, the right invoked and the contested sign do not have a meaning in any languages spoken in the Benelux. However the opponent points out that it cannot be precluded that some consumers will believe that YELLO and Jello refer to the colour 'yellow'. In this case the prior mark and the contested sign are identical from a conceptual point of view. The opponent remarks that there is no link between the colour yellow and the related goods and services.

11. As for the comparison of the goods and services, the opponent is of the opinion that the contested goods and services of the defendant are either identical or similar to the prior goods and services of the opponent.

12. The opponent also refers to several prior cases in which he successfully invoked its 'yello' registrations in opposition proceedings before the Office.

13. Based on the foregoing, the opponent concludes that there clearly exists a likelihood of confusion. Therefore, he requests that the Office upholds the opposition and that the contested sign will not be registered.

**B. Arguments of the defendant**

14. The defendant states that 'Prime' is the dominant element of the contested sign as it is a noun to which the attention will be drawn. This is moreover only enhanced by the use of a capital letter P. The defendant continues that it is also inaccurate to separate the first element from the second and therefore it is logical to judge the sign 'JelloPrime' as a whole.

15. Visually, 'JelloPrime' is not identical to 'yello' as the distinctive and dominant part of the contested sign is 'Prime'.

16. Aurally, the signs will not be pronounced in the same way. The defendant explains that the contested sign contains two English words: 'jelly' and 'prime'. 'Jelly' means 'solidified'. 'Prime' means 'central point or hub' and is deducted from 'prime number' which is an important element of the encryption technology. In the English language, the letter 'j' is pronounced as 'dzj' as in the word 'jellyfish'. The word 'yello' will be pronounced as in the word 'yellow', so as in 'j'.

17. According to the defendant, 'JelloPrime' has a clear link with the product from a conceptual perspective. The contested sign means 'agglomerated hub'. He denies that a relation with the colour yellow is present as 'jello' is written with a 'j' and not with a 'y'. Consumers will connect 'jello' with coagulation due to the fact that the word 'jello' reminds them of 'jelly'. As the opponent indicated that his consumers will associate 'yello' with the colour yellow, the defendant holds that there is no conceptual similarity between the signs.

18. Furthermore, the goods and services of the defendant are not identical, nor similar to the goods and services of the opponent.

19. The defendant also points out that the Office's case law that was mentioned by the opponent is not relevant as the contested signs in all of these cases are written with a 'Y' which is not the case for 'JelloPrime'.

20. Based on the foregoing, the defendant concludes that the opposition should be rejected. Besides, the defendant also makes some last remarks. First of all, he states that the danger of confusion is not applicable at all as the defendant targets the B2B-market with a focus on IT-managers, whereas the opponent targets the consumer and B2B-market with a focus on procurement managers. Furthermore, the defendant also observes that the opponent will have to start using the 'yello' brands in only two months. As the opponent is now only using the rights invoked in Germany, the defendant is of the opinion that the opponent no longer has an interest in filing this opposition. Finally, the defendant also states that the parties already tried to reach a settlement in this case, however these negotiations did not come to a conclusion.

### **III. DECISION**

#### **A.1 Likelihood of confusion**

21. 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.

22. 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."*

23. According to case law of the Court of Justice of the European Union 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; Brussels, N-20060227-1, 27 February 2006).

**Comparison of the signs**

24. 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, ECLI:EU:C:1997:528).

25. 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).

26. As the rights invoked are identical, they will only be mentioned once below and they will be referred to together as ‘the right invoked’. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
yello	JelloPrime

*Visual comparison*

27. The right invoked is a word mark, consisting of one word of five letters: ‘yello’. The contested sign is also a word mark, consisting of one word of ten letters, ‘JelloPrime’. The trademark invoked is displayed in small letters. The contested sign is also displayed in small letters except for the first and sixth letter. The difference between the signs with regard to the use of capital letters or lower case letters is however not relevant for the visual comparison between two word marks (reference is made to EGC case, *Babilu*, T-66/11, 31 January 2013, ECLI:EU:T:2013:48).

28. The right invoked is almost completely present in the contested sign. Apart from the first letter, all other four letters ELLO appear identically in the same position in the contested sign. The signs differ in their first letter, as well as in the addition of the letters ‘Prime’ at the end of the contested sign. With regard to the different first letter of the signs, respectively ‘Y’ in the right invoked and ‘J’ in the contested sign, it should be noted however that these letters visually look alike as they both show a descending line with a slight curl on the end.

