



**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2015634**  
**of 26 November 2021**

**Opponent:** **Arbora & Ausonia, S.L.U.**  
Avenida de Bruselas 24  
28108 Alcobendas - Madrid  
Spain

**Representative:** **Bakker & Verkuijl B.V.**  
Alexander Office Prinsenkade 9 D  
4811 VB Breda  
Netherlands

**Invoked trademark:** **EU trademark 3780715**  
DODOT

*against*

**Defendant:** **Health and Happiness (H&H) HONG KONG LIMITED**  
St 4007-09 40/F 18 Westlands Road Quarry Bay One  
Island East Taikoo  
Hong Kong  
China

**Representative:** **Ploum**  
PO-box 711  
3000 AS Rotterdam  
Netherlands

**Contested trademark:** **Benelux application 1402594**



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

1. On 20 September 2019 the defendant filed a Benelux trademark application for the combined



word/figurative trademark for goods in class 5. This application was processed under number 1402594 and was published on 25 September 2019.

2. On 8 November 2019 the opponent filed an opposition against this application. The opposition is based on the earlier European Union trademark 3780715 for the word trademark DODOT, filed on 30 April 2004 and registered on 13 June 2012 for goods in classes 16, 24 and 25.

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

4. The opposition is directed against part of the goods of the contested application and is based on parts of the goods in class 16 and all the goods in classes 24 and 25 of the trademark invoked.

5. The grounds for opposition are those laid down in Article 2.14, 2 (a) Benelux Convention on Intellectual Property (hereinafter referred to as: "BCIP").

6. The language of the proceedings is English.

**B. Proceedings**

7. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 8 November 2019. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant, the opponent submitted proof of use. Upon request of the parties, the procedure was suspended. All the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 29 December 2020.

**II. ARGUMENTS OF THE PARTIES**

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 the relevant marks and of the goods or services concerned.

**A. Opponent's arguments**

9. The opponent observes that the goods of the trademark invoked and those of the contested application are all baby related. They coincide in relevant public, end users and distribution channels, their nature and their method of use are similar and they have the same purpose. The opponent concludes that the goods concerned are partly identical and partly similar.

10. Visually, both trademarks include verbal elements consisting of five letters, DODOT and DODIE. Three of the five letters are identical and the trademarks coincide in the initial part DOD, which first catches the attention of the reader. The opponent concludes that the trademarks are visually similar.

11. Aurally, the pronunciation of the trademarks coincides in the first syllable DO as well as the initial sound D of the second syllable. The opponent is therefore of the opinion that the trademarks are aurally highly similar.

12. As the trademarks do not have any meaning for the public, it is not possible to compare them conceptually.

13. Based on the above, the opponent concludes that a likelihood of confusion exists and he therefore requests that the Office rejects the contested application for the goods against which the opposition is directed.

14. Upon request of the defendant, the opponent has provided proof of use of the trademark invoked.

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

15. The defendant has requested proof of use of the trademark invoked.

16. Regarding the evidence of use provided by the opponent, the defendant observes that it does not show genuine use of the trademark for all the goods invoked. According to the defendant, the Opponent has at least not proven genuine use of the EUTM for the goods other than *diapers* and *wipes*. Moreover, a number of documents have not been submitted or translated into the language of the proceedings. Furthermore, the defendant establishes that the proofs of use originate from Procter & Gamble and that the opponent has not shown any connection with that company.

17. The defendant partially disagrees on the identity or similarity of the goods concerned. According to him, the goods *babies' napkins (diapers)* and *babies' diaper-pants* of the contested trademark are identical to the goods *babies' nappies* and *nappy pants of paper and cellulose* in class 16 and to *nappies and nappy pants of textile* in class 25 of the trademark invoked. Furthermore, one could argue that *sanitizing wipes* are to a certain extent similar to *tissues, napkins, toilet tissues* and *toilet paper* in class 16. According to the defendant, the other goods are not similar.

18. The defendant observes that the trademarks do not have any meaning for the relevant public since none of the verbal elements have any meaning. The figurative element of the rabbit presented in the contested trademark might evoke a concept that is absent from the trademark invoked. Therefore, he is of the opinion that the trademarks are conceptually not similar.

19. The defendant explains that the contested trademark with the rabbit device has been used for a wide range of baby and related products for more than 20 years in many member states of the EU, especially in France (for more than 60 years). The trademark has already been registered in various European countries, including the Benelux, by means of an international registration dated 3 July 2003, predating thus the trademark invoked. Therefore, the defendant is of the opinion that the figurative elements (the frame and the rabbit device) should also be taken into account. Moreover, the rabbit device has at least the same weight as the word element, if not more. Furthermore, the trademarks differ in their last two letters OT/IE of the verbal elements. Consequently, the defendant concludes that the trademarks are overall visually similar to a below-average degree.

20. The defendant states that the public will perceive the vowels O and I as being different. In short trademarks, as the ones at issue, this changes the whole overall impression of the words and thus, leads to an aural dissimilarity. Consequently, as the verbal elements DODOT and DODIE differ in the second syllable DOT/DIE (50%), the defendant is of the opinion that the trademarks differ significantly.

