



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2013481
of 29 February 2024

Opponent: **ERG S.P.A.**
Via de Marini 1
16149 Genova
Italy

Representative: **Lydian cvba**
Havenlaan 86
1000 Brussel
Belgium

Invoked right 1: **European registration 5733019**



Invoked right 2: **European registration 7292709**



Invoked right 3: **European registration 12423125**

ERG RENEW OPERATIONS & MAINTENANCE

against

Defendant: **Eurasian Resources Group S.à r.l.**
Rue Sainte Zithe 9

2763 Luxembourg
Luxembourg

Representative: **NLO Shieldmark B.V.**
Anna van Buerenplein 21 A
2595 DA Den Haag
Netherlands

Contested sign: **Benelux accelerated registration 1018221**

ERG

I. FACTS AND PROCEEDINGS

A. Facts

1. On 20 July 2017 the defendant filed an accelerated Benelux application for the word mark ERG for goods and services in classes 1, 2, 4, 6, 7, 9, 12, 14, 19, 35, 37, 39, 40, 41, 42 and 45. This application was processed under the number 1357927. The accelerated registration was published with registration number 1018221 on 1 August 2017.

2. On 28 September 2017 the opponent filed an opposition against the registration of the application. The opposition is based on the following older rights:

- European registration with number 5733019 of the combined word/figurative mark



, filed on 20 February 2007 and registered on 23 January 2008 for goods and services in classes 1, 3, 4, 9, 21, 37, 38 and 40 (hereinafter: invoked trademark 1);

- European registration with number 7292709 of the combined word/figurative mark



, filed on 7 October 2008 and registered 14 May 2009 for goods and services in classes 1, 4, 7, 9, 37, 38, 39, 40 and 42 (hereinafter: invoked trademark 2);

- European registration with number 12423125 of the word mark ERG RENEW OPERATIONS & MAINTENANCE, filed on 12 December 2013 and registered on 13 May 2014 for goods and services in classes 7, 9, 11, 35, 37, 39, 40 and 42 (hereinafter: invoked trademark 3).

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

4. The opposition is based on the goods and services in classes 1, 4, 37 and 40 of invoked trademark 1, goods and services in classes 1, 4, 37, 39 and 40 of invoked trademark 2, and services in classes 37, 39, 40 and 42 of invoked trademark 3. The opposition is directed against all goods and services in classes 1, 4, 7, 9, 37, 39, 40 and 42 of the contested sign.

5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 29 September 2017. On the joint request of the parties the opposition proceedings were suspended several times. The administrative proceedings commenced on 7 December 2022. During the administrative phase of the proceedings the defendant requested proof of use of the invoked trademarks and both parties filed arguments. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 19 July 2023.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. 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: Likelihood of confusion based on the identity or similarity of trademark and sign and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

8. Opponent is an Italian based company active in the production of energy from wind, sun and natural gas in France, Germany, Italy, Spain, Sweden, Poland, Romania, Bulgaria and the United Kingdom. The company is a leading independent operator of clean energy from renewable sources in Europe. Defendant is a natural resources producer and a mining and smelting group.

9. According to opponent the signs are visually very similar. The contested sign consists of the word ERG. The earlier trademarks are all dominated by the same and identical word element ERG. Considering that the visually dominant element in the trademarks at stake is the word ERG, it is very likely that the public will be more attentive to this word and will dismiss the other words RENEW OPERATIONS & MAINTENANCE which allude to the kind of designated activity. Phonetically the contested sign and invoked trademarks 1 and 2 are identical. The first word of invoked trademark 3 is also identical. From a conceptual point of view none of the signs at stake have a meaning for the public in the relevant territory. A conceptual comparison is therefore not relevant.

10. With regard to the comparison of the goods and services opponent provides a detailed overview of the goods and services that he considers to be very similar or identical and which are found in almost identical terms in the lists of goods and services of both the invoked trademarks and the disputed trademark.

11. According to opponent the earlier trademarks possess at least an average distinctive character per se because they do not in any way describe the goods and services for which they have been registered.

12. The visual and phonetic comparison suffices to conclude that the signs are very similar as the dominant element in the signs is the word ERG. During the global assessment by an average consumer, the only differences between the signs, namely differing graphic designs in the invoked trademarks or the additional words, will not at all be noticed.

13. Opponent concludes that there is a risk of confusion, and that the opposition is fully justified.

14. In reply to the request of defendant to submit proof of use, opponent stated that invoked trademark 3 is not yet subject to a requirement of use and that opponent will not produce proof of use for the invoked trademarks 1 and 2.

B. Defendant's arguments

15. Defendant first requested proof of use before filing the full observations. In his observations defendant mentions that opponent did not produce proof of use with regard to invoked trademarks 1 and 2. Therefore, these trademarks should not be included in the decision. Defendant therefore bases his observations only on the remaining trademark 3.

