



Benelux-Bureau voor de
**Intellectuele
Eigendom**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2013031
of 29 May 2019

Opponent: **ORIENT EXPRESS, Société par Actions Simplifiées**
16, Avenue d'Ivry
75013 Paris
France

Representative: **CABINET STRATO-IP, (Société à responsabilité limitée)**
Boulevard de Ménilmontant 63
75011 Paris
France

Right invoked: **European Union trademark 15078363**



against

Defendant: **AERO INTERNATIONAL LIMITED**
Ingles Manor, Castle Hill Avenue
CT20 2RD Folkestone
United Kingdom

Representative: **Trademarkers Merkenbureau C.V.**
Prinses Beatrixstraat 7
5953 LL Reuver
Netherlands


Contested trademark: Benelux trademark 1349771

OE.com

I. FACTS AND PROCEEDINGS

A. Facts

1. On 6 March 2017 the defendant filed a Benelux trademark application for the wordmark "OE.com" for goods and services in the classes 3, 9, 14, 26 and 41. The application was processed under number 1349771 and was published on 10 March 2017. During the proceedings the applicant limited the list of goods and services by deleting all the goods in class 3 from the application.

2. On 19 April 2017 the opponent filed an opposition against the registration of the application in the Benelux. The opposition is based on the earlier EU trademark 15078363, the combined word/figurative trademark , filed on 4 February 2016 and registered on 9 January 2018 for goods and services in classes 3, 4, 8, 11, 12, 14, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 34, 35, 39, 41, 43 and 44.

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

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

5. The grounds for opposition are those laid down in article 2.14, 2 (a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").¹

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 21 April 2017. Initially the proceedings were suspended awaiting the registration of the right invoked before the European Union Intellectual Property Office (hereinafter: "EUIPO"). 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 4 September 2018.

II. ARGUMENTS

8. The opponent filed an opposition at the Office under article 2.14, 2 (a) BCIP, in accordance with the provisions of article 2.2ter, 1 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

¹ This decision refers to the laws and regulations applicable at the date of the decision, unless it concerns provisions that have undergone a material change relevant to the decision during the proceedings.

9. The opponent finds that the figurative element in the right invoked should be considered of secondary importance. The public's attention will be focused on the verbal element, OE, according to the opponent. The verbal element ".com" in the contested sign is of little significance. It is a generic domain and will therefore not be perceived as an indicator of commercial origin. Therefore, the opponent finds the verbal element "OE" in the contested application to be the dominant and distinctive element.

10. Visually, the right invoked and the contested sign both consist of the letters "O" and "E". The first in a certain typeface, the second in a standard computerized font. According to the opponent this results in a highly similar visual impression in the consumer's mind. The signs are therefore visually strongly similar.

11. Aurally, the opponent finds that the prior trademark and the dominant and distinctive element of the contested sign, will be pronounced in an identical manner. The pronunciation differs in the element ".com" of the contested application, which is non-distinctive and will most likely be disregarded by the relevant public. The opponent finds the signs in question to be aurally identical or at least highly similar.

12. As to the conceptual comparison, the opponent states that the dominant element of the signs, i.e. "OE" has no meaning as regards the goods and services. Therefore, the opponent is of the opinion that a conceptual comparison is not possible.

13. According to the opponent the contested goods and services are identical, highly similar or similar to the goods and services of the earlier trademark.

14. Taking into account the aforementioned conclusions, the opponent is of the opinion that consumers can believe that the contested trademark application "OE.com" refers to the opponent's website.

15. The opponent concludes that the average consumer will be lead to believe that the contested sign constitutes a variation of the same category of goods and services provided by the same company. Consequently, there is a likelihood of confusion. The opponent therefore asks that the Office rejects the contested Benelux application for all designated goods and services.

B. Defendant's arguments

16. The defendant is of the opinion that the only potential overlap between the goods and services of the right invoked and the contested sign could be found in the Classes 14 and 41. Furthermore, the defendant finds that the goods and services, although they coincide in Class 14, are not entirely identical or similar and that they therefore do not risk creating a likelihood of confusion in the mind of the relevant public. The defendant thereby points out to the dissimilarity of the signs.

