



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2014689
of 29 February 2024

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

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

Invoked right 1: **European registration 17776634**



Invoked right 2: **European registration 5733019**



Invoked right 3: **European registration 7292709**



Invoked right 4: **European registration 12423125**

ERG RENEW OPERATIONS & MAINTENANCE

against

Defendant: **Eurasian Resources Group S.à r.l.**

Rue Sainte Zithe 9

2763 Luxembourg

Luxembourg

Representative: **NLO Shieldmark B.V.**

Anna van Buerenplein 21 A

2595 DA Den Haag

Netherlands

Contested sign: **Benelux application 1381433**

ERG

I. FACTS AND PROCEEDINGS

A. Facts

1. On 12 September 2018 the defendant filed a Benelux application for the word mark ERG for goods and services in classes 1, 4, 6, 14, 37, 39, 40 and 42. This application was processed under the number 1381433 and was published on 18 October 2018.

2. On 14 December 2018 the opponent filed an opposition against the registration of the application. The opposition is based on the following older rights:

- European registration with number 17776634 of the combined word/figurative mark



, filed on 6 February 2018 and registered on 21 July 2018 for goods and services in classes 4, 7, 9, 11, 35, 37, 39, 40 and 42 (hereinafter: invoked trademark 1);

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



, filed on 20 February 2007 and registered on 23 January 2008 for goods and services in classes 1, 3, 4, 9, 21, 37, 38 and 40 (hereinafter: invoked trademark 2);

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



, filed on 7 October 2008 and registered 14 May 2009 for goods and services in classes 1, 4, 7, 9, 37, 38, 39, 40 and 42 (hereinafter: invoked trademark 3);

- European registration with number 12423125 of the word mark ERG RENEW OPERATIONS & MAINTENANCE, filed on 12 December 2013 and registered on 13 May 2014 for goods and services in classes 7, 9, 11, 35, 37, 39, 40 and 42 (hereinafter: invoked trademark 4).

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

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

5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 14 December 2018. On the joint request of the parties the opposition proceedings were suspended several times. The administrative proceedings commenced on 19 October 2022. During the administrative phase of the proceedings the defendant requested proof of use of the invoked trademarks and both parties filed arguments. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 21 June 2023.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

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

A. Opponent's arguments

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

9. According to opponent the signs are visually very similar. The contested sign consists of the word ERG. The earlier trademarks are all dominated by the same and identical word element ERG. Considering that the visually dominant element in the trademarks at stake is the word ERG, it is very likely that the public will be more attentive to this word and will dismiss the other words RENEW OPERATIONS & MAINTENANCE which allude to the kind of designated activity. Phonetically the contested sign and invoked trademarks 1, 2 and 3 are identical. The first word of invoked trademark 4 is also identical. From a conceptual point of view none of the signs at stake have a meaning for the public in the relevant territory. A conceptual comparison is therefore not relevant.

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

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

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

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

14. In reply to the request of defendant to submit proof of use, opponent stated that invoked trademarks 1 and 4 are not yet subject to a requirement of use and that opponent will not produce proof of use for the invoked trademarks 2 and 3.

B. Defendant's arguments

15. Defendant first requested proof of use before filing the full observations. In his observations defendant mentions that opponent did not produce proof of use with regard to invoked trademarks 2 and 3. Therefore, these trademarks should not be included in the decision. Defendant therefore bases his observations only on the remaining trademarks 1 and 4.

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

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

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

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

19. Aurally the trademarks could sound identical. But this is not the case in practice. The invoked ERG is pronounced as one word, while the contested sign is an abbreviation of Eurasian Resource Group and is always pronounced as separate letters of the alphabet and not as a word. Therefore, the signs are aurally not similar/different.

20. Visually the trademarks are not similar. In the invoked trademarks the public's attention will not be focussed on the weak, descriptive word element, but rather on the other elements.

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

22. Subsequently defendant compares the goods and services taking into account the fact that opponent withdrew invoked trademarks 2 and 3. Therefore, no earlier rights exist anymore for class 1, and so the goods of class 1 are not to be regarded as similar and should consequently be fully registered. The goods in class 4 are identical (in red), similar (in blue) or similar to a low degree (in yellow). With regard to class 37 opponent did only mention the services of the revoked trademark 3 in his arguments. Since these services are not part of the opposition, class 37 should be registered in full. In addition, opponent only mentioned some of the services in class 37 of the contested sign so that at least the other services should be registered. Furthermore, if the services in class 37 of the invoked trademark 4 are taken in consideration, the services are not similar due to the limitation mentioned in the list of services of the contested sign. Defendant explains that some services in class 39 are similar (in red), but other services in class 39 are not, since trademark 3 is revoked (in blue) or due to their nature, purpose, method of use, distribution channels, relevant public and producer (in green). Opponent only opposed some services in class 40. These services are identical/similar (in bold and red). The other services should be registered because they are only addressed based on revoked trademarks 2 and 3 (in blue) or because they are not addressed and not similar (in green). Defendant explains that in class 42 some services are slightly similar (in yellow) and others are not similar (in green).

