



BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2014306
of 23 December 2019

Opponent :**Paul International SA**

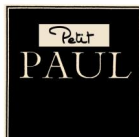
Rue de Saint-Léger 2
1205 Genève
Switzerland

Representative:**Merkenbureau Knijff & Partners B.V.**

Leeuwendeldseweg 12
1382 LX Weesp
Netherlands

Invoked trademark 1:**EU trademark 13155031**

PETIT PAUL

Invoked trademark 2:**EU trademark 13063111***against***Defendant:****Anna&Paul, société à responsabilité limitée**

Rue Pletzer 4B
8080 Bertrange
Luxembourg

Representative:**Office Freylinger S.A.**

Route d'Arlon 234
8010 Strassen
Luxembourg

Contested trademark:**Benelux application 1373838**

I. FACTS AND PROCEEDINGS

A. Facts

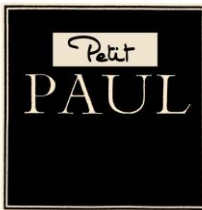
1. On 18 April 2018 the defendant filed a Benelux trademark application for the combined word and



figurative trademark for goods and services in classes 30 and 35. This application was processed under number 1373838 and was published on 15 May 2018.

2. On 13 July 2018 the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:

- European Union trademark 13155031 for the word trademark PETIT PAUL, filed on 8 August 2014 and registered on 18 December 2014 for goods and services in classes 29, 30, 35 and 43;
- European Union trademark 13063111 for the combined word and figurative trademark



, filed on 8 July 2014 and registered on 2 December 2014 for goods and services in classes 29, 30, 35 and 43.

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

5. The grounds for opposition are those laid down in Article 2.14, 2 (a) Benelux Convention on Intellectual Property (hereinafter referred to as: "BCIP").¹

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 17 July 2018. During the administrative phase of the proceedings both parties filed arguments and at the joint request of the parties, the proceedings were suspended. All of the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 16 May 2019.

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.

II. ARGUMENTS OF THE PARTIES

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

9. The opponent states that the signs share the identical element PAUL, preceded by another word. This element is dominant in the contested sign as well as in the rights invoked, as it is situated almost in the middle of the devices, where it draws most of the consumer's attention. Therefore, the opponent concludes that the signs are visually similar.

10. Phonetically, the common element PAUL is pronounced identically. It is preceded by another differing word but, according to the opponent, this difference is not sufficient to offset the similarity. The figurative elements do not play a role in the aural comparison. The opponent concludes that the signs are aurally highly similar.

11. Conceptually, the shared element PAUL refers to a male first name. Because the word "petit" in the rights invoked describes "Paul" and "Anna" implies Paul has company, in the contested trademark, the trademarks are not conceptually identical, but surely highly similar, according to the opponent.

12. The opponent finds that the goods and services of the contested sign are identical or similar to the goods and services of the rights invoked.

13. The opponent concludes that the likelihood of confusion is obvious and he therefore requests that the Office grants the opposition and rejects the contested application.

B. Defendant's arguments

14. According to the defendant, the trademarks under comparison have no verbal elements which could be considered clearly more dominant than other elements. At least, the word element PAUL cannot be considered as the dominant element, because the consumer is unable to affiliate the name PAUL, taken alone, to the origin of the products and services provided. Moreover, the name PAUL is included in many trademarks registered in class 30 and/or 35.

15. Furthermore, the other verbal element of the trademarks, which figures at the beginning of them, is completely different.

16. The defendant points out that the particularly detailed figurative elements of the opposed sign have a higher or at least an equal importance to the verbal elements. In that respect, the figurative elements of the sign have a significant visual impact and cannot be excluded from the visual comparison. In the case at hand, these figurative elements are completely different of those in the rights invoked. The defendant concludes that the signs are not visually similar in their overall impression.

17. Phonetically, the signs only share the identical syllable [pɔl] which is the last one of the trademarks. The beginning of the signs is aurally completely different. Therefore, the defendant concludes that the signs are not aurally similar.

18. Conceptually, the defendant finds that the graphical elements of the opposed application lead to consider the trademarks as completely different. According to the defendant, the intellectual objective

aimed by the detailed design of the opposed trademark is an idea of travel, adventure, a perception that is not found in the earlier trademarks.

19. Furthermore, the word "petit" in the rights invoked will be understood as the adjective "little, small". In that regard, the rights invoked will be understood by the public as "a little boy named Paul". The first name in the contested sign on the other hand, followed by the ampersand, will be understood as a conjunction connecting Anna with Paul, both going on an adventure in a hot-air balloon. The defendant concludes that the signs are not conceptually similar.

