

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2015763
of 23 July 2021**

Opponent: **Google LLC a Delaware limited liability company**
1600 Amphitheatre Parkway
Mountain View California 94043
United States of America

Representative: **Brinkhof N.V.**
Grote Bickersstraat 74 - 78
1013 KS Amsterdam
Netherlands

Invoked right 1: **EU trademark 14783989**

ANDROID

Invoked right 2: **EU trademark 14486823**

ANDROID ONE

against

Defendant: **Rudi Conings h.o.d.n. Terradroid**
Bredabaan 784
2170 Merksem
Belgium

Representative: -

Contested trademark: Benelux application 1404907

Terradroid

I. FACTS AND PROCEEDINGS

A. Facts

1. On 29 October 2019 the defendant filed an application for a trademark in the Benelux for the wordmark Terradroid for goods and services in classes 9 and 42. This application was processed under number 1404907 and was published on 1 November 2019.

2. On 2 January 2020 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- EU trademark registration 14783989 of the wordmark ANDROID, filed on 11 November 2015 and registered on 1 June 2016 for goods and services in classes 9, 14, 25, 28, 35, 38 and 42;
- EU trademark registration 14441414 of the wordmark ANDROID, filed on 5 August 2015 and registered on 4 December 2015 for goods and services in classes 9 and 36;
- EU trademark registration 14486823 of the wordmark ANDROID ONE, filed on 18 August 2015 and registered on 16 December 2015 for goods and services in classes 9, 38 and 42.

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

4. In the arguments, the opponent limits the opposition to EU trademarks 14783989 and 14486823. The opposition is directed at all goods and services of the contested trademark and is based on all goods and services of the trademarks 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").

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 2 January 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 8 July 2020.

II. ARGUMENTS

8. 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.

9. The opponent claims that the contested sign should not be registered based on the following grounds:

- Article 2.2ter, 1 BCIP, likelihood of confusion: "*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."

- Article 2.2ter, 3 (a) BCIP, reputation: *"a trademark shall, in case an opposition is filed, not be registered (...) where: a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark"*.

A. Opponent's arguments

10. The opponent argues that the ANDROID mobile operating system is one of the most famous software systems developed by Google. According to the opponent, the ANDROID system has become the most used smartphone operating system worldwide. The opponent points out that in previous opposition decisions, the worldwide renown of ANDROID has been confirmed by the European Union Intellectual Property Office (EUIPO). Furthermore, the opponent states that the EUIPO has also acknowledged that the trademark ANDROID has a reputation in relation to the goods "computer software for use in connection with mobile devices, namely cell phones, mobile phones, smart phones and handheld personal digital assistants (PDAs)" in class 9. In addition, the opponent argues that the trademarks invoked have a reputation in the Benelux. In order to substantiate this statement, the opponent submits evidence. For these reasons, the opponent concludes that the ANDROID trademark has a reputation pursuant to article 2.2ter, 3(a) BCIP.

11. With regard to the grounds for the opposition, the opponent states that there exists a likelihood of confusion between the trademarks invoked and the contested trademark. The opponent also states that the contested trademark takes unfair advantage of or is detrimental to the distinctive character or repute of the ANDROID trademark. The opponent also refers to previous opposition decisions rendered by EUIPO in this context.

12. The opponent argues that all the contested goods and services are identical or highly similar to the goods and services of the trademarks invoked.

13. With regard to the comparison of the trademarks, the opponent states that the English word ANDROID will be understood by the French and Dutch-speaking public in the Benelux, as 'robot with a human appearance', because the equivalent word in French and Dutch is very similar. According to the opponent, this element is distinctive as it has no direct or indirect meaning regarding the relevant goods and services. The opponent argues that the contested trademark as a whole has no meaning and that the public will split this sign into two elements: TERRA and DROID.

14. According to the opponent, the public will understand that the word 'terra' means 'earth' or 'land'. Furthermore, the opponent argues that the element 'droid' is the diminutive of the word 'android'. The opponent states that even if the element 'droid' is not understood immediately, it is so similar to the word 'android', that the relevant public will associate it with the concept of 'android'. Consequently, according to the opponent, the word 'terrandroid' will be understood as an android for use on earth or land, or a terra coloured android. The opponent also states that the addition of the word ONE in the second trademark

invoked has a lesser impact on the overall impression of the trademarks. Therefore, the trademarks are conceptually similar.

