



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2014580
of 6 July 2023

Opponent: **Hilton Worldwide Manage Limited**
Maple Court Central Park, Reeds Crescent
WD24 4QQ Watford
United Kingdom

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwenveldseweg 12
1382 LX Weesp
Netherlands

Invoked trademark 1: International trademark registration 926493

THE WALDORF=ASTORIA COLLECTION

Invoked trademark 2: EU trademark registration 001852946

Waldorf Astoria

against

Defendant: **Corinthia Hotels Limited**
1 John Lopez Street, Europa Centre
1400 Floriana FRN
Malta

Representative: **GEVERS**
Holidaystraat 5
1831 Diegem
Belgium

Contested mark: **Benelux trademark application 1379825**


CORINTHIA
GRAND HOTEL ASTORIA
BRUSSELS

I. FACTS AND PROCEEDINGS**A. Facts**

1. On 9 August 2018 the defendant filed a Benelux trademark application for the combined



word/figurative mark for services in classes 35, 36, 37, 41, 42, 43 and 44. This application was processed under number 1379825 and was published on 29 August 2018.

2. On 29 October 2018 the opponent filed an opposition against the registration of the application. The opposition is based on:

- International trademark registration 926493, designating the European Union (hereinafter: "EU"), of the wordmark THE WALDORF=ASTORIA COLLECTION filed on 21 May 2007 and registered on 26 May 2008 for services in classes 36 and 43.
- EU trademark registration 001852946 of the wordmark Waldorf Astoria filed on 13 September 2000 and registered on 7 October 2004 for services in class 42.

3. At the time of filing the opponent 'Hilton Worldwide Holding LLP' was the actual holder of the trademarks invoked. During the opposition proceedings, the invoked trademarks were transferred to 'Hilton Worldwide Manage Limited'. 'Hilton Worldwide Manage Limited' is deemed to have entered into the rights of the initial opponent 'Hilton Worldwide Holding LLP'.

4. The opposition was initially directed against all the services covered by the contested application and was based on all services covered by the trademarks invoked. Since the second trademark invoked is only registered for class 42, and the opponent fails to state or argue that any of the services from class 42 of the trademarks invoked are identical or similar to any of the services of the contested sign, the opposition cannot succeed on the basis of the second trademark invoked. The Office will continue by assessing the opposition on the basis of the first trademark invoked being International trademark registration 926493 of the wordmark THE WALDORF=ASTORIA COLLECTION.

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" or "BOIP") to the parties on 31 October 2018. Subsequently, the proceedings were suspended multiple times, at the request of the parties. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was submitted by the opponent. 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 1 June 2022.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

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

A. Opponent's arguments

8. The opponent starts by comparing the signs and states that the word elements WALDORF ASTORIA in the invoked trademarks are meaningless in relation to the services and therefore have a normal distinctive character. The word elements THE and COLLECTION belong to the basic vocabulary of the English language. COLLECTION will be understood as 'a range or group of objects of one type' and has weak distinctive character in relation to the services in classes 36 and 43.

9. In the view of the opponent the word elements in the contested sign are the dominant elements, since verbal components usually have a stronger impact on the consumer than figurative components and the public refers to a sign by using its verbal components.

10. The distinctive element ASTORIA is identically reflected in the signs involved. The opponent argues that due to the weak/non-distinctive nature of the words GRAND, HOTEL and BRUSSELS from the contested sign and THE COLLECTION from the first trademark invoked, the focus lies on the elements WALDORF ASTORIA from the invoked trademarks and CORINTHIA ASTORIA from the contested sign.

11. Visually, the signs coincide in the identical and normally distinctive verbal element ASTORIA. The signs differ in the figurative elements, in the normally distinctive elements WALDORF and CORINTHIA and they differ in the weak distinctive elements THE and COLLECTION. The signs also differ in the elements GRAND, HOTEL and BRUSSELS, belonging to the basic vocabulary of the English language and will be understood as 'a substantial building where people stay usually for a short period of time paying for their rooms and meals located in the city of Brussels'. Bearing in mind that the services involved can relate to hotels, these elements are weak for the services in classes 35, 36, 37, 41, 42 and 44 and non-distinctive and descriptive for the services in class 43. The signs are visually similar, at least to a low degree, according to the opponent.