29. The consumer normally attaches more value to the first part of a sign (EGC, *Mundicor*, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). The first letter is written similarly. The second to fifth letters are identical.

30. The Office finds that the signs are visually similar to a certain degree.

*Aural comparison*

31. The right invoked consists of one word that is pronounced in two syllables: YEL-LO. The contested sign consists of one word of three syllables: JEL-LO-PRIME, as the E at the end of the sign will not be pronounced.

32. As already mentioned, consumers generally take more note of the beginning of a sign than of its end (Mundicor, already cited). Aurally the first two syllables of the signs will be pronounced identically. At least part of the relevant public will not be familiar with the correct English pronunciation rules and will therefore pronounce the letters 'y' and 'j' identically, contrary to what the defendant asserts (see point 16). The signs differ because of the addition of the third syllable in the contested sign.

33. For this reason, the Office concludes that the signs are aurally similar.

#### *Conceptual comparison*

34. The right invoked has no precise meaning in one of the languages of the Benelux. However, the relevant public could perceive a reference to the English word for the colour yellow in the sign.

35. As for the contested sign, part of the public might recognize the element 'Prime' as an English adjective indicating that something is important or that it is of the best possible quality<sup>1</sup> and the element Jello as a reference to the English word for the colour yellow. However, the Office finds that the majority of the Benelux public will not attribute a particular meaning to the contested sign as a whole.

36. At least for a part of the public there might be a certain degree of conceptual similarity between the signs as they both could be perceived as containing a reference to the colour yellow.

37. Therefore, conceptually the signs are similar to a certain degree or a conceptual comparison is not relevant here.

#### *Conclusion*

38. The right invoked and the contested sign are visually similar to a certain degree and aurally similar. Conceptually the signs are similar to a certain degree or a conceptual comparison is not relevant.

#### ***Comparison of the goods and services***

39. 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).

40. In the comparison of the goods and services of the trademarks 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.

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<sup>1</sup> <https://www.collinsdictionary.com/dictionary/english/prime>.

41. The goods and services 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; unprocessed artificial resins, unprocessed plastics; fertilizers; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry. <i>(EU trademark 2782944)</i>	
Cl 2 Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists. <i>(EU trademark 2782944)</i>	
Cl 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices. <i>(EU trademark 2782944)</i>	
Cl 4 Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting. <i>(EU trademark 2782944)</i>	
Cl 5 Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. <i>(EU trademark 2782944)</i>	
Cl 6 Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; metallic pipes and tubes; mechanical home security products, in particular window handles with additional locks, hinge-side security devices for windows, additional box locks, reinforced bolt locks, door chains, security fittings, security rosettes, security strike plates, automatic locks, mortise locks, protective plates for doors and windows, security devices for lift gates, mechanical anti-burglar locks, mechanical security devices for roller	

<p>shutters, mechanical security devices for cellar shafts, mechanical security devices for cellar windows, security gratings for cellars, padlocks, long hoop locks, cable locks, spiral cable locks, chain locks; safes; goods of common metal, included in class 6; ores. (EU trademark 2782944)</p>	
<p>CI 7 Installations for energy production. (EU trademark 6404057)</p> <p>CI 7 Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs. (EU trademark 2782944)</p>	
<p>CI 8 Hand tools and implements (hand operated); cutlery; side arms; razors. (EU trademark 2782944)</p>	
<p>CI 9 Communications technology products, included in class 9; software, data processing equipment and computers; electric apparatus; electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision) and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; gramophone records; calculating machines. (EU trademark 6404057)</p> <p>CI 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; webpads; information technology equipment; equipment, hardware, software for the remote operation and remote control of household and garden appliances and devices; data carriers containing technical and commercial data relating to used vehicles; equipment, hardware, software and</p>	<p>KI 9 VPN-hardware; VPN-besturingssoftware; besturingssoftware voor virtuele particuliere netwerken (VPN); apparaten voor een veilige back-up van gegevens; beveiligde digitale geheugenkaarten; chipkaarten (gecodeerde elektronische - ); computergeheugen- apparatuur; computergeheugens; computergeheugentoestellen; dataverwerkende programma's vastgelegd op machineleesbare gegevensdragers; digitale notepads; digitale opnamemedia; digitale opnamen; diskdrives; elektronische geheugens; elektronische identificatiekaarten; elektronische kaartlezers; flashkaartlezers; flashmemory kaarten; gecodeerde geïntegreerde circuitkaarten; gecodeerde schijven; gecodeerde smartcards; gegevensdragers; geheugenapparaten; geheugenapparatuur; gegevensopslag (apparatuur voor -); geheugenkaarten; harde schijfeenheden; harde-schijfstations; harde schijven; informatiedragers [gecodeerd of magnetische]; kaarten gecodeerde met beveiligingskenmerken voor identificatiedoeleinden; kaartleesapparaten; schijfgeheugens; usb-hardware; usb-sticks; computerrandapparatuur (draadloze -); computerterminals; draagbare</p>