16. According to defendant no confusion is likely. The element ERG of the invoked trademark has a low or weak distinctive character. ERG in the energy sector has a fixed meaning. ERG is a unit of energy. It

originated in the Centimetre-gram-second system of units (CGS). The name is derived from egon, a Greek word meaning 'work' or 'task'. Since the opponent is a company operating in energy, the trademark ERG has besides the fact that a three-letter mark is not very distinctive, also a relevant meaning in the sector and is therefore descriptive. The relevant public of opponent's business is a professional public and therefore they can understand the meaning and reference to the word ERG as being a unit of energy.

17. Defendant, Eurasian Resources Group (ERG), is a leading diversified natural resources group and has a portfolio of production assets and development projects in more than 16 countries, and is represented by over 80.000 people globally, including contractors, being a major employer in the industry. The name of the company as well as the trademark is always pronounced as an abbreviation and not as a single word with a meaning. The contested sign ERG has a high reputation and gained distinctiveness through use.

18. The relevant public in this case is professional. Defendant's business is with strategic business partners and governments. Opponent's business is also aimed at the professional public and specialist consumers in the energy sector. Therefore, there is a higher level of attention.

19. Aurally ERG RENEW OPERATIONS & MAINTENANCE consists of five words compared to one word resulting in a low similarity. The element ERG in the invoked trademark 3 is pronounced as one word, while the contested sign is an abbreviation of Eurasian Resource Group and is always pronounced as separate letters of the alphabet and not as a word. Therefore, the signs are aurally not similar/different.

20. Visually the signs are not similar. In the invoked trademark the public's attention will not be focussed on the weak, descriptive first word element, but rather on the entire slogan and the last word of the long slogan.

21. Conceptually the signs are not similar. In the invoked trademark ERG has a meaning in the energy business. The contested sign is merely an abbreviation of Eurasian Resources Group and has no relevant meaning. Alternatively and subsidiary defendant follows what opponent states, namely that a conceptual comparison is not relevant.

22. Subsequently defendant compares the goods and services taking into account the fact that opponent withdrew invoked trademarks 1 and 2. Defendant also mentions that looking at the schedule in the arguments of opponent, opponent limited the goods and services they oppose to. Defendant explains that the goods and services in classes 1, 4, 7, 9, 37 are not to be regarded as similar and should be fully registered. In class 39 only the services "*transport and distribution of electricity; transport and distribution of heating*" are similar. In class 40 the services "*production and generation of electricity; production and generation of heating*" are identical/similar. The other services in class 40 should be registered. Defendant furthermore explains that the services in class 42 are not similar to services in class 42 of the invoked trademark 3.

23. Defendant concludes with a global assessment. The relevant public will be able to distinguish the signs. There does not exist a likelihood of confusion. The opposition must be rejected in full or subsidiary partly. Defendant requests the Office to reject the opposition and have the opponent bear the costs incurred by defendant.

III. DECISION

A Genuine use

24. Defendant requested proof of use of the invoked trademarks. Opponent replied that the invoked trademark 3 is not subject to a requirement of use. Opponent did not produce proof of use regarding invoked trademarks 1 and 2 (see above under 14).

25. Given the above, the opposition proceedings proceed solely based on the invoked trademark 3.

B Likelihood of confusion

26. Article 2.2ter, 1 BCIP stipulates insofar as relevant 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."*¹

27. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.²

28. According to settled case-law of the Court of Justice of the European Union (hereinafter: "CJEU"), the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.³

Comparison of the goods and services

29. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. 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.⁴

30. Goods and services are complementary when they 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.⁵

31. In comparing the goods and services, the goods and services shall be considered in the terms set out in the register, and not the actual or intended use.⁶

¹ Art. 2.2ter, 1, b BCIP implements art. 5, 1, b 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. A similar provision can be found in art. 8, 1, b Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

² CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 and the case-law mentioned there (Equivalenza).

⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁵ General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

⁶ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

32. Opponent included an overview and comparison of some goods and services in his arguments stating that these goods and services are very similar or identical (see above under 10). The Office takes this overview of opponent as a starting point and as a limitation of the goods and services on which the opposition is based on and directed against.⁷

33. Since the opposition is no longer based on the invoked trademarks 1 and 2 (see above under 24 and 25) the comparison based on goods and services of the invoked trademarks 1 and 2 is deleted from the overview provided by the opponent. To the extent that the opposition directed against certain goods and services of the contested sign was solely based on the invoked trademarks 1 and 2, the opposition cannot succeed.

