



Benelux Office for  
**Intellectual  
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2017013**  
**of 15 January 2024**

**Opponent:** **Arla Foods Deutschland GmbH**  
Wahlerstrasse 2  
40472 Düsseldorf  
Germany

**Representative:** **NLO Shieldmark B.V.**  
Anna van Buerenplein 21  
2595 DA Den Haag  
Netherlands

**Invoked trademark 1: International trademark registration 610679**



**Invoked trademark 2: EU trademark registration 000038646**



*against*

**Defendant:** **Molkerei Alois Müller GmbH & Co. KG**  
Zollerstr. 7  
86850 Aretsried  
Germany

**Representative:** **GEVERS**  
Holidaystraat 5  
1831 Diegem  
Belgium

**Contested mark: Benelux trademark application 1436521**



## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 22 February 2021 the defendant filed a Benelux trademark application for goods in classes 29, 30 and 32 for the following trademark (shape mark with word elements):



The application was processed under number 1436521 and was published on 29 March 2021.

2. On 28 May 2021 the opponent filed an opposition against the registration of the application. The opposition is based on:

- International trademark registration 610679, designating the Benelux, registered on 9 November 1993 for goods in class 29, of the combined word/figurative mark:



- EU trademark registration 000038646, filed on 1 April 1996 and registered on 23 July 1998 for goods in classes 29, 30 and 32, of the combined word/figurative mark:



3. The opposition is directed against all goods covered by the contested application and is based on all goods covered by the trademarks invoked.

4. The language of the proceedings is English.

### B. Proceedings

5. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") to the parties on 9 June 2021. Subsequently, the proceedings were

suspended multiple times at the request of the parties. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was submitted by the opponent. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 25 January 2023.

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

6. The opponent filed an opposition at the Office under article 2.14 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 the identity or similarity of the goods or services concerned.

### **A. Opponent's arguments**

7. The opponent states that the earlier marks consist of the word element "MUH" and since these trademarks have been successfully registered in the Benelux and the EU, BOIP and EUIPO have made it clear that these words can be considered normally distinctive for the goods in question.

8. According to the opponent, in both the earlier marks and the contested sign the word element "MUH" or "MÜH" clearly stands out, the other word elements in the contested sign being hardly legible, descriptive, and therefore subsidiary. When pronouncing the marks, the other elements would logically be left out, resulting in a comparison between the distinctive elements "MUH" and "MÜH", which are (nearly) identical. The signs are, according to the opponent, phonetically highly similar.

9. Visually, the signs are also highly similar, since the earlier trademark is included in its entirety in the contested sign, the similarities between the dominant identical elements are obvious and the relevant public will not clearly recollect all the details of the signs, but rather their more distinctive and dominant components.

10. The opponent points out that MUH is a fanciful abbreviation of MILCH-UNION HOCHEIFEL, without any meaning for the relevant public and the contested trademark MÜH (yum so good) is a fanciful trademark as well. So conceptually, a comparison is not possible.

11. According to the opponent, the goods in class 29 of both earlier marks and the contested sign are (a variety of) milk and milk products, so there cannot be any debate on the fact that these are identical. The goods in class 32, waters and all kinds of non-alcoholic beverages, are identical as well. In class 30, the goods "*rice pudding; mousses; mousses au chocolat; semolina pudding; pudding; jelly [confectionery]; frozen yoghurt (ices); Pastries, cakes, tarts and biscuits (cookies); Confectionery*" of the contested sign are (highly) similar to "*edible ices*" of the (second) invoked trademark, and the remaining goods are, according to the opponent, identical.

12. In the present case, both parties target a wide range of individuals and professionals, and the level of attention of the relevant public is average.

13. The opponent concludes that there is a likelihood of confusion on the part of the relevant public. Especially since the earlier trademark is adopted as a whole into the contested sign, the relevant public may well think that the contested sign is a variation to the earlier trademarks. He requests the Office to uphold the opposition and order the applicant to bear the costs.

14. Upon request of the defendant, the opponent submitted proof of use of the invoked trademarks.

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

### *Response to proof of use*

15. The defendant disputes that the documents submitted by the opponent are sufficient to prove genuine use of the trademarks invoked. He points out that most of the documents date from after the relevant period or are undated. Further, he points out that none of the documents show any use of the second trademark invoked, since the elements "MILCH-UNION" and "Hocheifel" do not occur under "MUH", and the omission of these elements constitutes an alteration of the distinctive character of the sign as registered.

16. As to the use of the first trademark invoked, the defendant finds that the only documents that may somehow relate to potential use in the Benelux during the relevant period are not sufficient to prove that the trademark had been put to genuine use. In this respect, he points out that some of the documents merely mention that milk products were delivered, but it is not proven that those milk products actually bear the mark. Besides, the objectiveness and reliability of the documents are questionable, since they seem to be internal documents which are not corroborated by other valid pieces of evidence. Further, the defendant states that the documents relate to a short period of 6 months and fall short in terms of duration, commercial volume and frequency of use, since they only show that the products were sold/ delivered to only one shop in the whole territory of the Benelux and the sales volumes were very low (or even purely symbolic) for common daily products.

