

BOIP



Benelux Office for
**Intellectual
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2014599
of 15 January 2020**

Opponent: **Ableton AG**
Schönhauser Allee 6-7
10119 Berlin
Germany

Representative: **Cornelius Richter**
Wittenbergplatz 1
10789 Berlin
Germany

Invoked right: **International registration 1178721**



against

Defendant: **Hoffmann Eitle B.V.**
Strawinskylaan 3051
1077 ZX Amsterdam
Netherlands

Representative: -

Contested trademark: Benelux application 1379601



HOFFMANN EITLE
AMSTERDAM

I. FACTS AND PROCEEDINGS

A. Facts

1. On 6 August 2018 the defendant filed an application for a trademark in the Benelux for the



combined word/figurative mark for goods and services in classes 9, 16, 35, 41, 42 and 45. This application was processed under number 1379601 and was published on 30 August 2018.

2. On 30 October 2018 the opponent filed an opposition against the registration of the application. The opposition is based on international registration 1178721, designating the European Union amongst



others, of the figurative mark, filed on 20 November 2012 and registered on 11 September 2014 for goods and services in classes 9, 15, 16, 18, 25, 35, 38, 41, 42 and 45.

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

4. The opposition is directed against all of the goods and services in classes 9, 16, 41 and 42 and part of the services in class 35 of the contested application and is based on all of the goods and services in classes 9, 16, 35, 41 and 42 of the trademark invoked.

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

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 1 November 2018. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 30 July 2019.

II. ARGUMENTS

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

¹ This decision shall always refer to the laws and regulations applicable on the date of the decision, except in the case of provisions which have undergone a material change during the proceedings and which are relevant to the decision.

A. Opponent's arguments

9. The opponent argues that both trademarks, when compared, show the same patterns. The figurative part of the contested trademark follows the same pattern as the trademark invoked. Even though the contested trademark contains more lines, the thickness of the lines varies so the impression arises that there are also four vertical and four horizontal lines. The opponent is of the opinion that the consumer will assume that the contested trademark is a variation to the earlier trademark so there exists a clear likelihood of association between the signs. This risk cannot be offset by the word elements in the contested trademark. The last word 'Amsterdam' will go unnoticed given its purely descriptive character as an indication of where the goods are made available to the public.

10. As for the comparison of the goods and services, the opponent finds that the contested goods in class 9 are identical to the earlier goods in the same class. The same holds true for the comparison of the goods in class 16, according to the opponent. The contested services 'business management; commercial management' are identical to the earlier services registered in class 35. Furthermore, the services in class 35 are identical as well. The opponent refers here to case law from the Boards of appeal of the European Union Intellectual Property Office (hereinafter 'EUIPO') to substantiate this claim. The opponent continues that the services in class 41 are identical as well. Finally, the contested 'design and development software related to services of lawyers and intellectual property agents' in class 42 are identical to the earlier generic service 'digital image processing (graphic design services)', according to the opponent.

11. Based on the foregoing, the opponent concludes that the goods and services are for the most part identical and the visual comparison has shown a similarity to a high degree. Therefore a likelihood of confusion/association exists and the contested trademark should not be registered in regard of the contested goods and services.

B. Defendant's arguments

12. First of all the defendant requests that the opposition is rejected and the trademark be registered for the goods and services as filed and, as a subsidiary request, that the opposition is rejected and the trademark be registered for the goods and services as modified.

13. The defendant explains that the opposition is unfounded because the earlier trademark and the current trademark have no similarity, that the opponent acquiesced the use of similar trademarks used and registered by the group of companies of which the applicant is a part and finally that there is no likelihood of confusion or association.

14. The defendant states that he is an entity in the Hoffmann Eitle group, an IP law firm in Europe and a subsidiary of Hoffmann Eitle Patent- und Rechtsanwälte PartmbB. The Hoffmann Eitle group is owner of several trademarks regarding the name, the logo and the combination of the name and the logo. The present application serves to avoid dilution of the marks and to ensure trademark protection for the precise manner in which the subsidiaries present themselves.