17. Visually, the signs differ significantly, according to the defendant. The earlier mark is highly stylised overall and contains a large dot between the "O" and "E" and a stylised star in the center of the "O". The contested sign is a plain word mark, without any stylization, star or large dot and has the additional ".com" added to the "OE", indicating a link to internet or technology related goods and/or services. The earlier mark is comprised of two letters while the contested sign is comprised of five letters. The aforementioned differences will be instantly perceived by the relevant consumer. Accordingly, the defendant concludes that no likelihood of confusion can possibly exist between the signs.

18. Aurally, the contested sign is clearly pronounced differently to the earlier mark, according to the defendant. The contested sign is pronounced as four syllables, "O-E-DOT-COM" whereas the earlier mark will be read as two syllables "O-E". Therefore, the number, rhythm and flow of the syllables are completely different. The defendant concludes that there is no possibility that the signs could be found to be aurally similar.

19. Conceptually, the defendant finds that the right invoked has no meaning in the relevant territory of the Benelux. However, the contested sign clearly links to internet or technology related goods and/or services because of the addition of the element ".com". Consequently, the defendant finds that the signs are conceptually different.

20. The defendant concludes by summarizing that the goods and services at hand are entirely dissimilar and by stating that there are clear differences between the signs. Therefore the defendant finds that a likelihood of confusion cannot exist and the relevant consumer would easily be able to differentiate between the goods and services provided under the signs.

21. The defendant requests that the Office rejects the opposition, accepts the contested sign for registration and that the opponent should bear the costs.

III. DECISION

A.1 Likelihood of confusion

22. In accordance with article 2.14 BCIP, the holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.2ter BCIP.

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

24. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (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, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).


Comparison of the signs

25. The wording of Article 5, 1 (b) of the Directive (cf. article 2.2ter, 1 (b) BCIP) according to which “there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark” 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).

26. 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).

27. 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, ECLI:EU:C:2007:333). 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, ECLI:EU:T:2002:261 and *El Charcutero Artesano*, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

28. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	OE.com

29. The right invoked is a combined word/figurative sign. It consists of the letters “O” and “E” depicted in a black stylized typeface. The letters are divided by a small black point and inside the letter “O” is a (shape of a) star depicted. The contested sign is a word mark, which consists of the letters “OE” followed by the element “.com”.

Visual comparison

30. The right invoked consist of two stylized letters “O” and “E” which are dominantly visible. The figurative elements are depicted smaller and do not visually distract the attention from the letter combination “OE”, which should therefore be held dominant in the right invoked. The contested sign consist of five letters, “OE.com”. The dominant element of the contested sign is the first element, “OE” whereas the second element, .com, is the most widely known generic top level domain (gTLD). This element simply refers to an internet address and can be held descriptive for goods offered via and services provided for by the Internet.

31. The earlier trademark and the contested sign therefore visually coincide in their dominant elements, namely "OE".

32. The Office finds that the signs are visually similar to a high degree.

Aural comparison

33. The right invoked consist of two syllables, O-E which will be pronounced as [-o:-e:], [-o-e] or [-o-i]. The dominant element of the contested sign is identical and will therefore be pronounced identically. When and if pronounced the last element will sound as [punt-kom] (in Dutch), [pwã-kom] (in French) or [dat-cam] (in English). As mentioned before (paragraph 30) this element is descriptive and non-distinctive for the relevant goods and services, due to which it certainly cannot be ruled out that this element will not be pronounced at all. Furthermore, consumers will in general visually and aurally pay more attention to the beginning of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79) and it must also be noted, that, when speaking, the average consumer will tend to abbreviate a mark comprising a number of terms in order to make it easier to pronounce, thereby often omitting descriptive or non-distinctive elements of the mark (see to that effect EGC, GREEN by missako, T-162/08, 11 November 2009, ECLI:EU:T:2009:432 and BROTHERS by CAMPER, T-43/05, 30 November 2006, ECLI:EU:T:2006:370).

34. If and when the second element of the contested sign, ".com" will be pronounced, the earlier mark and the contested sign are considered to be at least aurally similar. However, if this element is not pronounced, they are identical.