21. The defendant concludes that the relevant public is not likely to be confused between the trademarks in question. He therefore requests that the Office rejects the opposition and orders the opponent to bear the costs pursuant to the BCIP and its IR.

### **III. DECISION**

#### **A.1 Proof of use**

22. In application of the provisions of articles 2.16bis (1) and 2.23bis (1) of the BCIP and rule 1.25 of the UR, the trademark relied upon must have been in genuine use during a period of five years preceding the date of filing of the younger trademark.

23. The contested trademark was filed on 20 September 2019. Thus, the period to be considered - the relevant period - is from 20 September 2014 to 20 September 2019.

24. In accordance with the decision of the Court of Justice of the European Union (hereinafter referred to as "CJUE") of 11 March 2003 (CJUE, 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 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).

25. 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).

26. In addition the EGC held that genuine use of a trademark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark in 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, SoniaSonia Rykiel, already referred to above).

27. The trademark invoked is a trademark of the European Union ("EUTM"), 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."*

28. In its decision of 19 December 2012 (case C-149/11, Onel, ECLI:EU:C:2012:816), the CJEU explained this provision. The CJEU 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 CJEU 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.*"

29. 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 considering all relevant facts and circumstances.

30. Following rule 1.41 io. 1.25 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the trademark invoked for the goods on which the opposition is based.

#### **Analysis of the proof of use**

31. Without formally limiting the scope of the opposition, the opponent explicitly states that the trademark invoked has been used for *baby napkins* and *baby diapers*. The opponent submitted the following exhibits to demonstrate genuine use of the trademark invoked for these products:

- 1) Invoices for Spain and Portugal;
- 2) Commercials 2015-2019;
- 3) Article in the HuffPost blog of February 2019;
- 4) Survey Statistica June 2020;
- 5) Report of Mintel in respect of the trademark in Spain and Portugal;
- 6) Overview of commercials;
- 7) Article in the Ekonomista of 30 May 2016;
- 8) Facebook ads 2017-2019;
- 9) Sale on the Amazon platform in Germany and the United Kingdom.

32. As the defendant states, a number of documents have not been submitted or translated into the language of the proceedings (see point 16). However, the Office points out that documents serving to prove the use of a trademark may be submitted in their original language provided that they are sufficiently comprehensible, in the light of the reason for their submission. Although some of the documents are in Spanish and Portuguese, the Office considers that they are sufficiently comprehensible since the opponent summarises the essence of them in English.

33. The invoices (number 1 above) for Spain cover the period 2016-2019 and for Portugal the period 2014-2019. The trademark invoked is mentioned several times in the invoices, but nowhere is shown for which goods it was used, as the defendant states. However, the descriptions correspond to those of the various types of napkins and diapers in the other documents. Therefore, it follows that the trademark mentioned in the invoices is used for selling those products.

34. The Commercials (number 2) were, according to the explanation of the opponent, displayed on TV and on YouTube in Spain during the relevant period. The defendant agrees that these commercials show use for baby diapers.

35. The article in the HuffPost blog (number 3) states that the trademark invoked takes the first five positions on the ranking of the best diapers on the Spanish market.

36. The survey from Statistica (a statistical database for market and consumer data, 4) reveals, according to the opponent, that in 2019 an estimated 411.000 people used the DODOT Activity baby diapers in Spain.

37. The report of Mintel (a market research firm, 5) shows numerous packages of the trademark invoked with product description, price, publication date and stores of diapers, diaper-pants and wipes for babies.

38. The overview under 6 above shows several commercials which were, according to the opponent's explanation, displayed within the relevant period on YouTube and on TV in Portugal. The overview shows stills of broadcasting channels with texts as *Anúncio Dodot bebé seco...* The defendant observes that the commercials only show use of the trademark for baby diapers and that there is no reference to the trademark holder. The Office points out that the latter is not necessary, since genuine means that the trademark is put on the market, be it by the proprietor or by a third party with his consent.

39. The article in the *Ekonomista* (a Portuguese newspaper, 7) states that a study conducted in 2016 of the Portuguese Association for Consumer Protection revealed the 15 best diapers on the market in Portugal, which includes several types of DODOT diapers.

40. The Facebook advertisements (8) contain more photos and images than text, which make it clear that they are for nappies in Portugal, as the defendant also notes, and the opponent explains.

41. The prints of Amazon under 9 show the website of this platform in Germany and the United Kingdom in the period 2017-2019, and several types of diapers offered for sale under the trademark invoked. The defendant observes that these pieces offer no information on actual sales. However, the Office points out that this is not necessary since it appears that the goods are offered for sale and are therefore present on the market.

### *Conclusion*

42. The Office concludes that the evidence of use, taken together, sufficiently demonstrates that the trademark invoked has been put to genuine use in a significant part of the EU, i.e., Germany, Portugal, Spain and the UK (at that time still a member of the EU), during the relevant period for part of the goods on which the opposition is based, namely *baby napkins* and *baby diapers*. Therefore, the trademark invoked shall, for the purpose of this opposition examination be deemed to be registered in respect of these goods only.

## A.2 Likelihood of confusion

43. 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.