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

III. DECISION

A Genuine use

24. Defendant requested proof of use of the invoked trademarks. Opponent replied that the invoked trademarks 1 and 4 are not subject to a requirement of use. Opponent did not produce proof of use regarding invoked trademarks 2 and 3.

25. Given the above, the opposition proceedings proceed solely based on the trademarks 1 and 4.

B Likelihood of confusion

26. Article 2.2ter, 1 BCIP stipulates insofar as relevant that, *"A trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*¹

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

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

Comparison of the goods and services

29. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. These factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary.⁴

30. Goods and services are complementary when they are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both.⁵

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

¹ Art. 2.2ter, 1, b BCIP implements art. 5, 1, b Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in art. 8, 1, b Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

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

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

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

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

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

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

33. Since the opposition is no longer based on the invoked trademarks 2 and 3 (see above under 24 and 25) the comparison based on goods and services of the invoked trademarks 2 and 3 is deleted from the overview provided by the opponent. To the extent that the opposition directed against certain goods and services of the contested sign was solely based on the invoked trademarks 2 and 3, the opposition cannot succeed.

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

Opposition based on:	Opposition directed against:
<u>Invoked trademark 1:</u> Cl 4 Fuel gas; Natural gas.	Cl 4 Fuels; light oil; coal; thermal coal; long flame coal; semi coke; industrial oils and greases; mineral fuel; biofuels; kerosene; diesel oil; fuel oil; fuel gas; natural and synthetic fuel gases; gasoline; raw and refined petroleum; crude oil; crude oil products derived from the refining of crude; coal and carbonaceous fuels for power generation use; coke; coal tar oil; electrical energy; industrial lubricants; petroleum (raw and refined).
<u>Invoked trademark 1:</u> Cl 39 Transport, distribution and storage of gas and chemicals and derivatives thereof. <u>Invoked trademark 4:</u> Cl 39 Distribution, storage, supply of energy and sale of energy.	Cl 39 Collection, removal, storage, handling and delivery of goods; transport and distribution of electricity Cl 39 Transport and distribution of electricity; transport and distribution of heating; delivery of goods; distribution services.
<u>Invoked trademarks 1 and 4:</u> Cl 40 Generation of electricity and energy, for others; Energy production.	Cl 40 Production and generation of electricity; production and generation of heating; energy production; all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas).
<u>Invoked trademarks 1 and 4:</u> Cl 42 Technical and engineering studies, research and design, in particular relating to energy, renewable energy and technologies necessary for the development thereof.	Cl 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services in particular in relation to production technologies and marketing

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

	<p>of products, including material testing, quality control, technical project studies, engineering work; geophysical exploration for the mining industry; technical consulting in the field of mining exploration and extraction of natural resources; mining services, namely, mining exploration; analysis for oil-field exploitation; oil prospecting; oil exploration; oil field exploration; underwater exploration; gas exploitation; analysis for oil-field exploration; geological research; land surveying; analysis, testing and research services associated with oil fields, oil workings, gas and oil installations, power stations, mines, steel mills, aluminum smelters, copper smelters and nickel smelters, including providing the services of analysis, testing and research laboratories in the aforementioned fields; research in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; engineering consulting in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; technical project studies in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; technical research in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals,</p>
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	treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas).
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Class 4

35. Opponent argues that the goods in class 4 of the invoked trademark 1 and the goods in class 4 of the contested sign are very similar or identical. Defendant explains that the goods in class 4 of the contested sign are partly identical, partly similar and partly similar to a low degree to the goods in class 4 of the invoked trademark 1. According to the Office, the goods in class 4 are partly identical ("Fuels" and "Natural gas") and partly similar, since all goods relate to energy and therefore share the same public and means of distribution. The goods are also in competition with each other.

Class 39

36. Opponent argues that the services in class 39 are very similar or identical to the services in class 39 of the invoked trademarks 1 and 4. Defendant explains that only the "*collection, removal, storage, handling and delivery of goods*" and "*delivery of goods; distribution services*" (all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas)) in class 39 of the contested sign are similar to services in class 39 of the invoked trademarks 1 and 4. The Office assumes with the parties that these services are similar. According to the Office, however, also the other services in class 39 of the contested sign mentioned in the overview, namely "*Transport and distribution of electricity*" and "*transport and distribution of heating*" are clearly highly similar to the services in class 39 of the invoked trademark 4. These services all concern distribution of energy (electricity, heating and energy) and are similar in their nature, public and means of distribution.