services for detecting functional defects (including by means of remote diagnosis), for transmitting data relating to these functional defects and for rectifying these functional defects in household and garden appliances and devices; fire-extinguishing apparatus; alarms; home security installations, equipment and devices, alarm door locks; burglar alarm installations and other equipment and installations for crime prevention and for deterring and identifying criminals; security cameras; photovoltaic installations; electronic hotel guides (software); animated cartoons; attracting and killing insects (Electric devices for -); cigar lighters for automobiles; cleaning apparatus for phonograph records; containers for contact lenses; door closers, electric; door openers, electric; electric arc cutting apparatus; electric arc welding apparatus; electric welding apparatus; electronic publications [downloadable]; electroplating apparatus; eyeglass cases; eyeglass chains; eyeglass cords; eyeglass frames; flat irons, electric; galvanizing apparatus; hair-curlers, electrically heated; lift operating apparatus; magnets; magnets (Decorative -); make-up removing appliances, electric; mouse pads; sealing plastics (Electrical apparatus for -) [packaging]; soldering apparatus, electric; soldering irons, electric; spectacle cases; spectacle frames; wrist rests for use with computers.

(EU trademark 2782944)

computerrandapparatuur; drives voor reservebestanden voor computers; terminals (interactieve -); computer hardware; boordcomputers; communicatiecomputers; communicatieservers [hardware]; computercomponenten en -onderdelen; computerhardware; computernetwerkserver; computers; computers in zakformaat voor het maken van aantekeningen; computers op handformaat; computers voor gegevensbeheer; computerservers; computersystemen; computerwerkstations; draagbare computers; draagbare personal computers; draagkoffers voor computers; elektronische tablets; e- mailservers; file servers; hardware (computer -); interactieve computersystemen; internetserver; intranetserver; netwerkserver; laptops; notebook computers; thin client (computers); werkstations [computerapparaten]; werkstations [computers].

*CI 9 VPN hardware; VPN operating software; operating software for VPN; data protection backup units; secure digital (SD) memory cards; encoded electronic chip cards; computer memory devices; computer memory devices; computer memory hardware; data processing programs recorded on machine-readable data carriers; digital notepads; digital recording media; digital recordings; floppy disk drives; electronic memories; electronic ID cards; electronic card readers; flash card readers; flash memory cards; encoded integrated circuit cards; encoded discs; encoded smart cards; data storage media; memory devices; memory apparatus; storage apparatus for computer data; memory cards; hard disk drives; hard disk drives; hard discs; information carriers [encoded or magnetic]; cards encoded with security features for identification purposes; card reading equipment; disc memories; USB hardware; USB flash drives; wireless computer peripherals; computer terminals; wearable computer peripherals; backup drives for computers; interactive terminals; computer hardware; on-board computers; communications computers; communications servers [computer hardware]; computer components and parts;*

	<p><i>computer hardware; computer servers; computers; pocket computers for note taking; palmtop computers; computers for use in data management; computer servers; computer systems; work stations [computers]; wearable computers; handheld personal computers; bags adapted for laptops; tablet computers; electronic mail servers; file servers; hardware (computer-); interactive computer systems; internet servers; intranet servers; network servers; laptop computers; notebook computers; thin client computers; work stations [computer apparatus].</i></p>
<p>CI 10 Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials. (EU trademark 2782944)</p>	
<p>CI 11 Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes. (EU trademark 2782944)</p>	
<p>CI 12 Vehicles; apparatus for locomotion by land, air or water; air bags [safety devices for automobiles]; air pumps [vehicle accessories]; anti-glare devices for vehicles; anti-skid chains; anti-theft alarms for vehicles; anti-theft devices for vehicles; automobile bodies; automobile chains; automobile chassis; automobile hoods; automobile tires [tyres]; axle journals; axles for vehicles; balance weights for vehicle wheels; bands for wheel hubs; baskets adapted for cycles; bicycle stands; boat hooks; bodies for vehicles; bogies for railway cars; brake linings for vehicles; brake segments for vehicles; brake shoes for vehicles; brakes for vehicles; buffers for railway rolling stock; bumpers for automobiles; caps for vehicle petrol [gas] tanks; casings for pneumatic tires [tyres]; casters for trolleys [vehicles] [carts (Am)]; cleats [nautical]; clutches for land vehicles; connecting rods for land vehicles, other than parts of motors and engines; couplings for land vehicles; crankcases for land vehicle components, other than for engines; cranks for cycles; cycle bells; cycle brakes; cycle chains; cycle frames; cycle handle bars; cycle hubs; cycle mudguards; cycle pumps; cycle rims; cycle saddles; cycle spokes; cycle stands; davits for boats; direction indicators for bicycles, cycles, etc; disengaging gear for boats; doors for vehicles; dress</p>	