44. Article 2.2ter, para. 1 BCIP stipulates that "*A trademark shall, in case an opposition is filed, not be registered (...) where 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.*"

45. According to case law of the CJEU concerning the interpretation of 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 (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 and the goods**

46. The wording of Article 5, 1 (b) of the Directive (compare 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).

47. 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).

48. 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, C334/05 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).

49. The trademarks and the goods to be compared are the following:

Opposition based on:	Opposition directed against:
DODOT	
Baby napkins and baby diapers.	Class 5 Food for babies, Powdered milk for babies, Lacteal flour for babies, Infant formula, Babies' napkins [diapers], Babies' diaper-pants, Sanitizing wipes, Breast-nursing pads.

#### *Visual comparison*

50. The trademark invoked is a purely verbal trademark, consisting of the word DODOT. The contested trademark is a combined word/figurative trademark, consisting of the stylised word "dodie" in white letters in a black shape. Next to this frame is a stylised sitting white rabbit depicted.

51. In the case of composite trademarks (word and figurative element), the word element often has a greater impact on the consumer than the figurative element. The reason for this is that the public does not always analyse the trademarks and often refers to them by using the word element (see in this sense also EGC, SELENIUM-ACE, T-312/03, 14 July 2005, ECLI:EU:T:2005:289). In the present case, this is true for the black background. This will be perceived by the relevant public as a decoration and layout. The stylised bunny, on the other hand, will certainly not escape consumers' attention (see in that sense Court of Appeal The Hague, MOOVE-4MOVE, 200.105.827/0, 11 September 2012, ECLI:NL:GHSGR:2012:BX8916).

52. The only similarity between the trademarks exists therefore in the word elements, of which the first three letters are identical, although the letters of the contested trademark are slightly stylised.

53. The trademarks are visually similar to a low degree.

#### *Aural comparison*

54. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level (EGC, PC WORKS, T-352/02, 25 May 2005, ECLI:EU:T:2005:176 and Thai Silk, T-361/08, 21 April 2010, ECLI:EU:T:2010:152).

55. Both trademarks consist of one word of two syllables. The first syllable [do] will be pronounced in an identical manner whereas the pronunciation of the second syllable is identical in the first letter but different in the sound of the vowel and the extra letter in the trademark invoked: [dot] versus [di:].

56. The trademarks are phonetically similar to a certain degree.



*Conceptual comparison*

57. The parties agree that the word elements in the trademarks have no meaning. The Office adds that the stylised image in the contested trademark will immediately evoke the image or concept of a rabbit.

58. Moreover, the verbal element of the contested sign Dodie is also used as a first name. So both the reference to a rabbit and the reference to a rabbit named Dodie are completely absent from the trademark invoked. Therefore, the trademarks are conceptually dissimilar.

*Conclusion*

59. The trademarks are visually similar to a low degree and aurally similar to a certain degree while they are conceptually dissimilar.

**A.3 Global assessment**

60. 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 trademarks are important factors.

61. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be considered that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question. The present case concerns basic consumer goods which are targeted at the public that cares about diaper-wearing babies and toddlers. This public is, on the one hand, aware that nappies consume a considerable amount of the household budget and, on the other hand, will only want the best for their little ones in this respect. They will therefore pay attention to trademarks, prices, quality and so on, so that a slightly higher level of attention has to be assumed.

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

63. 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.

64. According to the European case-law, the visual and phonetic similarities may be counteracted by the conceptual differences between the trademarks in question. For there to be such a counteraction, at least one of the trademarks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. This neutralisation can take place regardless of whether that trademark does not refer to any characteristic of the goods in respect of which the registration of the trademarks in question has been made and regardless of whether the other trademark does not have such a meaning or only a totally different meaning (EGC, Bass, T-292/01, 14 October 2003, ECLI:EU:T:2003:264; CJEU, Zirh, C-206/04P, 23 March 2006, ECLI:EU:C:2006:194 and

Picarro, 12 January 2006, ECLI:EU:C:2006:25). As stated above, the contested trademark has a clear meaning and de trademark invoked has none (see point 58).

65. The trademarks are visually similar to a low degree, aurally similar to a certain degree and conceptually they are dissimilar. Due to the conceptual difference between the trademarks, the (low and certain degree of) visual and phonetic similarity is neutralised with the result that the trademarks are not similar in their overall impression. Based on the aforesaid, and taking into account all factors to be considered, the Office comes to the conclusion that the relevant public (with a slightly higher level of attention) will not believe that the goods in question – even if they would be found identical – come from the same undertaking or from economically linked undertakings.

#### **B. Conclusion**

66. Based on the foregoing, the Office concludes that the trademark invoked and the contested trademark are not sufficiently similar to lead to a likelihood of confusion.

#### **IV. CONSEQUENCE**

67. The opposition with number 2015634 is rejected.

68. The Benelux application with number 1402594 will be registered for all the goods it has been applied for.

69. The opponent is under obligation to pay the defendant EUR 1,045 in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is not justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP

The Hague, 26 November 2021



Willy Neys  
*rapporteur*

Eline Schiebroek

Camille Janssen

Administrative officer:

Gerda Veltman