

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2015593**  
**25 March 2022**

**Opponent:** **Warner Bros. Entertainment Inc. Delaware corporation**  
4000 Warner Blvd.  
91522 Burbank California  
United States of America

**Representative:** **Leeway B.V.**  
James Wattstraat 100  
1097 DM Amsterdam  
Netherlands

**1<sup>st</sup> Invoked right:** **according to the opponent, a well-known mark within the meaning of Article 6bis of the Paris Convention**

CHARLIE AND THE CHOCOLATE FACTORY

**2<sup>nd</sup> Invoked right:** **European Union trademark registration 3482692**

CHARLIE AND THE CHOCOLATE FACTORY

*against*

**Defendant:** **SOREMARTEC SA**  
16 Rue de Trèves  
2633 Senningerberg  
Luxembourg

**Representative:** **Pascal Becker**  
31 Rue d'Eich  
1461 Luxembourg  
Luxembourg

**Contested trademark: Benelux application 1399785**

CHARLIE AND THE CHOCOLATE FACTORY

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 26 July 2019 the defendant filed a Benelux trademark application for the wordmark "CHARLIE AND THE CHOCOLATE FACTORY" for goods in class 30. This application was processed under number 1399785 and was published on 20 August 2019.

2. On 19 October 2019 the opponent filed an opposition against the registration of the application. The opposition is based on

1. the wordmark "CHARLIE AND THE CHOCOLATE FACTORY" according to the opponent, is a well-known mark within the meaning of Article 6bis of the Paris Convention.
2. the European Union trademark 3482692 of the wordmark "CHARLIE AND THE CHOCOLATE FACTORY", filed on 30 October 2003 and registered on 14 October 2005 for goods and services in classes 3, 9, 14, 16, 18, 24, 25, 28 and 41.

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 initially based on all of the goods and services covered by the trademark invoked. In his arguments the opponent makes it clear that he does not wish to include the goods covered in class 14 of his European Union trademark 3482692.

5. The grounds for opposition are those laid down in article 2.14, 2 (a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

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 22 October 2019. Upon a mutual request of the parties, communicated on 5 November 2019, the proceedings were suspended until 23 April 2020. 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 9 September 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 articles, 2.2ter, 3 (a) BCIP: infringement of a trademark with a reputation and 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 a presentation of the opponent's company, the background of the invoked trademark, as it refers to a movie, and notes the trademark licensing practice of the opponent.

10. Regarding the likelihood of confusion, the opponent notes in the first place that the signs concerned are identical.

11. As regards the comparison of the goods covered by the trademarks, the opponent notes that the invoked trademark is used for merchandise purposes, vending machines and entertainment services. As regards merchandise products, the opponent notes that these have evolved over the years as to include food products such as the ones covered by the contested trademark. In addition, since the "CHARLIE AND THE CHOCOLATE FACTORY" reference in the Willy Wonka Films relates to chocolate and sweets, the consumer would, according to the opponent, undoubtedly assume that these products would be marketed or licensed by the opponent. Furthermore, the opponent notes that cinema visits have evolved so as to include a multisensory experience in the form of popcorn and candy, making these goods and services similar. Also, as regards the vending machines covered in class 9 by the opponent, since these can be used to sell candy, these goods qualify as complementary according to the opponent. Finally, the opponent notes that the goods covered by the trademarks are part of the same supply chain, target the same public, have the same distribution channels and are technically complementary and may originate from the same undertaking. All of this leads the opponent to conclude that the goods covered by the trademarks are similar to an average degree.

12. The opponent argues that the likelihood of confusion is increased due to the high level of distinctiveness the invoked trademark has obtained as a result of its reputation elaborated below.

13. Furthermore, the opponent argues that the invoked trademark is largely addressed at children for which the likelihood of confusion between the trademarks concerned is higher.

14. Concerning the infringement of a trademark with a reputation, the opponent first notes that the invoked trademark has a reputation in the European union and refers to evidence submitted as to the success enjoyed by the "CHARLIE AND THE CHOCOLATE FACTORY" movie.

