

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2015858
of 8 October 2021

Opponent: **Chocoladefabriken Lindt & Sprüngli AG**
Seestrasse 204
8802 Kilchberg
Switzerland

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

Invoked trademark: **EU trademark 18063126**
HELLO

against

Defendant: **PepsiCo Inc. North Carolina corporation**
700 Anderson Hill Road
Purchase New York 10577-1444
United States of America


Representative: **Hogan Lovells International LLP**
Atrium - North Tower / Strawinskylaan 4129
1077 ZX Amsterdam
Netherlands

Contested trademark: **Benelux application 1408229**



I. FACTS AND PROCEEDINGS

A. Facts

1. On 20 December 2019 the defendant filed a Benelux trademark application for the combined word/figurative trademark  for goods and services in classes 7, 11, 29, 30, 32 and 35. This application was processed under number 1408229 and was published on 31 December 2019.

2. On 4 February 2020 the opponent filed an opposition against this application. The opposition is based on the earlier European Union trademark 18063126 for the word trademark HELLO, filed on 10 May 2019 and registered on 12 October 2019 for goods and services in classes 29, 30 and 35.

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

4. The opposition is directed against all the goods in classes 29 and 30 and against part of the services in class 35 of the contested application and is based on all the goods and services 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 11 February 2020. During the administrative phase of the proceedings both parties filed arguments. 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 24 August 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 explains that its company is an internationally active and acknowledged producer of chocolate products for over 175 years and is considered being one of the market leaders in chocolate products in Europe.

10. The identical word HELLO is completely comprised in the contested trademark and is prominently shown at its beginning. The trademarks coincide in the presence of this identical word element, which the opponent considers as the most distinctive element of the contested trademark. He therefore considers the trademarks being similar to a high degree from a visual perspective.

11. Although the contested trademark also has the addition of the (descriptive) words GOOD CHOICES, following the opponent it is unlikely that the public will refer to HELLO GOOD CHOICES, but will more likely

considerably perceive the trademarks as and refer to HELLO. Therefore, the trademarks are audibly identical in their shared and most distinctive word element HELLO, and overall considered similar.

12. With regard to the conceptual comparison, the trademarks will be understood as a social greeting and can therefore be considered at least similar.

13. According to the opponent, all goods in classes 7 and 11 covered by the application can be considered complementary to the goods covered by the earlier registration due to the circumstance that these goods are very often sold to consumers through vending machines and/or refrigerated merchandise displays.

14. The goods in classes 29 and 30 of the contested trademark can be considered identical and/or highly similar and/or related or complementary to the goods covered by classes 29 and 30 of the trademark invoked.

15. The goods in class 32 of the contested trademark can also be considered being complementary to the goods covered by the earlier registration due to the same circumstance that these goods are often offered to consumers jointly (by regular sale or through vending machines).

16. Finally, for the services in class 35 aiming on retail services in the field of food and beverage, it can be concluded that these services are also complementary to the goods in classes 29 and 30 of the earlier trademark. Moreover, these services are considered being identical and/or highly similar to the services in class 35 of the trademark invoked.

17. Based on these observations, the opponent concludes that it is likely that consumers will make a connection between the trademarks and will assume that the goods originate from the same or economically linked undertakings and thus there exists a real risk of confusion. He therefore requests that the Office upholds the opposition.

B. Defendant's arguments

18. According to the defendant, it has to be established that the verbal part of the contested trademark is much longer than the trademark invoked, as it contains two additional words. This constitutes a significant difference from the visual point of view, as it is more than three times longer.

19. Moreover, the contested trademark is a complex mark, consisting of graphically displayed word elements and purely figurative elements. The purely graphic elements are eye-catching due to their size, independent position and colour. The bright colours and playful composition of the figurative elements are striking and immediately attract the eye. Finally, the figurative elements take up almost twice as much space as the word elements. The defendant concludes that the trademarks are visually similar only to a very limited degree, if at all.

20. Phonetically, the trademark invoked is pronounced in two syllables [he-llo], whereas the contested trademark is pronounced in five syllables [he-llo good choi-ces]. The defendant observes that the trademarks only have the sound of the first two syllables in common. He concludes that the trademarks are similar from an aural perspective only to a very limited degree, if at all.

21. The defendant establishes that HELLO is a social greeting as well as an expression of surprise. While the trademark invoked will be understood by the public in its function of a general social greeting, the element HELLO in the contested application is directed at the word elements GOOD CHOICES. Therefore this trademark will be understood by the public as a welcoming of choices that are good for someone, if

not as an expression of surprise to find such good choices in places where notoriously only or predominantly unhealthy choices are available (i.e. vending machines and kiosks). The defendant concludes that the trademarks are conceptually clearly different and points out that this conceptual difference may counteract the visual and phonetic similarity.

22. The defendant can find no complementarity between the goods of classes 7 and 11 and those of the trademark invoked and finds these products dissimilar. The mere circumstance that products can be sold through vending machines, doesn't mean that vending machines are essential or even important for the use of these products or vice versa.