20. As the signs involved are highly different, the defendant considers that it is not relevant to focus on the comparison of the goods and services.

21. The defendant concludes that there is no likelihood of confusion between the trademarks in presence and he thus requests that the Office proceeds with the registration of the opposed sign.

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 trademarks

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, C334/05 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:
PETIT PAUL	
	

29. The first right invoked is a purely verbal trademark, consisting of two words of respectively five and four letters. The second right invoked is a combined word/figurative trademark, containing the same words in a black square with a beige-black-beige border. The word "Petit" is depicted in a handwriting font in black letters on a rectangular beige background. The word PAUL appears below it in beige letters.

30. The contested application is a combined word/figurative trademark, consisting of the superposed names ANNA and PAUL with an ampersand between them. These names are placed on a black surface, which appears to be the contours of a hot-air balloon. A stylized basket is hanging on ropes below the balloon. Standing in the basket the contour of a man is depicted, holding a cup in his right hand. In front of him stands a little girl, looking downwards and, according to the defendant, enjoying an ice-cream. On the ropes two flags are waving. Also visible are two sandbags and an anchor which are attached to the basket.

31. As the defendant points out (see point 16), the design of the contested application is particularly detailed. The first right invoked on the other hand contains no figurative elements at all and the second right invoked only some geometrical backgrounds, a handwriting and two basic colours.

32. The signs have an identical element in common, Paul, according to the opponent the dominant element in both the contested sign and the trademarks invoked (see point 9). The Office does not share the opinion that this word is the dominant element in the contested application because of its central

position. The other element, ANNA, is positioned almost as centrally and will draw equally the consumer's attention.

33. Moreover, it is the first part of the sign, to which the consumer normally attaches more value (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). This does not mean that it is automatically the dominant element of the sign, but there is no reason either to consider the element PAUL to be dominant (in this sense GEU, Westlife, T-22/04, 4 May 2005, ECLI:EU:T:2005:160).

34. It is true that the fact that a mark consists exclusively of the earlier mark, to which another word has been added, is an indication that the two trademarks are similar (EGC, ECOBLUE, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). This is especially the case when the element that the signs have in common still has an independent distinctive role in the composed sign (CJEU, THOMSON LIFE, C120/04, 6 October 2005, ECLI:EU:C:2005:594).

35. In the case at hand, the common element PAUL has an independent distinctive role in the contested sign, as it is one of the main elements in it. However, it cannot be said that the rights invoked are integrally repeated in the contested sign, since the first contain the verbal elements PETIT PAUL.

36. According to the opponent, the trademarks are conceptually highly similar because they share the male first name PAUL (see point 11). However, according to established case-law, a common name does not imply that the trademarks are conceptually similar. The purpose of the conceptual comparison is to compare the "concepts" that the marks at issue convey. According to the case-law, conceptual similarity means that the trademarks at issue convey analogous semantic content (see CJEU, Sabel, already cited). Therefore, a first name or a surname which does not convey a "general and abstract idea" and which is devoid of semantic content, is lacking any "concept", so that a conceptual comparison between two trademarks consisting solely of such first names or surnames is not possible. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content (see EGC, Luciano, T-268/18, 27 June 2019, ECLI:EU:T:2019:452).

37. On the contrary, in the case at hand, there are conceptual differences that counterbalance the possible points of similarity: a small male person on the one hand and a couple of a little girl and a taller boy on the other.

38. The signs have indeed an identical verbal element in common, but at the end of them, whereas the first element is visually, phonetically and conceptually completely different. Furthermore, the signs differ in their overall visual and conceptual impression, due to the figurative elements. The rights invoked will be understood as "little/small Paul", the contested sign on the other hand as a couple, Anna and Paul, flying in a hot-air balloon. Although the contested trademark depicts merely a stylized impression of this conception, its elaboration will make a lasting impression to the consumer which makes it easy for him to distinguish the contested trademark from the rights invoked.

Conclusion

39. The signs are dissimilar in their overall impression.

Comparison of the goods and services

40. For reasons of procedural economy, the Office will not conduct a comparison of the goods and services. This comparison would not influence the outcome of this decision. Even if the goods and services are identical, there would be no likelihood of confusion, because the signs are dissimilar. Only for the purpose of the readability and the scope of this opposition are the goods and services concerned listed below.