15. Considering the reputation of the invoked trademark and the identity of the signs, the opponent considers that the conditions for infringement of a trademark with a reputation are fulfilled in that the consumers would create a link between the trademarks concerned due to the strong association existing between sweets and the "CHARLIE AND THE CHOCOLATE FACTORY" movie. To that end, the opponent considers that the contested trademark is taking unfair advantage without due cause by free-riding on the distinctive character of the invoked trademark, causing as a detrimental effect the dilution of the distinctive character of the latter trademark.

16. As a result, the opponent considers that there exists a likelihood of confusion and that the defendant is taking undue advantage of the reputation and distinctiveness of the trademark invoked. Thus, he asks the Office to uphold the opposition and refuse the registration of the contested trademark application.

## **B. Defendant's arguments**

17. In his arguments the defendant starts with an introduction of his company and points out that the defendant has recently acquired a large confectionery company which held numerous trademarks among which several word marks related to the Roald Dahl's children novel "Charlie and the Chocolate Factory" in different countries. As a result of the acquisition, the defendant is now the owner of these trademarks.

18. Comparing the signs in question, the defendant does not contest that they are identical.
19. The defendant notes that some of the goods and services referred to in the arguments of the opponent do not appear verbatim in the invoked trademarks. Furthermore, the defendant contests the assessment of complementarity as found by the opponent and notes to that end that the term "merchandise products", for which the opponent argues his invoked right to be registered, is too broad. Upon comparing the goods and services covered by both trademarks, the defendant concludes that these are dissimilar.
20. According to the defendant, it follows from the dissimilarity of the goods and services covered by the trademarks that there cannot be any likelihood of confusion in this case. Considering the lack of any similarity between these goods and services, the opponent's arguments such as the higher level of distinctiveness of the invoked right or its reputation cannot, according to the defendant, impact this finding.
21. As regards the ground of opposition invoked by the opponent pertaining to the well-known character of the invoked trademark, the defendant notes that the evidence submitted merely relates to a movie of the same name. As such, the defendant argues that such use does not constitute trademark use as it merely serves as a reference to the movie and not a commercial origin of the products or services. Thus, the defendant concludes that the opponent failed to prove reputation as a trademark for the invoked right.
22. As regards the requirement of a link between the signs, the defendant notes that since the opponent did not prove that the prior trademark has acquired a reputation as a trademark, but merely as the title of a film and the goods covered by that trademark are not in any way linked to confectionary, the defendant concludes that the opponent failed to show the existence of such a link. The defendant also considers that the opponent did not sufficiently prove the existence of an actual risk of injury caused by the contested application.
23. The defendant notes that the opponent did not provide arguments in support of the well-known character of the first trademark invoked according to the Paris Convention.
24. In that regard and considering the arguments above, the defendant finds that there exists no risk of confusion for consumers confronted with these trademarks due to there being no similarity between the goods, furthermore the opponent failed to substantiate the claim for an infringement by the contested trademark application of his invoked and allegedly reputed trademark. Thus, he asks the Office to reject the opposition and to register the contested trademark.

### **III. DECISION**

#### **A.1 Likelihood of confusion**

25. 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.
26. 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.*"

27. 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**

28. 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).

29. 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).

30. 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).

31. The trademarks to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
CHARLIE AND THE CHOCOLATE FACTORY	CHARLIE AND THE CHOCOLATE FACTORY

32. 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 10 and 18). The Office will therefore not proceed to a comparison of the signs.

### *Conclusion*

33. The trademarks in question are identical.

**Comparison of the goods and services**

34. 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).

35. In his arguments, the opponent used a different description of the goods and services than the one in the register. However, in opposition proceedings the comparison of the goods and services of the trademark invoked and the goods against which the opposition is filed, the goods and services are considered only on the basis of what is expressed in the register. Furthermore, the opponent argues that the invoked trademark is used in the context of merchandise products (paragraph 11). Since this term does not appear on the list of goods and services covered by the earlier mark, it can have no bearing on the comparison of the goods and services..