23. In the same way, the defendant states that the goods applied for in class 32 cannot be considered complementary to the goods covered by the earlier registration due to the mere circumstance that they are often offered to consumers together.

24. The defendant agrees that some goods applied for in classes 29 and 30 bear similarity to a more or lesser degree to the goods of the trademark invoked. However, some goods of the contested trademark do not find their equivalent in the trademark invoked. Finally, the services of the trademark invoked in class 35 do not give any guidance on how to interpret the very broad category of retailing foodstuffs, unlike the services distinguished in various subcategories by the defendant.

25. Given the fact that the word HELLO is a general social greeting and as such will be seen as welcoming, it is of a laudatory nature and therefore has a below average distinctive character, according to the defendant.

26. The defendant concludes that no likelihood of confusion exists and therefore requests the Office that it rejects the opposition and grants registration of the contested trademark application for all goods and services applied for.

III. DECISION

A.1 Likelihood of confusion

27. 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.

28. 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.*"

29. According to case law of the Court of Justice of the European Union (hereinafter: 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

30. 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).

31. 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).

32. 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).

33. The trademarks to be compared are the following:

Opposition based on:	Opposition directed against:
HELLO	

34. According to relevant case-law, two trademarks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, inter alia the visual, aural and conceptual aspects (reference is made to Matratzen and Sabel, already cited). The fact that a trademark consists exclusively of the earlier mark, to which another word has been added, is an indication that the two trademarks are similar (EGC, ECOBLUE, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). This is especially the case when the element that the trademarks have in common still has an independent distinctive role in the composed trademark (CJEU, THOMSON LIFE, C-120/04, 6 October 2005, ECLI:EU:C:2005:594).

35. In addition, according to the case-law, when a complex mark consists of an element juxtaposed with another trade mark, that latter mark, even where it is not the dominant component in the complex mark, may still have an independent distinctive role in the complex mark. In such a case, the complex

mark and the other mark can be regarded as similar (EGC, Life Blog, T-460/07, 20 January 2010, ECLI:EU:T:2010:18).

36. The trademark invoked is a pure verbal trademark, consisting of the word HELLO. The contested trademark is a combined word/figurative trademark, consisting of the word elements "hello" and "GoodChoices" in different shades of green, placed underneath each other and separated by the images of a stylized green leaflet, an orange circle and a blue drop of water. The right-hand side of the mark features different kinds of coloured geometric figures in red, green, purple, blue and yellow.

37. The noun (or exclamation) "hello" is, according to the Oxford Learner's dictionaries, 1) used as a greeting when you meet somebody, in an email, when you answer the phone or when you want to attract somebody's attention; 2) used to show that you are surprised by something; 3) used to show that you think somebody has said something stupid or is not paying attention. The parties agree on the first meaning of the word (see points 12 and 21), the defendant adds that in the contested mark it will be understood as an expression of surprise, due to the presence of the word elements GOOD CHOICES (see point 21). He therefore concludes that the trademarks are conceptually different.

38. The Office points out, however, that at least part of the eligible public will understand the word as a greeting, as confirmed by the parties. Moreover, the risk of confusion of part of the public is sufficient to allow the opposition to be granted (see, to that effect, Hai v Shark, T-33/03, 9 March 2005, ECLI:EU:T:2005:89).

39. 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). Both trademarks contain the identical word HELLO at the beginning. The trademarks differ because of the addition of the other word elements and the figurative elements in the contested trademark. However, the trademark invoked is completely included in the beginning of the contested trademark and retains an independent distinctive position therein by standing above the other words, by its colour and font (EGC, Life Blog, already cited).

40. The defendant emphasises that the element "hello" is only a minor part of the contested mark, in view of the other word elements and the very prominent figurative elements (see points 18-20). This may be so, but it does not alter the fact that the word is visually, phonetically and conceptually identical to the trademark invoked, whereby the difference between upper and lower case letters may be disregarded (see EGC, babilu, T-66/11, 31 January 2013, ECLI:EU:T:2013:48).

Conclusion

41. Due to the identical element "hello" and despite the verbal and figurative differences, the trademarks are visually, aurally and conceptually similar to a certain extent.

Comparison of the goods and services

42. 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).

43. With the comparison of the goods and services of the trademark invoked and those 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.

44. The opponent includes all the goods and services of the contested trademark in the comparison (see points 13-16). However, when the opposition was filed, it was directed solely against the goods and services in classes 29, 30 and 35. Since the scope of the opposition cannot be extended beyond the opposition period, the opposition decision must be limited to those goods and services. The goods and services to be compared are thus the following:

Opposition based on:	Opposition directed against:
Class 29 Meat; Fish; Poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies; Jams; Compotes; Eggs; Milk; Cheese; Butter; Dairy products, yoghurt; Edible oils and fats.	Class 29 Hummus chick pea paste; Potato-based snack foods; meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.
Class 30 Cocoa and coffee substitutes; Rice; Pasta and noodles; Tapioca and sago; Flour and preparations made from cereals; Bread; Pastry and confectionery goods; Chocolate; Ice cream, sorbets and other kinds of edible ices; Sugar; Honey; Golden syrup; Yeast; Baking powder; Salt; Seasonings; Spices; Preserved herbs; Vinegar; Sauces & condiments; Ice [frozen water].	Class 30 Cookies; Corn-based snack foods; Grain-based food bars; Iced tea; Multigrain-based snack foods; Pita chips; Popcorn; Pretzels; Tortilla chips; coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.
Class 35 Retailing of foodstuffs.	Class 35 Retail sale services in the field of food and beverage, also provided by mobile points of sale; retail store services in the field of food and beverage; online retail services in the field of food and beverage; retail sale services by kiosks in the field of food and beverage.