12. Aurally, the signs coincide in the distinctive element ASTORIA. Aurally the signs differ in the elements WALDORF, THE, COLLECTION, CORINTHIA, GRAND, HOTEL and BRUSSELS. Taking into account the distinctiveness of the elements, there is aural similarity between the signs involved, according to the opponent.

13. The opponent is of the view that, conceptually, the coinciding word ASTORIA will evoke a concept namely a port in Oregon, United States of America. WALDORF and CORINTHIA share a concept, namely both being geographical names. The word elements GRAND, HOTEL and BRUSSELS will be understood as 'a substantial building where people stay usually for a short period of time paying for their rooms and meals located in the city of Brussels'. The word COLLECTION will be understood as 'a range or group of objects of one type which could be a group of hotels'.

14. The opponent is of the opinion that, overall, the marks are to be deemed similar.

15. With regard to the comparison of services the opponent argues that the services in classes 35, 37, 41 and 44 of the contested sign are similar or complementary to 'hotel services' in class 43 of the first

trademark invoked. The services in class 36 of the contested sign and the services in class 36 of the first trademark invoked are identical. The services in class 43 of the contested sign are all identical to a selection of services from class 43 of the first trademark invoked.

16. The respective services are directed to the public at large whose degree of attention is considered average, according to the opponent.

17. As the services are identical and/or similar and the signs are similar, the opponent finds it evident that the public will associate the involved signs and finds that there is a likelihood of confusion on the part of the public.

18. The opponent requests the refusal of the contested Benelux trademark application and an award of costs granted in his favour.

B. Defendant's arguments

Response to proof of use

19. The defendant argues that the fact sheet concerning WALDORF ASTORIA is a marketing instrument emanating from opponent and therefore has limited probative value. The 'hotel services' are more often than not promoted under the brand name 'True Waldorf Service'. The fact sheet only mentions hotels located in Amsterdam, Versailles, Berlin and Rome. Such use can hardly be considered as constituting genuine use throughout the EU. The fact sheet is dated October 2021, which is outside the relevant period.

20. Regarding the submitted news articles the defendant notes that half of the news articles are dated outside the relevant period. Even if all the news articles are being taken into account, the news articles confirm that use of WALDORF ASTORIA is limited to locations in the Netherlands, France, Germany and Italy.

21. According to the defendant the annual reports discuss business operations, market shares and new openings of the Hilton Group. WALDORF ASTORIA is merely one of the 14 brand names in opponent's portfolio. The annual reports bear the titles 'Hilton Worldwide', 'We are Hilton we are hospitality' and 'The Hilton Effect'. The reports discuss operations worldwide and consequently a large part of the information does not relate to the relevant territory.

22. The defendant notes that it is well-established that pages from Wikipedia cannot be regarded as comprising admissible and reliable evidence. Also the submitted Wikipedia excerpt is dated outside the relevant period. Again this excerpt confirms operations within the EU in the Netherlands, France, Germany and Italy only. One hotel in each country.

23. None of the evidence relates to use of the first trademark invoked namely THE WALDORF=ASTORIA COLLECTION, according to the defendant.

Response to opponent's arguments

24. The defendant is of the view that when considering the contested sign the word element CORINTHIA, centrally placed within the sign, must be considered as the dominant element. The element of secondary importance is the column device, placed above the word elements of the contested sign and thus attracting the consumer's attention. Finally, the word elements GRAND HOTEL ASTORIA BRUSSELS are the

least important, according to the defendant. These word elements are smaller than the dominant element CORINTHIA. The word element ASTORIA is somewhat lost in the wording GRAND, HOTEL and BRUSSELS. The elements GRAND HOTEL ASTORIA BRUSSELS will be seen by the public as merely a baseline or addendum. Due to the complexity of the sign the consumer will simply read and pronounce CORINTHIA.

25. As to the second trademark invoked, Waldorf Astoria, the defendant argues that the element WALDORF must be seen as the dominant element, being placed in the beginning of the mark. The signs only coincide in the element ASTORIA, which cannot be considered as the dominant element. The degree of similarity between the signs is insufficient to lead to a risk of confusion, according to the defendant. This applies a fortiori to the first trademark invoked THE WALDORF=ASTORIA COLLECTION.

26. The defendant requests the Office to declare the documents as being insufficient to demonstrate genuine use of the invoked trademarks, to reject the opposition since there is no risk of confusion and to grant an award of costs in favour of the defendant.