15. The opponent argues that the trademarks are visually similar, because both trademarks contain the letters A-D-R-O-I-D. Aurally, according to the opponent, the pronunciation of the trademarks coincides in the sound of the letters D-R-O-I-D. Furthermore, the contested trademark and the second trademark invoked both have three syllables. Therefore, the opponent states that the trademarks are aurally similar.

16. According to the opponent, the goods and services are directed at the public at large, as well as at business consumers with specific professional knowledge or expertise in, inter alia, the IT field. The opponent also argues that the trademarks invoked have a highly distinctive character and therefore enjoy a broader scope of protection than marks with a lesser distinctive character. Therefore, taking into account the similarity between the trademarks and goods and services, as well as the reputation of the trademarks invoked, the opponent states that there exists a risk of confusion, even for the public with a high level of attentiveness.

17. Furthermore, with regard to article 2.2ter, 3 (a) BCIP, the opponent argues that a link exists between the trademarks, not only because the signs are similar, but also because there is a connection between the goods and services, as they all relate to the IT sector and target the same public. In the light of the level of similarity of the trademarks and the goods and services, and taking into account the fact that ANDROID has become an attractive and powerful brand in the EU (including the Benelux), the opponent also argues that there is a serious risk that use of the contested trademark Terradroid would take unfair advantage of the distinctiveness or reputation of the trademark ANDROID.

18. According to the opponent, the consumer might believe that the goods and services covered by the contested trademark belong to the products marketed by Google. As a consequence there is a transfer of the image of the earlier trademark and its characteristics which it projects, to the goods and services covered by the trademark Terradroid. The opponent states that the defendant therefore commercially benefits from the huge success of the trademark ANDROID, without having to make any effort of its own.

19. Furthermore, the opponent argues that the use of the contested trademark could also lead to the perception that the applicant is associated with Google and, that this, therefore, could facilitate the marketing of the contested goods and services.

20. In addition, the opponent states that, considering the reputation of the ANDROID trademark, it is most likely that the use of Terradroid will weaken the distinctive character and consequently the reputation of the trademarks invoked. In this respect, the opponent refers to an opposition decision from the Spanish National Trademark Office.

21. In the light of the above, the opponent requests that the Office upholds the opposition and refuses the registration of the contested trademark. In addition, the opponent requests an award of the costs in its favour.

B. Defendant's arguments

22. The defendant argues that he started his company, named Terradroid, in 2006. This company provides Business-to-Business engineering services. These services mainly involve the design of electronic circuits. According to the defendant, it is well known that ANDROID is an operating system for mobile phones and tablets. On the other hand, the defendant's company is not in the business of producing operating systems for mobile phones. The defendant points out that the opponent has argued that the ANDROID trademark only covers "computer software for use in connection with mobile devices, namely cell

phones, mobile phones, smart phones and handheld personal digital assistants". Therefore, the defendant states that the engineering services provided by Terradroid are very different from the software ANDROID represents. Furthermore, the defendant also argues that the words ANDROID and Terradroid are visually very different.

23. The defendant argues that there are several trademarks, registered prior to the trademarks invoked, that are similar to the trademarks invoked. According to the defendant, the fact that other trademark holders have tolerated the ANDROID trademark shows that they accept that ANDROID represents something else. The defendant also refers to several trademarks, registered after the trademarks invoked, that also contain the element DROID.

24. The defendant disputes the opponent's statement that the word ANDROID has no direct or indirect meaning in relation to the goods and services. The defendant refers to the argumentation of the opponent with regard to the similarity of the goods and services. He points out that the opponent has argued that robotics is a part of engineering and science and that this concerns the creation and building of robots, as well as computer programming. Therefore, the defendant concludes that the word ANDROID is descriptive for the goods and services of the trademarks invoked, because this word refers to a man-like robot. The defendant also argues that the word Terradroid has no meaning.

25. According to the defendant, the contested trademark does not take unfair advantage, because it has been in use as a tradename since 2006, before ANDROID was launched as a product. Furthermore, the defendant argues that the opponent does not substantiate its statement that the contested trademark will weaken the trademark ANDROID. The defendant points out that the Spanish opposition the opponent refers to was granted for administrative reasons, namely a lack of reply.

26. The defendant concludes that there is no likelihood of confusion between the trademarks and requests that the Office rejects the opposition.