Conceptual comparison

35. The combined letters "OE" do not have a specific and known meaning in the relevant territory. Therefore, a conceptual comparison is not relevant. The fact that the last element of the contested sign ".com" has a descriptive meaning, does not alter the aforementioned conclusion.

36. A conceptual comparison is not possible.

Conclusion

37. The earlier trademark and the contested sign are visually highly similar. Aurally they are at least similar or identical. A conceptual comparison is not possible.

Comparison of the goods and services

38. 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).

39. With the comparison of the goods and services of the earlier mark invoked and the goods and services against which the opposition is filed, the goods and services are only considered on the basis of

what is expressed in the register or the goods or services for which genuine use has been proven on the one hand and the goods as indicated in the trademark application on the other hand.

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

Opposition based on:	Opposition directed against:
CI 3 Cosmetics; Fragrances, namely perfumes, eau de parfum, scented water, eau de toilette; Perfume; Fragrance oils; perfumery; Eau-de-Cologne; Room odorising preparations; Air fragrancng preparations; Foaming bath; Lotions and creams for hands, face and body; Aromatherapy oils and creams; Non-medicated toiletries, namely cosmetic creams, deodorants (perfumery), oils for toilet purposes, cleansing milk for toilet purposes, lotions for cosmetic purposes, soaps, shampoos, toiletry preparations; Cosmetic preparations for the bath, gels (cosmetics for the body), oils (cosmetics for the body), pearls, salts and crystals (cosmetics); Body-powders; Soaps; Massage oils; Scented sachets; Air fragrancng preparations; Room fragrancng preparations.	
CI 4 Tapers; Perfumed candles; Wicks for candles; Wicks for lighting; Lighting fuel; Firelighters.	
CI 8 Hand tools and implements (hand-operated); Cutlery; Side arms; Razors.	
	CI 9 Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data- carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; microprocessors; keyboards; video films.
CI 11 Lighting apparatus; lamps; Desk lamps; Table lamps; Bedside lamps; Mounted lights; Hanging ceiling lamps; Reading lights; Pocket searchlights; Screens for lamps; Pedestal lamps; Reading lights; Lanterns; Standard lamps; Halogen lamps; Electric firelighters.	

<p>CI 12 Vehicles; Apparatus for locomotion by land, air or water; Vehicles for locomotion by rail; Railway vehicles; Rolling stock for railways; Trains (railway rolling stock); Locomotives; Power units; Cars; Carriages [railways]; Trains; Railway car compartments; Sleeping cars; Dining cars (carriages); Bar cars; Lounge cars; Bathroom cars; Handling carts; Trolleys for luggage and packages; Sack trucks; Trolleys; Bicycles.</p>	
<p>CI 14 Alloys of precious metal; Movements for watches, clocks; Housings for watches; Watch springs or glasses; Cases for watches.</p>	<p>CI 14 Precious metals; jewellery; precious stones; chronometric instruments.</p>
<p>CI 16 Books; Art books; Printed matter, including printed articles, prospectuses, flyers, booklets, leaflets, brochures, information brochures, catalogues, newspapers, periodicals, journals, magazines, publications, guides, travel guides, manuals, directories, bulletins, news bulletins, newsletters, printed timetables, schedules, indexes; Agendas; Tear-off calendars; Scrapbooks; Almanacs; Notebooks; Pamphlets; Calendars; Posters; Postcards; Greeting cards; Geographical maps; Rail network cards; Blueprints; Drawings; Pictures; Photographs; Pictograms; Tickets; Notes; Train tickets; tickets; Reservations; Combined travel tickets; Season tickets and books of tickets for transport and/or travel, in particular by train; Cases and pouches for tickets, transport tickets, cards, books and booklets; Stationery, including writing paper, envelopes, wallets, cards, announcement cards; Writing and drawing instruments, supplies and sets, and cases therefor; Office requisites (except furniture); Bookmarks; Bags (envelopes, pouches) of paper and/or cardboard and/or plastics for packaging; Signs, placards and signboards of paper and/or cardboard; Coasters of paper and/or cardboard; Luggage labels of paper and/or cardboard and/or plastic; Checkbook covers; Advertising material (printed matter); Promotional material (printed matter); Display material (printed matter).</p>	
<p>CI 18 Trunks [luggage]; Portmanteaus; Traveling trunks; Valises; Holdalls; Flight bags;</p>	