34. Given the above, the services to be compared are the following:

Opposition based on:	Opposition directed against:
<u>Invoked trademark 3:</u> CI 37 Construction, repair, installation and maintenance of systems for generating electricity, wind power and alternative energies in general.	CI 37 Construction, repair and maintenance services, in particular of industrial facilities, transport vehicles and constructions; repair and maintenance of railcars and locomotives.
<u>Invoked trademark 3:</u> CI 39 Distribution, storage, supply of energy and sale of energy.	CI 39 Transport and distribution of electricity; transport and distribution of heating.
<u>Invoked trademark 3:</u> CI 40 Generation of electricity and energy, for others; Energy production.	CI 40 Production and generation of electricity; production and generation of heating.
<u>Invoked trademark 3:</u> CI 42 Technical and engineering studies, research and design, in particular relating to energy, renewable energy and technologies necessary for the development thereof.	CI 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services in particular in relation to production technologies and marketing of products, including material testing, quality control, technical project studies, engineering work; hosting of the digital online platform containing and providing news and information, as well as various digital services.

Class 37

35. Opponent argues that the services in class 37 of the contested sign are very similar or identical to the services in class 37 of invoked trademark 3. Defendant has disputed with reasons that there is similarity. The Office agrees with defendant that there is no similarity. Although the services all relate to construction, repair and maintenance, and therefore coincide in their nature, the specific fields are very different (electricity/wind power and transport vehicles/railcars). They also target a different public. Furthermore the services are not in competition with each other nor are they complementary. The services are dissimilar.

⁷ BenCJ (second chamber) 18 October 2022, C 2021/13, points 17-19 (Sitel).

Class 39

36. Opponent argues that the services in class 39 of the contested sign are very similar or identical to the services in class 39 of the invoked trademark 3. Defendant explains that "*transport and distribution of electricity; transport and distribution of heating*" in class 39 of the contested sign are indeed similar to the services in class 39 of invoked trademark 3. The Office assumes with the parties that the services are similar.

Class 40

37. Opponent argues that the services in class 40 of the contested sign are very similar or identical to the services in class 40 of the invoked trademark 3. Defendant explains that the "*Production and generation of electricity; production and generation of heating*" in class 40 of the contested sign are indeed identical/similar to services in class 40 of the invoked trademark 3. The Office assumes with the parties that the services are identical/similar.

Class 42

38. Opponent argues that the services in class 42 of the contested sign are very similar or identical to the services in class 42 of the invoked trademark 3. Defendant argued that the services are not similar. According to the Office, the services "*Scientific and technological services and research and design relating thereto;*" are identical or similar to the services "*Technical and engineering studies, research and design, in particular relating to energy, renewable energy and technologies necessary for the development thereof*" for which invoked trademark 3 is registered in class 42. Not only are these services mentioned in almost identical wordings but they definitely coincide in their nature and target the same public and are therefore considered to be partly identical and partly (highly) similar.

39. The services "*industrial analysis and research services in particular in relation to production technologies and marketing of products, including material testing, quality control, technical project studies, engineering work; hosting of the digital online platform containing and providing news and information, as well as various digital services*" in class 42 of the contested sign are according to the Office not similar to the services in class 42 of the invoked trademark 3. The object and nature of these services differ.

Conclusion

40. The goods and services are partly not similar and partly identical or (highly) similar.

41. Insofar as the opposition is directed against services in class 37 and 42 (see above under 35 and 39) of the contested sign that are found not similar the opposition cannot succeed, because there can be no likelihood of confusion if there is no similarity between the goods and services involved.

42. For the services in classes 39, 40 and 42 of the contested sign that are identical or similar (see above under 36, 37 and 38), the Office will proceed with the global assessment of the likelihood of confusion.

Comparison of the signs

43. To assess the degree of similarity between the conflicting signs, their visual, phonetic and conceptual similarity should be determined. The comparison must be based on the overall impression given

by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.⁸

44. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.⁹ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.¹⁰

45. The assessment of the similarity between the signs, regarding the visual, phonetic and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, *inter alia*, their distinctive and dominant components.

46. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
Invoked trademark 3: ERG RENEW OPERATIONS & MAINTENANCE	ERG

Visual comparison

47. The invoked trademark 3 is a word mark containing of four words of in total 29 letters and an ampersand: ERG RENEW OPERATIONS & MAINTENANCE

48. The contested sign is a word mark consisting of one word of three letters: ERG.

49. In the invoked trademark 3 the word element ERG is dominant. Firstly, because the consumer normally attaches more importance to the first part of words.¹¹ Secondly, because the Office is of the opinion that other word elements RENEW, OPERATIONS & MAINTENANCE are descriptive for the goods and services concerned.

50. The contested sign consists of the dominant element ERG of the invoked trademark 3.

51. Based on the above the Office is of the opinion that the signs are visually similar to a high degree.

Aural comparison

52. According to the Office the invoked trademark 3 and the contested sign will also be pronounced highly similar. Although the signs differ in length and rhythm, the identical syllable ERG in both signs is

⁸ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivaleza).