15. According to the defendant, there is no similarity between the trademarks. As none of the figurative elements of the signs evoke any concept, the only comparison to be made is a visual comparison. When putting the two marks next to each other it is immediately apparent that there is no similarity and no risk that the relevant public might believe that the goods or services marketed under the trademarks in question come from the same or economically linked undertakings. The defendant submits the results of a search for registered EU trademarks similar to the contested trademark. The trademark invoked does not show up in these results and thus it is not identified as bearing any similarity with the

contested trademark. The figurative element in the contested trademark is only a secondary element. The verbal element HOFFMANN EITLE is the dominant element. The defendant explains that when a trademark is composed of verbal and figurative elements, the former are in principle more distinctive than the latter. Besides, the supportive figurative element differs from the one composing the right invoked. The figurative element in the trademark invoked is a two-dimensional shape of 4 horizontal and 4 vertical flat bars, all having the same shape and dimensions with the space in between being equal to the thickness of the lines. However the figurative element in the contested trademark consists of 8 vertical lines and 8 horizontal lamellas drawn in perspective view conveying the image of a vertical diffraction grating and a horizontal shutter, not of separate flat bars, according to the defendant.

16. The defendant also observes that the figurative elements are not only completely different, their styling is different as well. The contested trademark is dominated by the verbal element HOFFMANN EITLE and an elegant supporting figurative element, whereas the earlier trademark is purely geometric without styling. Hence there is no visual similarity between the trademarks. By lack of any similarity, there cannot be a likelihood of confusion or association. Besides, the nature of the services and goods implies that the level of attention of the relevant public will be fairly high. For this reason, the defendant finds this opposition unfounded.

17. The defendant notes that the trademarks registered by the HOFFMANN EITLE group's mother company (the logo as well as the logo followed by the name HOFFMANN EITLE) have been coexisting with the right invoked with full awareness of the opponent since their registration. Moreover, the opponent has given tacit consent prior to the priority filings for those trademarks. The contested trademark is almost identical to those earlier trademarks, except for the addition of the geographical indication AMSTERDAM. The defendant explains that prior to the filing of those earlier Hoffmann Eitle trademarks, the opponent was consulted on the figurative elements. Correspondence between Hoffmann Eitle PartmbB and the opponent's legal counsel with respect to those trademarks is presented as evidence in these proceedings. The defendant is thus of the opinion that the opponent should be precluded from action against the registration of similar trademarks. For this reason the opposition has to be rejected.

18. Even if one would assume a similarity between the earlier trademark and the contested trademark, there still is no likelihood of confusion due to the limited distinctiveness of the earlier trademark and the differences between the earlier trademark and the contested trademark, according to the defendant. The figurative element in the right invoked is not unique, nor especially original. In fact there are many signs sharing a similar visual impact that are registered EU and international trademarks that coexist with the right invoked. The defendant submits the results of a search for figurative EU trademarks similar to the opponent's trademark.

19. Furthermore, the defendant observes that the opponent has not explained or made clear how the earlier goods and services correspond to the present goods and services. In fact the opponent just made a statement without any further support, and erroneously reads the earlier goods and services. Thus, the defendant submits that there is no overlap between the goods and services at issue here.

20. Given the limited distinctiveness and the main differences between the signs, the defendant is of the opinion that there cannot be any likelihood of confusion or association.

21. In case the Office would allow the opposition against the contested trademark, the defendant requests that the goods and services be limited. As a result of such a limitation there would be no overlap between the goods and services anymore. As the earlier trademark and the contested trademark are not similar and there is no risk of confusion or association between the trademarks, the relevant public will not see any relationship between them and will thus not confuse them.

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 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).



Comparison of the signs

25. The wording of Article 5, 1 (b) of the Directive (cf. article 2.2ter, 1 (b) BCIP) according to which "there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark" shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, Sabel, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

26. Global assessment of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (CJEU, Sabel and Lloyd, already cited).

27. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, Limonchello, C-334/05 P, 12 June 2007, ECLI:EU:C:2007:333). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, Matratzen, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and El Charcutero Artesano, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

28. The signs to be compared are the following:

| Opposition based on: | Opposition directed against: |
|---|--|
|  |  |

Visual comparison

29. The trademark invoked is a figurative trademark. It is composed of four black vertical lines followed by four black horizontal lines. All these lines are equal in length and are positioned with an equal amount of space between them. The contested trademark is a complex word-/figurative trademark composed of three words: HOFFMANN EITLE and AMSTERDAM. The word elements are preceded by a figurative element composed of eight vertical black lines followed by eight horizontal grey lines. All of these lines are equal in length and share a similar amount of space between them. The word AMSTERDAM is written in a smaller typeface than the words HOFFMANN EITLE. AMSTERDAM is positioned under the two other words.