17. The defendant concludes that the opponent failed to prove use of its prior marks, and the present opposition must therefore be rejected.

### *Response to opponent's arguments*

18. The defendant gives a detailed description of the signs in question. In his view, the element



consists of a cow device that may represent the letter M and the stylized letters "UH" or "UM", as the last letter could be seen either as "H" or "M". The opposed sign is a shape mark consisting of an original bottle shape, drawings of several distinctive features (background consisting of black bricks, an elegant white ribbon embracing a shape of chocolate cookie) and some verbal elements in stylized letters: "MÜH" and "YUM SO GOOD".

19. According to the defendant, the marks are visually completely different. The description "MÜH" contained in the opposed mark is merely an interjection to express a feeling of surprise (like "Oh", "Wow", etc.) and must be read together with "YUM SO GOOD". In addition, the defendant states that both "MÜH" and "YUM SO GOOD" which are written in small size, are almost negligible and there is no way in which the term "MÜH" itself could draw the attention of the consumers.

20. As the opposed mark is a shape mark, aural comparison is generally not possible according to the defendant. And even if the verbal elements "MÜH YUM SO GOOD" in the opposed mark could be pronounced, the defendant finds the pronunciation is very different from "MUH" or "MUM" or "MUH/MUM MILCH-UNION Hocheifel".

21. The defendant agrees with the opponent that a conceptual comparison is not possible. He concludes that, in view of the visual, aural and conceptual comparison, the marks are dissimilar.

22. Regarding the similarity of the goods, the defendant first recalls that since there is no document showing that the second invoked trademark has ever been used by the opponent, the comparison of the goods should be limited to the goods covered by the first invoked trademark. The goods in classes 30 and 32 of the opposed mark are, according to the defendant, dissimilar to the goods (in class 29) for which the first invoked trademark is registered.

23. The defendant concludes that the opposition must be rejected, since the opponent failed to prove genuine use of the prior marks and, even if certain goods are identical or similar, there is no likelihood of confusion since the marks are different.

### **III. DECISION**

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

24. In accordance with article 2.16bis BCIP the opponent, at the request of the defendant, shall furnish proof that the trademarks invoked have been put to genuine use as provided for in article 2.23bis BCIP, or that proper reasons for non-use existed. The evidence must show genuine use in a period of five years prior to the filing date of the trademark against which the opposition is lodged.

25. The filing date of the contested sign is 22 February 2021. Therefore, the opponent was required to show use of the invoked trademark during the period from 22 February 2016 to 22 February 2021 ('the relevant period'). Given the fact that the invoked trademarks are registered more than five years prior to the filing date of the contested sign, the defendant's request for proof of use is legitimate.

#### *In general*

26. In accordance with the case-law of the European Court of Justice (hereinafter: "CJEU") there is genuine use of a trademark if the mark, in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, is used in order to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.<sup>1</sup> When assessing whether use of the trade mark is genuine, regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.<sup>2</sup> In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly.<sup>3</sup>

27. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.<sup>4</sup> In interpreting the concept of genuine use, account should be taken of the

<sup>1</sup> CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis) and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

<sup>2</sup> CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:-80, point 83 (Pandalis) and CJEU 11 March 2003, C40/01, ECLI:EU:C:2003: 145, point 43 (Ansul).

<sup>3</sup> General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

<sup>4</sup> General Court (EU) 8 July 2004, T-334/01, ECLI:EU:T:2004:223, point 36 (Hipoviton) and General Court (EU) 30 April 2008, T-131/06, ECLI:EU:T:2008:135, point 41 (Sonia Sonia Rykiel).

fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trademark protection to the case where large-scale commercial use has been made of the marks.<sup>5</sup>

28. The first invoked trademark is an international registration designating the Benelux and the second invoked trademark is an EU trademark. The territorial scope of use is not a separate requirement of genuine use, but one of the elements of genuine use that must be included in the overall analysis and examined together with its other elements. An EU-trademark enjoys territorially broader protection than a national (or Benelux) trademark, which also affects the territorial scope of the use obligation. As a result, an EU trademark can reasonably be expected to be used in a wider territory than the territory of a single Member State, barring the (exceptional) case where the market for the goods or services in question is in practice territorially limited. This must be abstracted from the borders of the territories of the Member States. It is not possible to determine a priori and in the abstract what quantitative threshold should be chosen in order to determine whether use is genuine or not.<sup>6</sup> It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU, taking into account all relevant facts and circumstances such as characteristics of the market concerned, the nature of the goods or services protected by the trademark and the territorial extent and the scale of the use as well as its frequency and regularity.<sup>7</sup>

29. Genuine use of a trademark cannot be proven by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.<sup>8</sup>

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

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

31. The opponent submitted the following proof of use:

- Annex 1: Invoices for Luxembourg, Hungary, and Greece.
- Annex 2: Detailed pictures of packaging.
- Annex 3: Pictures of packaging to show a connection with the invoices.
- Annex 4: Overviews of sales.
- Annex 5: Screenshots of (German) websites where products are offered.
- Annex 6: Photo's from Supermarché Massen S.A. in Luxembourg.