III. DECISION

A.1 Proof of use

27. In accordance with article 2.16bis BCIP the opponent, at the request of the defendant, shall furnish proof that the trademarks invoked have been put to genuine use as provided for in article 2.23bis BCIP. Or that proper reasons for non-use existed. The evidence must show genuine use in a period of five years prior to the filing date of the trademark against which the opposition is lodged.

28. The filing date of the contested sign is 9 August 2018. Therefore, the opponent was required to show use of the invoked trademark during the period from 9 August 2013 to 9 August 2018 ('the relevant period'). Given the fact that the invoked trademarks are registered more than five years prior to the filing date of the contested sign, the defendant's request for proof of use is legitimate.

29. In accordance with the case-law of the European Court of Justice (hereinafter: "CJEU") there is genuine use of a trademark if the mark, in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, is used in order to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.¹ When assessing whether use of the trade mark is genuine, regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.² In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly.³

30. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.⁴ In interpreting the concept of genuine use, account should be taken of the

¹ CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis) and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

² CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:-80, point 83 (Pandalis) and CJEU 11 March 2003, C40/01, ECLI:EU:C:2003: 145, point 43 (Ansul).

³ General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

⁴ General Court (EU) 8 July 2004, T-334/01, ECLI:EU:T:2004:223, point 36 (Hipoviton) and General Court (EU) 30 April 2008, T-131/06, ECLI:EU:T:2008:135, point 41 (Sonia Sonia Rykiel).

fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trademark protection to the case where large-scale commercial use has been made of the marks.⁵

31. Genuine use of a trademark cannot be proven by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.⁶

32. The invoked trademark concerns an International trademark designating the EU. Whilst it is reasonable to expect that an International trademark designating the EU should - because it enjoys more extensive territorial protection than a national trade mark - be put to use in a larger area than the territory of a single Member State in order for that use to be capable of being deemed to be 'genuine use', it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market.⁷ It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU, taking into account all relevant facts and circumstances such as characteristics of the market concerned, the nature of the goods or services protected by the trademark and the territorial extent and the scale of the use as well as its frequency and regularity.⁸

33. Following rule 1.25, paragraph 2 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the trademarks invoked for the services on which the opposition is based.

Analysis of the proof of use

34. The opponent submitted the following proof of use:

1. Fact sheet dated October 2021 concerning WALDORF ASTORIA showing the brand ethos, the history and showing that there are multiple hotels in different cities around the world;
2. News articles dated 7 January 2013, 4 March 2013, 27 June 2013, 19 March 2015, 7 June 2017 and 12 June 2018 about WALDORF ASTORIA opening a hotel in Berlin, the intentions of opening a hotel in Amsterdam, restaurant services, the offer of 7 complimentary nights in the WALDORF ASTORIA hotels in Paris and Rome to travellers flying with Deer Jet from Hong Kong to Paris or Rome and about the actual opening of the hotel in Amsterdam offering a restaurant, brasserie, bar, spa, event areas;
3. Annual reports dated 2013, 2015, 2016, 2017 and 2018 showing figures and information concerning business operations, market shares and new openings of the Hilton group and figures for each brand separately, amongst which the WALDORF ASTORIA brand;
4. Excerpt from Wikipedia dated 14 March 2022 concerning WALDORF ASTORIA, containing general information on the history, the number of locations, the number of rooms, the brand positioning and references to online articles concerning WALDORF ASTORIA.

35. The defendant argues that none of the evidence relates to use of the International trademark invoked, being THE WALDORF=ASTORIA COLLECTION (see point 23). The Office agrees that the sign WALDORF ASTORIA mentioned in the proof of use differs from the first trademark invoked being the

⁵ General Court (EU) 4 April 2019, T-910/16 and T911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

⁶ General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

⁷ General Court (EU) 1 June 2022, T-316/21, ECLI:EU:T:2022:310, point 73 (Superior Manufacturing) and CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, points 50 and 54 (ONEL).