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

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
CI 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; non-medicated toilet preparations; cosmetic and toilet preparations for use in the bath; preparations for the hair, shampoo and conditioners; liquid bath soap, gel soap, bar soap; bubble bath; shower gel; toothpaste; mouthwash; sun-tanning preparations; sunscreen preparations, namely cream and lotion; pre-shave and after-shave cream and lotions; cleansing, toning, moisturising and exfoliating preparations and substances; emollient preparations and substances; body cream and lotion; hand cream and lotion; skin cleanser and non-medicated body soaks; deodorant and anti-perspirant preparations; body deodorant, cologne and perfume; bath powder and perfumed body powder; bath oil, bath gel and non-medicated bath salts; baby oil, baby powder, baby gel and baby lotion; cosmetics all for sale as part of a kit; make-up preparations; lipstick, lip gloss, non-medicated lip balm; mascara; face powder, face cream; nail enamel; nail care and manicure kits; false nails; sachets for perfuming linen; essential oils, massage oils and lotions all for sale as part of a kit; aromatherapy preparations; incense; Abrasive cloth; Abrasive	

<p>paper; Adhesives for affixing false hair; Adhesives for cosmetic purposes; Alum stones [antiseptic]; Antiperspirants [toiletries]; Antistatic preparations for household purposes; Bath salts, not for medical purposes; Breath freshening sprays; Cobblers' wax; Cotton sticks for cosmetic purposes; Cotton wool for cosmetic purposes; Denture polishes; Emery cloth; Emery paper; Eyelashes (Adhesives for affixing false-); Eyelashes (False-); False eyelashes; False hair (Adhesives for affixing-); False nails; Fumigation preparations [perfumes]; Glass cloth; Glass paper; Incense; Lacquer removing preparations; Linen (Sachets for perfuming -); Mouth washes, not for medical purposes; Nails (False-); Paint stripping preparations; Pets (Shampoos for -); Polishes (Denture-); Polishing paper; Potpourris [fragrances]; Pumice stone; Sachets for perfuming linen; Sandcloth; Sandpaper; Scented wood; Shampoos; Shampoos for pets; Shaving stones, antiseptic; Shiny (Preparations to make the leaves of plants-); Shoemakers' wax; Smoothing stones; Sprays (Breath freshening -); Swabs [toiletries]; Tailors' wax; Toiletries; Transfers (Decorative-) for cosmetic purposes; Tripoli stone for polishing; Varnish-removing preparations; Wax (Cobblers'-); Wax (Tailors' -).</p>	
<p>CI 9: Photographic, cinematographic and optical apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computers, computer hardware and computer software, parts and fittings for all the aforesaid goods; electronic publications (downloadable); interactive computer software; apparatus for searching electronic information from a global computer network or the Internet; computer programs, namely, software linking digitised video and audio media to a global computer information network; arcade games adapted for use with television receivers only; CD-ROM games; video and computer game programs; video game</p>	

<p>discs, cartridges and cassettes; digital music (downloadable) provided from the Internet; digital music (downloadable) provided from MP3 Internet web sites; MP3 players; motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation, pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes (all being sold together with booklets); digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; stereo headphones; batteries; cordless telephones; mobile telephones; parts and accessories for mobile telephones; mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitation of leather; mobile telephone covers made of cloth or textile materials; telephone and/or radio pagers; hand-held calculators; hand-held karaoke players; short motion picture film cassettes featuring comedy, drama, action, adventure and/or animation to be used with hand-held viewers or projectors; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players, electronic diaries; radios; mouse pads; eyeglasses, sunglasses and cases therefore; encoded magnetic cards, phone cards, credit cards, cash cards, debit cards and magnetic key cards; decorative magnets; swimming floats; kickboard flotation devices; swim boards; global positioning systems; navigation apparatus for vehicles (on-board computers); parts and fittings for all of the aforementioned goods.</p>	
<p>Cl 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed matter</p>	



