

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2017810
of 22 December 2022

Opponent: **Aqua-Concept Ges. für Wasserbehandlung mbH**
Am Kirchenhözl 13
82166 Gräfelfing
Germany

Representative: **Lecomte & Partners Sarl**
Rue de Merl 76
2146 Luxembourg
Luxembourg

Invoked right: **European Union trademark registration 018105098**

CAREBLUE

against

Defendant: **Spruyt hillen bv**
Tinbergenlaan 1
3401 MT IJsselstein
Nederland

Contested sign: **Benelux trademark application 1455756**

CareBlue

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

1. On 13 December 2021 the defendant filed a Benelux trademark application for the wordmark CareBlue for services in class 35. This application was processed under the number 1455756 and was published on 15 December 2021.

2. On 7 February 2022 the opponent filed an opposition against the registration of the application. The opposition is based on the European Union trademark 018105098 of the wordmark CAREBLUE, filed on 8 August 2019 and registered on 9 January 2020 for goods in class 9 and services in classes 35 and 42.

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

4. The opposition is directed against all services covered by the contested application and is based on all the goods and services covered by the trademarks invoked. In its arguments opponent only relies on services in class 35 for which the earlier trademark is registered.

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 8 February 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 11 August 2022.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. The opponent filed an opposition at the Office under article 2.14, (2)(a) BCIP, in accordance with the provisions of article 2.2ter, (1)(b) BCIP: the likelihood of confusion based on the identity or similarity of trademark and sign and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

8. Opponent argues that the services in class 35 of the contested sign are similar to the services covered in class 35 of the trademark invoked. The wholesale and retail services as mentioned in class 35 of the contested sign imply a management of goods and stocks, as mentioned in class 35 of the trademark invoked. Stock management and sales are interconnected and sales cannot be concluded on a long-term basis and in a sustainable manner if there is no stock management in a company. The contested services could only be done if the services of the earlier mark are achieved. According to opponent, the services are thus complementary. Also, the end goal of the services is the same.

9. Opponent states that the signs are identical or at least highly similar. Both signs consist of one word with 8 identical letters in the same order. The signs only differ with the writing of the letters in capitals and lower-case letters. According to case law these differences will be perceived as differences so insignificant that they may go unnoticed by an average consumer. The signs are also phonetically identical. Regarding the conceptual comparison, opponent argues that the signs are composed of the same two terms.

Firstly, the English term CARE means to protect someone and provide what the person or thing needs. Secondly, BLUE refers to the colour. The signs, taken as whole, do not have a special meaning. Since no further elements or references may be recognized in the signs at stake which could differentiate the signs from a conceptual point of view, the signs are conceptually identical.

10. The trademark invoked is neither descriptive nor allusive. There is no link with the goods and services. Therefore, it is deemed to possess a normal degree of inherent distinctiveness and its capacity to identify the goods and services for which it has been registered as coming from a particular undertaking is not in any way diminished or impaired.

11. Opponent concludes that since the services concerned are similar and the signs at stake are identical or obviously highly similar, there exists a likelihood of confusion. Opponent requests the refusal of the contested sign and that the defendant bears the costs incurred by the opposition proceedings.

B. Defendant's arguments

12. Defendant argues that he intends to distribute under the name CareBlue the following products: Urine containers, Diabetes cases with cooling element, lip balms, Vitamin B12 capsules, Eyedrop assistance, Cranberry capsules, Tick tweezers, Capsule splitters and Medicine dosing containers. These products do not in any way resemble the products or services delivered under the trademark invoked. The mere fact that to sell products a sort of inventory control is necessary, does not constitute a resemblance between the products listed above and a stock management. It is a completely different product or service. It is impossible to confuse the two categories. Consequently, none of the services covered by the contested sign are similar to the services covered by the trademark invoked.

13. According to the defendant, the signs are phonetically and visually comparable in some ways. This, however, is not enough to hinder the registration of the contested sign.

14. Defendant concludes that the difference between the services that fall under the contested sign and the trademark invoked is too big to conclude that there is a likelihood of confusion between the signs. The services have nothing to do with each other. The services lie that far from each other that it would be extremely unlikely that a consumer would regard the services as coming from the same undertaking. The defendant requests the approval of the contested sign as no likelihood of confusion results from the co-existence of the two signs.

III. DECISION

A Likelihood of confusion

15. 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.