Opposition based on:	Opposition directed against:
<p><u>EU trademark 13155031</u> Class 29 Prepared (or cooked) dishes based on meat, fish, poultry, game and vegetables; Meat, fish, poultry and game; Preserved, frozen, dried and cooked fruits and vegetables; potato crisps; Olives, preserved, Tapenades; Nuts, Hazelnuts and Ground almonds; Gherkins, jellies, jams, compotes, fruit salads, crystallised fruits, fruit-based snack food, vegetable salads, soups; Eggs, milk and milk products; Edible oils and fats; Charcuterie, crustaceans, not live, tinned meat, tinned fish; Milk beverages, milk predominating.</p>	
<p>Class 30 Prepared or cooked dishes based on pastry, pasta or rice; Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour for food and preparations made from cereals; Bread, rusks, pastry, confectionery, Viennese pastries, cakes, pancakes, edible decorations for cakes, pizzas, quiches, tacos, tortillas, sandwiches, pasta, meat pies, ices, custard, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, seasonings, condiments, garden herbs (preserved), spices, ice, chocolate; Beverages with a coffee, tea, cocoa or chocolate base; Mayonnaise.</p>	<p>Class 30 Coffee, tea, cocoa and artificial coffee; Rice; Flour and preparations made from cereals; Bread, pastries and confectionery; Edible ices; Sugar, honey, treacle; Yeast, baking-powder; Spices; Ice [frozen water]; Chocolate; Chocolate extracts; Chocolate flavourings; Chocolates; Chocolate spreads; Chocolate sauce; Chocolate topping; Chocolate brownies; Chocolate biscuits; Chocolate sweets; Chocolate wafers; Chocolate coffee; Chocolate cake; Chocolate syrup; Chocolate cakes; Drinking chocolate; Chocolate beverages; Filled chocolate; Chocolate desserts; Chocolate confectionery; Chocolate fudge; Chocolate waffles; Chocolate pastries; Chocolate mousses; Chocolate chips; Chocolate truffles; Hot chocolate; Chocolate candies; Chocolate bars; Chocolate powder; Liqueur chocolates; Chocolate coated nuts; Chocolate based fillings; Chocolate based products; Chocolate drink preparations; Chocolate flavoured confectionery; Chocolate flavoured beverages; Chocolate flavoured coatings; Chocolate based drinks; Chocolate with alcohol; Chocolate coated fruits; Chocolate-based bars; Dairy-free chocolate; Chocolate-coated bars; Ice creams containing chocolate; Pralines made of chocolate; Drinks prepared from chocolate; Beverages based on chocolate; Beverages made from chocolate; Chocolate decorations for cakes; Chocolate syrups for the preparation of chocolate based beverages; Turkish delight coated in chocolate; Chocolate fillings for bakery products; Chocolate for confectionery and bread; Ice creams flavoured with chocolate; Shortbread with a chocolate coating; Waffles with a chocolate coating; Chocolate-based meal replacement bars; Chocolate decorations for christmas trees; Chocolate drink preparations flavoured with mocha; Chocolates in the form of pralines; Chocolates presented in an advent calendar; Chocolate essences for the preparation of beverages; Chocolate extracts for the preparation of beverages; Non-medicated sweets in the nature of chocolate eclairs; Frozen yoghurt [confectionery ices]; Powder for making ice cream; Aromatic preparations for ice-creams; Frozen confectionery containing ice cream; Ice confectionery; Ice</p>

