

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2013108
of 1 October 2018

Opponent: **citizenM IP Holding B.V.**
Leidseweg 219
2253 AE Voorschoten
The Netherlands

Representative: **NLO Shieldmark B.V.**
New Babylon City Offices Anna van Buerenplein 21 A
2595 DA Den Haag
The Netherlands

Invoked right : **EU trademark 6444251**

CITIZEN M

against

Defendant: **Grigory Dubois**
Rue de la reine 1
5600 Philippeville
Belgium

Representative: /

Contested trademark: **Benelux application 1350523**

Citizen Cook

I. FACTS AND PROCEEDINGS

A. Facts

1. On 17 March 2017 the defendant filed an application in the Benelux for the word trademark 'Citizen Cook' for goods and services in classes 9, 35, 42 and 43. This application was processed under number 1350523 and was published on 23 March 2017.

2. On 18 May 2017 the opponent filed an opposition against the registration of the application. The opposition is based on EU trademark 6444251 of the word mark CITIZEN M filed, on 19 November 2007 and registered on 9 October 2008 for services in classes 35 and 43.

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

4. The opposition was initially directed against all goods and services of the contested application, but afterwards limited to the services in classes 35 and 43. The opposition is based on all services of the trademark invoked.

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

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and was notified to the parties on 19 May 2017. 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 6 December 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 limits the services against which the opposition is directed to the services in classes 35 and 43 of the defendant.

10. The opponent points out that the right invoked is almost completely incorporated in the contested application. The identical first element CITIZEN of the signs will have to be taken into account when assessing the likelihood of confusion. Furthermore, the element CITIZEN is to be regarded as the dominant part of the contested sign, as the element COOK is descriptive in relation to the services in classes 35 and 43. The opponent concludes that the signs are visually similar to a high degree.

11. Aurally, both signs consist of four syllables. Although the second word of the contested application contains a phonetic difference with the opposing mark, the opponent is of the opinion that the pronunciation of the first word CITIZEN is identical to the contested sign. Thus the signs are aurally highly similar according to the opponent.

12. The common element CITIZEN is a noun and means 'a legally recognized subject or national of a state or commonwealth, either native or naturalized', 'an inhabitant of a particular town or city'. The letter M in the right invoked has no specific meaning. The opponent also explains that the word COOK refers to 'a person who prepares and cooks food'. Conceptually, the right invoked has no specific meaning considered as a whole in relation to the services concerned. The contested application can conceptually refer to a 'citizen that cooks or is a cook'. The opponent finds that there is no such conceptual difference that the visual and aural similarity between the signs is counteracted by an explicit conceptual difference.

13. Given the foregoing, the opponent concludes that the signs are highly similar.

14. As for the comparison of the services the opponent explains that the services of the right invoked are either identical or similar to the services of the contested sign.

15. The services concerned are services, the consumer is regularly confronted with. The average consumer may therefore be regarded as reasonably observant, according to the opponent.

16. The opponent is of the opinion that the right invoked has at least a normal, if not a greater distinctive character. The CITIZEN M hotels represent a highly popular concept which results in the rapid growth of hotels all over the world. In the Benelux there are CITIZEN M hotels located in Amsterdam and Rotterdam.

17. Based on the foregoing, the opponent concludes that the public may think that the services of the defendant have the same origin or originate from economically related companies as the opponent's. Therefore, there is a risk of confusion. The opponent thus asks the Office to grant the opposition and to order the defendant to bear the costs related to these proceedings.

B. Arguments of the defendant

18. The defendant is of the opinion that the limitation of the opposition by the opponent implies that he recognizes that the defendant and the opponent carry out different activities. Any claim of confusion regarding the average consumer for the services concerned is therefore just not worth considering. Furthermore, he states that similarity between the services in question has already been addressed and shown different.

19. As for the comparison of the signs, the defendant states first of all that the word CITIZEN is a generic name. As it results from a simple search in the Benelux register on the word CITIZEN, there already appear to be 80 matches, some of which are way closer to the right invoked than the contested sign. Furthermore, the second word 'Cook' gives a preview of what the contested sign is all about, food. The combination of the two words raises a distinct and evocative activity. According to the defendant, the element COOK is to be considered as different from the letter M, which the opponent defines as meaningless. The defendant also adds that online tools established 0% similarity between the two signs when compared.

20. The defendant compares the services of the contested sign and those of the right invoked and states that the word 'food' appears 8 times in the list of contested services as to only once for the list of services for the right invoked. He thus stays far away from the opponent's field of activity (hospitality).