⁸ CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 58 (ONEL).

international trademark registration for THE WALDORF=ASTORIA COLLECTION, but only in minor aspects. Omitting a symbol, in this case the symbol = (equal symbol), does not normally alter the distinctive character of the mark as registered⁹. Where the other omitted elements of the mark as registered are non-distinctive, in this case the elements THE and COLLECTION, the distinctive character of the mark as registered will also not be altered¹⁰. The sign used, WALDORF ASTORIA, can thus be regarded as a sign that differs in part, without altering the distinctive character of the invoked international trademark THE WALDORF=ASTORIA COLLECTION. The mark used constitutes an acceptable variation of its registered form.¹¹

36. As regards the geographical scope of use, an EU trademark is put to genuine use when it is used in accordance with its essential function and with a view to maintaining or creating market share in the EU for the services concerned. It is not necessary that the mark be used in an extensive geographic area for the use to be deemed genuine. The Office identifies that the opponent operates a hotel chain under the invoked trademarks in dozens of countries, including several countries in the EU, being The Netherlands (Amsterdam), Germany (Berlin), France (Versailles), Scotland (Edinburgh) and Italy (Rome). Although the annual reports discuss operations worldwide, a considerable part of the reports are specified to WALDORF ASTORIA operations within the EU.

37. The submitted documents show that the invoked trademarks concern the name of a hotel chain. Primarily, the services consist of *'hotel services'* and *'rental of temporary accommodation'*. But also services inextricably linked to hotels are being offered under the invoked trademarks according to the submitted documents, such as *'reservations (temporary accommodation), bar services, cafe services, restaurant services, rental of rooms for holding functions, conferences, conventions, exhibitions, seminars and meetings, provision of facilities for meetings, conferences and exhibitions, reservation services for hotel accommodation'*.

38. The news articles, annual reports and Wikipedia excerpt read in conjunction with the fact sheet show, despite the lower probative value of the latter as argued by defendant (see point 19), that the opponent is active under the invoked International trademark in the EU.

39. The defendant notes that pages from Wikipedia cannot be regarded as comprising reliable and admissible evidence (see point 22). The Office considers that although this source can be edited and published by anyone, this does not necessarily mean that Wikipedia pages are unreliable and are not entitled to any probative value at all. When assessing the probative value of such pages, it is necessary to examine whether, given its content, the document appears reasonable and credible and can serve as support for or find support in the other evidence. This is the case in this matter. The information on the Wikipedia page is in line with data on the fact sheet and data from the annual reports.

40. With regard to the defendant's argument that some of the evidence is undated or is dated before or after the relevant period (see points 19, 20, 22), it should first be noted that the fact that certain documents are undated or originate from outside the relevant period does not necessarily mean that they should be ignored. Even if a document is dated after a certain date, it may be possible to draw conclusions

⁹ Common Communication no. 8 on the common practice concerning use of a trade mark in a form differing from the one registered of 15 October 2020 (<https://www.boip.int/en/ip-professionals/regulations-policy/policy#commoncommunication>).

¹⁰ Common Communication no. 8 on the common practice concerning use of a trade mark in a form differing from the one registered of 15 October 2020 (<https://www.boip.int/en/ip-professionals/regulations-policy/policy#commoncommunication>).

¹¹ Article 18 (1) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017, on the European Union trade mark.

from it about a situation that occurred before that date.¹² Furthermore, these documents are likely to support the other evidence relied upon.¹³ For example, although the fact sheet, three out of six news articles and the Wikipedia excerpt date from before or after the relevant period, they may nevertheless allow conclusions to be drawn about the situation prevailing during the relevant period since they discuss hotels to be opened in the near future or the history of WALDORF ASTORIA. Such circumstances may confirm or contribute to a better assessment of the extent of use of the mark in question during the relevant period.¹⁴ Moreover, a fair share of documents is indeed dated within the relevant period. All in all, the documents provided cover the entirety of the relevant period.

Conclusion

41. After careful analysis, the Office concludes that the evidence of use, taken together, sufficiently demonstrates genuine use in the EU within the relevant period of the invoked International trademark for the following services in class 43: *Rental of temporary accommodation; reservations (temporary accommodation); hotel, bar, cafe, restaurant services; rental of rooms for holding functions, conferences, conventions, exhibitions, seminars and meetings.* The Office will continue with the assessment of the likelihood of confusion considering these services, for which the opponent has proven genuine use.

A.2 Likelihood of confusion

42. 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 following 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.

43. 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."*¹⁵

44. 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.¹⁶

45. According to settled case-law of the 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

¹² CJEU 17 July 2008, C-488/06, ECLI:EU:C:2008:420, point 72 (Aire Limpio); BOIP 23 October 2008, opposition decision 2000904 (Y-TAG).