<p>Sports bags and travelling bags; Sports bags for general use; Holdalls; Duffle bags; Bags of leather and imitations of leather; Luggage garment bags for travel; Handbags and pouches; Waist bags and pouches; Shoulder bags; Beggar's bags; Backpacks; Beach bags; Wheeled shopping bags; Briefcases; Briefbags; Satchels; School bags and satchels; Attache cases; Attaché cases; Wallets; Card wallets [leatherware]; Purses, not of precious metal; Purses; Vanity cases (not fitted); Travelling sets (leatherware), not decorative; Wheeled shopping bags; Bags, sachets, envelopes and pouches for packaging, of leather or imitations of leather; Key holders of leather or imitations of leather; Umbrellas, parasols and walking sticks; Luggage straps and bands; Leather and imitation leather label holders for luggage.</p>	
<p>Cl 20 Furniture; Mirrors, picture frames; Goods not included in other classes, namely furniture of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; Cushions; Pillows; Mattresses, Writing tables; Tables; Coffee tables; Folding tables; High tables; Bedside cabinets; Bedside cabinets; Side tables; Beds; Furniture incorporating beds; Furniture being convertible into beds; Settees; Extendible sofas; Travel cots; Mattresses; Bed heads; Trunks (furniture); Chests for storage purposes; Armchairs; Office armchairs; Seats; Stools; High stools [furniture]; Mobile stools (furniture); Chaise lounge; Benches (furniture).</p>	
<p>Cl 21 Glassware, namely boxes of glass, figurines of glass, flasks, perfume sprayers, perfume atomisers, porcelain and earthenware; Scoops (tableware), pie servers; Basting spoons [cooking utensils]; Chopsticks (kitchen utensils); Cheese makers and cheese-dish covers; Butter dishes and butter-dish covers; Tableware, other than knives, forks and spoons; Butlers' trays; Dishes; Plates; Glasses, mugs and bowls; Cabarets (trays); Caffetieres (non-electric); Teapots; Corkscrews, electric and non-electric; Ice buckets; Knife rests for the table; Napkin holders; Decanters; Pitchers</p>	

and jugs; Bread baskets, domestic; Bread boards; Coasters (not of paper and other than table linen); Egg cups; Sugar bowls; Tea services [tableware]; Coffee services [tableware]; Boxes for sweetmeats; Non-drip collars (for wine bottles); Candelabras (candle holders); Candlesticks; Vases; Piggy banks; Works of art, of porcelain, terra-cotta or glass; Storage tidiies (household containers); Baskets, cups, trays and containers for household use; Bathroom accessories (not included in other classes), namely tooth mug holders, Holders for toothbrushes, Holders for tooth-brush glasses, Napkin holders, Soap dishes, Soap dishes, soap holders; Chopsticks (kitchen utensils); Candle jars [holders]; Candle extinguishers; Saucer lights with snuffers.	
CI 24 Sheets, travel blankets, covers for cushions and pillows; Curtains; Net; Materials for soft furnishings; Curtain fabric; Linens; Table linen; Bed linen; Linens; Kitchen linen; Bath linen; Covers; Tablecloths; Towels of textile; Bath towels; Beach towels; Napkins; Eiderdowns [down coverlets]; Comforters; Covers for eiderdown and duvets; Textile fabrics for use in the manufacture of bedding.	
CI 25 Clothing; Headgear; Tee-shirts; Neckties; Scarves.	
	CI 26 Lace; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers; embroidery.
CI 27 Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; Wall hangings (non-textile); Wallpaper.	
CI 28 Games; Toys; Soft toys; Mechanical toys; Electronic toys; Remote control toys; Scale model vehicles; toys vehicules; Remote controlled toy vehicles; Balls for games; Balls for games; Balloons; Card games; Card games; Board games; Board games; Parlour games.	
CI 29 Jellies, jams; Edible oils and fats.	
CI 30 Coffee, tea, cocoa and artificial coffee;	

