

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2016976**  
**of 27 September 2022**

**Opponent:** **Tyco International Services GmbH**  
Freier Platz 10  
8200 Schaffhausen  
Switzerland

**Representative:** **Marks & Clerk LLP**  
Rue de la Vallée 44  
2661 Luxembourg  
Luxembourg

**Invoked trademark 1: European Union trademark registration 16473134**



**Invoked trademark 2: International trademark registration 1099190**



**Invoked trademark 3: International trademark registration 1099191**

TE

*against*

**Defendant:** **TE PARTS, SIA**  
Jupatovkas iela 5B  
4601 Rēzekne  
Latvia

**Representative:** **Novagraaf Belgium S.A./N.V.**  
Chaussée de la Hulpe 187  
1170 Watermael-Boitsfort  
Belgium

**Contested sign:**            **International trademark application 1581874**



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

1. On 19 August 2020, the defendant filed an International trademark application, in which inter alia the Benelux has been designated, for the following combined word/figurative trademark for goods and services in the classes 9, 12 and 35:



This application was processed under the number 1581874 and was published on 18 March 2021.

2. On 17 May 2021, the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- European Union trademark 16473134 of the combined word/figurative trademark



, filed on 15 March 2017 and registered on 30 April 2018 for goods and services in classes 6, 7, 8, 9, 10, 11, 17, 37, 38, 40 and 42;

- International registration 1099190, designating the European Union, of the combined



word/figurative trademark , filed 3 May 2011 and registered for goods and services in classes 7, 8, 9, 17, 37 and 38;

- International registration 1099191, designating the European Union, of the word mark TE, filed 3 May 2011 and registered for goods and services in classes 7, 8, 9, 17, 37 and 38.

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

4. The opposition is directed against all goods and services covered by the contested application and is based on all 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 19 May 2021. 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 25 October 2021.

**II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES**

8. The opponent filed his 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 trademark and sign and of the goods or services concerned.

**A. Opponent's arguments**

9. The opponent explains that the company is part of TE Connectivity, an American Swiss-domiciled technology company that designs and manufactures connectors and sensors for, inter alia, the automotive industry, data communication systems and industrial equipment.

10. With regard to the comparison of the signs, the opponent argues that all signs include the two-letter combination 'TE'. Regarding the word 'parts', in the contested sign, the opponent states that this word has an obvious meaning for all consumers of the Benelux territory, because it is commonly used to designate components or accessories of other products, such as cars and other vehicles. According to the opponent, the word 'parts' is purely descriptive and therefore the contested sign will be perceived as the name or brand for spare parts under the name 'TE'.

11. The signs are visually similar because they all share the same element 'TE'. Furthermore, the opponent also argues that if the contested sign is compared with the first trademark invoked, an additional point of similarity resides in the colour orange that is used in both combined word/figurative trademarks.

12. Aurally, the signs are identical in the 'TE' element and if it is taken into account that the word 'parts' has a descriptive meaning, the opponent argues that the signs are highly similar.

13. Regarding the conceptual comparison, the opponent states that the word 'te' means 'you' in French. However, in the context of the trademarks concerned, the public will understand that this is not the intended meaning. According to the opponent, the letters 'TE' are clearly an abbreviation, because it is written in standard capital letters. Furthermore, in the contested sign the descriptive meaning of the word 'parts' suggest that a consumer will perceive the trademark as a sub mark of 'TE' or a mark that was specifically designed to cover spare parts for goods sold under the prior TE marks. The opponent therefore concludes that the signs are conceptually identical.

14. The opponent compares the goods and services of the contested sign with the goods mentioned in class 9 of the trademarks invoked, because, according to the opponent, only these goods are of interest. With regard to class 9 of the contested sign, the opponent argues that these goods are included in several broad terms mentioned in class 9 of the trademarks invoked. For this reason, these goods are identical. Furthermore, the goods in class 12 are complementary to the goods in class 9 of the trademarks invoked. With regard to the services in class 35 of the contested sign, the opponent states that the services that relate to spare parts of vehicles are complementary to the goods mentioned in class 9 of the trademarks

invoked. According to the opponent, the other services mentioned in class 35 can also relate to the promotion and retail automobile components and for this reason, the services are also similar to the goods in class 9.