¹³ General Court (EU) 8 July 2004, T-203/02, ECLI:EU:T:2004:225, point 53 (Vitafruit); BOIP 30 June 2008, opposition decision 2000980 (HOLLANDER).

¹⁴ CJEU 27 January 2004, C-259/02, ECLI:EU:C:2004:50, point 31 (La Mer Technology).

¹⁵ Article 2.2ter (1) (b) BCIP implements article 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 article 8 (1) (b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

¹⁶ CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.¹⁷

Comparison of the signs

46. 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.¹⁸

47. While the comparison must be based on the overall impression left by the signs in the memory of the relevant public, it must nevertheless be made in the light of the intrinsic qualities of the conflicting signs.¹⁹ The overall impression created by a composite mark (word and figurative element) in the minds of the relevant public may, in certain circumstances, be dominated by one or more of its components. In assessing whether this is the case, particular account must be taken of the intrinsic qualities of each of those components by comparing them with the qualities of the other components. Moreover, it is possible to consider how the various components in the configuration of the composite mark relate to one other.²⁰

48. In short, as regards the visual, phonetic and conceptual similarity of the marks, the assessment of their similarity should be based on the overall impression created by the marks, taking into account, inter alia, their distinctive and dominant components.

49. The signs to be compared are the following:

| Opposition based on: | Opposition directed against: |
|--------------------------------|--|
| THE WALDORF=ASTORIA COLLECTION |  |

Visual comparison

50. The invoked International trademark concerns a wordmark consisting of the verbal elements “THE WALDORF=ASTORIA COLLECTION” composed of 4 words and 28 characters in total.

51. The contested sign concerns a combined word/figurative mark consisting of a column device in gold at the top, underneath it the word element “CORINTHIA” in a large font, underneath it the word elements “GRAND HOTEL ASTORIA” in a smaller font and at the bottom the word element “BRUSSELS” in the same smaller font, all aligned in the centre and all words in the colour black.

¹⁷ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

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

¹⁹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

²⁰ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) ; 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

52. Where a trademark consists of both verbal and figurative elements the former has, in principle, a greater impact on the consumer than the latter. The reason for this is that the public does not always analyse the signs and often refers to the sign by using the word element.²¹ The figurative element of the contested sign, being the column device, will in this case not go unnoticed by the average consumer because of its top central position and size. Nonetheless, the office is of the opinion that the relevant public will perceive the verbal elements as the dominant elements since these make up the majority of the contested sign.

53. While the elements "THE", "WALDORF", "=", "COLLECTION" from the invoked International trademark and "CORINTHIA", "GRAND", "HOTEL", "BRUSSELS" from the contested sign differ, both signs nonetheless contain the identical word element "ASTORIA". Although depicted in a smaller font than "CORINTHIA", the element "ASTORIA" in the contested sign will still attract the attention of the relevant public due to its inclusion in the middle sentence, its easy-to-read font size and will as such play a role in the overall impression of the contested sign.

54. Considering the above the office cannot agree to the argument of the defendant that the element "GRAND HOTEL ASTORIA BRUSSELS" will be seen by the public as merely a baseline or addendum to "CORINTHIA" and that "ASTORIA" is "lost" between "GRAND, HOTEL and BRUSSELS" (see point 24). While there are visual differences between the signs, these are not sufficient to entirely detract from the visual similarities between the signs.

55. The trademarks are visually similar to a certain degree.

Phonetic comparison

56. As regards the phonetic comparison, it must be borne in mind that, strictly speaking, the phonetic representation of a combined word/figurative mark is the same as that of its word elements, irrespective of the graphical characteristics of those components, which are more subject to examination in the context of the visual aspects of the sign.²²

57. The invoked International trademark consists of the word elements "THE", "WALDORF", "ASTORIA" and "COLLECTION" and the "=" symbol of which the phonetic representation is "equal" or "is". The contested sign consists of the word elements "CORINTHIA", "GRAND", "HOTEL", "ASTORIA" and "BRUSSELS". The signs will be pronounced as their word elements and symbol.

58. Although consumers usually attach more importance to the initial elements,²³ the Office considers that the full inclusion of the word "ASTORIA" in the contested sign will by no means go unnoticed. While the remaining words affect the pronunciation of the signs, the common element "ASTORIA" will be pronounced identically.