III. DECISION

A.1 Likelihood of confusion

27. According to case law of the Court of Justice of the European Union (hereinafter: "CJEU" or "Court") 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 goods and services

28. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. These factors include, inter alia, their

nature, their end-users and their method of use and whether they are in competition with each other or are complementary (Canon, already cited).

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

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

Opposition based on:	Opposition directed against:
CI 9 Computer software; computer software for use in connection with mobile devices, namely cell phones, mobile phones, smart phones and handheld personal digital assistants (PDAs); computer hardware; mobile devices, namely cell phones, mobile phones, smart phones, and handheld personal digital assistants (PDAs), and peripherals for same; computers, tablet computers, netbook computers, laptop computers; integrated circuit chips, microchips; camera cases, camcorder cases; thermostats; radios, telephones, remote controls for radios, televisions and stereos; DVD players, video cassette recorders, digital video recorders, MP3 players; audio amplifiers; computer servers, printers, scanners, photocopying machines, computer monitors, fax machines, network routers; keyboards, computer mice, external computer hard drives; camcorders, cameras; calculators, gps navigation devices; audio components, headphones, audio speakers, audio receivers and video receivers; set-top boxes, home theatre systems, video projectors, movie projectors; security alarms, fire alarms, fire and smoke detectors, radar detectors; audio and video equipment for vehicles, battery chargers, adapters (electricity); answering machines, headsets, electric light switches; satellite-aided navigation systems; navigation apparatus for vehicles; smart watches.	CI 9 Electronic components for computers; Industrial automation controls. <i>KI 9 Elektronische onderdelen voor computers; Industriële automatiseringsbesturingen.</i>
CI 14 Watches; timepieces; watchbands.	
CI 25 Clothing; clothing, namely, shirts, t-shirts, hats, caps, children's clothing; footgear; headgear.	
CI 28 Collectable toy figures, not in the shape of an android or robot with human appearance; gymnastic and sporting articles: arcade games; tabletop games; board games; card games;	

<p>balls for games; coin-operated video games; video game consoles; hand-held units for playing electronic games; action figures, not in the shape of an android or robot with human appearance; educational toys; toy vehicles; plush toys; toy robots, not in the shape of an android or robot with human appearance; water toys; wind-up toys; dolls and doll accessories; flying discs; talking toys; toy musical instruments.</p>	
<p>CI 35 Online retail services in connection with computer software, computer software for use in connection with mobile devices, namely cell phones, mobile phones, smart phones and handheld personal digital assistants(PDAs), computer hardware, mobile devices, namely cell phones, mobile phones, smart phones, and handheld personal digital assistants(PDAs), and peripherals for same, computers, tablet computers, netbook computers, laptop computers, integrated circuit chips, microchips, camera cases, camcorder cases, thermostats, radios, telephones, remote controls for radios, televisions and stereos, DVD players, video cassette recorders, digital video recorders, MP3 players, audio amplifiers, computer servers, printers, scanners, photocopying machines, computer monitors, fax machines, network routers, keyboards, computer mice, external computer hard drives, camcorders, cameras, calculators, gps navigation devices, audio components, headphones, audio speakers, audio receivers and video receivers, set-top boxes, home theatre systems, video projectors, movie projectors, security alarms, fire alarms, fire and smoke detectors, radar detectors, audio and video equipment for vehicles, battery chargers, adapters(electricity), answering machines, headsets, electric light switches, satellite-aided navigation systems, navigation apparatus for vehicles, smart watches; online retail services in connection with watches, timepieces, watchbands; online retail services in connection with clothing, clothing, namely, shirts, t-shirts, hats, caps, children`s clothing, footwear, headgear; online retail services in connection with collectable toy figures, gymnastic and sporting articles, arcade games, table top games, board games, card games,</p>	