16. 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

17. 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

18. 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.³

Comparison of the signs

19. 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

20. 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

21. 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.

22. The signs to be compared are the following:

¹ Art. 2.2ter (1)(b) BTIP 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.

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 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) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

Opposition based on:	Opposition directed against:
CAREBLUE	CareBlue

Visual and phonetic comparison

23. Given that the trademark and the sign applied for are wordmarks, the fact that the former is represented in capital letters, whereas the latter is represented in capital letters and lower-case letters, is irrelevant for the purposes of a visual comparison of those marks. The protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics which that mark might possess.⁷

24. Considering the above, the signs are visually identical.

25. Phonetically the signs are also identical. The signs are pronounced in the same way.

Conceptual comparison

26. Although the average consumer normally perceives a trademark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a verbal sign, the consumer will break it down into elements which suggest a concrete meaning or which resemble words known.⁸ According to the Office the consumer will break down the signs in the elements 'CARE' and 'BLUE', because 'care' and 'blue' are basic English words which are known to the Benelux consumer.

27. Since both signs refer to the concepts 'care' and 'blue' the signs are conceptually identical.

Conclusion

28. The signs are visually, phonetically and conceptually identical.

Comparison of the goods and services

29. 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.⁹

30. Goods and services are complementary when they are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both.¹⁰

31. 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.¹¹

⁷ General Court (EU) 31 January 2013, T-66/11, ECLI:EU:T:2013:48, point 57 (Badibu).

⁸ General Court (EU) 13 February 2007, T-256/04, ECLI:EU:T:2007:46, point 57 (Respicur).

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

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

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

32. In his arguments, the opponent explicitly only compares the services in class 35 of the trademark invoked with the services of the contested sign (see paragraph 8). Since the opposition proceedings are limited to the arguments, facts and evidence put forward by the parties, the Office will only assess the similarity of the services in class 35.

33. The services to be compared are the following:

Opposition based on:	Opposition directed against:
Class 35 Computerised inventory control; Inventory management of parts and components for manufacturers and suppliers; Inventory management services; Inventory management services.	Class 35 Groothandelsdiensten op het gebied van medische apparaten; Onlinedetailhandelsdiensten op het gebied van cosmetica; Detailhandelsdiensten op het gebied van medische apparaten; Groothandelsdiensten op het gebied van medische instrumenten; Detailhandelsdiensten op het gebied van medische instrumenten; Online detailwinkeldiensten met cosmetica en schoonheidsproducten. <i>Class 35</i> <i>Wholesale services in the field of medical devices; online retail services in the field of cosmetics; retail services in the field of medical devices; Wholesale services in the field of medical instruments; retail services in the field of medical instruments; Online retail shopping services featuring cosmetics and beauty products</i>
	N.B. The original classification language is Dutch. The English translation has been added solely to improve the readability of the decision.

34. According to the Office the wholesale and retail services for which the contested sign is applied for are complementary to the inventory services of the trademark invoked. It all concerns commercial services to be managed in order to be profitable. The services, thus, have a similar nature and purpose. In addition, inventory is essential for wholesale and retail. Therefore, the Office concludes that the services in class 35 of the trademark invoked are similar to the services in class 35 of the contested sign.

Conclusion

35. The services concerned are similar.

Global assessment

36. 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.¹² In the present case, the services concerned are aimed at the public at large for which the level of attention is deemed to be normal.

37. The greater 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.¹³ In the present case the invoked trademark has to be considered as having normal distinctiveness for the services concerned as it does not describe the characteristics of the services in question.

38. 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 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.¹⁴

39. In this case the signs are visually, phonetically and conceptually identical. The relevant services are similar. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that there is a likelihood of confusion in the sense that the public may believe that the services designated by the trademark relied on and those to which the contested sign relates come from the same undertaking or, as the case may be, from undertakings which are economically linked.

Other factors

40. Defendant argues that the business activities of the parties are completely different (see paragraph 12). However, actual use cannot be considered in opposition proceedings, as the comparison of the signs and goods and services is solely based on the trademark and sign as registered (see paragraph 31 above).

B. Conclusion

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

IV. DECISION

42. The opposition with number 2017810 is justified.

43. The Benelux application with number 1455756 will not be registered.

44. 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.

¹² CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹³ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, punt 59 (Equivalenza) and the case-law mentioned there.



The Hague, 22 December 2022

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