Class 40

37. Opponent argues that the services in class 40 are very similar or identical to services in class 40 of the invoked trademarks 1 and 4. Defendant agrees that the services "*Production and generation of electricity; production and generation of heating*" and "*energy production*" in class 40 of the contested sign are indeed identical/similar to services in class 40 of the invoked trademarks 1 and 4. The Office assumes with the parties that the services in class 40 mentioned in the overview are identical/similar.

Class 42

38. Opponent argues that the services in class 42 are very similar or identical to the services in class 42 of invoked trademarks 1 and 4. Defendant explains that only "*Scientific and technological services and research and design relating thereto; industrial analysis and research services in particular in relation to production technologies and marketing of products, including material testing, quality control, technical project studies, engineering work;*", "*analysis for oil-field exploration*", "*analysis for oil-field exploration;*

geological research" and *"power stations"* in class 42 of the contested sign are slightly similar to services in class 42 of the invoked trademarks 1 and 4. However, according to the Office all the services in class 42 of the contested sign mentioned in the overview can and will be carried out under the categories *"Technical and engineering studies; research and design, in particular relating to energy, renewable energy and technologies necessary for the development thereof"* as mentioned in class 42 of the invoked trademarks 1 and 4. After all, the subject of all services relates to energy and the services are therefore aimed at the same public and coincide in their nature and means of distribution. Therefore, the Office is of the opinion that the services in class 42 are identical or at least similar.

Conclusion

39. The goods and services are partly identical and partly similar.


Comparison of the signs

40. To assess the degree of similarity between the conflicting signs, their visual, phonetic and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.⁸

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

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

43. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
<p data-bbox="215 1552 470 1579"><u>Invoked trademark 1:</u></p> <div data-bbox="363 1630 639 1706" style="text-align: center;">  </div> <p data-bbox="215 1771 470 1798"><u>Invoked trademark 4:</u></p>	<p data-bbox="1093 1742 1141 1769" style="text-align: center;">ERG</p>

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

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

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

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44. Invoked trademark 1 is a combined word/figurative trademark consisting of the word ERG in dark blue stylized letters, with a figurative element of three stylized lines in light blue, green and dark blue in front of it. Invoked trademark 4 is a word mark containing of four words of in total 29 letters and an ampersand: ERG RENEW OPERATIONS & MAINTENANCE.

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

Visual comparison

46. 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.¹¹ In this case, the figurative elements in the invoked trademark 1 will not go unnoticed to the average customer. However, the attention of the public will particularly be focused on the dominant word element ERG.

47. Also in the invoked trademark 4 the word element ERG is dominant. Firstly because the consumer normally attaches more importance to the first part of words.¹² Secondly, because the Office is of the opinion that the word elements RENEW, OPERATIONS & MAINTENANCE are descriptive for the goods and services concerned.

48. The contested sign consists of the dominant element ERG of the invoked trademarks.

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

Aural comparison

50. According to the Office the invoked trademark 1 and the contested sign will both be pronounced identical as one word: ERG. The Office does not follow the argument of defendant that the contested sign will be pronounced as separate letters, because ERG is an abbreviation of Eurasion Resource Group (see above under 19). The Office is not convinced that the relevant (professional) Benelux public will perceive the sign as an abbreviation of Eurasion Resource Group, as defendant also did not substantiate this

51. The invoked trademark 4 and the contested sign will be pronounced highly similar. Although these signs differ in length and rhythm, the identical syllable ERG in both signs is dominant and will also aurally receive the most attention (see above under 48 and 49). In addition, it is possible that the public will not pronounce the words RENEW OPERATIONS & MAINTENANCE in the invoked trademark 4, because a mark which includes several words will generally be abbreviated aurally to something easier to pronounce.¹³ In that case, the invoked trademark 4 and the contested sign are aurally identical.

¹¹ General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 and the case-law mentioned there (Smarter Travel).

¹² General Court (EU) 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

¹³ General Court (EU) 30 November 2006, T-43/05, ECLI:EU:T:2006:370, point 75 (Brothers by Camper).

52. Given the above the Office is of the opinion that invoked trademark 1 and the contested sign are aurally identical and invoked trademark 4 and the contested sign are aurally at least highly similar.

Conceptual comparison

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

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

Conclusion

55. The signs are visually highly similar and aurally identical (invoked trademark 1) or highly similar (invoked trademark 4). A conceptual comparison is not relevant.

Global assessment

56. 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.¹⁴ In the present case, the Office assumes that the relevant public consists of the general public (for some goods in class 4) and professionals. The level of attention will vary from average to high.

57. The higher the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.¹⁵ In the present case the invoked trademarks have to be considered as having normal distinctiveness for the goods and services concerned as they do not describe the characteristics of the goods and services in question (see above under 53). The Office also does not follow the argument of defendant that a three-letter mark is not very distinctive per se (see above under 16).