15. The opponent concludes that there exists a likelihood of confusion and requests that the Office refuses the contested sign and orders the defendant to bear the costs of the proceedings.

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

16. The defendant argues that there are several visual differences between the contested sign and the trademarks invoked. They differ in length since the trademarks invoked are composed of 2 letters and the contested sign is composed of 7 letters. Furthermore, the first and second trademark invoked also contain a figurative element. These visual elements differ from the figurative element of the contested sign. For this reason, according to the defendant, the signs are visually only slightly similar.

17. The defendant states that because of the difference in length the signs will be pronounced differently. Therefore, the signs are aurally slightly similar at most.

18. According to the defendant, the word element 'TE' does not have an obvious meaning for the public. Furthermore, the additional word element of the contested sign has a meaning. However, the defendant is of the opinion that a conceptual comparison is not possible.

19. The defendant argues that the differences between the signs outweigh the similarities, and that therefore the signs are not similar.

20. With regard to the goods in classes 9 and 12, the defendant states that some of the products of the contested sign fall under some of the categories of products covered by the trademarks invoked. However, the majority of the products of classes 9 and 12 is not similar to any of the products of the trademarks invoked. Furthermore, the services in class 35 of the contested sign are not similar to the goods of the trademarks invoked.

21. The defendant also argues that, considering the nature of the goods concerned, the public has a level of attention higher than average.

22. Defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition, registers the contested sign, and decides that the opponent should bear the costs.

## **III. DECISION**

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

23. 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.

24. Article 2.2ter (1) BCIP stipulates insofar as relevant 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.”<sup>1</sup>*

25. 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.<sup>2</sup>

26. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public 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.<sup>3</sup>

### **Comparison of the signs**

27. To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.<sup>4</sup>

28. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.<sup>5</sup> The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.<sup>6</sup>

29. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, inter alia, their distinctive and dominant components.

30. For reasons of procedural economy, the Office will first compare the contested sign with the first trademark invoked (EU trademark 16473134). The signs to be compared are the following:

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<sup>1</sup> Art. 2.2ter (1)(b) BCIP implements art. 5 (1)(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 similar 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 European Union trademark.



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

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

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

<sup>5</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

<sup>6</sup> General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

Opposition based on:	Opposition directed against:
	

### *Visual comparison*

31. The trademark invoked is a combined word/figurative mark that consists of two white capital letters 'TE', depicted in italics and placed in an orange rectangle. To the left of the word TE there are three staggered white stripes beneath each other. The contested sign is also a combined word/figurative mark, consisting of the word elements 'TE PARTS', depicted in grey capital letters, of which the arm of the T continues further to the left than normal. The two words are placed underneath each other. To the left of the word element there is a circle that contains an abstract combination of gray and orange shapes. The shapes inside the circle might be perceived as an entanglement of the letters T and E.

32. Where a sign consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods or services in question by quoting their name than by describing the figurative element of the trademark.<sup>7</sup> Therefore, although the figurative elements present in both signs will not be overlooked due to their positioning and size, the attention of the public will be particularly focused on the word elements TE and TE PARTS.

33. With regard to the contested sign, the Office finds that the element 'TE' will be perceived as more dominant than the element 'PARTS', as this word is descriptive in view of the goods and services concerned and also because it is placed underneath the element 'TE'.

34. Both trademark and sign contain the dominant element 'TE'. Furthermore, in both signs, this word element is placed to the right of a figurative element and in addition, both figurative elements contain the colour orange.

35. In view of the foregoing, the Office finds that the signs are visually similar.

### *Phonetic comparison*

36. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level.<sup>8</sup>

37. The Office finds that the public either pronounces the word 'TE' as two separate letters, if it is perceived as an abbreviation, or simply as the short word 'te'. Either way, the pronunciation of this element is identical in both signs. Indeed, while the trademarks differ in length, because of the presence of the word "PARTS", the verbal element "TE" is identically present in both signs. Taking into account the element 'TE' is dominant element, the Office finds that the signs are aurally highly similar.

<sup>7</sup> General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 and the case-law mentioned there (Smarter Travel).