Pastry and confectionery; Ices; Honey; Salt; Mustard; Vinegar, sauces (condiments); Spices.	
CI 34 Tobacco; Smokers' articles; Matches; Cigarette lighters; Electronic cigarettes; Snuff boxes, cigarette cases, ashtrays, pipes.	
CI 35 Arranging subscriptions and promotional and advertising operations for the purposes of creating customer loyalty with regard to transport and/or travel, in particular by train, including those enabling the use of a card, badge and/or transport or access voucher; Business management; Advertising; Rental of advertising space, material and time; Promotion of goods and/or services; Arranging promotional and advertising activities; Direct mail advertising (tracts, brochures, printed matter, samples); Dissemination of advertising matter; Organisation of exhibitions for commercial or advertising purposes; Bill-posting; Public relations; Retailing of cosmetics, fragrances, namely perfumes, eaux de parfum, scented water, eaux de toilette, perfumes, perfume oils, perfumery, eaux de Cologne, indoor fragrances, room fragrances, foam bath preparations, lotions and creams for the face, hands and body, aromatherapy creams and oils, non-medicated toiletries, namely cosmetic creams, deodorants (perfumery), oils for toilet purposes, cleansing milk for toilet purposes, lotions for cosmetic purposes, soaps, shampoos, toiletry preparations, cosmetic preparations for the bath, gels (cosmetics for the body), oils (cosmetics for the body), pearls, salts and crystals (cosmetics), body powder, soaps, massage oils, fragranced sachets, room fragrances, preparations for room fragrances, candles, scented candles, wicks for candles, wicks for lighting, illuminants, firelighters, hand tools and implements (hand-operated), cutlery, side arms, razors, lighting apparatus, lamps, desk lamps, table lamps, bedside lamps, standing lamps, suspended ceiling lights, reading lamps, pocket torches, lamp shades, lamps on feet, readers, lanterns, standard lamps, halogen lamps, electric firelighters, vehicles, apparatus for locomotion by land, air or water, vehicles for locomotion by rail, railway	

<p>vehicles, rolling stock for railways, trains (railway rolling stock), locomotives, power units, cars, carriages, trains of cars or carriages, railway car compartments, sleeping cars, restaurant cars, buffet cars, lounge cars, sanitary cars, handling carts, carts for luggage and parcels, two-wheeled trolleys, trolleys, bicycles, precious stones, precious metals and their alloys, keyrings of precious metal, works of art of precious metal, jewellery boxes, boxes of precious metal, watches, stopwatches, movements for clocks and watches, cases, straps for watches, chains and springs or glasses for watches, novelty keyrings, presentation cases for watches, medals, bag charms, coins, books, art books, printed matter, including printed articles, prospectuses, flyers, booklets, leaflets, brochures, information brochures, catalogues, newspapers, periodicals, journals, magazines, publications, guides, travel guides, manuals, directories, bulletins, news bulletins, newsletters, printed timetables, schedules, indexes, organisers, tear-off calendars, albums, almanacs, notebooks, booklets, calendars, posters, postcards, greetings cards, maps, rail network maps, plans, drawings, images, photographs, pictograms, tickets, train tickets, transport tickets, reservation tickets, combined transport tickets, transport and/or travel season ticket cards, books and booklets, in particular for travel by train, cases and pouches for tickets, transport tickets, cards, books and booklets, stationery, including writing paper, envelopes, wallets, cards, announcement cards, instruments, supplies and sets for writing and drawing, and cases therefor, office requisites (except furniture), bookmarks, bags, sachets, envelopes and pouches, all for packaging, of paper and/or cardboard and/or plastic, display boards, placards and signs of paper and/or cardboard, coasters of paper and/or cardboard, luggage labels of paper and/or cardboard and/or plastic, chequebook holders, advertising material (printed matter), promotional material (printed matter), display material (printed matter), trunks, travel cases, travelling trunks, suitcases, travelling bags, flight bags, sports bags for travel, sports bags for everyday use,</p>	
--	--