<p>balls for games, coin-operated video games, hand-held units for playing electronic games, action figures, educational toys, toy vehicles, plush toys, toy robots, water toys, wind-up toys, dolls and doll accessories, flying discs, talking toys, toy musical instruments, video game consoles, and in connection with digital content, computer games, audio works and visual works; online retail services in connection with electronic publications, including music, books, movies, games, and other digital media; online retail services in connection with electronic devices and mobile peripherals.</p>	
<p>CI 38 Telecommunications services; transmission of data by global computer network; streaming of audio, visual and audiovisual material via a global computer network.</p> <p><i>EU trademark 14486823</i></p> <p>CI 38 Telecommunications services; transmission of data by global computer network; streaming of audio, visual and audiovisual material via a global computer network; providing online resources for software developers, namely providing discussion groups.</p>	
<p>CI 42 Application services provider (ASP), namely, hosting computer software applications of others; computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking in the field of software development; providing temporary use of non-downloadable software; providing online resources for software developers, namely providing software and sample codes.</p> <p><i>EU trademark 14486823</i></p> <p>CI 42 Scientific and technical services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; ASP, namely, hosting computer software applications of others; computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form</p>	<p>CI 42 Engineering services relating to robotics.</p> <p><i>KI 42 Ingenieursdiensten met betrekking tot robotica.</i></p>

virtual communities, and engage in social networking in the field of software development; providing temporary use of non-downloadable software.	
	<i>N.B. The original classification language is not English. The translation has been added solely to improve the readability of the decision.</i>

Class 9

31. The Office finds that the goods "*Electronic components for computers*" fall under the broad category "computer hardware" mentioned in the trademarks invoked. According to established case law, if the goods and services of the earlier trademark also contain goods and services that are mentioned in the application for the contested trademark, these goods and services are considered identical (see EGC, *Fifties*, T-104/01, 23 October 2002, ECLI:EU:T:2002:262; *Arthur et Félicie*, T-346/04, 24 November 2005, ECLI:EU:T:2005:420 and *Prazol*, T-95/07, 21 October 2008, ECLI:EU:T:2008:455). Furthermore, the contested goods cover the goods "integrated circuit chips, microchips" of the trademarks invoked, because a chip is an electronic component of a computer. Therefore, these goods are also identical, (EGC, *Metabiomax*, T-281/13, 11 June 2014, ECLI:EU:T:2014:440).

32. The goods "*Industrial automation controls*" relate to a control system that operates an industrial process or machinery in order to reduce human intervention.¹ The goods "computers and computer software" mentioned in class 9 of the trademarks invoked are a vital element of such a control system. Furthermore, these goods can share the same distribution channels, target the same relevant public and can be produced by the same manufacturers. Therefore, the Office finds that these goods are similar to a certain extent.

Class 42

33. The "*Engineering services relating to robotics*" fall under the broad category of "Scientific and technical services and research and design relating thereto", mentioned in the second trademark invoked and are therefore identical.

Conclusion

34. The goods and services are identical or similar to a certain extent.

Comparison of the trademarks

35. 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).

¹ <https://en.wikipedia.org/wiki/Automation>

36. 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).

37. 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).

38. The trademarks to be compared are the following:

Opposition based on:	Opposition directed against:
ANDROID	Terradroid
ANDROID ONE	

Conceptual comparison

39. The trademarks invoked consist of the English word ANDROID, which means "a robot in the shape of a person"². The second trademark invoked also contains the word ONE, which refers to the number 1. The Office finds that the public in the Benelux will understand the meaning of the word ANDROID, because it is similar to the Dutch and French equivalent 'androïde'.

40. The contested sign 'Terradroid', seen as a whole, has no meaning. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Sabel, already cited), the fact remains that, when perceiving a verbal sign, he or she will break it down into elements which, for him or her, suggest a concrete meaning or which resemble words known to him or her (EGC, Respicur, T-256/04, 13 February 2007, ECLI:EU:T:2007:46; Aturion, T-146/06, 13 February 2008, ECLI:EU:T:2008:33; Galvalloy, T-189/05, 14 February 2008, ECLI:EU:T:2008:39 and Ecoblue, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). For this reason, the Office finds that the public will recognize the word 'terra' and the word 'droid'. Part of the public will perceive the word 'terra' as the Latin word for 'earth'³ or as referring to the red-brown colour of terra cotta⁴. With regard to the word droid, the Office finds that part of public will also know that a droid is a type of robot⁵.

41. In the light of the above, the Office concludes that the trademarks are conceptually similar to the extent that they both refer to the concept of a robot.

² <https://www.oxfordlearnersdictionaries.com/definition/english/android>

³ <https://www.woorden.org/woord/terra>; <https://en.wikipedia.org/wiki/Terra>

⁴ <https://dictionary.cambridge.org/dictionary/english/terra-cotta?q=terra>

⁵ <https://www.oxfordlearnersdictionaries.com/definition/english/droid>

Visual comparison

42. The trademarks invoked, as well as the contested trademark are purely verbal marks. The first trademark invoked consists of one word of seven letters and the second trademark invoked consists of two words of seven and three letters. The contested trademark consists of one word of ten letters.