and paper goods, namely, books featuring characters from animated, action, adventure, comedy and/or drama features, comic books, children's books, magazines featuring characters from animated, action, adventure, comedy and/or drama features, colouring books, children's activity books; booklets (all being sold together with audio tapes); stationery, writing paper, envelopes, notebooks, diaries, note cards; greeting cards, trading cards, lithographs; pens, pencils, cases therefor, erasers, crayons, markers, coloured pencils, painting sets, chalk and chalkboards; decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper; paper party decoration, namely, paper napkins, paper doilies, paper place mats, crepe paper, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliqués; printed patterns for costumes, pyjamas, sweatshirts and T-shirts; Adhesive tapes for stationery or household purposes; Aquaria (Indoor -); Aquarium hoods; Architects' models; Babies' diapers of paper and cellulose, disposable; Babies' napkin-pants [diaper-pants]; Bags (Garbage-) of paper or of plastics; Bags for microwave cooking; Balls for ball-point pens; Chalk (Marking -); Chaplets; Checkbooks [cheque books] (Holders for-); Composing frames [printing]; Composing sticks; Diaper-pants (Babies'-); Engraving plates; Galley racks [printing]; Garbage bags of paper or of plastics; Graining combs; Hand labelling appliances; Holders (Passport-); Holders for checkbooks [cheque books]; House painters' rollers; Indoor aquaria; Indoor terrariums [vivariums]; Marking chalk; Microwave cooking (Bags for -); Models (Architects' -); Mounting photographs (Apparatus for-); Napkin-pants (Babies'-); Packaging material made of starches; Passport holders; Photograph stands; Photographs (Apparatus for mounting -); Printers' blankets, not of textile; Printers' reglets; Rollers (House painters'-); Rosaries; Self-adhesive tapes for stationery or household purposes; Sheets of reclaimed cellulose for wrapping; Starches (Packaging material made of-); Steatite [tailor's chalk]; Tailors' chalk; Tanks [indoor aquaria];

<p>Terrariums (Indoor-) [vivariums]; Trays for sorting and counting money; Vignetting apparatus; Wristbands for the retention of writing instruments.</p>	
<p>Cl 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; athletic bags; bath bags; beach bags; book bags; diaper bags; duffel bags; leather bags; school bags, shoe bags; shopping bags; tote bags; toiletry bags; suit carriers being travelling bags; waist bags; weekend bags; work bags; backpacks; knapsacks; fanny packs; waist packs; wallets; purses; chain mesh purses, not of precious metal; clutch purses; coin purses; cosmetic purses; evening purses; leather purses; purses, not of precious metal; parts and accessories for all of the aforementioned; Attaché cases; Backpacks; Bags (Game-) [hunting accessories]; Bags (Net-) for shopping; Bags (Nose-) [feed bags]; Bandoliers; Beach bags; Briefcases; Card cases [notecases]; Chain mesh purses not of precious metal; Clothing for pets; Collars for animals; Covers (Umbrella-); Covers for animals; Dog collars; Frames (Handbag-); Frames for umbrellas or parasols; Game bags [hunting accessories]; Gold beaters' skin; Gut for making sausages; Handbag frames; Handbags; Handles (Suitcase-); Handles (Walking stick-); Haversacks; Horse blankets; Knee-pads for horses; Music cases; Muzzles; Net bags for shopping; Nose bags [feed bags]; Pets (Clothing for-); Pocket wallets; Purses; Purses, not of precious metal; Ribs (Umbrella or parasol-); Rucksacks; Satchels (School-); Sausages (Gut for making-); School bags; School satchels; Shopping bags; Skates (Straps for -); Skin (Goldbeaters' -); Sling bags for carrying infants; Soldiers' equipment (Straps for-); Sports (Bags for-); Straps for skates; Straps for soldiers' equipment; Suitcase handles; Umbrella covers; Umbrella handles; Umbrella or parasol ribs; Umbrella rings; Umbrella sticks; Vanity cases, [not fitted]; Walking cane handles; Walking stick handles;</p>	