holdalls, duffel bags, sling bags of leather or imitations of leather, garment bags (for travel), handbags and clutch bags, bags and pouches worn on belts, shoulder bags, panniers, backpacks, beach bags, wheeled bags, briefcases (leatherware), document holders, satchels, school bags and satchels, document cases, attaché cases, pocket wallets, card cases, coin purses not of precious metal, purses, vanity cases, empty toiletries bags (leatherware), wheeled bags, bags, sachets, envelopes and pouches for packaging, of leather or imitations of leather, key cases, of leather or imitations of leather, umbrellas, parasols, sunshades and walking sticks, belts and straps for luggage, luggage label holders of leather or imitations of leather, furniture, mirrors, picture frames, furniture of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, cushions, pillows, mattresses, desks, tables, coffee tables, folding tables, high tables, nightstands, bedside tables, side tables, beds, furniture incorporating beds, furniture being convertible into beds, sofas, sofa beds, travel beds, bed bases, headboards, chests (furniture), chests for storage purposes, armchairs, office chairs, chairs, stools, high stools (furniture), mobile stools (furniture), daybeds, benches (furniture), glassware, namely boxes of glass, figurines of glass, flasks, perfume atomisers, perfume sprayers, porcelain and earthenware, scoops (tableware), pie servers, kitchen ladles, chopsticks, cheese dishes and cheese-dish covers, butter dishes and butter-dish covers, tableware, trays for domestic purposes, dishes, plates, glasses, cups and bowls, cabarets (trays), non-electric coffeepots, teapots, corkscrews, ice buckets, knife rests for the table, napkin rings, carafes, pitchers and jugs, bread baskets, bread boards, coasters for carafes and coasters for glasses (not of paper and other than table linen), egg cups, sugar bowls, tea sets, coffee sets, candy boxes, non-drip collars (for wine bottles), candelabra (candlesticks), candlesticks, vases, moneyboxes, works of art of porcelain, terra cotta or glass, storage tidies (household

<p>containers), baskets, cups, household trays and containers, bathroom accessories, namely tooth mug holders, toothbrush holders, toothbrush mugs, towel holders, soap dishes, soap holders, chopsticks, candle jars (holders), candle extinguishers, saucer lights with snuffers, sheets, travelling rugs, cushion covers and pillowcases, curtains, net curtains, upholstery fabrics, curtain fabrics, linen, table linen, bed linen, household linen, kitchen linen, bath linen, blankets, towels, face towels, bath towels, beach towels, table napkins, duvets, eiderdowns, covers for eiderdowns and duvets, textiles for the manufacture of bedding, clothing, headgear, T-shirts, neckties, scarves, carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile), wallpaper, games and playthings, soft toys, mechanical playthings, electronic playthings, remote-controlled playthings, scale model vehicles, vehicles (playthings), remote-controlled vehicles (playthings), balls for games, balloons for games, play balloons, playing cards, card games, board games, table-top games, parlour games, jellies, jams, edible oils and fats, coffee, tea, cocoa and artificial coffee, pastries and confectionery, edible ices, honey, salt, mustard, vinegar, sauces (condiments), spices, tobacco, smokers' articles, matches, lighters, electronic cigarettes, snuff boxes, cigarette cases, ashtrays, pipes.</p>	
<p>CI 39 Issuing of tickets for travel; Issuing of transport papers; Travel reservations and bookings; Booking and reservation of transport; Reservation and rental, including online, of travel tickets, in particular by train; Transport; Freightage (shipping of goods); Passenger transport; Transportation of luggage; Transport of parcels; Railway transport; Collection, removal, storage, forwarding and delivery of goods, luggage and parcels; Loading and unloading cargo; Parking place, parking area and garage rental; Loan and rental of vehicles, rail carriages, wagons, lorries, vans, cars, motorcycles, bicycles; Shipping services; Transit services; Packaging, packing and wrapping of products, goods and packages;</p>	