58. 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.¹⁶

59. In this case the invoked trademarks and the contested sign are visually highly similar and phonetically identical (invoked trademark 1) or highly similar (invoked trademark 4). The relevant goods and services are partly identical and partly similar. On the basis of these and the other factors mentioned above, amongst which the average to high level of attention of the relevant public, and considering their

¹⁴ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁵ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹⁶ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, punt 59 and the case-law mentioned there (Equivalenza).

interdependence, the Office considers that there is a likelihood of confusion in the sense that the public may believe that the goods and services designated by the invoked trademarks and the goods and services to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically linked.

Other factors

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

C. Conclusion

61. Based on the foregoing, the Office concludes that there is a likelihood of confusion for some of the contested goods and services.

IV. DECISION

62. The opposition with number 2014689 is partly justified.

63. The Benelux application with number 1381433 will not be granted for the following goods and services:

- Class 4: (all goods)
- Class 39: "Collection, removal, storage, handling and delivery of goods; transport and distribution of electricity; transport and distribution of heating; delivery of goods; distribution services; all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas)."
- Class 40: "Production and generation of electricity; production and generation of heating; energy production; all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas)."
- Class 42: "Scientific and technological services and research and design relating thereto; industrial analysis and research services in particular in relation to production technologies and marketing of products, including material testing, quality control, technical project studies, engineering work; geophysical exploration for the mining industry; technical consulting in the field of mining exploration and extraction of natural resources; mining services, namely, mining exploration; analysis for oil-field exploitation; oil prospecting; oil exploration; oil field exploration; underwater exploration; gas exploitation; analysis for oil-field exploration; geological research; land surveying; analysis, testing and research services associated with oil fields, oil workings, gas and oil installations, power stations, mines, steel mills, aluminum smelters, copper smelters and nickel smelters, including providing the services of analysis, testing and research laboratories in the aforementioned fields; research in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of

¹⁷ CJEU 3 September 2009, C-498/07 P, ECLI:EU:C:2009:503, point 84 (La Espanola).

metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; engineering consulting in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; technical project studies in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; technical research in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas)."

64. The Benelux application with number 1381433 will be granted for the following goods and services as the opposition was not directed against these goods and services (see above under 4 and 32) or because the opposition cannot succeed for these goods and services (see above under 33):

- Class 1 (all goods)
- Class 6 (all goods)
- Class 14 (all goods)
- Class 37 (all services)
- Class 39: "Transport; railway transport; water vessel transport; car transport; transportation of passengers by bus or cars; freight (shipping of goods); packaging and storage of goods; ship brokerage; transport brokerage; freight and cargo transportation; unloading cargo; collection of goods; consignment services; information, consultancy and advisory services relating to the aforesaid services; all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas)."
- Class 40: "Treatment of materials; treatment of ores and of common metals and their alloys; treatment of metals, including upgrading and refinement; refining services; custom manufacture and assembly services; treatment and transformation of materials; processing of ferroalloys, ferrochrome, manganese, chrome ore, iron ore, limestone, dolomite and construction gravel; alumina, aluminum, bauxite, copper, cobalt, coal, platinum, fluor spar, coke, semi-coke; production of ferroalloys, ferrochrome, manganese, chrome ore; iron ore, limestone, dolomite and construction gravel; processes associated with extraction of metals from minerals; information, consultancy and advisory services relating to the aforesaid services; all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas)."
- Class 42: "Information, consultancy and advisory services relating to scientific and technological services and research and design relating thereto; industrial analysis and research services in particular in relation to production technologies and marketing of products, including material testing, quality control, technical project studies, engineering work; geophysical exploration for the mining industry; technical consulting in the field of mining exploration and extraction of natural resources; mining services, namely, mining

exploration; analysis for oil-field exploitation; oil prospecting; oil exploration; oil field exploration; underwater exploration; gas exploitation; analysis for oil-field exploration; geological research; land surveying; analysis, testing and research services associated with oil fields, oil workings, gas and oil installations, power stations, mines, steel mills, aluminum smelters, copper smelters and nickel smelters, including providing the services of analysis, testing and research laboratories in the aforementioned fields; research in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; engineering consulting in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; technical project studies in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; technical research in the field of treatment of materials, mining, oil exploration, gas exploration, processing of ores and metals, treatment of ores and metals, processing of petroleum, treatment of petroleum, processing of coal, treatment of coal, processing of industrial oils, treatment of industrial oils, processing of crude oil, treatment of crude oil, processing of metal alloys, treatment of metal alloys, processing of chemicals and treatment of chemicals; all of the afore-mentioned services not in the field of "green energy" (energy from wind, sun, water and natural gas)."

65. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.28(3) IR, as the opposition is partly justified.



The Hague, 29 February 2024

Marjolein Bronneman
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Pieter Veeze

Tomas Westenbroek

Administrative officer: Raphaëlle Gerard