



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2014692
of 14 October 2021

Opponent: **GRE Grand River Enterprises Deutschland GmbH**
Rietzer Berg 28
14797 Kloster Lehnin/OT Rietz
Germany

Representative: **Novagraaf Nederland B.V.**
Hoogoorddreef 5
1101 BA Amsterdam
Netherlands

Invoked right: **European trademark registration 008710221**

MOHAWK

against

Defendant: **Aphria Inc.**
Talbot Street West 265
ON N8H Leamington
Canada

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

Contested trademark: Benelux application 1380167

MOHAWK

I. FACTS AND PROCEEDINGS

A. Facts

1. On 17 August 2018 the defendant filed a Benelux trademark application for the wordmark "MOHAWK" for goods in class 5, 29, 31 and 34. This application was processed under number 1380167 and was published on 19 November 2018. The application claimed as a priority the Canadian trademark application "MOHAWK" number 1912932 with a priority date of 1 August 2018.

2. On 17 December 2018 the opponent filed an opposition against the registration of the application. The opposition is based on the European registration 008710221 of the wordmark "MOHAWK", filed on 9 November 2009 and registered on 3 May 2010 for goods in class 34.

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 covered by the contested application and is based on all of the goods covered by the trademark invoked.

5. The grounds for opposition are those laid down in article 2.14, 2 (a) 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" or "BOIP") to the parties on 18 December 2018. During the administrative phase of the proceedings both parties filed arguments and the opponent filed documents to prove use of his trademark. In addition, the defendant has made a limitation of the products covered by its application. 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 7 January 2020.

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.

A. Opponent's arguments

9. The opponent starts his arguments with the comparison of the signs. He notes that both signs are composed of the same word element and as such identical visually, phonetically and in their conceptual reference to a native American tribe, language or a haircut. Thus, the signs in question are identical according to the opponent.

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.

10. With regard to the goods and services, the opponent notes that the goods covered by the defendant in class 5 and 29 are all related to cannabis and marijuana which is a stimulant just like the tobacco products covered by the opponent. As a result, the opponent considers these to be similar to the goods covered by the trademark invoked. According to the opponent, the goods covered in class 31 by the defendant's application, are highly similar to tobacco covered by the opponent in that both cannabis and tobacco are made out of dried living plants and used as a stimulant by smoking. As concerns the goods covered in class 34 by the contested trademark, the opponent notes, beyond the fact that they have a similar purpose, both cannabis/marijuana products and tobacco are often used in combination. As a result, the opponent finds that they are similar to a high degree. In the same class the opponent notes that the smoker's articles of the contested trademark are highly similar if not identical to the "smoker's articles" of the invoked right.

11. In general, the opponent finds the goods in question similar as they can be produced by the same manufacturers, share a common nature and purpose and are addressed at the same public. Furthermore, the opponent argues that the close link between these goods may lead consumers to believe that the opponent is entering a new market with the sale of cannabis and cannabis-related products.

12. As a result, the opponent considers the trademarks identical while also finding the goods covered by both trademarks highly similar, thus concluding that there is likelihood of confusion for the consumer.

13. In addition, should the Office find that the goods are dissimilar, the opponent points out that the signs being identical alleviates the need for similarity between the goods.

14. Following the request by the defendant, the opponent submitted proof of use.

B. Defendant's arguments

15. In the first place the defendant asks the opponent to provide proof of use for his trademark.

16. In that regard the defendant considers that the proof submitted by the opponent is insufficient to prove genuine use of the invoked trademark. More specifically, as concerns the invoices and export documents submitted, the defendant finds the lack of end consumers and limited number of distributors too low to prove genuine use for the relevant territory or the Benelux. The fact that the sales numbers provided are issued by the opponent himself also lowers their probative value according to the defendant. Concerning the illustration of the packaging, advertisement, sales catalogue and brand overview provided, the defendant notes that none of these provide any information on the actual use of the trademark and doubts the actual publication of some of these documents.

17. In his arguments addressing the likelihood of confusion invoked by the opponent, the defendant starts by conceding that the signs in question are indeed identical.