59. Taking the aforementioned into consideration, the Office finds that on a phonetic level, the signs at hand are similar to a certain degree.

²¹ General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 (Smarter Travel) and the case-law mentioned there.

²² General Court (EU) 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

²³ EGC 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor)

Conceptual comparison

60. The signs coincide in the word element "ASTORIA", being the name of a port in Oregon. The average Benelux consumer will however not recognize "ASTORIA" as being the name of a port and therefore this element has no meaning for the relevant public.

61. With regard to the element "WALDORF" from the invoked International trademark, the relevant Benelux public will recognize "WALDORF" as a surname. In principle, a name has no specific meaning. This is different only if the name in question has become a conceptual symbol, for example due to the familiarity of the person bearing the name, or if the name has a clear and immediately recognizable semantic content.²⁴ "WALDORF" has no clear meaning for the relevant Benelux public. While "CORINTHIA", from the contested sign, refers to a geographical name according to the opponent (see point 13) namely a region in Greece, the average consumer in the Benelux will not be aware of this and thus will not perceive the word "CORINTHIA" as having a meaning.

62. The word element "THE" from the invoked International trademark concerns an article to the word "WALDORF". The element "=" from the invoked International trademark will be understood as the mathematical symbol for equal. The word "COLLECTION" from the invoked International trademark means a group of things or people. "GRAND" from the contested sign means magnificent and imposing in appearance, size or style. "HOTEL" from the contested sign refers to an establishment providing accommodation, meals and other services for travellers and tourists. "BRUSSELS" from the contested sign will be understood as the capital city of Belgium. These meaningful words from the invoked International trademark and the contested sign will be recognized by the public.²⁵ Conceptually these words are dissimilar.

63. Following the above, the signs are conceptually dissimilar.

Conclusion

64. In view of the foregoing, the Office considers that the signs are visually and phonetically similar to a certain degree and are conceptually dissimilar.

Comparison of the services

65. When assessing the similarity of services, all relevant factors characterising the relationship between them must be taken into account. These include, inter alia, their nature, their end-users, their method of use and whether they are in competition with each other or are complementary.²⁶

66. When comparing the services, the services shall be considered in the terms set out in the register, in as far as genuine proof of use was provided, and not the actual or intended use.²⁷

67. Having regard to the principle of hearing both sides, opposition proceedings are limited to the arguments, facts and evidence put forward by the parties.²⁸

²⁴ General Court (EU) 27 June 2019, T-268/18, ECLI:EU:T:2019:452, points 85-90 (Luciano Sandrone) and 18 June 2021, T-386/20, ECLI:EU:T:2021:372, point 54 (Miley Cyrus).

²⁵ See also BenCJ 23 January 2023, C 2021/17/7, point 33 (Tubex Piping)

²⁶ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

²⁷ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

²⁸ Article 2.16 (1) BCIP and rule 1.21 IR.

68. Genuine use has only been demonstrated for the following services in class 43 of the invoked International trademark: *Rental of temporary accommodation; reservations (temporary accommodation); hotel, bar, cafe, restaurant services; rental of rooms for holding functions, conferences, conventions, exhibitions, seminars and meetings.* As mentioned under point 41, the office will continue with the assessment of this opposition considering these services.

69. In his arguments, the opponent argues that the services in class 36 of the International trademark invoked are identical to the services in class 36 of the contested sign (see point 15). Since no genuine use has been demonstrated for the services in class 36 invoked International trademark, class 36 is not included in the table and the comparison of services below. The opponent fails to argue or state that the services in class 36 of the contested sign are identical or similar to any other services of the invoked International trademark.

70. The opponent does not argue or state identity or similarity between the services in class 42 of the contested sign and any of the services from the invoked International trademark.

