



BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2016267
of 11 July 2022

Opponent: **SOFAR SWISS SA**
Via Nassa 3
6900 Lugano
Switzerland

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

Invoked trademark: **International trademark 1410088**
YALU

against

Defendant: **LABORATOIRES VIVACY, SAS - Société par Actions Simplifiée, France**
Rue Paul Valéry 44
75116 Paris
France

Representative: **INLEX IP EXPERTISE, Société par actions simplifiée**
Rue Pierre Charron 60
75005 Paris
France

Contested trademark: **International application 1536751**
HYALU CALM

I. FACTS AND PROCEEDINGS

A. Facts

1. On 30 April 2020 the defendant filed an international trademark application designating the Benelux, for the word trademark HYALU CALM for goods in classes 3 and 5. This application was processed under the number 1536751 and was published in the Gazette 2020/23 on 18 June 2020.
2. On 5 August 2020 the opponent filed an opposition against the registration in the Benelux of the application. The opposition is based upon the international registration with designation of the European Union for the word trademark YALU, filed under number 1410088 on 13 December 2017 and registered in the European Union on 8 April 2021 for goods and services in classes 3, 5 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 covered by the contested trademark and is based on all the goods and services covered by the trademark invoked
5. The grounds for opposition are those laid down in article 2.14, 2 (a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").
6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 6 August 2020. The opposition proceedings were suspended ex officio until the finalisation of the registration procedure of the trademark invoked. 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 21 January 2022.

II. LEGAL GROUNDS AND ARGUMENTS

8. The opponent filed his opposition 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 trademark and the sign, and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. The opponent considers the second element of the contested trademark, CALM, being part of the basic vocabulary of the English language and therefore immediately understood by the Benelux public as describing a characteristic of the goods involved, namely, to tranquilize or sooth the skin as a result whereof *inter alia* redness is reduced and/or inflammation is relieved. As a result, he considers the word CALM having no or hardly any impact on the mind of the consumer. Hence, according to the opponent, the attention of the consumer will be focused on the highly similar elements YALU and HYALU.
10. Visually, the trademarks at issue are similar since they have in common the letters Y, A, L and U. Moreover, the trademark invoked is fully included in the first and dominant word of the contested trademark, differing in one letter only (the letter 'H'). Therefore, the opponent considers the dominant parts of the trademarks highly similar from a visual point of view.

11. Aurally, the trademarks coincide in the sound of the letters YALU at the beginning. Moreover, as the first letter H in the contested trademark will not be pronounced by the French speaking Benelux consumer, the pronunciation of the first element is identical. When pronounced by the Dutch speaking consumer the H is hardly recognizable, meaning that the words are phonetically highly similar, according to the opponent.

12. None of the trademarks as a whole have a specific meaning in one of the Benelux languages and, according to the opponent, a conceptual comparison is therefore not possible.

13. The opponent notes that the goods in classes 3 and 5 in the contested application are identical or at least highly similar to the goods and services covered by the prior trademark.

14. The opponent concludes that there is a clear risk of confusion, and he therefore requests the Office that the contested application is refused for registration in the Benelux.

B. Defendant's arguments

15. The defendant does not dispute the similarity of the goods covered by the two trademarks in classes 3 and 5. However, it is settled case-law that the similarity of the goods is not sufficient to conclude that there is a likelihood of confusion between two trademarks if differences between the signs allow them to be distinguished.

16. The defendant strongly disagrees with the opponent's analysis of the signs, focusing on the element HYALU on the ground that the element CALM is in the public domain and therefore has no impact on the overall impression of the contested trademark. Although the English term CALM may be reminiscent of the verb *to calm*, it is not without distinctive character. The term HYALU has no direct meaning either and will at most evoke *hyaluronic acid* without being an official or commonly used abbreviation of it. Both elements are therefore at most evocative but have no direct meaning and are not devoid of distinctive character. According to the defendant, they therefore have equivalent distinctive value, and both must be considered in the analysis of the similarity of the signs.

17. The initial letter of the contested sign is the letter H, which is completely different from the letter Y in the trademark invoked. Furthermore, the first element in the contested sign is followed by the word CALM, which produces an overall very different visual impression from that of the trademark invoked.