<p>Walking stick seats; Wallets (Pocket -); Wheeled shopping bags.</p>	
<p>CI 24: Textiles and textile goods, not included in other classes; bed and table covers; rugs; travelling rugs; lap rugs; towels; bed linen, blankets, bedspreads, quilts, canopies, bed pads, bed sheets, pillow cases, comforters, duvet covers, mattress covers, crib bumpers, mosquito nets, pillow shams; sleeping bags (sheeting); cloth; fabric; table covers and table linen; place mats; napkins, serviettes and table runners; kitchen linens, namely, barbecue mitts, cloth doilies, cloth napkins, dish cloths, fabric table cloths, kitchen towels, fabric place mats, oven mitts, washing mitts, fabric table runners, pot holders cloth coasters; curtains; draperies; curtain holders of cloth; banners; handkerchiefs; bath linen; bath towels and wash cloths; household linen; mats of linen; coverings of textile and of plastic for furniture; covers for toilet lids of fabric; covers for cushions; loose covers for furniture; textile wall hangings; shower curtains; cotton, polyester and/or nylon fabric; fabric of imitation animal skins; upholstery fabrics; lingerie fabric; golf towels; Banners; Bunting; Coverings of plastic for furniture; Curtains of textile or plastic; Flags [not of paper]; Furniture coverings of plastic; Plastic material [substitute for fabrics]; Shower curtains of textile or plastic.</p>	
<p>CI 25: Clothing, footwear, headgear; clothing for men, women and children, namely, shirts, T-shirts, sweatshirts, jogging suits, trousers, jeans, pants, shorts, tank tops, rainwear, cloth bibs, skirts, blouses; dresses, suspenders, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sunvisors, belts, scarves, sleepwear, pyjamas, lingerie, underwear, boots, shoes, sneakers, sandals, booties, slipper socks, swimwear and masquerade and Halloween costumes; Babies' diapers of textile; Babies' napkins of textile; Boot uppers; Boots (Heelpieces for-); Boots (Iron fittings for-); Boots (Non-slipping devices for-); Boots (Welts for-); Cap peaks; Diapers (Babies'-) of textile; Dress shields; Fittings of metal for shoes and boots; Footwear (Tips for-); Footwear uppers; Frames (Hat-) [skeletons]; Hat frames [skeletons]; Heelpieces for boots</p>	

<p>and shoes; Heelpieces for stockings; Heels; Inner soles; Linings (Ready-made-) [parts of clothing]; Napkins (Babies'-) of textile; Non-slipping devices for boots and shoes; Peaks (Cap-); Pockets for clothing; Ready-made linings [parts of clothing]; Shields (Dress-); Shirt fronts; Shirt yokes; Shoes (Heelpieces for-); Shoes (Iron fittings for-); Shoes (Non-slippings devices for-); Shoes (Welts for-); Soles for footwear; Stockings (Heelpieces for-); Studs for football boots[shoes]; Tips for footwear; Uppers (Footwear-); Visors [hatmaking]; Welts for boots and shoes; Yokes (Shirt-).</p>	
<p>Cl 28: Games and playthings; gymnastic and sporting articles not included in other classes; toys and sporting goods, namely, action figures and accessories therefor; plush toys; balloons; bathtub toys; ride-on toys; playing cards; equipment sold as a unit for playing card games; toy vehicles; dolls; flying discs; amusement apparatus for use in arcades; stand alone video output game machines; coin or counter operated arcade games; pinball game machines; electronic hand-held game units; game equipment sold as a unit for playing a board game; a card game, a manipulative game, a parlor game, a parlor-type computer game, an action type target game; jigsaw and manipulative puzzles; paper party favors, paper hats; paper face masks; masquerade and Halloween masks; skateboards; ice skates; water squirting toys; balls; namely, playground balls, soccer balls; baseballs, basketballs; baseball gloves; surfboards; swimming floats for recreational use; kickboard flotation devices for recreational use; swim boards for recreational use; swim fins; toy zip guns; toy bakeware and toy cookware; toy banks; toy snow globes; Christmas tree ornaments.</p>	
	<p>Cl 30 Pastries and confectionery; chocolate; ice creams, sorbets and other edible ices; cocoa based beverages; sugar confectionery; chocolate confectionery; chewing gum.</p>
<p>Cl 41: Education; providing of training; entertainment; sporting and cultural activities; entertainment services in the nature of live-action, comedy, drama and/or animated television programmes; production of live-</p>	

action comedy, drama and/or animated television programmes; entertainment services in the nature of live action comedy, drama and/or animated motion picture theatrical films; production of live-action, comedy, drama and/or animated motion picture theatrical films; and theatrical performances both animated and live action; video and audio recording production and recitals; education and entertainment services provided via a global computer network; information relating to education and entertainment provided online from a computer database or the Internet; electronic games services provided via a global computer network; providing on-line publications (non-downloadable); on-line publication of electronic books and journals (non-downloadable); publication and distribution of printed media and recordings; publication of sheet music; organising of entertainment and social events; booking of entertainment; entertainer services; club entertainment services; provision of dancing facilities; nightclub, discotheque, music hall, concert, dance hall, ballroom, cabaret services; circuses; provision of live entertainment production of live entertainment; arranging of visual and musical entertainment; audiovisual display presentation services for entertainment purposes; organising of events, exhibitions and shows for entertainment purposes; production of audio entertainment; production of entertainment shows featuring dancers and singers; music competition services; organisation of balls; organisation of shows; providing karaoke services; management of entertainment services; training and management of performance artists; provision of entertainment services on cruise ships; video arcade services; providing amusement arcade services; amusement arcade machine rental services; theme park services; amusement park services with a theme of films; amusement park services with a theme of radio productions; amusement park services with a theme of television productions; education and training services relating to the establishment, operation, administration, management and conduct of amusement and theme parks; movie