Class 29

45. The goods *meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and edible oils and fats* are mentioned *expressis verbis* in both lists of goods and are thus identical.

46. The goods *milk products* of the contested trademark belong to the category *dairy products* of the trademark invoked and are therefore identical to them. Indeed, according to established case law, if the goods of the earlier trademark also contain goods that are mentioned in the application for the contested trademark, these goods are considered identical (see EGC, Fifties, T104/01, 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).

47. The goods *hummus chick pea paste* of the contested trademark are to a certain extent similar to the products *meat, fish, poultry and game, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs and cheese* of the trademark invoked. All these products are used as accompaniments, for example as spreads on sandwiches. These products are therefore also competitive in the sense that one product can serve as an alternative or substitute to another.

48. The goods *potato-based snack foods* of the contested trademark are to a certain extent similar to the products *meat, fish, poultry and game* and *preserved, frozen, dried and cooked fruits and vegetables, rice, pasta and noodles* of the trademark invoked. These goods are often served or consumed together and are therefore often considered as a whole as a quick meal, snack or treat.

Class 30

49. The goods *cocoa, rice, tapioca and sago, flour and preparations made from cereals, bread, pastries and confectionery, edible ices, sugar, honey, yeast, baking-powder, salt, vinegar, sauces(condiments), spices* and *ice* are mentioned *expressis verbis* in both lists of goods and are thus identical.

50. The product *treacle* of the contested trademark is synonymous of the product *golden syrup* of the trademark invoked and thus are these products identical.

51. The goods *cookies, corn-based snack foods, grain-based food bars, multigrain-based snack foods, pita chips, popcorn, pretzels* and *tortilla chips* of the contested trademark belong to the category *flour and preparations made from cereals* of the trademark invoked and are therefore identical to them.

52. The product *artificial coffee* of the contested trademark belongs to the category *coffee substitutes* of the trademark invoked and is therefore identical to it.

53. The product *mustard* of the contested trademark belongs to the category *sauces & condiments* of the trademark invoked and is therefore identical to it.

54. The products *iced tea, coffee* and *tea* of the contested trademark are similar to the products *coffee substitutes* of the trademark invoked. The nature and destination of these products are the same, they are used by the same consumers and delivered by the same suppliers. These products are consumed as drinks during a coffee break or after dinner. Furthermore, these products can be used as alternatives to each other.

Class 35

55. All services of the contested trademark belong to the category *retailing of foodstuffs* of the trademark invoked and are therefore identical to them. The modalities according to which and the places where these services are provided do not alter the nature of these services and their similarity. Moreover, it is not excluded that the broader category of services of the trademark invoked are also provided according to these or similar modalities and places.

Conclusion

56. The goods and services to which the opposition is directed are partly identical and partly similar to the goods and services of the trademark invoked.

A.2 Global assessment

57. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the trademarks are important factors.

58. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be 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 in general. For these goods the average level of attention of the public concerned may be deemed normal.

59. 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).

60. It should also be taken into consideration that the average consumer usually perceives a mark as a whole and does not proceed to an analysis of its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different trademarks and must place their trust in the imperfect picture of those that they have kept in their mind.

61. 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 and services concerned. The fact that the word HELLO is a general social greeting and as such will be seen as welcoming, does not mean that it is not distinctive for the goods and services concerned (see point 25).

62. The trademarks are conceptually, visually and aurally similar and the goods concerned are partly identical and partly similar. Based on the aforesaid, the Office comes to the conclusion that the relevant public might believe that the goods and services in question come from the same undertaking or from economically linked undertakings.

B. Conclusion

63. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

IV. CONSEQUENCE

64. The opposition with number 2015858 is justified.

65. The Benelux application with number 1408229 will not be registered for the following goods and services:

Class 29 All goods.

Class 30 All goods.

Class 35 Retail sale services in the field of food and beverage, also provided by mobile points of sale; retail store services in the field of food and beverage; online retail services in the field of food and beverage; retail sale services by kiosks in the field of food and beverage.

66. The Benelux application with number 1408229 will be registered for the following goods and services, since the opposition was not directed against them:

Class 7 All goods.

Class 11 All goods.

Class 32 All goods.

Class 35 Customer loyalty services and customer club services, for commercial, promotional and/or advertising purposes; advertising; business management; business administration; office functions.

67. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 8 October 2021



Willy Neys
rapporteur

Saskia Smits

Pieter Veeze

Administrative officer:

Guy Abrams