30. Where a sign consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods or services in question by quoting their name than by describing the figurative element of the trademark (EGC, SELENIUMACE, T-312/03, 14 July 2005, ECLI:EU:T:2005:289). Given its dimensions and its prominent position at the beginning of the sign, the figurative element in the contested trademark holds an autonomous position and will therefore capture the public's attention next to the verbal elements.

31. The consumer normally attaches more importance to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). Visually both signs begin with a very similar figurative element, a composition made up of a number of vertical lines followed by an equal number of horizontal lines. The figurative elements are similar to the extent that there is an equal number of vertical and horizontal lines, that these lines all have the same length and are positioned an equal width apart from one another. The figurative elements differ as to the number of lines used, the colour as well as straightness of the lines. Furthermore the contested sign differs from the trademark invoked because of the addition of the words HOFFMANN EITLE AMSTERDAM in the contested trademark. Overall these figurative elements at the beginning of both signs leave a very similar impression.

32. Visually, the trademarks are similar.

Aural and conceptual comparison

33. As the trademark invoked is a purely figurative trademark, thus without any word elements it can, by definition, not be pronounced and will have no conceptual meaning as such. Therefore, an aural and conceptual comparison are not relevant here.

Conclusion

34. The trademarks are visually similar. An aural and conceptual comparison is not relevant here.

Comparison of the goods and services

35. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary (Canon, already cited).

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

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

| Opposition based on: | Opposition directed against: |
|---|--|
| CI 9 Electro technical and electronic apparatus, devices and instruments, insofar as contained in this class; devices for recording, receiving, registering, transmitting, processing, converting, outputting and reproducing data, language, text, signals, sound and images, including multimedia devices, namely devices which are designated for computer-aided, integrated production, manipulation, presentation, storing and communication of independent information, which is encoded in at least one continuous and one discrete medium; devices for the connection and controlling, including the multimedia-based connection and controlling, of audio, video and telecommunications devices as well as computers and printers, including those with electronic programme operation; data carriers of all types which are provided with programmes; sound and image and data carriers containing music; data carriers for the storage of information, data, images and sound, insofar as these are contained in this class; USB sticks; computer hardware, particularly controllers, namely units for controlling other devices in connection with music via MIDI and other formats; interfaces (interface devices or programmes for computers); programmes (software) of all types which are stored and downloadable, particularly music software, software for processing sound, music, images, | CI 9 Media recorded with data and information about services of lawyers and intellectual property agents; Software related to services of lawyers and intellectual property agents; Data- processing apparatus; Recorded software; computer programs [downloadable software]; Recorded computer operating system programs. |

| | |
|---|---|
| <p>video, midi, multimedia, games and meta data, software for sound development, production and processing, music processing software with an online function, software for sound production and processing in online networks, software for processing graphics files, software for managing personal information and preferences in relation to music, video and entertainment products; software for the remote transmission of sound, music, images, video, midi, multimedia, games and meta data; computer software, particularly digital audio workstations, namely cross-platform audio and music software for creating, editing, registering, synchronising, reproducing, sequencing, transmitting and playing back audio and MIDI in diverse file formats, particularly 2-wav, .aiff, .MP3, .aac and MIDI files, as well as a plurality of audio and MIDI tracks in real time for professional and hobby musicians, disc jockeys and music producers, digital instruments for any possible improvisation; musical sound and video recordings, downloadable; recorded audio loops; sound, music, image, video, midi, multimedia and meta data (downloadable), particularly as Internet downloads; computer peripheral devices, accessories (insofar as contained in this class) for home computers, video and computer games (insofar as contained in this class), particularly audio cards (sound cards); electronic publications (downloadable); mouse mats (mouse pads); entertainment devices which are to be used with an external screen or monitor; laptop bags; software for the remote transmission of sound, music, images, video, midi, multimedia, games and meta data.</p> | |
| <p>CI 16 Printed accompanying material for software and data processing programmes, namely handbooks, catalogues, operating manuals and work manuals; printed products and bookbinding articles, particularly magazines, journals, booklets and other scripts (publications); photographs; stationery, including writing and drawing devices, covers for typewriters; teaching and instructional material (except for apparatus); student requirements (paper and stationery products); exercise books; display cards, musical greeting</p> | <p>CI 16 Stationery and office supplies; Printed Products; Instructional material, except apparatus; Binders; Educational publications.</p> |