18. Contrary to what the opponent states, the letter H is phonetically clearly present in the contested sign since it is pronounced in an aspirated manner in Dutch. Furthermore, the signs do not have the same number of syllables, not the same cadence and not the same final sound. The defendant concludes that the trademarks are phonetically different.

19. Although the two words of the contested sign may be evocative when taken separately, they do not have a direct meaning and do not refer to a precise concept and will be perceived rather as a fanciful designation. The trademark invoked refers to the river that marks the border between China and North Korea. According to the defendant, there is therefore no conceptual similarity between the signs.

20. In view of the above, the defendant concludes that the coexistence of the trademark invoked, and the contested trademark is not such as to create a likelihood of confusion. He therefore requests that the Office rejects the opposition and accepts the contested trademark for registration.

III. DECISION

A.1 Likelihood of confusion

21. 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.

22. Article 2.2ter, 1 BCIP stipulates that, *"A trademark shall, in case an opposition is filed, not be registered (...) where: [...] b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*¹

23. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.²

24. According to the settled case-law of the CJEU, the existence of a likelihood of confusion must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness - inherent or acquired through use - of the earlier trademark.³

Comparison of the signs

25. To assess the degree of similarity between the conflicting signs, their visual, phonetical, and conceptual similarity must be determined. The comparison must be based on the overall impression created by those signs. The perception of the signs by the average consumer plays a decisive role in the assessment. The average consumer usually perceives a sign as a whole and does not pay attention to its various details.⁴

26. In certain circumstances, although the overall impression given by a composed sign to the relevant public may be dominated by one or more of its components, the assessment of its compliance may be carried out based on the dominant component only if all the other components of the sign are negligible.⁵

27. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
YALU	HYALU CALM

¹ Art. 2.2ter, paragraph 1, sub b BCIP is the implementation of Art. 5 paragraph 1 sub b 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. A comparable provision can be found in Art. 8(1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the Union trademark

² CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 (Equivalenza) and the case-law mentioned there.

⁵ CJEU 22 October 2015, C-20/14, ECLI:EU:C:2015:714, point 37 (BGW) and the case-law mentioned there.

Visual comparison

28. Both signs are pure verbal trademarks, the trademark invoked consisting of a four-letter word and the contested trademark consisting of two words of five and four letters respectively. The trademark invoked is incorporated in the contested trademark, but it cannot be said to have an independent distinctive position in it, since it is part of a new word.

29. However, the trademark invoked remains easily recognisable in the first part of the contested sign since it is preceded by only one letter, namely the letter H. In addition, the contested sign contains a second word element, CALM. Those differences cannot, however, eliminate the similarity between the signs, owing to the four identical letters in the first element which, moreover, are placed in the same order.

30. The signs are visually similar to a certain degree.

Phonetic comparison

31. Contrary to the opinion of the opponent (see point 11), the letter H at the beginning of a word will be pronounced by at least a part of the French speaking Benelux consumer (so called *h aspiré*) and by the Dutch speaking part of the Benelux public, albeit weakly (as a glottal fricative).

32. The pronunciation or absence of the letter H will possibly have an impact on the pronunciation of the rest of the word. Without the letter H one will tend to pronounce the initial letter Y as a J, as in the trademark invoked: [ja-lu]. With the letter H, people will tend to pronounce the letter Y as an I: [hi-a-lu]. In both cases the last two sounds remain the same: [a-lu]. The second word element in the contested trademark is not phonetically similar to the trademark invoked.

33. The signs are phonetically similar to a certain degree.

Conceptual comparison

34. According to the defendant, HYALU may refer to *hyaluronic acid*, a chemical naturally occurring in the body which is also used in medicine and cosmetics (see point 16).⁶ However, he points out that it is not an official or commonly used abbreviation and therefore the Office considers that this meaning will not be immediately recognised by the eligible public. Nevertheless, it should also be noted in this connection that a likelihood of confusion on part of the public is sufficient.⁷ The element CALM in the contested sign will of course be recognized as the English adjective or verb, but it gives no established meaning to the sign as a whole.