43. The fact that the contested trademark is represented in capital letters, whereas the trademark invoked is represented in capital and lower-case letters, is irrelevant for the purposes of a visual comparison of these marks (see BOIP, opposition decision HY-BOND RESIGLASS, 2000572, 8 April 2008 and EGC, babilu, T-66/11, 31 January 2013, ECLI:EU:T:2013:48).

44. All the trademarks contain the element DROID, either at the end of the sign or, regarding the second trademark invoked, at the end of the first word element. However, the first part of the signs, namely the element 'AN' in the trademarks invoked and the element 'Terra' in the contested trademark, is different. Normally, the consumer attaches more importance to the first part of words (EGC, MUNDICOR, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). Furthermore, in contrast to the contested sign, the word 'DROID' does not, visually, stand out independently in the trademarks invoked, because it is part of the larger word 'android', which will be perceived as a whole by the public, because of its meaning.

45. In addition, the second trademark invoked contains the word ONE at the end, which is not present in the contested sign.

46. In the light of the above, the Office concludes that the trademarks are visually similar to a low extent, because both contain the element 'droid' at the end (of the first word element).

Aural comparison

47. The trademarks invoked will be pronounced in either two (AN-DROID) or three (AN-DROID-ONE) syllables. The contested trademark will be pronounced in three syllables (TER-RA-DROID).

48. The last syllable of the contested sign is identical to the second syllable of the trademarks invoked. However, the first part of the signs is different. In addition, the second trademark invoked contains the word ONE at the end, which is not present in the contested sign. For this reason, the Office finds that the trademarks are aurally similar to a certain extent.

Conclusion

49. The trademarks are conceptually and aurally similar to a certain extent. Visually, the trademarks are similar to a low extent.

A.2 Global assessment

50. 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.

51. 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 contested goods in class 9 could be intended for both the professional and the general public. Therefore the lowest level of attention must be taken into account. The general public is deemed to have a normal

level of attention. The contested services in class 42 are directed at a professional public, such as specialists working in the field of robotics or professionals working in industries that require such specific services, for which the degree of attention is above average.

52. 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). With regard to the goods concerned, the Office finds that the trademarks invoked have a normal distinctiveness, as they are not descriptive for the goods in class 9 that are identical or similar. In addition, the opponent has argued that the trademark ANDROID has a reputation for some of the goods in class 9 (see paragraph 10). This statement has not been disputed by the defendant (see paragraph 22).

53. However, with respect to the identical services in class 42, the meaning of the words ANDROID and DROID is descriptive, because it describes the subject of these services, namely designing or creating a robot. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003, ECLI:EU:T:2003:184). However, by analogy to the case law of the European Court of Justice in the case F1-LIVE (C196/11 P, 24 May 2012, ECLI:EU:C:2012:314), it cannot be concluded that an EU trademark that serves as the basis for an opposition in Benelux is considered as being devoid of distinctive character.

54. In the light of the above, with regard to the services in class 42, the Office finds that the word ANDROID is weak. In this context, the Office also takes into account that the relevant public has specific know-how and experience, which also includes knowledge of commonly used English terms in that specific field (EGC, UMA Workspace, 28 May 2020, T-506/19, ECLI:EU:T:2020:220). Furthermore, the opponent has not argued that the trademarks invoked have a reputation for the identical services in class 42, nor does this follow from the evidence submitted.

55. The Office points out that, according to European case law, a weak distinctive character does not, by definition, mean that there is no likelihood of confusion. Although the distinctive character of the marks must be taken into account with the assessment of the likelihood of confusion, it is only one of a number of elements concerning that assessment (CJEU, Ferromix, C-579/08, 15 January 2010, ECLI:EU:C:2010:18). The global assessment of the likelihood of confusion also 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 trademarks and of the goods or services covered. 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).

56. However, this is not the case with regard to the services in class 42. For these services, the conceptual, visual and aural similarity between the signs only lies within a descriptive element, DROID, which the public will not consider distinctive. For this reason, the Office finds that the public will give its attention to the notable visual and aural difference at the beginning of the signs, particularly the element TERRA. In addition, if the public understands the meaning of the word 'Terra', this only enhances the differences between the signs. It is also of importance that for the services concerned, the level of attention of the public is high. Therefore, the mere fact that both signs contain the word DROID does not lead to any confusing similarity for the contested services in class 42.