⁹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivaleza).

¹⁰ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 and 35 (Matratzen) and 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

¹¹ General Court (EU) 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

dominant and will also aurally receive the most attention (see above under 49 and 50). In addition, it is possible that the public will not pronounce the words RENEW OPERATIONS & MAINTENANCE in the invoked trademark 4, because a mark which includes several words will generally be abbreviated aurally to something easier to pronounce.¹² In that case, the signs are aurally identical.

53. The Office does not follow the argument of defendant that the contested sign will be pronounced as separate letters, because ERG is an abbreviation of Eurasion Resource Group (see above under 19). The Office is not convinced that the relevant (professional) Benelux public will perceive the sign as an abbreviation of Eurasion Resource Group, as defendant also did not substantiate this.

54. Given the above the Office is of the opinion that invoked trademark 3 and the contested sign are at least aurally highly similar.

Conceptual comparison

55. According to defendant ERG has a fixed meaning, namely a unit of energy and is derived from *ergon*, a Greek word meaning 'work' or 'task' (see above under 16). The Office is however not convinced that the relevant (professional) public is aware of these meanings of ERG, as defendant also did not substantiate this.

56. The Office assumes with opponent (see above under 9) that the relevant (professional) public will not address a meaning to the word ERG. A conceptual comparison is therefore not relevant.

Conclusion

57. The signs are visually and aurally similar to a high degree. A conceptual comparison is not relevant.

Global assessment

58. The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.¹³ In the present case the relevant public (of the identical/similar services in classes 39, 40 and 42) consists of professionals. The level of attention will vary from average to high.

59. The higher the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.¹⁴ In the present case the invoked trademark 3 has to be considered as having normal distinctiveness for the goods and services concerned as it does not describe the characteristics of the goods and services in question (see above under 46).

60. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be taken into account and, in particular, between the similarity of the conflicting signs and the

¹² General Court (EU) 30 November 2006, T-43/05, ECLI:EU:T:2006:370, point 75 (Brothers by Camper).

¹³ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.¹⁵

61. In this case the invoked trademark 3 and the contested sign are visually and aurally similar to a high degree. The relevant services in classes 39, 40 and 42 are partly identical and partly similar. On the basis of these and the other factors mentioned above, amongst which the average to high level of attention of the relevant public, and considering their interdependence, the Office considers that there will be a likelihood of confusion in the sense that the public may believe that the goods and services designated by the invoked trademark 3 and the identical/similar services in classes 39, 40 and 42 to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically linked.

Other factors

62. Defendant mentioned that the contested sign ERG has a high reputation and gained distinctiveness through use (see above under 17). In this respect the Office recalls that since it is established that the contested sign is younger than the invoked trademark 3, the defendant cannot rely on the reputation of the contested sign for its claim that there is no likelihood of confusion.¹⁶

C. Conclusion

63. Based on the foregoing, the Office concludes that there is a likelihood of confusion for some services in classes 39, 40 and 42.

IV. DECISION

64. The opposition with number 2013481 is partly justified.

65. The Benelux accelerated registration with number 1018221 will be cancelled for the following services:

- Class 39: "Transport and distribution of electricity; transport and distribution of heating"
- Class 40: "Production and generation of electricity; production and generation of heating"
- Class 42: "Scientific and technological services and research and design relating thereto"

66. The Benelux accelerated registration with number 1018221 will be upheld for the following goods and services as the opposition was not directed against these goods and services (see above under 4 and 32) or because the opposition cannot succeed for these goods and services (see above under 33 and 41):

- Class 1: (all goods)
- Class 2: (all goods)
- Class 4: (all goods)
- Class 6: (all goods)
- Class 7: (all goods)
- Class 9: (all goods)
- Class 12: (all goods)
- Class 14: (all goods)
- Class 19: (all goods)

¹⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, punt 59 and the case-law mentioned there (Equivalenza).

¹⁶ CJEU 3 September 2009, C-498/07 P, ECLI:EU:C:2009:503, point 84 (La Espanola).

- Class 35: (all services)
- Class 37: (all services)
- Class 39: "Transport; railway transport; water vessel transport; car transport; transportation of passengers by bus or cars; freight (shipping of goods); collection, removal, storage, handling and delivery of goods."
- Class 40: "Treatment of materials; treatment of ores and of common metals and their alloys; treatment of metals, including upgrading and refinement."
- Class 41 (all services)
- Class 42: "Industrial analysis and research services in particular in relation to production technologies and marketing of products, including material testing, quality control, technical project studies, engineering work; hosting of the digital online platform containing and providing news and information, as well as various digital services"
- Class 45 (all services)

67. 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 February 2024

Marjolein Bronneman
(*rapporteur*)

Pieter Veeze

Tomas Westenbroek

Administrative officer: Vincent Munier