71. With regard to the services in class 43 of the invoked International trademark the opponent argues identity, similarity or complimentary between the services '*Rental of temporary accommodation; hotel, bar, cafe, restaurant services; rental of rooms for holding functions, conferences, conventions, exhibitions, seminars and meetings*' and the services in class 35, 37, 41, 43 and 44 of the contested sign. In his comparison of services the opponent does not include the service '*reservations (temporary accommodation)*' from class 43 of the invoked International trademark. The Office takes this as a limitation of the services on which the opposition is based.²⁹

72. As a result, the services to be compared are:

| Opposition based on: | Opposition directed against: |
|---|---|
| | CI 35 Administrative hotel management; hotel management for others; business management of hotels; advertising services relating to hotels. |
| | CI 37 Cleaning of hotels; repair and maintenance of buildings, hotels and utilities in buildings; dry cleaning. |
| | CI 41 Entertainment services provided by hotels; provision of entertainment facilities in hotels. |
| International trademark registration 926493 CI 43 Rental of temporary accommodation; hotel, bar, cafe, restaurant services; rental of rooms for | CI 43 Hotel, bar and restaurant services; hotel reservations; services for providing food and |

²⁹ BenCJ 18 October 2022, C 2021/13/7, point 19 (Sitel).

| | |
|--|--|
| holding functions, conferences, conventions, exhibitions, seminars and meetings. | drink; catering; rental and reservation of rooms; providing temporary accommodation in apartments; rental of meeting accommodations and other temporary accommodations; rental of spaces for exhibitions, meetings, seminars, conferences, receptions and parties; consultancy and information regarding the rental of temporary accommodations, also via electronic networks, such as the internet. |
| | CI 44 Beauty salon services; implementation of therapies and massages; services of health centers; health and beauty care; operation of thermal baths; spas. |

Classes 35, 37, 41, 43 and 44

73. The opponent argues that 'hotel services' from class 43 of the invoked International trademark are similar or complementary to all services in classes 35, 37, 41 and class 44 of the contested sign (see point 15). Furthermore, the opponent argues that the services 'rental of temporary accommodation; hotel, bar, cafe, restaurant services; rental of rooms for holding functions, conferences, conventions, exhibitions, seminars and meetings' from class 43 of the invoked International trademark are identical to the services in class 43 of the contested sign (see point 15). The defendant does not contest the alleged similarity, complementary and identity of the mentioned services. The similarity, complementary and identity of the respective services is therefore *in confesso*.

B. Global assessment

74. 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.³⁰ According to the opponent the respective services are directed to the public at large whose degree of attention is considered average. (see point 16), to which the Office agrees. The defendant does not contest the level of attention being average, argued by opponent.

75. The greater 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.³¹ The invoked International trademark has a normal distinctiveness, due to the presence of the non-descriptive and distinctive elements WALDORF and ASTORIA. The opponent does not claim an enhanced distinctiveness for the trademarks invoked.

³⁰ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

³¹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

76. 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 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.³²

77. In this case the signs are visually and phonetically similar to a certain degree and conceptually dissimilar. The conceptual dissimilarity is insufficient to neutralize the visual and phonetic similarity. The conceptual comparison involves the descriptive elements "COLLECTION", "GRAND", "HOTEL" and "BRUSSELS". The relevant public will generally not regard descriptive elements as the distinctive and dominant elements of a sign.³³ The similarity and identity of the respective services is *in confesso*. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that there is indeed a likelihood of confusion in the sense that the public may believe that the services designated by the trademarks invoked and the services to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically link.

B. Other factors

78. In an opposition procedure there is no question of the other party being ordered to bear the costs incurred (see points 18 and 26). Only a referral of the costs set at the established opposition fee in case the opposition is totally rejected (or justified) is provided for.³⁴

C. Conclusion

79. Based on the foregoing the Office is of the opinion that there is a likelihood of confusion.

IV. DECISION

80. The opposition with number 2014580 is partly justified.

81. The Benelux application with number 1379825 will not be registered for the following services:

- Class 35 (all services)
- Class 37 (all services)
- Class 41 (all services)
- Class 43 (all services)
- Class 44 (all services)

82. The Benelux application with number 1379825 will be registered for the following services against which the opposition is not directed:

- Class 36 (all services)
- Class 42 (all services)

³² CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 (Equivalenza) and the case-law mentioned there.

³³ See, for example, General Court (EU) 3 July 2003, T-129/01, ECLI:EU:T:2003:184, point 53 (Budmen) and BenCJ 18 October 2022, C-2021/5/7, point 25 (Luxauto).

³⁴ Article 2.16 (5) BCIP and rule 1.32 (3) IR.

83. 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, 6 July 2023



Yvonne Noorlander
(rapporteur)

Marjolein Bronneman

Camille Janssen

Administrative officer: Rémy Kohlsaet