| | |
|---|---|
| <p>cards, postcards and greeting cards, invitation cards, letter paper, entry tickets; <u>paper products</u>, including paper, cardboard, <u>binders</u> and goods made from these materials, insofar as contained in this class; adhesive tags, including self-adhesive tags, transfer pictures (including such transfer pictures made from vinyl) and stickers, labels, not made of textile materials (stationery); notebooks; calendars; packaging bags and packaging material made from paper and plastic (insofar as contained in this class); materials for artists.</p> | |
| <p>CI 35 Advertising, marketing, intermediary services relating to business contacts including via the Internet; business organisational and administration consultancy for the use, application and maintenance of programmes (software) or programme and technical solutions for information technology (data processing); business affairs related to musicians and artists; negotiation of commercial transactions for others; dissemination of advertising brochures; file management using computers; retail services, namely the negotiation of contracts for third parties through selling applications of programmes (software) or programme-technical solutions for information technology (data processing) and through the purchasing and selling of other goods and the rendering of other services, including via the Internet; services of an electronic commerce transactor, namely receiving orders and the delivery request service as well as account handling for electronic ordering systems; online procurement of contracts for third parties both through the purchasing of goods and through the provision of services; presentation and marketing of goods and services on the Internet; online advertising on a computer network; renting of advertising space, advertising material and advertising time in communication media; collection and <u>arrangement of theme-related articles</u>.</p> | <p>CI 35 Business management; commercial management.</p> |
| <p>CI 41 Providing non-downloadable electronic publications; online publication of electronic books and journals; entertainment services, namely organising and holding interactive music competitions as well as organising and</p> | <p>CI 41 Legal education services; Providing continuing legal education courses; Editing and publishing printing products, including books, brochures, magazines and information in electronic support; Publication of educational printing products;</p> |

| | |
|---|---|
| <p>presenting show, quiz and music events; information in the fields of entertainment, music and education via a worldwide computer network; running a club (entertainment), a discotheque and sound studios; services of a sound and television studio, particularly digital production and reproduction of music and sound files, image, video, MIDI, multimedia and games; composing music; musical performances; video performances; compilation of broadcasting and television programmes; organising, arranging and holding conferences, congresses, concerts, symposia, seminars, workshops (education) and colloquia; arranging competitions (education and entertainment) and distance-learning courses; holding lotteries; holding live events; gaming services (from a computer network) offered online; renting of audio devices and sound recordings; video film production; events agency services, namely organising and arranging of artistic events and exhibitions for cultural or educational purposes; interpretations by artists; producing Web TV programmes, interactive programmes and Internet TV programmes; information in the field of music in oral and written forms, including through printed and electronic media; running of holiday camps (entertainment).</p> | <p>Publication of printing products related to intellectual property rights; Publication on Internet of printing products in electronic format; Organization, conduct and direction of seminars, conferences, symposia, improvement acts and scientific acts; Education; Training; Teaching.</p> |
| <p>CI 42 Scientific research for new products, namely according to musical taste, based on consumer selection; scientific research in the field of music; creating, developing, designing and supporting computer programmes and software, particularly for music processing, for processing sound and image files, for sound development, production and processing in online networks, for sound production and processing, for processing graphics files, for managing personal information and preferences in relation to music, video and entertainment products; services of a programmer, namely constructing an Internet platform for electronic commerce; services of an engineer, particularly in the field of multimedia, digital or interactive television and pay-tv (insofar as contained in this class); research in the field of computer programmes and software; technical consultancy and application consultancy in</p> | <p>CI 42 Scientific and technological services, as well as related research services related to intellectual property lawyers and firms; industrial analysis and research services relating to intellectual property firms; Design and development of software related to services of lawyers and intellectual property agents.</p> |