<sup>8</sup> General Court (EU) 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

*Conceptual comparison*

38. Although the word 'TE' means 'you' in French, the Office agrees with the opponent that the public will not understand the signs in that meaning in view of the relevant goods and services (see paragraph 13). Furthermore, the Office agrees with the defendant that the word 'TE' has no clear and obvious meaning (see paragraph 18). On the other hand, the public will understand the meaning of the word 'parts' as a piece of a machine or structure. This reference is not present in the trademark invoked, however due to its descriptive character, the Office finds this difference insufficient to conclude that the signs are conceptually dissimilar.

39. In the light of the above, the Office finds that because the dominant element TE has no established meaning, a conceptual comparison is not possible.

*Conclusion*

40. The signs are visually similar and aurally highly similar. A conceptual comparison is not possible.

***Comparison of the goods and services***

41. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. 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.<sup>9</sup>

42. Complementarity only exists where the products and/or services are so closely related to each other that one is indispensable or important for the use of the other so that consumers may believe that the same undertaking is responsible for those products.<sup>10</sup>

43. 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.<sup>11</sup>

44. In his arguments, the opponent explicitly only compares the goods in class 9 of the trademarks invoked with the goods and services of the contested sign (see paragraph 14). 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.<sup>12</sup> For this reason, the Office will only assess the similarity between these goods and services.

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<sup>9</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

<sup>10</sup> General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

<sup>11</sup> General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

<sup>12</sup> Art. 2.16, paragraph 1 BCIP and Rule 1.21 IR.



45. The goods to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
<p>Cl 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking [supervision], life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording disks; mechanisms for coin-operated apparatus; cash registers, calculating machines; data processing apparatus and computer hardware and peripheral devices for computers; computer software; computer wiring systems; electrochemical systems, included in this class, namely high power electrical connectors and cables, high power contactors for battery switching and control, circuit protection devices, power distribution units and parts and components related thereto; connectors and connection systems; electrical connectors, components for connectors, particularly containers; connections for equipment (plug-in connections); couplings, connections and joints; connector housings; components of wiring systems, particularly punchdown blocks (bars for multiple connections); jacks, plugs, connecting cords, connecting panels; wires and cables, cables of fiber optics; underwater cables, telecommunication cables, fiber optic and wiring harnesses, electrically conductive cable terminations; collars for wiring not of metal; housings for ground connections and guard shields for high voltage cables; accessories for high voltage cables for industry in aerial and underground installations, including external terminals with oil baths, dry exterior terminals; electrical cables for lighting installations; canals for electrical wiring, cassettes for managing fiber optic cables (plug and play cassettes), components of cabling for improving transmission of signals, particularly plates, divider coils, blocks, brackets, wiring ducts, rings and clips, housing for outlets and panels,</p>	<p>Cl 9 Electric parts or components and diagnostic systems applied in brake control systems and light alarm systems of trucks, buses, trailers and semi-trailers.</p>

and overvoltage protector devices; communication equipment, particularly electric jacks, plugs, blocks, terminal strips, connector panels, connectors for couplings and cords, signal repeaters, signal conditioners, communication distribution frames, couplers for fiber optics, fiber optical wavelength-division multiplexers/demultiplexers, connection modules, interface modules, test modules, disconnection modules, connection and commutation chassis, switching (patching); devices for switching and monitoring electrical power supplies; control modules for connection and switching, data line emulators and monitors, transmission test kits, test cards for network switches (PBX), controllers for switching and controllers for networks, switching cards, switching cables, digital signal cross-circuit modules, transmission circuit boards, signaling sub-boards, transmission setting plates and connection designation bands; test equipment for private lines for carrying out tests on communication systems comprising test modules, service modules, signal test modules, cable reels, electrical panels and cable cages, particularly with the option of oscillation; amplification, attenuation, and comprising kits, terminals, repeating reels, terminal signal converters, signal relays, cords with plugs, monitor loudspeakers, control devices for transmission buffers, automatic level control devices, bridge transformers, pulse generators, external impellers, loop returns and control devices for test baseplates, sold as a modular unit; electrical apparatus used as components of a private line test system for carrying out tests on communication systems, particularly test modules, service modules, signal test modules, cable reels, electrical panels and cable cages, particularly with the option of oscillation, amplification, attenuation and comprising kits; terminals, repeating reels, terminal signal converters, signal relays, cords with plugs, loudspeakers, control devices for transmission buffers, automatic level control devices, bridge transformers, external impellers, loop returns and control devices for test baseplates; electrical apparatus used as components of a private line test system for