18. Regarding the comparison of goods, the defendant notes, first and foremost that the fact that the goods in class 5 could be used for e-vaping seems farfetched, especially considering e-vaping is not mentioned in this class. Furthermore, considering the goods in class 5 of the defendant, consisting of goods intended for medical use and not as stimulants, the fact that the goods covered by the trademark invoked specifically exclude medical use leads the defendant to conclude that these goods must be considered dissimilar.

19. In relation to the goods in class 29 the defendant argues that cannabis should be perceived as an ingredient of these products and not as a stimulant. As such there is no similarity according to the defendant between the food products covered in class 29 and the tobacco in class 34 of the trademark invoked.

20. For the goods in class 31, the defendant notes that the live plants covered in this class are different from the goods covered by the invoked right in class 34. Indeed, cannabis can be consumed in other ways than by smoking and is not necessarily used as a stimulant. Thus, considering that the goods of the trademark invoked do not refer to cannabis, there is no similarity between these goods.

21. As regards the goods in class 34, the defendant notes that cannabis is not exclusively consumed in conjunction with tobacco, in fact it appears that use without tobacco is recommended for health reasons and thus these goods cannot be considered complementary. The defendant also notes that it is very uncommon for tobacco manufacturers to also offer cannabis related products, thus he finds the assertion of the opponent according to which it is very likely that the consumer would perceive the sale of such products as an extension of their business not founded. Furthermore, the defendant notes that the relevant public of both types of goods is very different and that nicotine contained in tobacco, contrary to cannabis, is highly addictive. Finally, the defendant notes that both products differ in their channels of distribution, nicotine being freely available whereas cannabis can only be sold in small amounts through vendors appointed via licenses by the government. As such the defendant concludes that the goods must be considered dissimilar.

22. The defendant, referring to case law, notes that for goods in class 34 the level of attention of the relevant public is higher than average.

23. Notwithstanding the identity of the signs in question, the defendant notes that for there to be likelihood of confusion there still needs to be at least a similarity between the goods in question.

24. In that regard and considering the arguments above, the defendant finds that the proof of use submitted is insufficient to prove a genuine use of the invoked trademark for the relevant period and in the relevant territory. Nonetheless, should the Office decide that use was sufficiently proven, the defendant still finds that there exists no risk of confusion for consumers confronted with these trademarks due to their higher level of attention and the lack of similarity between the goods covered. Thus he asks the Office to register the contested trademark and to order that the costs be borne by the opponent.

III. DECISION

A.1 Proof of use

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

26. The publication date of the contested trademark is 19 November 2018. Therefore, the opponent was required to show use of the invoked trademark during the period from 19 November 2013 to 19 November 2018 ('the relevant period'). Given the fact that the trademark invoked was registered more than five years prior to the publication date of the contested trademark, the defendant's request that proof of use is submitted is legitimate.

In general

27. In accordance with the decision of the European Court of Justice (hereinafter referred to as "ECJ") of 11 March 2003 (ECJ, Ansul, C-40/01, ECLI:EU:C:2003:145) there is genuine use of a trademark where

the mark is used 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. This is done in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. 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 (see also General Court of the European Union (hereinafter referred to as "EGC"), *Silk Cocoon*, T-174/01, 12 March 2003, ECLI:EU:T:2003:68; EGC, *Vitafruit*, T-203/02, 8 July 2004, ECLI:EU:T:2004:225; EGC, *Charlott*, T-169/06, 8 November 2007, ECLI:EU:T:2007:337).

28. The EGC held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (EGC, *Hipoviton*, T-334/01, 8 July 2004, ECLI:EU:T:2004:223; EGC, *Sonia-Sonia Rykiel*, T 131/06, 30 April 2008, ECLI:EU:T:2008:135). The purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trademark protection to the cases where large-scale commercial use has been made of the mark (EGC, *Vitafruit*, already referred to above).

29. In addition the EGC held that 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 (see EGC, *Hiwatt*, T-39/01, 12 December 2002, ECLI:EU:T:2002:316; EGC, *Vitakraft*, T-356/02, 6 October 2004, ECLI:EU:T:2004:292 and EGC, *Sonia-Sonia Rykiel*, already referred to above).

