



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2017783
of 29 December 2022

Opponent: **Merck KGaA**
Frankfurter Str. 250
64293 Darmstadt
Germany

Representative: **V.O.**
Carnegieplein 5
2517 KJ Den Haag
Netherlands

Invoked trademark: **European Union trademark registration 16159048**

MERCK

against

Defendant: **Christophe Esquenet**
Beerlegemsebaan 90
9630 Zwalm
Belgium


Representative: -

Contested sign: **Benelux trademark application 1454766**



FACTS AND PROCEEDINGS

A. Facts

1. On 27 November 2021, the defendant filed a Benelux trademark application for the combined word/figurative trademark  , for goods in class 5. This application was processed under number 1454766 and was published on 2 December 2021.

2. On 28 January 2022, the opponent filed an opposition against the registration of the application. The opposition is based on the earlier European Union trademark registration 16159048 of the verbal trademark MERCK, filed on 9 December 2016 and registered on 6 September 2017 for goods and services in classes 1, 2, 3, 5, 7, 9, 10, 11, 16, 17, 29, 30, 32, 35, 38, 40, 41, 42 and 44.

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

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

5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 31 January 2022. During the administrative phase of the proceedings both parties filed arguments. 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 8 August 2022.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. 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

8. The opponent argues that the trademark MERCK is a short and distinctive sign, which will be remembered by the public. With regard to the contested sign, the opponent states that the word elements MERCOC MEDICS have a more prominent position compared to the figurative elements. Moreover, the public will give more attention to the first word MERCOC, also because the word MEDICS is descriptive in the light of the relevant goods in class 5. The words MERCK and MERCOC show significant visual similarities, with 4 out of 5 letters being identical. The figurative element, due to its position and size does not influence this visual similarity. Therefore, trademark and sign are visually similar to a high degree.

9. Phonetically, the words MERCK and MERCOC are also highly similar. They only differ in the last letter, but this difference will hardly be noticed when the marks are pronounced in its totality. Therefore, the signs are phonetically highly similar or almost identical.

10. The opponent states that the word MERCK has no meaning. For this reason, a conceptual comparison does not play a role in the comparison of the trademarks. The opponent argues that the above-mentioned visual and phonetical similarities are sufficient to conclude that there is a likelihood of confusion.

11. With regard to the comparison of the goods and services, the opponent only compares the goods in class 5 of the trademark invoked with the goods of the contested sign. The opponent states that the goods are identical. Furthermore, the opponent also argues that the relevant public has a normal level of attention.

12. The opponent also states that the distinctive character of MERCK is enhanced because of the fact that it concerns a well-known company and the trademark has been used extensively worldwide and for many years. In order to substantiate this argument, the opponent refers to information on his website and Wikipedia.

13. 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

14. The defendant argues that although part of the goods in class 5 are the same, there is no risk of confusion, because the signs are visually and phonetically different.

15. The defendant also refers to the figurative element in the contested sign, which is not present in the trademark invoked.

16. Defendant requests that the Office therefore rejects the opposition.

III. DECISION

A. Likelihood of confusion

17. 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.

18. 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.*"¹

¹ 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.

19. 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

20. According to settled case-law of the Court of Justice of the European Union (hereinafter: "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.³


Comparison of the signs

21. 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.⁴

22. 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.⁵ 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.⁶

23. 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.

24. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
MERCK	

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 and the case-law mentioned there (Equivalenza).

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

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

Visual comparison

25. The trademark invoked is a purely verbal sign, that consists of one word of five letters: 'MERCK'. The contested sign is a combined word/figurative sign, containing the word elements 'MERCO MEDICS' placed below each other. To the right of the word elements there is a stylized image of part of a jumping horse with a yellow circle in the background.

26. 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.⁷ In this case, the image of the horse will not go unnoticed to the average customer. However due to the position and size, the attention of the public will be particularly focused on the word elements MERCO MEDICS.