<p>Vehicle garages (parking); Travel agency services; Organisation of transport and travel, including by rail; Arranging of excursions; Arranging of tours and sightseeing tours; Reservation and rental, including online, of travel tickets, in particular by train; Escorting of travellers; Chauffeur services; Taxi transport; Online transport and travel information, in particular by train; Information, including online, relating to transport fares and timetables, in particular by train and car.</p>	
<p>CI 41 Publishing, including publication and electronic and online publication, newspapers, magazines, periodicals, bulletins, newsletters, pamphlets, manuals, guides; Publication of texts, other than publicity texts; Entertainment; Musical entertainment; Cinematographic and/or video entertainment; Entertainment by interactive means or online, including via the Internet; Sporting and cultural activities; Arranging of games, competitions, trade fairs and exhibitions, for educational, training, cultural, sport and/or entertainment purposes; Arranging and production of concerts, shows, films and cultural events; Arranging of meetings and cultural events; Party planning (entertainment); Organization of balls; Providing amusement arcade services; Museum facilities (providing-) presentation, exhibitions); Leisure services; Booking of seats for concerts, cinema, shows and exhibitions; Clubs (entertainment, cultural, sport or education activities); Information, including online, relating to education, cultural, entertainment, sport and leisure activities.</p>	<p>CI 41 Teaching; education; training; entertainment services; production of television programs; film distribution; production of shows; production of films; arranging, conducting and organisation of workshops; conducting of seminars and congresses; arranging of exhibitions for cultural purposes; organizing and arranging exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes; provision of non-downloadable films.</p>
<p>CI 43 Providing of food and drink (food, dishes, snacks, dishes or meals), on site or to take away, including on trains; Bars and snack bars, fixed or moving, including on trains; Snack-bars; Self-service restaurants; Catering; Organization of banquets and cocktail-parties; Temporary accommodation; Hotel services; Room reservation services; Hotel accommodation; Boarding house bookings; Booking of restaurant seats; Information relating to temporary accommodation and restaurants, provided by any means, including</p>	

by electronic means or online.	
CI 44 Beauty care; Beauty salons; Care services (saunas), spas (care and beauty services); Beauty and make-up advice via all kinds of communications media; Hygienic care for human beings; Advice on care and parapharmaceuticals; Manicuring; Massage; Wellbeing salons, namely clinics for beauty care, manicure, massage and saunas; Hair salon services.	

Class 9

41. The goods "*video films*" of the contested application are similar to a low degree to the services "*cinematographic and/or video entertainment*" of the earlier trademark. Even though goods and services are in principle different by nature, they can be found similar due to their complementarity. The Office is of the opinion that the goods may be the tangible result of the aforementioned services. They are aimed at the same end users and have the same purpose and may be expected to have the same origin by the end users. Therefore they are similar to a low degree.

42. The remaining goods in Class 9, namely "*computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data- carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; microprocessors; keyboards*" of the contested sign differ by their nature, intended purpose and method of use and nor are they in competition or are they complementary to the goods and services of the earlier trademark. Therefore these goods are dissimilar. The mere fact that goods such as "*computer hardware and electronic data processing equipment*" can be used in offices does not support the opponent's finding that these goods are therefore similar to "*office requisites (except furniture)*" as mentioned in Class 16 of the earlier trademark. They differ by nature and intended purpose. Moreover, they are provided for by different manufacturers.

Class 14

43. The goods "*chronometric instruments*" of the contested sign are similar to the goods "*movements for watches, clocks; housings for watches; watch springs or glasses; cases for watches*" of the earlier right. These goods are constituent parts of the contested goods which include watches. They will therefore most likely originate from the same manufacturers and will be distributed through the same distribution channels. The goods are similar.

44. The goods "*precious metals; jewellery; precious stones*" of the contested sign are dissimilar to the goods "*alloys of precious metal*" of the earlier trademark. The opponent's goods are valuable materials used in the manufacture of the defendant's goods, but this association alone is not sufficient to establish a similarity between them, since metals and their alloys are not available in a raw or unworked

condition in jewellery stores. The goods in question have different uses and target different consumers (for instance, the general public versus professional jewellers). Their distribution networks and their origins are also different and they are neither interchangeable nor in competition. The goods are dissimilar.