studios; recording studio services; television entertainment; cinema services; providing cinema and theatre facilities; booking agency services for cinema tickets; rental and leasing of movie projectors and accessories; rental of cinematographic and motion picture films; distribution of cinematographic and motion picture films; editing of cinematographic and motion picture films; showing of cinematographic and motion picture films; organisation and management of cinemas and theatres; education and training, services relating to the establishment, operation, administration, management and conduct of cinemas and theatres; training services for cinema technicians; providing of sports facilities; providing of recreation facilities, services and amenities; leisure centre and boating lake services; provision of swimming facilities, services and amenities; tenpin bowling alley and bowling green services; providing of golf facilities; providing of tennis court facilities; health and fitness club services; providing of casino and gaming facilities; booking of seats for shows; organisation of quizzes, games and competitions; organisation of beauty competitions; organisation of sporting competitions; rental of diving equipment; rental of sports equipment; arranging, planning and conducting of conferences, seminars, exhibitions and banquets; information, advice and consultancy relating to all the aforesaid services; Booking of seats for shows; Books (Publication of-); Digital imaging services; Diving equipment (Rental of skin-); Education information; Electronic desktop publishing; Entertainment information; Information (Education-); Information (Entertainment-); Information (Recreation-); Interpretation (Sign language-); Microfilming; Modelling for artists; Movie projectors and accessories (Rental of-); Providing on-line electronic publications [not downloadable]; Publication of books; Publication of electronic books and journals on-line; Publication of texts [other than publicity texts]; Radio and television sets (Rental of-); Recorders (Rental of video cassette-); Recreation information; Rental of audio equipment; Rental of camcorders; Rental of

<p>lighting apparatus for theatrical sets or television studios; Rental of movie projectors and accessories; Rental of radio and television sets; Rental of show scenery; Rental of skin diving equipment; Rental of sports equipment [except vehicles]; Rental of stage scenery; Rental of video cameras; Rental of video cassette recorders; Show scenery (Rental of-); Sign language interpretation; Sports equipment (Rental of-) [except vehicles]; Sports events (Timing of-); Stage scenery (Rental of-); Television sets (Rental of radio and-); Texts (Publication of-), other than publicity texts; Timing of sports events; Translation; Videotaping.</p>	
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37. The goods covered by the contested trademark concern sweet food products in class 30 namely: *"Pastries and confectionery; chocolate; ice creams, sorbets and other edible ices; cocoa based beverages; sugar confectionery; chocolate confectionery; chewing gum."* The invoked trademark does not cover any edible goods nor goods which share the same nature, purpose, relevant public or have a similar origin. Furthermore, there exists no link between the goods and services provided as the respective goods and services covered are not indispensable nor important for the use of any of the goods or services covered by the other trademark in such a way that consumers may think that they may originate from the same undertaking. Despite the arguments of the opponent (paragraph 11), the goods covered by the contested trademark are not indispensable to entertainment services as these can be performed and enjoyed without such goods. In the same vein the Office considers that there is not a sufficiently strong link between vending machines and the goods covered by the defendant as the former can be used for the sale of different products, nor would the consumer assume that the responsibility for the production of these goods lie with the same undertaking.

#### *Conclusion*

38. The goods covered by the contested trademark are dissimilar to the goods and services covered by the trademark invoked.

39. Considering the lack of similarity between the goods and services covered, there can be no likelihood of confusion between the trademarks.