| | |
|---|--|
| <p>relation to computer and data processing programmes; renting and maintaining storage areas for use as Websites for third parties (hosting); information in the field of software in oral and written form, including through printed and electronic media; consultancy services relating to computer software, namely in the field of software configuration management, software processes and software patterns, namely means to optimize the musical performance of the software; online consultancy in the software field by telephone and via the Internet; reproduction, conversion and format alteration of computer programmes; hosting an interactive platform on the Internet for the exchange of information, particularly music and contact information of all types; hosting Internet platforms for real time interaction with other computer users in relation to themes of general interest and for the creation of music, videos and computer software; hosting an e-commerce platform on the Internet and other audio-visual media; hosting Internet platforms for real time interaction with other computer users in relation to themes of general interest, particularly music, video, games and software; hosting music and entertainment portals.</p> | |
|---|--|

Class 9

38. The defendant's goods *Media recorded with data and information about services of lawyers and intellectual property agents* are similar to the goods *electronic publications (downloadable)* of the opponent. The defendant's media refer to an array of communication channels through which information is disseminated on a particular topic, here services of lawyers and intellectual property agents. The opponent's electronic publications also constitute a means of communication that can contain data and information. Both goods serve the same purpose, that is to spread information, they can be produced by the same companies and distributed via the same channels.

39. The goods *Software related to services of lawyers and intellectual property agents; Recorded software; computer programs [downloadable software]; Recorded computer operating system programs* of the defendant are similar to the goods *programmes (software) of all types which are stored and downloadable, particularly music software, software for processing sound, music, images, video, midi, multimedia, games and meta data, software for sound development, production and processing, music processing software with an online function, software for sound production and processing in online networks, software for processing graphics files, software for managing personal information and preferences in relation to music, video and entertainment products* of the opponent. All of these goods constitute either software or computer programs. They therefore share the same nature. Where the defendant's goods relate to software in general or software related to services of lawyers and intellectual property agents in particular, the software of the opponent relates to software in general and software

related to music in particular. The Office observes that the term 'particularly' used in the opponent's classification indicates that the specific goods are only examples of items included in this category, and that protection is not restricted to them. Furthermore, these goods can be developed by the same companies and distributed via the same stores and are thus similar.

40. The goods *Data- processing apparatus* of the defendant are identical or highly similar to the goods *Electro technical and electronic apparatus, devices and instruments, insofar as contained in this class; devices for recording, receiving, registering, transmitting, processing, converting, outputting and reproducing data, language, text, signals, sound and images, including multimedia devices, namely devices which are designated for computer-aided, integrated production, manipulation, presentation, storing and communication of independent information, which is encoded in at least one continuous and one discrete medium* of the opponent. The goods at issue here concern devices or apparatuses that enable the processing of data. Considering that the goods of the opponent concern a particular type of data processing apparatus and the goods of the defendant relate to data processing apparatuses in general, these goods can be considered identical. Indeed, according to established case law, if the goods of the contested sign also contain goods that are mentioned in the earlier trademark, these goods are considered identical (see EGC, *Metabiomax*, T-281/13, 11 June 2014, ECLI:EU:T:2014:440).

Class 16

41. The goods *stationery* of the defendant are identical to the goods *stationery, including writing and drawing devices, covers for typewriters; stationery, including writing and drawing devices, covers for typewriters* of the opponent. The goods *office supplies* of the defendant are also identical to these goods of the opponent. Stationery, meaning the goods one needs for writing, concern necessary office materials and are thus included in the defendant's goods. As the goods of the defendant cover the particular goods of the opponent, they are deemed identical (see EGC, *Metabiomax*, already cited).

42. The defendant's *printed products* are identical to the goods *printed products and bookbinding articles, particularly magazines, journals, booklets and other scripts (publications)* of the opponent.