35. The Office considers that the ready geographical knowledge of the relevant public is not such that the trademark invoked will immediately be recognised as the river that forms the boundary between China and North Korea, as the defendant claims (see point 19). It must therefore be held that the trademark invoked does not have an established meaning either.

36. Since neither trademark has a fixed meaning, a conceptual comparison is not appropriate.

⁶ https://en.wikipedia.org/wiki/Hyaluronic_acid.

⁷ In this sense: EGC 9 March 2005, T-33/03, ECLI:EU:T:2005:89, point 39 (Hai/Shark).

Conclusion

37. The trademarks are visually and phonetically similar to a certain degree and a conceptual comparison is not possible.

Comparison of the goods and services

38. In assessing the similarity of the goods or services concerned, account must be taken of all the relevant factors which characterise the relationship between them. These include, *inter alia*, their nature, their end users, their method of use as well as whether they are in competition with each other or are complementary.⁸

39. In comparing the goods and services, the goods and services shall be considered in the terms set out in the register, and not the actual or intended use.⁹

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

Opposition based on:	Opposition directed against:
Class 3 Soaps; perfumery products; essential oils; hair care lotions; anti-aging gels; anti-aging lotions; anti-aging moisturizers for cosmetic use; cosmetics containing hyaluronic acid; anti-aging creams; anti-wrinkle creams; face creams [non-medicated]; cold cream not for medical use; cosmetics for the treatment of wrinkles; anti-wrinkle cosmetic facial preparations for topical use; cosmetic creams; skin whitening cream; eaux de toilette; scented water; aloe vera preparations for cosmetic use; food flavorings [essential oils]; astringents for cosmetic use; balms other than for medical use; cosmetics; eyelash cosmetics; eyebrow cosmetics; massage gels other than for medical use; cosmetics, namely, gels; moisturizing gels [cosmetics]; face gels; cosmetic eye contour gels; moisturizing creams, lotions and gels; greases for cosmetic use; petroleum jelly for cosmetic use; almond milk for cosmetic use; cleansing milk for toilet purposes; lotions for cosmetic use; beauty masks; oils for toilet purposes; oils for perfumes and scents; oils for cosmetic use; pomades for cosmetic use; cosmetic skin-tanning preparations; cosmetic preparations for baths; cosmetic preparations for slimming; cosmetic skin care preparations; perfumery products; make-up preparations; toiletries; tissues impregnated with cosmetic lotions; cosmetics for use on the skin; non-medicated skin creams.	Class 3 Cosmetics and cosmetic preparations for the face and body; dermocosmetic products; cosmetic creams; cosmetic oils; cosmetic masks; cosmetic soaps; preparations for skin care, namely creams, milks, serums, lotions, gels and powders for the face and body.
Class 5 Dermatological preparations; dermatological pharmaceutical products; dermatological pharmaceutical substances; pharmaceutical preparations for dermatological use; creams for dermatological use; gels for dermatological use; lotions for the skin for medical use; skin care lotions for medical use; skin care preparations for medical use; medicated skin creams; food supplements, nutritional supplements, mineral supplements, dietary supplements (for medical and non-medical use), nutraceutical preparations, vitamin preparations, anti-oxidants, preparations for the intestinal flora, bacterial preparations, food	Class 5 Dermatological preparations; gels, creams and solutions for dermatological use; products for skin, face and body hygiene and care for medical use.

⁸ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁹ CJEU 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