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 services

24. In assessing the similarity of the services concerned, all the relevant factors relating to these 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).

25. In the comparison of the services of the trademark invoked and the services against which the opposition is filed, the services are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

26. The services to be compared are the following:

Opposition based on:	Opposition directed against:
CI 35 Advertising; business management.	CI 35 Online retail services connected with the sale of food and drink; management of food ordering systems; business advice; customer relationship management; customer support services relating to online orders and collection of orders; provision of business information and business consultancy services relating to individuals engaging in the cooking of food for customers; advertising services including the provision of an online advertising marketplace for customers to search for selected chefs; marketing and promotion services; advisory and consultancy services relating to all of the aforesaid services.
CI 43 Providing of food and drink, temporary accommodation; temporary accommodation reservations; hotel, motels and floating hotels, restaurants and bars; rental of conference rooms, rental of venues for exhibitions, seminars and meetings; catering and other hotel and catering services.	CI 43 Booking services for takeaway food and drink; services for providing food and drink; arranging for the provision of food and drink; food and drink hospitality services; food and drink preparation services; food and drink takeaway services; provision of information relating to food and drink; advisory and consultancy services relating to all of the aforesaid services.

Class 35

27. The defendant's *Advertising services including the provision of an online advertising marketplace for customers to search for selected chefs; marketing and promotion services* are identical to the opponent's *Advertising services*. 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). All advertising, marketing and promotion services of the defendant can be considered as a specific type of advertising service and they can thus be considered identical.

28. The defendant's *Online retail services connected with the sale of food and drink* are similar to the opponent's *Business management services*. Retail services concern a commercial business that needs to be managed in order to be profitable. The defendant's and opponent's services are therefore similar as to their nature and destination (Opposition decision BOIP *Pinkberry*, 2001848, 3 July 2009).

29. The defendant's *Management of food ordering systems; business advice; customer relationship management; customer support services relating to online orders and collection of orders; provision of business information and business consultancy services relating to individuals engaging in the cooking of food for customers* are similar to the opponent's *Business management* services. The defendant's services have some relevant points of contact with the opponent's business management as they are intended to help companies to manage their business by setting out the strategy and/or direction of the company. Business management services aim to gather information and provide tools and expertise to enable their customers to carry out their business or provide businesses with the necessary support to acquire, develop and expand market share. Both sets of services may derive from the same undertakings and be aimed at the same consumers, meaning also a match in distribution channels. As such the services under comparison are similar

Class 43

30. The defendant's *Services for providing food and drink* are identical to the opponent's services *Providing of food and drink*.

31. The defendant's *Booking services for takeaway food and drink; arranging for the provision of food and drink; food and drink hospitality services; food and drink preparation services; food and drink takeaway services; provision of information relating to food and drink* are similar to the opponent's *Providing of food and drink* services in class 45 (now class 43). All of the defendant's services relate to the provision of food and drink and how to facilitate this. The services of the defendant and the opponent both share the same purpose and the same method of use. They are provided by the same undertakings that have the expertise in the field of providing food and drinks, their preparation and the service related to their provision to third parties. Furthermore, these services also target the same relevant public and some are also in competition.

32. Finally the Office observes that the lists of services in classes 35 and 43 of the contested sign are both concluded by the following text *advisory and consultancy services relating to all of the aforesaid services*. The Office considers that these advisory and consultancy services relating to all of the aforesaid services can all be provided by the same undertakings as those providing the services to which they relate, thus allowing the same conclusion to be drawn regarding the similarity of these services.

Conclusion

33. The services against which the opposition is directed are either identical, or similar to the services of the opponent.

Comparison of the signs

34. 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).

35. 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).

36. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
CITIZEN M	Citizen Cook

Conceptual comparison

37. Both the right invoked and the contested sign refer to 'citizen' meaning 'a legally recognized subject or national of a state or commonwealth, either native or naturalized'¹.

38. The letter M in the right invoked refers to a letter of the alphabet but has no precise meaning in itself.

39. The word Cook in the contested sign will either be perceived as an English verb meaning 'prepare (food, a dish, or a meal) by mixing, combining and heating the ingredients', or as an English noun meaning 'a person who prepares and cooks food, especially as a job or in a specified way'². The Benelux public will immediately understand the meaning of this word, either as a noun or as a verb, as it belongs to his basic knowledge of the English language.