#### **B.1 Infringement of a trademark with a reputation, art 2.2ter, 3 (a) BCIP**

40. Pursuant to Article 2.2ter, 3 (a) of the BCIP a trademark may be refused registration if:

1. *the trademarks are either identical or similar;*
2. *the earlier trademark has a reputation;*
3. *the use of the later trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;*
4. *there is no due cause for the use of the later trademark.*

41. The conditions thus set out are cumulative in nature so that if any of them is not fulfilled, the Office is obliged to reject the application on the basis of Article 2.2ter, 3(a) BCIP.

i) *Similarity of the trademarks*

42. As established above (paragraphs 33) the signs in question are indeed identical.

ii) *Reputation of the trademark invoked*

43. It must be observed that the expression "has a reputation in the Member State", in Article 5(3) of the Directive, has the same meaning as the identical expression in Article 10(2)(c) of the Directive, which is identical to Articles 8 (5) and 9(2)(c) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (hereinafter: "Regulation"). In that connection, according to case law of the Court concerning the interpretation of the Directive and the Regulation, the trademark invoked must be known by a significant part of the public concerned by the goods or services covered by that trademark (CJEU cases C-375/97, 14 September 1999, General Motors, ECLI:EU:C:1999:408 and C-301/07, 6 October 2009, Pago International, ECLI:EU:C:2009:611), in a substantial part of the relevant territory. Such part may, with regard to both an EU trademark or a Benelux trademark, in some circumstances, correspond to the territory of a single Member State (Pago, already cited). In the Benelux territory, it is sufficient for the registered trademark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory (General Motors, already cited).

44. This assessment concerns the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect (CJEU, C-252/07, 27 November 2008, Intel, ECLI:EU:C:2008:655). The public amongst which the earlier trademark must have acquired a reputation is that concerned by that trademark, that is to say, depending on the product or service marketed, either the public at large or a more specialist public, for example traders in a specific sector (General Motors, already cited).

45. In examining the degree of knowledge amongst the relevant public all the relevant facts of the case, in particular the market share held by the trademark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it, must be taken into consideration (General Motors, already cited).

46. The relevant point in time to establish that the earlier trademark has acquired a reputation is the filing date or, where appropriate, the priority date of the contested trademark (see Article 2.2ter (2) and, by analogy, Article 2.30sexies BCIP).

*Analysis of reputation*

47. The opponent submitted the following exhibits to demonstrate the reputation of the invoked trademark in the European Union:

1. A declaration from Megan L. Martin, VP of the opponent's company, on the use made of the invoked trademark and commercial extent of the success of the movie "Charlie and the Chocolate Factory".
2. Copies of posters for the movie "Charlie and the Chocolate Factory".



3. A screenshot from the webpage "boxofficemojo.com" and "pro.imdb.com" dated June 2020 showing the commercial success of the release of the movie "Charlie and the Chocolate Factory".
4. Screenshots dated June 2020, of online articles published on the webpages "boxofficemojo.com" and "theguardian.com" mentioning "Charlie and the Chocolate factory" and dating from July to October 2005.
5. Screenshots dated June 2020, of online articles published on the webpage "warnerbros.com" mentioning "Charlie and the Chocolate factory" and dating from July to September 2005.
6. Screenshots dated June 2020, of a product page for the movie "Charlie and the Chocolate factory" on the webpages "warnerbros.com".
7. An overview of the different Charlie and the Chocolate factory movie discs available for sale in different countries and languages with publication dates.
8. An article published on Wikipedia about the movie "Charlie and the Chocolate Factory" dating from, at the earliest, 14 June 2020.
9. Print screen from the webpage IMDb.com concerning the movie "Sjakië en de chocoladefabriek" from 2005, the source is not dated.
10. Register extract of the invoked trademark.
11. Screenshots of online articles published on the webpages "irishpost.com", "theguardian.com", "broadwyworld.com", "lemonde.fr", "elpais.com" and "eldiariomontanes.es" concerning Charlie and the Chocolate factory/ Charlie et la chocolaterie/ Charlie y la f brica de chocolate and its adaptation of the Roald Dahl novel of the same name dating from July 2004 to January 2020.
12. Screenshots dated June 2020, of online articles published on the webpage "warnerbros.com" announcing theatre adaptations of Roald Dahl's novel Charlie and the Chocolate factory, dating from October 2012 to January 2018.
13. A screenshot of a flyer from Roald Dahl's Charlie and the Chocolate Factory musical dated June 2020 and from the webpage "charlieontour.com", showing several performance locations merchandise products.
14. Screenshots dated June 2020 showing the "Charlie & The Chocolate Factory UK" and "Charlie and the Chocolate Factory" pages on the website Facebook.com.
15. Screenshot of an article, press release and brochure concerning an exhibition on Tim Burton in Ghent mentioning Charlie and the Chocolate factory.
16. An overview showing broadcast licensing information related to Charlie and the Chocolate Factory during the period of 2014 to 2019 for the European Union.
17. Screenshots taken in June showing the Sjakië en de chocoladefabriek /Charlie and the chocolate factory/ Willy Wonka und die Schokoladenfabrik movies offered for viewing by different online movie streaming providers.
18. Screenshots dated June 2020 showing Charlie and the Chocolate Factory/Charlie und die Schokoladenfabrik/ Charlie et la Chocolaterie movies available individually or within package deals on the webpages Amazon.de, Amazon.it and Bol.com.
19. Screenshots dated from June 2020 on the webpages pro.imdb.com and playstation.com showing a "Charlie and the Chocolate Factory" videogame and a screenshot made using wayback machine, showing an advertisement for "Charlie and the Chocolate Factory" video game on the website charliegame.com dated October 2005.
20. Registration certificates emitted different countries or institutions for the trademark "CHARLIE AND THE CHOCOLATE FACTORY".
21. An overview of different "CHARLIE AND THE CHOCOLATE FACTORY" trademarks held by the opponent.
22. Printouts for a variety of product and service advertisement from different companies containing a reference to Charlie and the Chocolate Factory / Charlie et la Chocolaterie / Charlie und die