<p>carrying out tests on return loops, for controlling and testing two-wire communication lines, comprising an emitter and a receiver, sold as a unit; electrical apparatus used as components of a private line test system for carrying out tests on emitters and receivers, used in return loop test systems, for controlling and testing two-wire communication lines; electrical apparatus used as components of a private line test system for carrying out tests on fuse panels; electrical apparatus used as components of a private line test system for carrying out tests on terminals used in systems for condition monitoring, for controlling and supplying diagnostics for telemetry and information in a remote communication network system, particularly principal display terminals; electrical apparatus used as components of a private line test system for carrying out tests on systems for condition monitoring for controlling circuits and supplying diagnostics for telemetry and information in a remote communication network system, principal display terminals sold as a unit; electrical apparatus used as components of a private line test system for carrying out tests on audio distribution amplifiers; electrical apparatus used as components of a private line test system for carrying out tests on loudspeaker monitors; electrical apparatus used as components of a private line test system for carrying out tests on series loop access systems, for providing access to series loop circuits comprising access panels to series loops and control panels relating thereto, sold as a unit; switching panels (patching); components of apparatus for communication and communication devices, particularly terminal blocks, conference bridges, jack panels, jacks, transfer switches, coupling leads, plugs, reels for telephones, repeating reels, connector cables, solid state telegraphic relays; battery chargers, particularly battery chargers for aircraft and battery chargers for industrial and leisure vehicles; ammeters for direct current, transformers; mechatronic systems, namely synergistic and systematic combinations of mechanics, electronics and computing in real-time, relays, automobile telecommunication devices, computing and</p>	
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<p>industrial relays; Electronic and electrical apparatus, namely electronic control apparatus, electric regulating apparatus, electronic telecommunications apparatus, electronic surveillance apparatus, electronic locking apparatus, electrical access control apparatus, electric access security apparatus, electronic target location apparatus, electric power distribution apparatus, electronic process control apparatus, apparatus for controlling electricity, electronic tracking apparatus, electronic and electrical apparatus, namely electronic monitoring and checking apparatus and electrical monitoring and checking apparatus used in relation with aerospace industry and defence (except armaments), with computing, electronic, electrical tools, multi-switches, fixed stations, network interface cards, cards for computers, systems for the distribution of electrical power including rail transportation systems, network wiring for buildings; electric and electrical components for automobiles, transportation namely with all kinds of water, air and land vehicles particularly aircraft, cars, trucks, boats, motor cycles, bicycles, telecommunications networks, industrial engines, lighting, machine tools and production monitoring equipment, Electric and electrical components for heating, ventilation and air-conditioning, components for security systems, instrumentation and electric and electrical components for medical equipment as well as in relation with devices for assisting mobility and medical diagnostic devices and railway devices; terminals; splices, support sockets for chips; linear, digital, analogical, electronic, electrical circuits; bridge circuits; integrated circuits; electrical adapters, hybrid adapters; sensors, magnetic sensors, radar sensors, inductive sensors; gas sensors; wireless components and subsystems; antennas; aerial systems; audio- and video-receivers; GPS receivers; circuit boards; electrical distribution boxes; multi-circuit electrical bands; touch screens; tactile computers, interactive screens; monitors for computers; computer monitor bezels, computer network nodes, switches and routers; apparatus for computer networking; apparatus for linking</p>	
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computers in networks, apparatus for protecting computers against electrical power supply problems; items intended for single use in computer wiring ducts, items intended for single use in supporting computer cables, emergency controls for computers; broadband data interconnection computer installations; electronic components for computers; fiber optic computer installations for use with computers; components of connections (plug-in) for computer modems; electrical processing equipment, namely connectors between wires and boards, boards and boards, cables and boards and cables and cables; inductors, high current indicators, cable wind indicators, chokes, high current indicators, drum core indicators, shielded cable reel inductors, non-shielded reel inductors, electric inductors; LAN protocol magnetic elements; magnetic modules; resistors; resistances, electric; commutators; switches, electric; chip cards; fiber optic products; electro-optical products; circuit board assemblies for multiple connectors; circuit board assembly interconnections for multiple connectors; attenuators; multiplexers; amplifiers; data communication systems; heat-shrink sheathes; filters, electrical line filters; signal filters, duplexers; capacitors; transformers; couplers; batteries; battery terminals; microwave products, circuit mixers, frequency modulators; converters; heat sinks; heat sinks intended for electronic apparatus; measuring devices; controllers; radio frequency identification tags for radio frequency identification (RFID), protective devices against short circuits; fuses; radar systems; components of radio frequencies (RF); cabinets for loudspeakers, switchboxes (electricity), distribution boxes (electricity), cabinets intended for computers; thermoretractable sheaths and their enclosures; electrical and electronic components for identification and labelling; electronic and electrical panels; fiber optic panels; radios; accessories for radios; converters, electric; keyboards; screens; touchscreen systems, namely touchscreens, touchscreen monitors, computer keyboards, touchscreen computers, electronic components for touchscreen technology, particularly micro