Class 26

45. The goods *"lace; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers; embroidery"* of the contested sign are different to all the opponent's goods and services. They differ in their nature and purpose. Their producers, relevant public and distribution channels are also different. They are not in competition with, or complementary to, each other. The opponent states that "these goods can be used together as components for the manufacture or finished products made of textile" (as mentioned in Class 24) and that they are complementary (to some of the goods in Class 24) "since they may be used as decorations or tools for decorations" for these goods. The Office would like to clarify that the mere fact that a certain product can be composed of several components does not establish automatically similarity between the finished product and its parts (EGC, Mobilix, T-336/03, 27 October 2005, EU:T:2005:379). Similarity will be found only in exceptional cases and requires that at least some of the main criteria for a finding of similarity, such as the goods having the same producers, having the same public and/or being complementary, are fulfilled. Complementarity between goods means that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods lies with the same undertaking (EGC, Flaco, T-74/10, 11 May 2011, EU:T:2011:207); Artis, T-558/11, 21 November 2012, EU:T:2012:615 and Dignitude, T-504/11, 4 February 2013, EU:T:2013:57). In the present case, the criterion of complementarity is not met, since it is not common in the market for components such as ribbons, braid, buttons, hooks and eyes or pins to be produced by, or under the control of, the 'original' manufacturer of the goods in which these components are incorporated, and the public would not expect this to be the case. Where the goods are parts or components, the criterion of complementarity is not applicable to the analysis of similarity. Even if the components are also sold independently in textile handicraft shops, textile stores or haberdasher's shops, as stated by the opponent, this is not sufficient to justify a finding of similarity. The goods are dissimilar.

Class 41

46. The services *"teaching; education; training; arranging, conducting and organisation of workshops; conducting of seminars and congresses"* of the contested application are similar to the services *"arranging of games, competitions, trade fairs and exhibitions, for educational purposes"* of the earlier trademark. They have the same nature (educational activities) and purpose (education) and can originate from the same providers companies and are aimed at the same public. These services are therefore similar.

47. The services *"entertainment services; production of television programs; film distribution; production of shows; production of films; organizing and arranging exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes; provision of non-downloadable films"* of the contested application are all "entertainment" services and are therefore identical to these services as

mentioned in right invoked. Indeed, 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; Arthur et Félicie, T-346/04, 24 November 2005, ECLI:EU:T:2005:420 and Prazol, T-95/07, 21 October 2008, ECLI:EU:T:2008:455).

48. Lastly, the services "*arranging of exhibitions for cultural purposes*" of the contested application are identical or (highly) similar to the services "*cultural activities and arranging of meetings and cultural events*" of the earlier right.

Conclusion

49. The goods and services of the earlier trademark and the contested application are partly identical, partly similar and partly not similar.

A.2 Global assessment

50. 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.

51. 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 goods and services concerned are targeted at the public in general. For these goods and services the average level of attention of the public concerned may be deemed normal, with the exception of the goods as mentioned in Class 14, which are luxury items and not purchased regularly and because they are generally bought through a salesperson, whether or not as a gift. Therefore a relatively high degree of attention on the part of the consumer may be assumed (see also EGC, quantum, T-147/03, 12 January 2006, ECLI:EU:T:2006:10).

52. 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).

53. 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). The letter combination "OE" is without meaning in relation to the goods and services for which it is registered. Therefore the distinctive character of the earlier trademark may be deemed at least normal.

54. 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. The Office thereby stresses the fact that both signs are aurally identical and visually highly similar, when it comes to the shared and dominant word element "OE".

Conclusion

55. In view of the aforementioned circumstances, including the visual and aural similarity combined with the identity and similarity of (some of) the goods and services, the Office is of the opinion that the relevant public, even with a higher degree of attention, might believe that the identical and similar goods originate from the same undertaking or from economically-linked undertakings.

B. Conclusion

Based on the foregoing the Office is of the opinion that there is a likelihood of confusion for the goods and services which were found to be identical or similar.

IV. DECISION

56. The opposition with number 2013031 is partly justified.

57. Benelux application with number 1349771 will not be registered for the following goods and services which are identical or similar to the goods and services of the right invoked:

- CI 9: *Video films.*
- CI 14: *Chronometric instruments.*
- CI 41: *(all services).*

58. Benelux application with number 1349771 will be registered for the following goods which are not similar to the goods and services of the right invoked:

- CI 9: *Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data- carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; microprocessors; keyboards.*
- CI 14: *Precious metals; jewellery; precious stones.*
- CI 26: *(all goods).*

59. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.28(3) IR, as the opposition is partly justified.

The Hague, 29 May 2019

Tomas Westenbroek
(*rapporteur*)

Diter Wuytens

Willy Neys



Administrative officer: Jeanette Scheerhoorn