<p>preparations (for medical and non-medical use), homeopathic supplements (for medical and non-medical use), homeopathic medicines, homeopathic pharmaceutical products; dietetic substances for medical use and dietary food substances; food supplements; vitamin supplements; nutritional supplements; anti-oxidant supplements; probiotic supplements; pharmaceutical products, substances, preparations and para-pharmaceutical products, substances, preparations.</p>	
<p>Class 35 Retail sale and wholesale for others, also sale by mail order and by other means of communication, including the Internet, of soaps, perfumery products, essential oils, hair care lotions, anti-aging gels, anti-aging lotions, anti-aging moisturizers for cosmetic use, anti-aging creams, anti-wrinkle creams, face creams [non-medicated], cold cream not for medical use, cosmetics for wrinkle treatment, anti-wrinkle cosmetic facial preparations for topical use, cosmetic creams, skin whitening creams, toilet water, scented water, aloe vera preparations for cosmetic use, aromas [essential oils], astringents for cosmetic use, balms other than for medical use, cosmetics, eyelash cosmetics, eyebrow cosmetics, massage gels other than for medical use, cosmetics, namely, gels, moisturizing gels [cosmetics], face gels, cosmetic eye contour gels, moisturizing creams, lotions and gels, greases for cosmetic use, petroleum jelly for cosmetic use, almond milk for cosmetic use, cleansing milks, lotions for cosmetic use, beauty masks, oils for toilet purposes, oils for perfumes and scents, oils for cosmetic use, pomades for cosmetic use, cosmetic skin-tanning preparations, cosmetic bath preparations, cosmetics for slimming, cosmetic skin care preparations, perfumery products, make-up preparations, toiletries, tissues impregnated with cosmetic lotions, cosmetics for use on the skin, skin creams [non-medicated]; retail sale and wholesale for others, also sale by mail order and by other means of communication, including the Internet, of dermatological preparations, dermatological pharmaceutical products, dermatological pharmaceutical substances, pharmaceutical preparations for dermatological use, creams for dermatological use, gels for dermatological use, skin lotions for medical use, skin care lotions for medical use, skin care preparations for medical use, cold cream for medical use, food supplements, nutritional, mineral, dietary (for medical and non-medical use), nutraceutical, vitamin, antioxidant preparations and substances, preparations for the intestinal flora, bacterial preparations and food preparations and homeopathic substances (for medical and non-medical use), dietetic substances for medical use and dietary food supplements, food supplements, vitamin supplements, nutritional supplements, anti-oxidant supplements, probiotic supplements, pharmaceutical products, substances, preparations; business management assistance relating to franchising. Retail sale and wholesale for others, also sale by mail order and by other means of communication, including the Internet, of soaps, perfumery products, essential oils, hair care lotions, anti-aging gels, anti-aging lotions, anti-aging moisturizers for cosmetic use, anti-aging creams, anti-wrinkle creams, face creams [non-medicated],</p>	

cold cream not for medical use, cosmetics for wrinkle treatment, anti-wrinkle cosmetic facial preparations for topical use, cosmetic creams, skin whitening creams, toilet water, scented water, aloe vera preparations for cosmetic use, aromas [essential oils], astringents for cosmetic use, balms other than for medical use, cosmetics, eyelash cosmetics, eyebrow cosmetics, massage gels other than for medical use, cosmetics, namely, gels, moisturizing gels [cosmetics], face gels, cosmetic eye contour gels, moisturizing creams, lotions and gels, greases for cosmetic use, petroleum jelly for cosmetic use, almond milk for cosmetic use, cleansing milks, lotions for cosmetic use, beauty masks, oils for toilet purposes, oils for perfumes and scents, oils for cosmetic use, pomades for cosmetic use, cosmetic skin-tanning preparations, cosmetic bath preparations, cosmetics for slimming, cosmetic skin care preparations, perfumery products, make-up preparations, toiletries, tissues impregnated with cosmetic lotions, skin cosmetics, skin creams [non-medicated]; retail sale and wholesale for others, also sale by mail order and by other means of communication, including the Internet, of dermatological preparations, dermatological pharmaceutical products, dermatological pharmaceutical substances, pharmaceutical preparations for dermatological use, creams for dermatological use, gels for dermatological use, skin lotions for medical use, skin care lotions for medical use, skin care preparations for medical use, cold cream for medical use, food supplements, nutritional, mineral, dietary (for medical and non-medical use), nutraceutical, vitamin, antioxidant preparations and substances, preparations for the intestinal flora, bacterial preparations and food preparations and homeopathic substances (for medical and non-medical use), dietetic substances for medical use and dietary food supplements, food supplements, vitamin supplements, nutritional supplements, antioxidant supplements, probiotic supplements, pharmaceutical products, substances, preparations; business management assistance relating to franchising. Retail sale and wholesale for others, also sale by mail order and by other means of communication, including the Internet, of soaps, perfumery products, essential oils, hair care lotions, anti-aging gels, anti-aging lotions, anti-aging moisturizers for cosmetic use, anti-aging creams, anti-wrinkle creams, face creams [non-medicated], cold cream not for medical use, cosmetics for wrinkle treatment, anti-wrinkle cosmetic facial preparations for topical use, cosmetic creams, skin whitening creams, toilet water, scented water, aloe vera preparations for cosmetic use, aromas [essential oils], astringents for cosmetic use, balms other than for medical use, cosmetics, eyelash cosmetics, eyebrow cosmetics, massage gels other than for medical use, cosmetics, namely, gels, moisturizing gels [cosmetics], face gels, cosmetic eye contour gels, moisturizing creams, lotions and gels, greases for cosmetic use, petroleum jelly for cosmetic use, almond milk for cosmetic use, cleansing milks, lotions for cosmetic use, beauty masks, oils for toilet purposes, oils for perfumes and scents, oils for cosmetic use, pomades for cosmetic use, cosmetic skin-tanning preparations,