	candies; Water ice; Ice milk [ice cream]; Fruit ice; Ice lollies; Ice-cream; Soft ices; Sorbets [ices]; Iced coffee; Iced cakes; Flavored ices; Ice cream powder; Ice cream drinks; Dairy ice cream; Ice cream desserts; Ice cream sandwiches; Ice cream bars; Edible ice sculptures; Ice cream cones; Sauces for ice cream.
Class 35 Retailing of foodstuffs, including: prepared (or cooked) dishes based on vegetables, meat, fish, poultry or game, meat, fish, poultry and game, preserved, frozen, dried and cooked fruits and vegetables, potato crisps, preserved olives, tapenades, processed almonds, hazelnuts and walnuts, gherkins, jellies, jams, compotes, fruit salads, crystallised fruits, snack foods based on fruits, vegetable salads, soups, eggs, milk and milk products, edible oils and fats, charcuterie, crustaceans (not live), tinned meat, tinned fish, milk beverages, milk predominating, prepared (or cooked) dishes based on pastry, pasta or rice, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour for food and preparations made from cereals, bread, rusks, pastry, confectionery, Viennese pastries, cakes, pancakes, edible decorations for cakes, pizzas, quiches, tacos, tortillas, sandwiches, pasta, meat pies, edible ices, custard, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, seasonings, condiments, preserved garden herbs, spices, ice, chocolate, beverages based on coffee, tea, cocoa or chocolate, mayonnaise.	Class 35 Advertising; Business management; Business administration; Office functions; Retail sale services in relation to cocoa, chocolate, cocoa based products, chocolate based products, ice-creams; Wholesale services in relation to chocolate and chocolate based products; Retail sale services and wholesale services in relation to and derived products, in particular cups, mugs, sugar and compote bowls, Chocolate molds, electric chocolate makers, chocolate fountains, drip mats, coffee scoops, mixing spoons, drink and cocktail shakers, whisks, milk frothers, mixing bowls, boxes of porcelain, boxes of earthenware, boxes of glass, candy boxes, storage tins, insulating flasks, milk pans, cake domes, cake decorating tips and tubes, basting spoons, potholders, pots and pans, cupcake molds, chocolate molds, jugs, basting brushes, cake trays, cake stands, food containers, ice containers, Vessels of metal for making ices and iced drinks; Ice scoops.
<u>EU trademark 13063111</u> Class 29 Prepared (or cooked) dishes based on meat, fish, poultry, game and vegetables; Meat, fish, poultry and game; Preserved, frozen, dried and cooked fruits and vegetables; potato crisps; Olives, preserved, Tapenades; Nuts, Hazelnuts and Ground almonds; Gherkins, jellies, jams, compotes, fruit salads, crystallised fruits, fruit-based snack food, vegetable salads, soups; Eggs, milk and milk products; Edible oils and fats; Charcuterie, crustaceans, not live, tinned meat, tinned fish; Milk beverages, milk predominating.	
Class 30 Prepared or cooked dishes based on pastry, pasta or rice; Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour for food and preparations made from cereals; Bread, rusks, pastry, confectionery, Viennese pastries, cakes, pancakes, edible decorations for cakes, pizzas, quiches, tacos, tortillas, sandwiches, pasta, meat pies, ices, custard, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, seasonings, condiments, garden herbs (preserved), spices, ice, chocolate; Beverages with a coffee, tea, cocoa or chocolate base; Mayonnaise.	
Class 35 Retailing of foodstuffs, including: prepared (or cooked) dishes based on vegetables, meat, fish, poultry or game, meat, fish, poultry and game, preserved, frozen, dried and cooked fruits and vegetables, potato crisps, preserved olives, tapenades, processed almonds, hazelnuts and walnuts, gherkins, jellies, jams, compotes, fruit salads, crystallised	

fruits, snack foods based on fruits, vegetable salads, soups, eggs, milk and milk products, edible oils and fats, charcuterie, crustaceans (not live), tinned meat, tinned fish, milk beverages, milk predominating, prepared (or cooked) dishes based on pastry, pasta or rice, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour for food and preparations made from cereals, bread, rusks, pastry, confectionery, Viennese pastries, cakes, pancakes, edible decorations for cakes, pizzas, quiches, tacos, tortillas, sandwiches, pasta, meat pies, edible ices, custard, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, seasonings, condiments, preserved garden herbs, spices, ice, chocolate, beverages based on coffee, tea, cocoa or chocolate, mayonnaise.	
Class 43 Services for providing food and drink, catering services, self-service restaurants, snack-bars, cafeterias, cafés, bars, tea rooms, preparation of take-away meals and dishes.	

A.2 Global assessment

41. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the signs are important factors.

42. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be considered that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question. The present case concerns goods and services which 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.

43. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors that have to be considered, 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).

B. Conclusion

44. On the basis of the foregoing, the Office concludes that the trademarks invoked and the contested sign are not sufficiently similar to lead to a likelihood of confusion, even if the goods and services were identical. For this reason, there is no need to compare the goods and services (see TEU, YoKaNa, T-103/06, 13 April 2010, ECLI:EU:T:2010:137).

IV. CONSEQUENCE

45. The opposition with number 2014306 is rejected.

46. The Benelux application with number 1373838 will be registered for all the goods and services applied for.

47. The opponent is under obligation to pay the defendant EUR 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is not justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 23 December 2019

Willy Neys
rapporteur

Camille Janssen

Tomas Westenbroek



Administrative officer:

Annadina Dikken