30. The trademark invoked is a trademark of the European union, hence the obligation to use the trademark is administered by article 18 of Regulation (EU) No 2017/1001 of the European Parliament and of the Council of 14 June 2017. This article, entitled "Use of an EU mark", stipulates: *"If, within a period of five years following registration, the proprietor has not put the EU trade mark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the EU trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use."*

31. In its decision of 19 December 2012 (case C-149/11, *Onel*, ECLI:EU:C:2012:816), the ECJ explained this provision². The ECJ considers regarding the concept "in the Community" that there is a difference between the territorial extent of the protection conferred on national trademarks and the extent of the protection conferred on EU trademarks. From a territorial point of view, an EU trademark enjoys a more extensive scope of protection than a national trademark. As a consequence it may reasonably be expected that an EU trademark can be used in a larger area, except for the (exceptional) case where the market for the goods and services at issue has been territorially restricted. Abstraction should be made here of the boundaries of the territory of the Member States. The ECJ concludes: *"A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."*

² Referring to the equivalent provision, article 15 in the previous Regulation No 2015/2424 of the European Parliament and of the Council.

32. The threshold for genuine use of an EU trademark is therefore in principle higher than that for genuine use of a national (or Benelux) trademark. It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU and taking into account all relevant facts and circumstances.

Analysis of the proof of use

33. The opponent submitted the following exhibits to demonstrate the genuine use of the invoked trademark in the European Union:

1. Several administrative documents showing the transit of goods carrying the name of the invoked trademark to Austria covering a period from 2015 to 2017.
2. Sales figures provided by the opponent for the period of 2014 to 2018 for goods sold under the invoked trademark in the Netherlands.
3. Invoices originating from the opponent and addressed at a company named TGC Trading B.V showing sales of products under the invoked trademark in the Netherlands during the period of 2017 to 2018.
4. Prints of packaging for cigarettes showing the invoked trademark.
5. Invoices originating from the opponent and addressed at a company named Logista Italia showing sales of products under the invoked trademark in Italy during the period of 2013 to 2015.
6. An advertisement for cigarettes in German showing the invoked trademark.
7. Invoices originating from the opponent and addressed at a company named Poligono Polvoranca showing sales of products under the invoked trademark in Spain in 2013.
8. A sales catalogue issued in 2014 showing the products offered by the opponent, among which cigarettes and tobacco sold under the invoked trademark.
9. An overview of the brands held by the opponent dating from 2013, among which cigarettes and tobacco products containing the invoked trademark are displayed.

34. 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 goods concerned. The invoices provided (exhibits 3, 5 and 7) read in conjunction with the sales figures and transit related administrative documents (exhibits 2 and 1), show, despite the lower probative value of the sales figures provided by the opponent himself, that the opponent is active with the invoked trademark in several Member States, namely the Netherlands, Germany, Austria, Italy and Spain. All in all, the documents provided cover the entirety of the relevant period.

35. The individual sales figures and invoices provided cover relatively modest amounts with regards to the cigarettes and tobacco market in the European Union. Indeed while the invoices cover about 125'000 units sold in addition to invoices totalling up to about 34'000 Euros, the sales figures show annual values of sales ranging from about 60'000 to 160'000 Euros annually over the relevant period. Taking all this into account, the Office is of the opinion that the figures still exceed the threshold for mere token use especially when considering all commercial documents provided in conjunction. Indeed, the purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking. The assessment is made in order to establish if the registered trademark has been put to use to fulfil its essential function as a badge of origin in a way that exceeds mere token use, i.e. use for the sole purpose of preserving the rights conferred by the mark.

36. Although, as the defendant points out (paragraph 16), no invoices to end consumers are provided, the Office finds that the proof submitted, when taken as a whole, is sufficient to show genuine use within the relevant territory. Especially when viewed in conjunction with the marketing and advertisement evidence provided (exhibits 4, 6, 8 and 9), which show that the invoked trademark is also used outwardly and publicly, the Office notes that the sales to external companies in charge of logistics and distribution of the products, as appears to be the case based on the evidence provided, is a common method of business organisation in the course of trade and implies use of the mark that cannot be regarded as purely internal use by a group of companies (see EGC, Friboi, T-324/09, 17 February 2011, ECLI: EU:T:2011:47).