Conclusion likelihood of confusion

57. Based on the abovementioned circumstances, with regard to the contested goods in class 9, the Office finds that the relevant public might believe that the identical and similar goods originate from the same undertaking or from economically-linked undertakings. On the other hand, with regard to the contested services in class 42, the differences outweigh the similarities and even for identical services, also taking into account the higher level of attention of the public concerned, the Office concludes that no risk of confusion exists.

B.1 Reputation

58. The opponent has also stated that the trademarks invoked have a reputation. The Office will proceed with the assessment of this claim, only with regard to the remaining services in class 42 for which no likelihood of confusion has been established, which are "*Engineering services relating to robotics*".

Legal framework

59. Article 2.2ter paragraph 3 (a) BCIP is only applicable when the following conditions are met:

- i. the trademarks are either identical or similar;
- ii. the earlier trademark has a reputation;
- iii. 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;
- iv. there is no due cause for the use of the later trademark.

60. According to the Court, the types of injury mentioned in this article, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (CJEU, C-252/07, 27 November 2008, Intel, ECLI:EU:C:2008:655).

61. The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition based on Article 2.2ter (3)(a) BCIP.

i) Similarity of the trademarks

62. The Office has already concluded that the trademarks invoked are conceptually and aurally similar to a certain extent and visually similar to a low extent (see paragraphs 39 - 49).

ii) Reputation of the trademark invoked

63. 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 a 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).

64. This assessment concerns the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect (Intel, already cited). The public amongst which the earlier trademark must have acquired a reputation is that concerned with 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).

65. 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).

66. 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 the evidence

67. The opponent submitted the following documents in order to demonstrate reputation of the trademarks invoked:

- 1) Several online articles regarding the Android operating system;
- 2) Overview of Android trademarks worldwide;
- 3) Several decisions of the EUIPO regarding the reputation of Android;
- 4) Several articles published in Dutch and Belgium newspapers and magazines in 2011, 2016, 2018 and 2019;
- 5) Data chart from StatCounter, dated March 2019 – March 2020;
- 6) Market study report from the 'Autoriteit Consument & Markt', published 11 April 2019;
- 7) Overview of social media channels which Google uses to promote Android;
- 8) Print-screens of the website www.android.com.

68. The reputation of the trademarks invoked must have been established prior to the filing or priority date of contested trademark, which in this case is 29 October 2019. The evidence must also show that the reputation was acquired for the goods and services for which the opponent has claimed reputation.

69. As argued by the opponent, and not disputed by the defendant (see paragraphs 10 and 22), ANDROID is a famous trademark for an operating system for, inter alia, mobile phones. This is also confirmed by the submitted evidence, that clearly shows that Android has achieved great success and that its operating system is used on mobile devices around the world. However, the evidence does not show, nor has it been stated by the opponent, that the trademarks invoked have a reputation for the other goods and services for which the trademarks invoked are registered. Therefore, the Office finds that the trademarks invoked have a reputation, within the meaning of article 2.2ter, 3 (a) BCIP, only for "computer software for use in connection with mobile devices, namely cell phones, mobile phones, smart phones and handheld personal digital assistants (PDAs)" mentioned in class 9 of the trademarks invoked.

iii) *Unfair advantage of or detriment to the distinctive character or reputation*

70. According to the opponent it is most likely that the trademark invoked is brought to the mind of the public when confronted with the contested trademark. The opponent also states that given the similarity of the trademarks and the fact that the goods and services relate to the same sector, namely the IT sector, there is a serious risk that use of the contested trademark Terradroid would take unfair advantage of and is detrimental to the distinctive character or reputation of the trademark ANDROID (see paragraph 17).

71. The holder of the earlier mark who invokes Article 2.2b(3)(a) of the BCIP is obliged to prove that 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. To this end, the holder of the earlier trademark is not required to demonstrate actual and present injury to an earlier mark. However, the holder of the earlier mark must prove that there are elements on the basis of which it may be concluded that there is a serious risk that such an injury will occur in the future (see GEU, Wolf, T-570/10, 22 May 2012, ECLI:EU:T:2012:250) or, with other words, submit elements from which it can be prima facie concluded that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (GEU, Krispy Kreme DOUGHNUTS, T-534/13, 7 October 2015, ECLI:EU:T:2015:751).