guards for bicycles, cycles; driving chains for land vehicles; driving motors for land vehicles; ejector seats for aircraft; fenders for ships; freewheels for land vehicles; funnels for locomotives; funnels for ships; gear boxes for land vehicles; gearing for land vehicles; gears for cycles; head-rests for vehicle seats; hoods for vehicle engines; hoods for vehicles; horns for vehicles; hub caps; hubs for vehicle wheels; hydraulic circuits for vehicles; inclined ways for boats; adhesive rubber patches for repairing inner tubes; inner tubes for bicycles, cycles; inner tubes for pneumatic tires [tyres]; jet engines for land vehicles; luggage carriers for vehicles; luggage nets for vehicles; mine cart wheels; motors, electric, for land vehicles; motors for cycles; motors for land vehicles; mudguards; oars; paddles for canoes; panniers adapted for cycles; pedals for cycles; portholes; propulsion mechanisms for land vehicles; pushchair covers; pushchair hoods; railway couplings; rearview mirrors; reduction gears for land vehicles; repair outfits for inner tubes; reversing alarms for vehicles; rowlocks; rudders; saddle covers for bicycles or motorcycles; saddles for bicycles, cycles or motorcycles; safety belts for vehicle seats; safety seats for children, for vehicles; screw-propellers; screw-propellers for boats; screws [propellers] for ships; sculls; seat covers for vehicles; security harness for vehicle seats; ships' hulls; ships' steering gears; shock absorbers for automobiles; shock absorbing springs for vehicles; ski carriers for cars; sleeping berths for vehicles; spars for ships; spoke clips for wheels; steering wheels for vehicles; studs for tires [tyres]; sun-blinds adapted for automobiles; suspension shock absorbers for vehicles; tailboard lifts [parts of land vehicles]; timbers [frames] for ships; tipping apparatus, parts of trucks and waggons; tipping bodies for lorries [trucks]; tires (flanges of railway wheel -); tires for bicycles, cycles; tires for vehicle wheels; tires (non-skid devices for vehicle -); tires, solid, for vehicle wheels; torque converters for land vehicles; torsion bars for vehicles; traction engines; trailer hitches for vehicles; transmission chains for land vehicles; transmission shafts for land vehicles; transmissions, for land vehicles; treads for retreading tires [tyres]; treads for vehicles [roller belts]; tubeless tires [tyres] for bicycles, cycles; turbines for land vehicles; turn signals for vehicles; undercarriages for vehicles; upholstery for vehicles; valves for vehicle tires [tyres]; vehicle bumpers; vehicle chassis; vehicle covers

<p>[shaped]; vehicle running boards; vehicle seats; vehicle suspension springs; vehicle wheel rims; vehicle wheel spokes; vehicle wheel tires [tyres]; vehicle wheels; wheels for bicycles, cycles; windows for vehicles; windscreen wipers; windscreens.</p> <p><i>(EU trademarks 6404057 and 2782944)</i></p>	
<p>CI 13 Firearms; ammunition and projectiles; explosives; fireworks.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 15 Musical instruments.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 16 Paper, cardboard and goods made from these materials, included class 16; printed matter; items for bookbinding; photographs; stationery; adhesives for stationery or household purposes; office requisites (other than furniture); instructional and teaching material (except apparatus); plastic materials for packaging, included in Class 16.</p> <p><i>(EU trademark 6404057)</i></p> <p>CI 16 Paper, cardboard and goods made from these materials (included in class 16); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (included in class 16); printers' type; printing blocks; maps; atlases; hotel guides; printed matter containing information relating to installation services, repair services, craft services, plant engineering services, key services, caretaker services, housekeeping services, gardening services, services in the field of housing and real estate management, building construction and real estate affairs, technical and commercial real estate management.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 17 Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and included in class 17; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 18 Leather and imitations of leather, and goods made of these materials and included in class 18; animal skins;</p>	