37. It should be noted that the evidence submitted relates solely to tobacco and tobacco related products like cigarettes. The Office therefore finds that the opponent has not submitted any evidence showing use of the mark at issue for the other goods covered in class 34. Therefore, genuine use of the mark cannot be established for these.

38. Thus, after careful analysis of all of the proof of use provided, the Office concludes that the evidence submitted, shows genuine use for the following goods mentioned in class 34 of the invoked trademark namely *"processed tobacco and tobacco products, included in class 34, in particular cigarettes"*. For this reason, the Office will continue with the assessment of the likelihood of confusion considering solely these goods for which the opponent has proven genuine use of his invoked trademark.

A.2 Likelihood of confusion

39. 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.

40. 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."*

41. 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 trademarks

42. 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).

43. 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).

44. 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).

45. The trademarks to be compared are the following:

Opposition based on:	Opposition directed against:
MOHAWK	MOHAWK

46. According to Rule 1.21(e) of the IR, compliance with the adversarial principle referred to in Article 2.16(1) CBPI implies, *inter alia*, that the examination of the opposition is limited to the arguments, facts and evidence put forward by the parties. The parties agree that the trademarks in question are identical (see paragraphs 9 and 17). The Office will therefore not proceed to a comparison of the signs.

Conclusion

47. The trademarks in question are identical.

Comparison of the goods

48. 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 (CJEU, Canon, already cited).

49. With the comparison of the goods of the trademark invoked and the goods against which the opposition is filed, the goods are considered only on the basis of what is expressed in the register in as far as genuine proof of use was provided.

50. Due to the limitation of the list of products claimed by the defendant during the procedure (see paragraph 7), the following comparison will take into account the products listed in the register after this limitation.

51. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
	Cl 5 nutraceuticals for medicinal purposes; nutraceuticals for medicinal purposes containing cannabis; nutraceuticals for medicinal purposes containing derivatives of cannabis, namely resins and oils; topical skin creams, bar and liquid soaps, bath additives, bath herbs, bath oils, body creams, body oils, face and body lotions, face and body milk, face lotion, and skin care preparations each containing derivatives of cannabis; each of the aforementioned products for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, as a sleep aid; personal sexual lubricants; transdermal patches containing cannabis; oral sprays containing cannabis.; Cannabis related products, namely medicinal oils; medicinal oils derived from cannabis; cannabis and marijuana; cannabis related products, namely medicinal oils, salves, concentrated pastes, tinctures, tablets and capsules, each containing cannabis; medicinal oils, salves, concentrated pastes, tinctures, tablets and capsules each containing resins and medicinal oils derived from cannabis.
	Cl 29 butter containing cannabis, cannabis resins and cannabis oils; cannabis related product, namely oils, not for medicinal use; oils derived from cannabis, not for medicinal use.
	Cl 31 Live cannabis plants; live marijuana plants; cannabis seeds.
Cl 34 <i>processed tobacco and tobacco products, included in class 34, in particular cigarettes</i>	Cl 34 Dried marijuana, dried cannabis; derivatives of cannabis, namely resins and oils; cannabis and marijuana for recreational use; none of the aforesaid consisting of, or containing, tobacco.
	<i>N.B: The list of goods used for the purposes of this decision is the revised list following the restrictions recorded in class 34 upon the request of the applicant.</i>

Class 5

52. The goods " *nutraceuticals for medicinal purposes; nutraceuticals for medicinal purposes containing cannabis; nutraceuticals for medicinal purposes containing derivatives of cannabis, namely resins and oils; topical skin creams, bar and liquid soaps, bath additives, bath herbs, bath oils, body creams, body oils, face and body lotions, face and body milk, face lotion, and skin care preparations each containing derivatives of cannabis; each of the aforementioned products for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, as a sleep aid; personal sexual lubricants; transdermal patches containing cannabis; oral sprays containing cannabis.; Cannabis related products, namely medicinal oils;*

medicinal oils derived from cannabis; cannabis and marijuana; cannabis related products, namely medicinal oils, salves, concentrated pastes, tinctures, tablets and capsules, each containing cannabis; medicinal oils, salves, concentrated pastes, tinctures, tablets and capsules each containing resins and medicinal oils derived from cannabis." concern goods used for their desirable positive impact on a person's health and body. As such these goods are dissimilar to the goods related to tobacco covered by the trademark invoked in class 34 which are used for a different purpose and vary in their nature, method of use, production and distribution channels. Furthermore, the relevant public for both types of goods are also dissimilar.