The link between the trademarks

72. As indicated above (see paragraph 60), in order to establish the existence of a risk of injury, it is necessary to demonstrate that the relevant public will establish a link (or association) between the trademarks. In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark (Intel, already cited).

73. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (CJEU, C-408/01, 23 October 2003, Adidas/Fitnessworld, ECLI:EU:C:2003:582). Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.

74. In the present case, the Office finds that such a link does not exist. The trademarks invoked have a reputation for a specific product (software for an operating system on mobile devices) which is directed at the general public. The Office finds that the proximity between these specific goods and the services concerned (engineering in the field of robotics) is not obvious, because these goods and services are different in nature and purpose and do not target the same public. It is also highly unlikely that that public will encounter these goods and services through the same distribution channels. This results in a very limited degree of closeness. Moreover, nowadays, the 'IT sector' is very broad and almost expands to every aspect in life. For this reason, although the services concerned also relate to IT, this mere argument does not convince the Office that when the relevant professional public, which has a high level of attention, is confronted with the contested trademark Terradroid, it will think of ANDROID, because both trademarks contain the word 'droid'. Especially in the light of the fact that the word 'droid' means 'robot' (see paragraph 40) and that the contested trademark contains a very notable difference at the beginning, namely the

element 'Terra'. Therefore, the Office concludes that although the trademark ANDROID enjoys a reputation for certain goods, the word 'droid' in the contested trademark does not make the relevant public for the services think of ANDROID.

75. Where the public concerned does not establish a link between the earlier trademark and the contested trademark, the use of the latter does not enable unfair advantage to be taken of, and is not detrimental to, the distinctive character or the repute of the earlier mark. In other words, the existence of such a link is a necessary (but not sufficient) condition for the third requirement of Article 2.2ter (3)(a) BCIP as mentioned above in paragraph 59 (see, CJEU Intel, already cited; CJEU, C-125/14, 3 September 2015, ECLI:EU:C:2015:539, Be Impulsive).

Conclusion unfair advantage of or detriment to the distinctive character or reputation

76. For these reasons, the Office concludes that the use of the contested trademark does not take unfair advantage of or is detrimental to the distinctive character or repute of the trademarks invoked. Consequently, one of the (necessary) conditions laid down in Article 2.2ter (3)(a) BCIP has not been fulfilled and the opposition must be rejected on these ground.

C. Other factors

77. Regarding the opponent's references to previous EUIPO opposition decisions (see paragraphs 11 and 20), the Office points out that it is obliged to render an independent decision based on regulation and case law applicable in the Benelux. The Office is not bound by decisions from other offices, whether they refer to similar cases or not (see, by analogy with, GEU, Curon, T- 353/04, 13 February 2007, ECLI:EU:T:2007:47).

78. Regarding the defendant's argument concerning the fact that many other trademark registrations contain the word DROID (see paragraph 23), the Office admits that the possibility cannot be entirely excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of confusion between the two marks at issue. However, that possibility can be taken into consideration only if, at the very least, during the proceedings, the defendant has duly demonstrated that such coexistence is based upon the absence of any likelihood of confusion on the part of the relevant public between the earlier marks upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier marks concerned and the marks at issue are identical (see EGC, Top iX, T-57/06, 7 November 2007, ECLI:EU:T:2007:333 and Life Blog, already cited). In this case, however, no evidence of such a kind has been provided by the defendant.

D. Conclusion

79. Based on the foregoing the Office concludes that there exists a likelihood of confusion for the goods in class 9 for which a risk of confusion has been established.

80. For the services in class 42 for which no likelihood of confusion was found, it has not been established that the contested sign takes unfair advantage of or is detrimental to the distinctive character or repute of the trademarks invoked with regard to these services in class 42.

IV. CONSEQUENCE(S)

81. The opposition with number 2015763 is partly justified.

82. Benelux application with number 1404907 will not be registered for the following goods:

- Class 9 (*all goods*)

83. Benelux application with number 1404907 will be registered for the following services:

- Class 42 (*all services*)

84. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP, as the opposition is partly justified.

The Hague, 23 July 2021



Eline Schiebroek
(*rapporteur*)

Diter Wuytens

Camille Janssen

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