27. Both signs begin with a word consisting of five letters of which the first four letters are the same, namely MERCK and MERCO. The difference of the fifth letter is insufficient to take away the overall visual similarity. Four of the five letters of the contested sign are identical to the trademark invoked, and this similarity is at the beginning. According to established caselaw, the consumer normally attaches more importance to the first part of a sign.⁸

28. The signs also differ because of the presence of the word 'MEDICS' in the contested sign. However, the Office finds that this word could refer to the products in class 5 of the contested sign and is therefore descriptive. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark.⁹

29. In the light of the above, the Office finds that the signs are visually similar.

Phonetic comparison

30. 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.¹⁰

31. The trademark invoked concerns one word of one syllable: "MERCK". The contested sign consists of two words and four syllables: "MER-CO-ME-DICS". The pronunciation of the first and second syllable of the contested sign is almost identical to the trademark invoked, except for the letter "O" at the end. Trademark and sign are also different in length, because of the presence of the word "MEDICS" in the contested sign. However, due to the descriptive character of this word, this difference is of less importance. The differences do not detract from the overall aural similarity, due to the high similarity in the beginning.

32. In the light of the above, the Office finds that the signs are aurally similar.

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

⁸ General Court EU 17 March 2004, T-183/02 en T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

⁹ General Court (EU) 3 July 2003, T-129/01, ECLI:EU:T:2003:184, point 53 (Budmen).

¹⁰ General Court (EU) 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

Conceptual comparison

33. Both signs, considered as a whole, have no clear and obvious meaning. Therefore, a conceptual comparison is not possible.

Conclusion

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

Comparison of the goods and services

35. 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.¹¹

36. 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.¹²

37. In his arguments, the opponent explicitly only compares the goods in class 5 of the trademark invoked with the goods of the contested sign (see paragraph 11). Having regard to the principle of hearing both sides of the argument, the opposition proceedings are limited to the arguments, facts and evidence put forward by the parties.¹³ For this reason, the Office will only assess the similarity between these goods.

38. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Cl 5 Pharmaceutical, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; dietary supplements and dietetic preparations, including dietary supplements for animals; dental preparations and articles; hygienic preparations and articles, including disinfectants and antiseptics, deodorizers and air purifiers, absorbent articles for personal hygiene; pest control preparations and articles; medical and veterinary preparations and articles, including live organs and tissues for surgical purpose, diagnostic preparations,	Cl 5 Complementary feed; Vitamins for animals; Supplementary fodder mixes; Dietary supplements for pets; Vitamin supplements for animals; Mineral dietary supplements for animals; Nutraceutical preparations for animals.

¹¹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹² General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

¹³ Art. 2.16, paragraph 1 BCIP and Rule 1.21 IR.

pharmaceuticals and natural remedies, medical dressings, coverings and applicators.	
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39. All of the contested goods fall under the category "*Veterinary preparations; dietetic food and substances adapted for medical or veterinary use, dietary supplements and animals; dietary supplements for animals*" as mentioned in class 5 of the trademark invoked and are therefore identical.¹⁴

Conclusion

40. The goods are identical.

Global assessment

41. 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.¹⁵ In the present case, the Office finds that the level of attention for the goods concerned will be enhanced since it concerns specific dietary products meant for enriching and/or improving the health and/or wellbeing of animals.

42. 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.¹⁶ In this case, the trademark invoked has a normal distinctiveness, as it is not descriptive for the goods and services concerned.

43. The opponent claims that the trademark invoked is famous, however this argument is not substantiated (see paragraph 12). A mere reference to the opponent's own website and a Wikipedia website is not enough in this context.

44. 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.¹⁷

45. In this case, the relevant goods are identical. Furthermore, the signs are visually and aurally similar. 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 of the public, there is a likelihood of

¹⁴ General Court (EU) 23 October 2002, T-104/01, ECLI:EU:T:2008:399, point 33 (Fifties) and General Court (EU) 24 November 2005, T-346/04, ECU:EU:T:2005:420, points 36-39 (Arthur et Félicie).

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

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

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

confusion in the sense that the public may believe that the goods and services 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

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

IV. CONSEQUENCE

47. The opposition with number 2017783 is justified.

48. The Benelux application with number 1454766 will not be registered.

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, 29 December 2022



Eline Schiebroek
(*rapporteur*)

Camille Janssen

Tineke Van Hoey

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