Class 29

53. The goods "*butter containing cannabis, cannabis resins and cannabis oils; cannabis related product, namely oils, not for medicinal use; oils derived from cannabis, not for medicinal use.*" concern food products containing or derived from cannabis. Thus, these goods differ from the tobacco products covered by the trademark invoked in their nature and the means of consumption. Furthermore, the production and distribution channels are different for both types of products and they do not share the same relevant public. Thus, these goods are dissimilar.

Class 31

54. The goods "*Live cannabis plants; live marijuana plants; cannabis seeds.*" in class 31 of the contested trademark concerns live plants and seeds. There is no indication that could lead to the assumption that these plants would be destined for consumption through smoking. Indeed even if this was the case, the live plants as covered in this class are not in a state ready for such consumption and would need to undergo further treatment to that end. Instead these goods cover plants which, in their nature, use, relevant public and distribution channels differ from the tobacco products covered by the invoked right. Thus, these goods are dissimilar.

Class 34

55. Finally the goods "*Dried marijuana, dried cannabis; derivatives of cannabis, namely resins and oils; cannabis and marijuana for recreational use; none of the aforesaid consisting of, or containing, tobacco*" from the contested sign are similar to the "*processed tobacco and tobacco products included in class 34, in particular cigarettes*" of the invoked trademark. Indeed, both share a similar purpose and method of use namely smoking and coincide in their relevant public. While, as the defendant notes, it is not mandatory for the consumption of marijuana to mix it with tobacco, this presents nonetheless an established practice reinforcing the link between both goods and making them potentially complementary. Furthermore, while it is true that the channels of distribution for cannabis are more heavily legislated than for tobacco, the latter can still be sold by these distributors too. The explicit exclusion in the list of the contested trademark's products "*none of the aforesaid consisting of, or containing, tobacco*" is not sufficient to rule out the similarities previously established between the goods covered by both trademarks.

Conclusion

56. The goods covered by the contested trademark are in part similar and in part dissimilar to the goods covered by the trademark invoked.

A.3 Global assessment

57. 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.

58. 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 according to the category of goods or services in question. In the present case, the goods which are found to be similar (see paragraph 55) are directed at the public at large with a higher than average degree of attention. Although tobacco products are 'relatively cheap' articles for mass consumption, smokers are considered particularly careful and selective about the brand of cigarettes they smoke, so a higher degree of brand loyalty and attention is assumed when tobacco products are involved. At the same time, the specific legislative framework in place for the sale of cannabis products covered in class 34 make it so that the relevant consumer purchasing such product will display a higher than average level of attention, due to the fact that such products can only be sold by specialised distributors.

59. 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 they cover. A lesser degree of similarity between the relevant goods can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

60. 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 concerned.

61. 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.

62. Based on the abovementioned circumstances, despite the higher level of attention, the Office finds that due to both signs being identical, the relevant public might believe that the similar goods in class 34 would come from the same undertaking or from economically-linked undertakings.

B. Other factors

63. In an opposition procedure there is no question of the other party being ordered to bear the costs incurred (see paragraph 24). Only a referral of the costs set at the established opposition fee in case the opposition is totally rejected (or justified) is provided for.

C. Conclusion

64. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion between both trademarks for the goods in class 34.

IV. DECISION

65. The opposition with number 2014692 is partially justified.
66. The Benelux application with number 1380167 will not be registered for:
- Class 34: All goods
67. The Benelux application with number 1380167 will be registered for:
- Class 5: All goods
Class 29: All goods
Class 31: All goods
68. 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, 14 October 2021

François Châtellier
(rapporteur)

Pieter Veeze

Eline Schiebroek

Administrative officer: Raphaëlle Gerard