Schockoladenfabrik / Sjakie en de chocoladefabriek / La Fabrica di Cioccolato / La Fábrica de Chocolate / Kalle och Chokladfabriken as well as in other languages.

23. Packaging for confectionery sold under the name "WONKA", some of which containing the reference "Charlie and the Chocolate Factory".
24. Product pictures of various toy figurines from and playsets derived the movie Charlie and the Chocolate Factory.
25. Product pictures of a keychain, posters, poster coloring sets and parts thereof, bead sets, promotional trading cards, dress-up sets, sew in label, toys and games all mentioning "Charlie and the Chocolate Factory".

48. Considering the proof submitted, the Office finds that the opponent does not sufficiently show that the trademark has acquired a reputation in the relevant territory.

49. The opponent invokes a reputation for merchandise, movies, musicals and videogames. These terms do not appear as such in the list of products and services for which the invoked trademark is registered. The vague nature of these terms, the fact that it is unclear which goods and services these would relate to and whether they coincide with the goods and services covered by the invoked trademark leads to the Office not being able to proceed to a substantial assessment of the reputation of the trademark as an indication of origin for the goods and services invoked. Indeed, it is unclear from the reasoning of the opponent which categories of goods constitute merchandise and which do not. Furthermore, trademark law cannot be used protect content matter of movies, musicals and videogames. It is also unclear from the evidence provided, and the opponent fails to indicate, for which specific goods or services the invoked trademark would have acquired a reputation as an indication of commercial origin. Without a clear indication as to the goods and services, the Office cannot proceed to examine whether the invoked right has acquired a reputation as a trademark.

50. In the light of the above, it cannot be established that the trademarks invoked had acquired a reputation. Therefore, one of the necessary conditions contained in Article 2.2ter (3) (a) BCIP is not fulfilled, and the opposition on the basis of this article must be rejected.

## **B.2 Well-known trademark within the meaning of Article 6bis of the Paris Convention**

51. In his arguments the opponent did not substantiate his ownership of a well-known trademark within the Benelux nor did he provide any proof to that end. As a result, the Office will not consider this basis for the opposition.

## **C. Conclusion**

52. Based on the foregoing the Office is of the opinion that there is no likelihood of confusion and no infringement of a trademark with a reputation in the present case.

## **IV. DECISION**

53. The opposition with number 2015593 is not justified.

54. The Benelux trademark application with number 1399785 will be registered in the Benelux.

55. The opponent shall pay the defendant 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is not justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 25 March 2022



*François Châtellier*  
(rapporteur)

*Pieter Veeze*

*Eline Schiebroek*

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