<p>controllers and electronic accessories, particularly magnetic tapes or credit card readers, small display devices for frontal display, for use with touchscreens and touchscreen computers; electrical sleeves, electrical connectors, electrical spacers, voltage surge protectors, electrical equipment for applying voltage and grounding; link boxes; electrical control cabinets; vibration indicators; electrical fuses, light-emitting diodes [LED]; telecommunication equipment, particularly terminal blocks for cables for moving and insulating; electrical protection devices (except for insulators) and against voltage surge for electrical and electronic telecommunications systems and data telecommunication systems; connectors, namely voltage surge protectors, fuses, diodes for fuses, thermo-protective switches and varistors; cable systems for telecommunication; dividers; optical dividers; multi-user wall housings; residential wall and floor cabinets for cabled or optical links; computer equipment such as gateways, switches, bridges, routers, concentrators, repeaters and network adapters, equipment and components for use in transmission or data, text, video, audio and voice transfer by broadband, radio broadcasting, cable broadcasting, coaxial cable, copper wires, fiber optics, radio, telephone, twisted pairs, wire, wireless and other telecommunication technology; computer software for use in the use and management of telecommunications systems, in equipment and in communications on such systems; electrical metal connectors and connectors, accessories for wiring for electrical distribution networks, electrical terminals and junctions, electrical locking devices; lighting controllers; systems for cables for vehicles, wiring harnesses for vehicles; controls for LEDs; systems for electrical cable harnesses and connectors; accessories for the distribution of electricity conduits; devices for managing cables, electrical lines; acoustic products, namely surface waves, sonic and ultrasonic waves traveling on the surface of a screen, systems for recognizing audio impulses, audio microphones; interfaces such as parts of the abovementioned goods; acoustic pick-ups,</p>	
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particularly audio microphones, micro controllers for tactile recognition of acoustic waves, software for tactile recognition of acoustic waves Ultrasonic, ultraviolet (UV), infrared and radiological apparatus and instruments for laboratory use; apparatus for laboratory use; laboratory apparatus for scientific research; scientific apparatus for laboratory purposes and laboratory use; accessories, parts and components for the afore-mentioned goods all included in this class; electronic components for machines, tools, automobile parts; electrical header connectors; defibrillator cable, electrodes.	
	CI 12 Vehicles; apparatus for locomotion by land, air or water.
	CI 35 Advertising; business management; business administration; office functions; wholesale and retail services for spare parts for automobile vehicles.

#### Class 9

46. The goods '*Electric parts or components and diagnostic systems applied in brake control systems and light alarm systems of trucks, buses, trailers and semi-trailers*' of the contested sign concern specific technical parts, components or systems designated for certain types of vehicles. These specific goods are either identical or highly similar to the goods '*systems for the distribution of electrical power including rail transportation systems*' and '*electric and electrical components for automobiles, transportation namely with all kinds of water, air and land vehicles particularly aircraft, cars, trucks, boats, motor cycles, bicycles*' mentioned in class 9 of the trademark invoked, because these goods also concern electric parts or systems that are designated for means of transportation. Furthermore, these goods can share the same distribution channels, target the same relevant public and can be produced by the same manufacturers.

#### Class 12

47. The goods '*automobile parts*' in class 9 of the trademark invoked and the goods '*Vehicles*' as mentioned in the contested sign are mutually indispensable to each other. After all, these goods can only function if they are together. For this reason, these goods are complementary. Furthermore, they target the same public and are often offered in the same outlets.