<p>trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery. (EU trademark 2782944)</p>	
<p>Cl 22 Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (so far as included in class 22); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials. (EU trademark 2782944)</p>	
<p>Cl 23 Yarns and threads, for textile use. (EU trademark 2782944)</p>	
<p>Cl 24 Textiles and textile goods (included in class 24); bed and table covers; furniture coverings of plastic; plastic material [substitute for fabrics]. (EU trademark 2782944)</p>	
<p>Cl 26 Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers; artificial fruit; badges for wear, not of precious metal; barrettes [hair-slides]; birds' feathers [clothing accessories]; bodkins; boxes, not of precious metal, for needles; brassards; brooches [clothing accessories]; collar supports; competitors' numbers; corset busks; darning lasts; decoration of textile articles (heat adhesive patches for -) [haberdashery]; expanding bands for holding sleeves; false beards; false hair; false moustaches; feathers [clothing accessories]; hair coloring caps; hair curlers, other than hand implements, nonelectric; hair curling papers; hair curling pins; hair grips [slides]; hair nets; hair ornaments; hair pins; hat ornaments [not of precious metal]; heat adhesive patches for repairing textile articles; letters for marking linen; mica spangles; monogram tabs for marking linen; needle cases, not of precious metal; needle cushions; numerals for marking linen; ostrich feathers [clothing accessories]; pin cushions; plaited hair; reins for guiding children; sewing boxes; sewing thimbles; shoe ornaments [not of precious metal]; shoulder pads for clothing; shuttles for making fishing nets; spangles for clothing; top-knots [pompoms]; toupees; trouser clips for cyclists; wigs. (EU trademark 2782944)</p>	
<p>Cl 27 Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile). (EU trademark 2782944)</p>	
<p>Cl 28 Games and playthings (except plush play figures).</p>	

<p><i>(EU trademark 6404057)</i></p> <p>CI 28 Game cards.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 29 Preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; milk and milk products.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 31 Agricultural, horticultural and forestry products and grains, included in class 31; fresh fruits and vegetables; seeds, natural plants and flowers; malt.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 35 Professional business and organisation consultancy in the energy sector; advertising, business management; business administration; office functions; commercial management services; marketing services, namely the marketing of new technologies, in particular in the environment and energy sector; temporary placement of personnel; professional business and organisation consultancy services in the energy sector; auctioneering.</p> <p><i>(EU trademark 6404057)</i></p> <p>CI 35 Organisation and facilitation of the short-term provision of installation services, repair services, craft services, plant engineering services, key services, caretaker services, housekeeping services, gardening services, services in the field of housing and real estate management, building construction and real estate affairs, technical and commercial real estate management (including outside normal working hours, weekends and public holidays), in particular in cases of emergency, including agency and information services for the aforesaid services, including online; purchasing consultancy, including online; agencies for craftsmen, including online; concluding and handling of contracts for the buying and selling of household and garden appliances, including via online shops; collating and systematic ordering of data in a computer database; collating and compiling subject-related press articles.</p>	

<i>(EU trademark 2782944)</i>	
<p>CI 36 Financial services; financial consultancy in the energy sector; venture capital investments; commercial and technical building management; insurance; financial affairs, monetary affairs; real estate affairs.</p> <p><i>(EU trademark 6404057)</i></p> <p>CI 36 Housing and real estate management.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 37 Construction of power stations, in particular hydroelectric power stations, nuclear power stations, coal power stations, gas and steam turbine power stations; construction, maintenance and upkeep of electric street lighting; energy management, namely the construction, management and maintenance of energy generation and distribution installations; creation, installation and operation of distribution and transport networks; construction of waste treatment installations; maintenance of sewage and fresh water installations; technical services for installations, namely construction, assembly, maintenance, servicing and repair services; repair services, namely the repair of technical apparatus and household appliances; installation services; building construction.</p> <p><i>(EU trademark 6404057)</i></p> <p>CI 37 Building construction, repair and installation services; installation, maintenance, servicing, renovation, modernising, extension, conversion, remediation and repair of waste water and fresh water installations, conduits and other installations for the supplying or drainage thereof, sanitary facilities, heating installations and parts therefor, technical equipment, household appliances, electronic entertainment apparatus and information technology equipment, and photovoltaic installations, supply lines (including for gas and electricity), buildings and parts therefor; craft services; technical services for installations, in particular construction, assembly, maintenance, servicing and repair services; services for detecting functional defects (including by means of remote diagnosis) in household and garden appliances and devices, for transmitting data relating to these functional defects and for rectifying these functional defects; repair of mobile phones; network</p>	