40. Generally, the public will not consider a descriptive element forming part of a mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003, ECLI:EU:T:2003:184). This is the case for the word element Cook in the contested sign. In relation to the provision of food and drinks the word Cook is descriptive as it can refer to the person who will provide the food and drink or it can refer to the way in which the food and drinks will be prepared. Given the descriptive character of the element Cook for the services at issue, it will not be perceived as the dominant element of the sign.

41. The signs are similar to the extent that they both refer to the same concept of 'citizen'. They differ because of the addition of respectively the letter M in the right invoked and the word 'Cook' in the contested sign.

42. The signs are thus conceptually similar to a certain degree.

Visual comparison

43. The right invoked is a word mark, consisting of one word of seven letters, CITIZEN, followed by the letter M. The contested sign is also a word mark, consisting of two words of seven and four letters, Citizen Cook. The trademark invoked is displayed in capital letters. The contested sign is displayed in small letters except for the first letters of both words. 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).

¹ <https://en.oxforddictionaries.com/definition/citizen>.

² <https://en.oxforddictionaries.com/definition/cook>.

44. The consumer normally attaches more attention 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 word in the right invoked and the contested sign CITIZEN is identical. The signs differ in their second element, a letter M in the right invoked and the word Cook in the contested sign.

45. The Office finds that the signs are visually similar.

Aural comparison

46. The right invoked is pronounced in four syllables: CI-TI-ZEN M. The contested sign is also pronounced in four syllables: CI-TI-ZEN COOK.

47. As already mentioned, consumers generally take more note of the beginning of a sign than of its end (Mundicor, already cited). Aurally the first word of the signs is pronounced identically. The pronunciation of the signs only differs because of the second element, respectively M and Cook.

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

Conclusion

49. The right invoked and the contested sign are conceptually similar to a certain degree. Visually and aurally they are considered 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 in accordance with the category of goods or services in question. The services at issue are intended for the public at large with a normal level of attention.

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. 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.

54. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). In the present case, the trademark invoked has a normal level of distinctiveness, as it is not descriptive of the services concerned.

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

B. Other factors

56. The opponent is of the opinion that the right invoked has at least a normal, if not a greater distinctive character (paragraph 16). As a risk of confusion has already been established a greater distinctive character of the right invoked does not need to be investigated as it will not affect the outcome of this opposition.

57. The defendant argues that the limitation of the opposition by the opponent implies that he recognizes that the defendant and the opponent carry out different activities (paragraph 18). The fact that the opponent has, for whatever reason, limited the services against which the opposition is directed cannot in itself be considered as a recognition that the defendant and the opponent carry out different activities. It is up to the opponent to decide whether or not he wants to file an opposition against all or part of the goods and services of the contested application.

58. Regarding the defendant's observation concerning the fact that a simple search in the Benelux register on the word CITIZEN gives 80 matches (paragraph 19), the Office admits that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between the two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings, the defendant has duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC, Top iX, T-57/06, 7 November 2007 and LIFE BLOG, T-460/07, 20 January 2010, ECLI:EU:T:2010:18). In this case, however, no evidence of such a kind, has been provided by the defendant.

59. The defendant considers that in the description of classes 35 and 43 the word 'food' appears 8 times in CITIZEN COOK's list of services as to only once for the list of services for the contested sign. He thus finds that he stays far away from the opponent's field of activity (hospitality) (see paragraph 20). This argument is not relevant in the assessment of the similarity of the services. It is not sufficient to count the number of times a certain noun is mentioned in the list of services of the contested sign and compare it to the number of times it is mentioned in the list of services of the right invoked, then make a mathematical comparison and draw conclusions as to the similarity of the services. The comparison of the services is solely based on the services as mentioned in the registration, possibly limited by the evidence of genuine use provided by an opponent (CJEU, Quantum, C-171/06, 15 March 2007, ECLI:EU:C:2007:171; 02 Holdings Limited, C-533/06, 12 June 2008, ECLI:EU:C:2008:339; EGC, Ferromix e.a., T-305/06-T-307/06, 15 October 2008, ECLI:EU:C:2008:339).

C. Conclusion

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

IV. DECISION

61. The opposition with number 2013108 is justified.

62. Benelux application with number 1350523 will not be registered for the following services against which this opposition is directed:

- Class 35: All services.
- Class 43: All services.

63. Benelux application with number 1350523 will be registered for the following goods and services against which this opposition was not directed:

- Class 9: All goods.
- Class 42: All services.

64. 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, 1 October 2018

Tineke Van Hoey
(*rapporteur*)

Willy Neys

Pieter Veeze

Administrative officer: Cees van Swieten