43. The goods *instructional material, except apparatus* of the defendant are identical to the goods *teaching and instructional materials (except for apparatus)* of the opponent. Furthermore, the goods *Binders* of the defendant are identical to the goods *paper products, including paper, cardboard, binders and goods made from these materials, insofar as contained in this class* of the opponent.

44. The goods *educational publications* of the defendant are similar to the opponent's *teaching and instructional material (except for apparatus)*. All of these goods share the same purpose, materials that are used to teach/educate. They can be produced by the same companies and distributed through the same channels to the same end user, educational and teaching institutions.

Class 35

45. The services *business management; commercial management* of the defendant are identical to the services *business affairs related to musicians and artists* of the opponent. Considering that the services of the opponent concern a particular type of business/management services and that the services of the defendant relate to management services in general, these services can be considered identical (see EGC, *Metabiomax*, already cited).

Class 41

46. The services *Organization, conduct and direction of seminars, conferences, symposia, improvement acts and scientific acts* of the defendant are identical or highly similar to the services *organising, arranging and holding conferences, congresses, concerts, symposia, seminars, workshops (education) and colloquia* of the opponent. All these services concern the organisation of gatherings intended to bring people together and to transfer information. Where the emphasis of the defendant's services seems to be on legal action, the focus of the opponent's gatherings seems to be on education. Nonetheless, the services share the same nature and purpose and can be provided by the same companies.

47. The defendant's *Legal education services; Providing continuing legal education courses; Education; Training; Teaching* of the defendant are similar to the services *organising, arranging and holding conferences, congresses, concerts, symposia, seminars, workshops (education) and colloquia* of the opponent. The services of the defendant concern education services in the legal field. The opponent's services also relate to providing education through the organisation of gatherings like conferences, seminars, workshops etc. Often the aim of the organisation of such gatherings is to educate people on a certain topic. Therefore the defendant's legal education services can be provided via the organisation of seminars, workshops, conferences etc. These services can thus be offered by the same companies and to a same end-consumer.

48. The services *Editing and publishing printing products, including books, brochures, magazines and information in electronic support; Publication of educational printing products; Publication of printing products related to intellectual property rights; Publication on Internet of printing products in electronic format* of the defendant are similar to the services *Providing non-downloadable electronic publications; online publication of electronic books and journal* of the opponent. The defendant's services cover editing and publication services of printing products either in electronic format or not. The opponent's services also concern publication of electronic books and journals as well as the provision electronic publication. Whereas the services concern publication services they all share the same nature. Editors often work for publishers by overseeing the work of writers in order to obtain a final product ready for publication. Once a publication is finished it will then be provided to readers. It is therefore established that these services can all be offered through the same company and via the same channels, either online or offline.

Class 42

49. The services *Scientific and technological services, as well as related research services related to intellectual property lawyers and firms; industrial analysis and research services relating to intellectual property firms* of the defendant are not similar to the opponent's goods and services. The Office observes that the defendant's services are activities provided by specialists in relation to theoretical and practical aspects of complex fields of activities such as intellectual property law in this case. Such services are rendered by specialised scientific institutes, research institutes, etc. These services of the contested application are neither of the same or similar nature to the opponent's goods and services, nor have they the same or similar purpose, nor are they in competition with or complementary to each other. Thus, it is concluded that the contested services are dissimilar to the opponent's goods and services.

50. The services *Design and development of software related to services of lawyers and intellectual property agents* are similar to the services *research in the field of computer programmes and software* of the opponent. The services of the defendant comprise design and development services in the IT field, which are essential for the functioning of the industry and will, therefore, include research and

investigation into new technologies and materials with the aim of discovering practical applications. These services have the same nature and can have the same providers, distribution channels and end users.

Conclusion

51. The goods and services of the defendant are partly identical, partly (highly) similar and partly dissimilar to the goods and services of the opponent.

A.2 Global assessment

52. 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.

53. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question. The relevant consumer who is part of the general public will decide to purchase certain goods and services covered by the signs at issue here – in particular those which are expensive or aim to meet a particular technological need such as the design and development of software in class 42 – on the basis of previously gathered information. In those circumstances, the level of attention of the relevant consumer will be higher than average for these services. On the other hand, such a level of attention may decrease in respect of other goods and services in classes 9, 16, 35 and 41, which constitute goods and services for the general public. In those circumstances, the relevant public will thus have an average level of attention (EGC, AAVA MOBILE, T-554/12, 27 March 2014, ECLI:EU:T:2014:158). Therefore, in defining the relevant public, account must be taken of the average consumer in the Benelux with either an average or above average level of attention, depending on the goods and services in question.

54. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken into account, particularly between the level of similarity of the signs and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

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

56. Account must also be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.

57. Notwithstanding the high level of attention of the public for some of the services, based on the abovementioned circumstances, especially the fact that the goods and services of the defendant are

identical, highly similar or similar to the goods and services of the opponent and that the signs are visually similar, the Office is of the opinion that the relevant public might believe that the identical or (highly) similar goods or services in question come from the same undertaking or from economically-linked undertakings.

B. Other factors

58. The defendant's conditional request to limit the goods and services, if the Office were to consider that they are similar, is not possible in opposition proceedings (see paragraphs 12 and 21). A limitation of goods and services can only be taken into account if it is expressly and unconditionally requested from the Office (see also GEU, Trenton, T-171/06, 17 March 2009, ECLI:EU:T:2009:70). This is not the case here. The defendant's request will thus not be taken into account.

59. The defendant observes that the opponent did not explain or make clear how the earlier goods and services correspond to the present goods and services, but he only made a statement without any further support (see paragraph 13). The Office establishes that in his analysis the opponent explicitly disputes the similarity of the contested goods and services for all of the contested classes. Even though the argumentation raised to dispute the similarity of the contested goods and services might be considered rather general, a reasoning has been established for each of the contested classes. Therefore, the Office concludes that the similarity of the remaining goods and services has sufficiently been motivated by the opponent in order for the Office to proceed to a comparison of the contested goods and services.

60. The defendant also argues that the right invoked did not show up in a search for registered EU trademarks similar to the contested trademark (see paragraph 15). Insofar as the defendant means that there would be no likelihood of confusion here given the coexistence of the trademarks, the Office admits that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between the two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings, the defendant has duly demonstrated that such coexistence was based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC, Top iX, T-57/06, 7 November 2007, ECLI:EU:T:2007:333 and LIFE BLOG, T460/07, 20 January 2010, ECLI:EU:T:2010:18). In this case, however, no such evidence has been provided by the defendant.

61. Furthermore, the defendant is of the opinion that the opponent should be precluded from action against the registration of the contested trademark as the opponent acquiesced the use of similar trademarks (see paragraph 17). Such argument cannot play a role in these proceedings. The opposition proceedings with the Office are intended to solve conflicts between trademark owners in a swift and simple manner. These proceedings are therefore limited to specific grounds, namely article 2.14 io 2.2ter par. 1 sub a and b BCIP. The application of these articles is solely judged based on the information as it appears in the trademark register. Other existing grounds of defence or objection against a trademark application cannot play a role in opposition proceedings. To that end the parties should file legal proceedings before a court.

C. Conclusion

62. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion for the goods and services that are deemed identical, highly similar and similar.

IV. DECISION

63. The opposition with number 2014599 is partially justified.

64. Benelux application with number 1379601 will not be registered for the following goods and services against which the opposition is directed:

- Class 9: All goods.
- Class 16: All goods.
- Class 35: Business management; commercial management.
- Class 41: All services.
- Class 42: Design and development of software related to services of lawyers and intellectual property agents.

65. Benelux application with number 1379601 will be registered for the following goods and services which were found to be dissimilar or against which the opposition was not directed:

- Class 35: Office functions; Office functions services; Providing office functions; Business office services; Computerised office management.
- Class: 42: Scientific and technological services, as well as related research services related to intellectual property lawyers and firms; industrial analysis and research services relating to intellectual property firms.
- Class 45: All services.

66. 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 only partly justified.

The Hague, 15 January 2020

Tineke Van Hoey
(rapporteur)

Tomas Westenbroek

Pieter Veeze



Administrative officer: Raphaëlle Gerard