<p>management, namely installation and maintenance of network systems, installation services for house automation; caretaker services, namely maintenance, safeguarding and care of residential buildings and industrial buildings.</p> <p><i>(EU trademark 2782944)</i></p>	
<p>CI 38 Telecommunications.</p> <p><i>(EU trademark 6404057)</i></p> <p>CI 38 Telecommunications, in particular electronic advertising; Providing access to a global computer network; providing telecommunications connections to a global computer network; teletext services; telephone services; radio and television broadcasting; telephone services; cable television broadcasting services; communications by optical fibre networks; cabling, routing and connection services for telecommunications; cellular telephone communication; collection and supply of news; message sending; computer-aided transmission of messages and images; electronic mail; rental of message sending apparatus; paging services (radio, telephone or other means of electronic communication); news agencies; news agencies; radio broadcasting; satellite transmission; telephone services; telegraph services; communications by telegraph; telegram services; transmission of telegrams; information about telecommunications; teleconferencing services; facsimile transmission; rental of fax machines; rental of modems; telephone rental services; rental of telecommunications apparatus; service hotlines; rental of mobile phones and providing replacement mobile phones.</p> <p><i>(EU trademark 2782944)</i></p>	<p>KI 38 Communicatie via virtuele particuliere netwerken [VPN]; verschaffen van virtueel particuliere netwerk [VPN] diensten; berichten (elektronische verzending van -); beschikbaarstelling van mogelijkheden voor videoconferenties; communicatie per computer voor de overdracht van informatie; communicatie tussen computers; communicatie via computers; communicatie via computerterminals; communicatie via computernetwerken; communicatie via een wereldwijd computernetwerk of het internet; communicatie via glasvezelnetwerken; communicatie via netwerken van optische vezels; communicatie via netwerken en optische vezels; computer communicatiediensten; datacommunicatiediensten; diensten inzake beveiligde e-mail; directe elektronische berichtendienst; gegevenstransmissiediensten tussen gekoppelde computersystemen; transmissie van computergegevens; transmissie van digitale bestanden; transmissie van gegevens via internet.</p> <p><i>CI 38 Communication via virtual private networks; providing virtual private network (VPN) services; electronic mail; providing videoconferencing facilities; computer communications services for the transmission of information; computer intercommunication; communication by computer; communications by computer terminals; communication services over computer networks; communications via a global computer network or the internet; communications by fibre optic networks; communications by fibre optic networks; communications by fibre optic networks; computer communication services; data communication services; secure e-mail services; instant electronic messaging services; data transmission services between networked computer systems; computer</i></p>



	<i>data transmission services; transmission of digital files; transmission of data via the Internet.</i>
<p>CI 39 Transport; providing transport networks for distributing energy; distribution of electrical energy; technical services for operating distribution networks; distribution of energy, in particular electricity; heating (local and long-distance heating) as well as provision for others of electricity and heating (local and long-distance heating); electricity distribution; collection, storage, dumping, transport and destruction of waste; supplying of fresh water; sewage disposal; shipping; road haulage; packaging and storage of goods; travel arrangement; distribution of electricity, gas and heating, in particular to industry. (EU trademark 6404057)</p> <p>CI 39 Transport and logistics in the transport sector; removal services, in particular rental of removal vehicles, providing furniture packers, assembly and disassembly of furniture; logistics services with regard to removals; delivery of goods of all kinds; collection and repair of mobile phones. (EU trademark 2782944)</p>	
<p>CI 40 Production of printed matter (printing) containing technical and commercial data relating to used vehicles. (EU trademark 2782944)</p>	
<p>CI 41 Staff training; education; providing of training; entertainment; sporting and cultural activities; publication of books; publication of texts [other than publicity texts]. (EU trademark 6404057)</p> <p>CI 41 News reporters services. (EU trademark 2782944)</p>	
<p>CI 42 Energy consultancy for domestic, commercial and industrial purposes; developing of integrated energy concepts; energy management, namely technical consultancy and planning regarding energy generation and distribution installations; technical and ecological consultancy in the energy sector; development of software architecture, modules and interfaces and the application thereof in electronic and electrotechnical apparatus, components and systems; planning of waste treatment installations; environmental services, namely consultancy relating to the environment and the development of</p>	<p>KI 42 Hardwareontwerp; adviesdiensten met betrekking tot hardware en software; adviesdiensten met betrekking tot informatietechnologie; advisering met betrekking tot it; advisering met betrekking tot computersysteemanalyse; computernetwerken (advisering met betrekking tot -); advies op het gebied van ontwerpen van computerhardware; advisering met betrekking tot computersysteemontwerp; advisering met betrekking tot hardwareontwerp; advisering op het</p>