48. The Office finds that there also exists complementarity between the goods '*apparatus for locomotion by land, air or water*' of the contested sign and the opponent's goods '*electric and electrical components for automobiles, transportation namely with all kinds of water, air and land vehicles particularly aircraft, cars, trucks, boats, motor cycles, bicycles*'. The goods of the opponent are designated to be part of the means of transportation mentioned in class 12 of the contested sign and are therefore also mutually indispensable to each other. Furthermore, these goods share the same distribution channels, target the same relevant public which may think that responsibility for the production of those goods or provision of

those services lies with the same undertaking. For this reason, the Office concludes that the goods are similar.

#### *Class 35*

49. In general, products and services are of a different nature, due to the fungible nature of the former and the non-fungible nature of the latter. Furthermore, they do not have the same use. However, products and services can be complementary: after all, some services cannot be rendered without using some products.<sup>13</sup>

50. In this case the goods '*automobile parts*', mentioned in class 9 of the trademark invoked, are the subject matter of the services '*wholesale and retail services for spare parts for automobile vehicles*' covered by the defendant. Clearly, in the present case, the relationship between these services and the goods covered by the trademark invoked is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. The objective of retail trade is the sale of goods to consumers (or in the case of wholesale trade, to retailers) and that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.<sup>14</sup>

51. The goods covered by the trademark invoked are identical to those to which the abovementioned services relate. Those goods and services are therefore so closely linked that the public may think that the same undertaking is offering such goods using its own trademark. The relationship between these services and these goods is therefore complementary. For that reason, the Office considers that those services are similar to a certain degree to the goods of the trademark invoked.

52. The other services mentioned in class 35, namely '*Advertising; business management; business administration; office functions*' are not similar to any of the goods of the trademark invoked. Although these services *could* be used in order to market the goods of the opponent, there is no complementarity between those services and the opponent's goods in the sense that these goods are indispensable for the provision of the services of the contested sign and that the public might believe that they would originate from the same undertakings.

53. For the sake of completeness, the Office concludes that these services are neither similar to any of the goods covered by class 9 of the second and third trademark invoked.

#### *Conclusion*

54. The goods and services of the defendant are partly identical or (highly) similar, partly similar to a certain degree and partly not similar to the goods of the opponent.

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<sup>13</sup> General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

<sup>14</sup> General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 54 (O STORE).



**Global assessment**

55. 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 the 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.<sup>15</sup> In the present case, the goods and services found to be identical or similar to varying degrees are directed at the public at large and at professionals with specific professional knowledge or expertise. The degree of attention may vary from average to high, depending on the specialised nature of the goods and services, the frequency of purchase and their price.

56. The higher the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.<sup>16</sup> In this case, the trademark invoked has a normal distinctiveness, as it is not descriptive for the goods concerned.

57. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and, in particular, between the similarity of the conflicting signs and the 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.<sup>17</sup>

58. In this case the signs are visually similar and aurally highly similar. The Offices also emphasize that this similarity concerns the dominant part in both signs, namely the element 'TE'. The relevant goods and services are partly identical or highly similar, partly (to a certain extent) similar and partly dissimilar. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that, notwithstanding the elevated level of attention, there is a likelihood of confusion in the sense that the public may believe that the identical and (to a certain extent) similar goods designated by the trademark relied on and the goods and services to which the contested sign relates originate from the same undertaking or, as the case may be, from undertakings which are economically linked.

**B. Conclusion**

59. Based on the foregoing, the Office concludes that there is a likelihood of confusion for the goods and services that are found to be identical or similar.

60. Because of the fact that the services of the contested trademark, which were not found to be similar to the first trademark invoked, are also not similar to the goods of the other two trademarks invoked, there is no need to assess the similarity of the other trademarks.

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<sup>15</sup> CJEU 22 Juni 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

<sup>16</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

<sup>17</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there. (Equivalenza)

**IV. CONSEQUENCE**

61. The opposition with number 2016976 is partly justified.

62. The International application with number 1581874 will not be registered for the following goods and services:

- class 9 (*all goods*);
- class 12 (*all goods*);
- class 35 Wholesale and retail services for spare parts for automobile vehicles.

63. The International application with number 1581874 will be registered for the following services that are not similar:

- class 35 Advertising; business management; business administration; office functions.

64. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.28(3) IR, as the opposition is partly justified.

The Hague, 27 September 2022



Eline Schiebroek  
(*rapporteur*)

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Willy Neys

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