<p>cosmetic bath preparations, cosmetics for slimming, cosmetic skin care preparations, perfumery products, make-up preparations, toiletries, tissues impregnated with cosmetic lotions, skin cosmetics, skin creams [non-medicated]; retail sale and wholesale for others, also sale by mail order and by other means of communication, including the Internet, of dermatological preparations, dermatological pharmaceutical products, dermatological pharmaceutical substances, pharmaceutical preparations for dermatological use, creams for dermatological use, gels for dermatological use, skin lotions for medical use, skin care lotions for medical use, skin care preparations for medical use, cold cream for medical use, food supplements, nutritional, mineral, dietary (for medical and non-medical use), nutraceutical, vitamin, antioxidant preparations and substances, preparations for the intestinal flora, bacterial preparations and food preparations and homeopathic substances (for medical and non-medical use), dietetic substances for medical use and dietary food supplements, food supplements, vitamin supplements, nutritional supplements, antioxidant supplements, probiotic supplements, pharmaceutical products, substances, preparations; business management assistance relating to franchising.</p>	
--	--

41. Having regard to the principle of *audi alteram partem*, the opposition proceedings are limited to the arguments, facts and evidence put forward by the parties.¹⁰ The defendant does not dispute the similarity of the goods covered in classes 3 and 5 (see point 15). The similarity of the goods concerned is thus manifestly *in confesso*, so that the Office need not examine it further.

A.2 Global assessment

42. The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.¹¹ This case concerns goods and services aimed at the general public and it has not been established that there is an increased level of attention.

43. The greater the degree of distinctiveness of the earlier mark, the greater the likelihood of confusion. Trademarks with a strong distinctive character, either by their nature or because of their reputation on the market, therefore, enjoy greater protection than trademarks with a weak distinctive character.¹² In the present case, the trademark invoked has a normal distinctive character as it does not describe the characteristics of the goods and services in question.

44. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be taken into account and, in particular, between the similarity of the conflicting signs and the

¹⁰ Art. 1.16, paragraph 1 BCIP and Rule 1.21 IR.

¹¹ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹² CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.¹³

45. The signs are visually and aurally similar to a certain degree and a conceptual comparison does not apply. The similarity of the goods and services concerned is *in confesso*. Based on the above factors, and considering their interdependence, the Office considers that the public may believe that these goods originate from the same or from an economically linked undertaking, thereby giving rise to a likelihood of confusion.

B. Conclusion

46. Based on the foregoing, the Office concludes that there is a likelihood of confusion.

IV. CONSEQUENCE

47. The opposition with number 2016267 is justified.

48. The International application with number 1536751 will not be registered in the Benelux, for none of the goods for which it has been filed.

49. 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. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 11 July 2022



Willy Neys
(*rapporteur*)

Tineke Van Hoey

Camille Janssen

Administrative officer:

Gerda Veltman

¹³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, punt 59 (Equivalenza) and the case-law mentioned there.