<p>strategies for environmental risk management; research and development, in particular in the field of environmental technology; computer programming; acquiring, implementing and issuing of licences, research and development contracts; temporary accommodation; legal services. (EU trademark 6404057)</p> <p>CI 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services; creating databases with search and retrieval facilities, containing technical and commercial information relating to used vehicles; creating databases with search and retrieval facilities, containing news, business and commercial company information; weather forecasting, including online. (EU trademark 2782944)</p>	<p>gebied van het technologisch ontwerpen; communicatiesystemen (ontwerp van -); dataverwerkingsapparatuur (verhuur van -); dataverwerkingsapparatuur en computers (verhuur van -).</p> <p><i>CI 42 Design of computer hardware; computer hardware and software consultancy; information technology consultancy; IT consultancy; advisory services relating to computer systems analysis; consultancy services relating to computer networks; advice relating to the design of computer hardware; advisory services relating to computer systems design; advisory services relating to computer hardware design; consultancy in the field of technological design; design of communications systems; rental of data processing equipment; rental of data processing equipment and computers.</i></p>
<p>CI 43 Services for providing food and drink, temporary accommodation. (EU trademark 2782944)</p>	
<p>CI 44 Medical and veterinary services; home care services; hygienic and beauty care for human beings or animals; agriculture and forestry services; gardening. (EU trademark 2782944)</p>	
<p>CI 45 Personal and social services rendered by others to meet the needs of individuals; housekeeping services in private households; caretaker services, namely security services in residential buildings and industrial buildings; security services for the protection of property and individuals; Services in the field of home security; security guard and alarm services; key cutting. (EU trademark 2782944)</p>	
	<p><i>N.B. The original language of the Benelux application is Dutch. The translation is only added to improve the readability of this decision.</i></p>

### Class 9

42. The Office considers that according to established case law, if the goods and services of the earlier trademark also contain goods and services that are mentioned in the application for the contested sign, these goods and services are considered identical (see EGC, Fifties, T-104/01, 23 October 2002, ECLI:EU:T:2002:262; EGC, Arthur et Félicie, T-346/04, 24 November 2005, ECLI:EU:T:2005:420 and EGC, Prazol, T-95/07, 21 October 2008, ECLI:EU:T2008:455). All goods of the defendant in class 9 can be considered as some type of electronic apparatus and they can thus be considered identical to the goods *electronic apparatus* of the opponent.

### Class 38

43. The defendant's services in class 38 are identical to the opponent's *telecommunications* services. The defendant's services are specific types of telecommunication services. These are all covered by the opponent's general indication telecommunications services. As the broad category of telecommunications services of the opponent encompasses the specific type of telecommunication services of the defendant they can be considered identical (see EGC, Fifties, Arthur et Félicie and Prazol, already cited).

### Class 42

44. The services *design of computer hardware; computer hardware and software consultancy; information technology consultancy; IT consultancy; advisory services relating to computer systems analysis; consultancy services relating to computer networks; advice relating to the design of computer hardware; advisory services relating to computer systems design; advisory services relating to computer hardware design; consultancy in the field of technological design; design of communications systems* of the defendant are similar to the services *development of software architecture, modules and interfaces and the application thereof in electronic and electrotechnical apparatus, components and systems* of the opponent. The services of the defendant concern not only the design of computer software and hardware, but also advisory and consultancy services related thereto. The services of the opponent relate to the design of software and the application thereof in electronic apparatuses. The relevant public interested in the services of the opponent will most likely also want corresponding consultancy and follow-ups in order to ensure that the software is correctly implemented and updated. Therefore, they have the same nature and very similar purposes, they may be provided by the same providers and they target the same customers through the same distribution channels.