32. The only documents that could demonstrate actual sales are the invoices (annex 1) and the sales overviews (annex 4).

33. Annex 1 comprises 16 invoices, 12 of which date from after the relevant period and 4 of which date from within the relevant period. 2 of these 4 invoices are from "Dachser SE" addressed to the opponent, and do not mention the mark MUH. Thus remain 2 invoices which appear to relate to sales of products bearing the trademark within the relevant period. One of these invoices addressed to Supermarché Massen

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<sup>5</sup> General Court (EU) 4 April 2019, T-910/16 and T911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

<sup>6</sup> CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, points 36, 44, 50 and 55 (ONEL); Benelux Court of Justice (second chamber) 28 June 2023, C-2022/6, point 20 (Gillette/Fontaine).

<sup>7</sup> CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 58 (ONEL).

<sup>8</sup> General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

S.A. in Luxembourg, states as delivery date 18.06.2020 and concerns 720 packs (60 boxes of 12 pieces) of milk 3.5% and 720 packs (60 boxes of 12 pieces) of milk 1.5%. The EAN codes on this invoice correspond to the EAN codes on the packaging (annex 3). The other invoice addressed to D.S.Gattegno & Son S.A. in Greece, states as delivery date 21.09.2020 and appears to concern 5,184 packs (432 boxes of 12 pieces) of whipped cream.

34. Annex 4 includes 4 overviews, apparently print screens from an (internal) computer system. On 2 of these overviews, a document dated within the relevant period is shown, with the destination being Supermarché Massen S.A. in Luxembourg. The first overview dates from 26.10.2020 and mentions descriptions that seem to indicate that the items in question are iced coffee and chocolate milk, both 84 items (boxes?) with a total weight of (almost) 703 kg. The second overview is dated 14.12.2020 and refers to milk, 75 pieces (boxes?) with a total weight of (almost) 775 kg.

35. Although the purpose of the genuine use requirement is not to assess commercial success or to review the economic strategy of an undertaking (*supra*, point 27), it must be recalled that regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*supra*, point 26).

36. The products in question are consumer goods, consumed on a daily basis by a large part of the population throughout the Benelux and throughout the European Union. The economic sector concerned is consequently very large. The Office notes that the relevant invoices and overviews (*supra*, points 33 and 34) only cover a six-month period (from June to December 2020), with (at most) several thousands of litres of products<sup>9</sup> sold to two customers, one in Luxembourg and one in Greece. The use demonstrated by the opponent is so limited, both in time as in quantity, that it cannot be considered to be warranted as a means of maintaining or creating market shares in the economic sector concerned, the dairy sector, at both Benelux and EU level.

37. As the opponent rightly points out, the mere fact that some of the documents are undated or date from after the relevant period does not necessarily mean that these cannot be taken into account. Even when a document post-dates the relevant period, it may enable the drawing of conclusions on the situation as it was within that period and such documents may confirm or contribute to a better assessment of the extent of use of the trademark in question during the relevant period.<sup>10</sup> It is, however, impossible to see, and the opponent does not raise any arguments to that point, how conclusions can be drawn from the remaining documents (at least without probabilities or suppositions) about use made within the relevant period.

## **B. Conclusion**

38. Based on the foregoing the Office concludes that the opponent did not provide proof of genuine use of the trademarks invoked within the relevant period, nor that there are proper reasons for non-use. For this reason, the opposition will be rejected.

## **IV. CONSEQUENCE**

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<sup>9</sup> i.e. less than the production of a single dairy cow, which on average produces nearly 8,900 litres (9,200 kilograms) of milk a year (<https://longreads.cbs.nl>).

<sup>10</sup> CJEU 17 July 2008, C-488/06, ECLI:EU:C:2008:420, point 71 (Aire Limpio); CJEU 27 January 2004, C-259/02, ECLI:EU:C:2004:50, point 31 (La Mer).



39. The opposition with number 2017013 is rejected.
40. The Benelux application with number 1436521 will be registered.
41. The opponent shall pay the defendant 1,045 euros in accordance with Article 2.16, 5 BCIP in conjunction with Rule 1.28, 3 IR, as the opposition is rejected. This decision constitutes an enforceable order pursuant to Article 2.16, 5 BCIP.

The Hague, 15 January 2024



Pieter Veeze  
(*rapporteur*)

Marjolein Bronneman

Camille Janssen

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