45. Furthermore, the defendant's *rental of data processing equipment; rental of data processing equipment and computers* services are considered similar to a certain degree to the goods *data processing equipment and computers* of the opponent. In general goods and services differ as to their nature. Goods are physical products that can be transferred. Services concern the execution of intangible activities. An inherent consequence of these differences is that the use of goods and services also differs. However, goods and services can be complementary, as certain services cannot be rendered without using certain goods.

46. Regarding the complementary nature of goods and services, it should be pointed out that, according to settled case law, complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (EGC, *The O STORE*, T-116-06, 24 September 2008; ECLI:EU:T:2008:399). The Office finds that the rental of data processing equipment; rental of data processing equipment and computers services of the defendant are similar to a certain degree to the goods *data processing equipment and computers* of the opponent. The goods covered by the earlier mark are identical to those to which the applicant's services relate. The relationship between the services and the goods covered by the earlier trademark is close in the sense that the goods are indispensable to or at the very least, important for the provision of these services, which are specifically provided when the goods at issue are rented. Therefore, these services and goods are considered complementary. Furthermore, both the goods covered by the earlier trademark and the services provided by the defendant can also be offered by the same companies. The services of the defendant can therefore be regarded as being similar to a certain degree to the goods of the opponent.

#### *Conclusion*

47. The goods and services of the defendant are identical, or similar (to a certain degree) to the goods and services of the opponent.

### **A.2 Global assessment**

48. 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.

49. 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 relevant consumer who is part of the general public will decide to purchase certain goods and services covered by the signs at issue here – in particular those which are expensive or aim to meet a particular technological need such as the design and development of computer hardware and software in class 42 – on the basis of previously gathered information. In those circumstances, the level of attention of the relevant consumer will be higher than average for these services. On the other hand, such a level of attention may decrease in respect of other goods and services in classes 9 and 38, which constitute goods and services for the general public. In those circumstances, the relevant public will thus have an average level of attention (EGC, *AAVA MOBILE*, T-554/12, 27 March 2014, ECLI:EU:T:2014:158). Therefore, in defining the relevant public, account must be taken of the average consumer in the Benelux with either an average or above average level of attention, depending on the goods and services in question.

50. 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).

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

52. 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 trademarks invoked have a normal level of distinctiveness, as they are not descriptive of the goods and services concerned.

53. Based on the circumstances mentioned above, the Office finds, given the interdependence between the identity and similarity of the goods and services and the similarity of the signs and taking into account either the average or above average level of attention of the relevant public, that this public might believe that the goods and services in question originate from the same undertaking or from economically-linked undertakings.

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

54. The defendant is of the opinion that the parties target different markets and that therefore the danger of confusion is not applicable at all (see paragraph 20). 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, ECLI:EU:C:2007:171; CJEU, O2 Holdings Limited, C-533/06, 12 June 2008, ECLI:EU:C:2008:339 and EGC, Ferromix e.a., T-305/06-T-307/06, 15 October 2008, ECLI:EU:T:2008:444).

55. The defendant indicates that there will soon be an obligation for the opponent to use the trademarks invoked. However, the defendant observes already that the opponent is now only using the rights invoked in Germany and therefore he is of the opinion that the opponent already no longer has an interest in filing an opposition against the defendant (paragraph 20). As the rights invoked are not subject to an obligation of use any arguments regarding the genuine use of the rights invoked are not relevant here.

56. Finally, the defendant also argues that parties already tried earlier to reach a settlement in this case, however these negotiations did not come to a conclusion (paragraph 20). Such an argument cannot play a role in these proceedings. The opposition proceedings with the Office are intended to solve conflicts between trademark owners in a swift and simple manner. These proceedings are therefore limited to specific grounds, namely article 2.14 jo 2.3 par. 1 sub a and b BCIP. The application of these articles is solely judged based on the information as it appears in the trademark register. Other existing grounds of defence or objection against a trademark application cannot play a role in opposition proceedings. To that end the parties should file legal proceedings before a court.

#### **C. Conclusion**

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

#### **IV. DECISION**

58. The opposition with number 2012560 is justified.

59. Benelux application with number 1340100 will not be registered.

60. The defendant shall pay the opponent 1,030 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, 30 July 2018

Tineke Van Hoey  
(*rapporteur*)

Diter Wuytens

Camille Janssen

Administrative officer: Cees van Swieten