



Benelux Office for  
**Intellectual  
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2018021**  
**of 14 March 2023**

**Opponent:** **Epic Games, Inc. MD**  
Crossroads Boulevard 620  
27518 Cary North Carolina  
United States of America

**Representative:** **Bird & Bird (Netherlands) LLP**  
Zuid-Hollandplein 22  
2596 AW Den Haag  
The Netherlands

**Invoked right 1:** **European Union trademark registration 018055566**  
  
UNREAL

**Invoked right 2:** **European Union trademark registration 015972524**  
  
UNREAL  
  
*against*

**Defendants:** **Wim Peeters**  
Sporweglaan 151  
9120 Melsele  
Belgium

**Aimdigital BV**  
Gijzelaarsstraat 10  
2000 Antwerpen  
Belgium

**Representative:** **deJuristen bvba**  
Heernislaan 19  
9000 Gent  
Belgium

**Contested sign:** **Benelux trademark application 1460532**  
  
unreel

## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 2 March 2022 the defendant filed a Benelux trademark application for the wordmark unreel for services in the classes 35, 41 and 42. This application was processed under the number 1460532 and was published on 2 March 2022.

2. On 26 April 2022 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- European Union registration 018055566 of the wordmark UNREAL, filed on 24 April 2019 and registered on 9 October 2019 for goods in class 9 and services in the classes 35, 38, 41 and 42;
- European Union registration 015972524 of the wordmark UNREAL, filed on 26 October 2016 and registered on 13 July 2017 for goods in the classes 9 and 28 and services in the classes 35, 38, 41, 42 and 45.

3. According to the register 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 the services in the classes 35, 38, 41 and 42 for which the earlier trademarks are 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 29 April 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 26 October 2022.

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

7. 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.

8. The opponent claims that the contested sign should not be registered based on the following grounds:

- Article 2.2ter, 1 BCIP, likelihood of confusion: "*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.*"

- Article 2.2ter, 3 (a) BCIP, reputation: *"a trademark shall, in case an opposition is filed, not be registered (...) where: a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark"*.

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

9. Opponent notes that the parties have previously been involved in opposition proceedings relating to the identical unreel Benelux word mark application, filed on 14 March 2021. However defendants failed to respond to this opposition. As a result this opposition was closed. Only a day after the decision of the Office to close the opposition, defendants filed a new, almost identical application. As a result of this conduct of defendants, opponent is incurring unnecessary costs, also because defendants have chosen different languages in the opposition proceedings.

10. Opponent explains that the UNREAL trademarks invoked enjoy a high degree of reputation in Europe, including the Benelux. Unreal is one of the (if not the) most used game engine(s) and was declared *"most successful videogame engine"* in 2014 by Guinness World Records. Right now, more than 11 million software developers are using Unreal. Also in Europe, the Unreal engine community is growing explosively. According to opponent Unreal is not only very well known in the gaming industry, but is now also known in other industries, such as architecture, fashion, advertising, automotive and the film industry. Opponent submits several exhibits to proof Unreal's reputation in the European Union and Benelux.

11. Opponent argues that when the UNREAL trademarks and the disputed sign are placed side by side, it is immediately clear that there is a great visual similarity. Both signs are of equal length and consist of six letters. Five of the letters are identical and are placed in the same position in the same order: UNRE\*L. The signs differ only in the penultimate letter A in the earlier marks as opposed to the letter E in the disputed sign. However, these vowels A and E are placed at the end of the signs, to which the public generally pays less attention. The fact that the disputed sign begins with the same four letters is all the more relevant given that the average consumer will generally pay more attention to the beginning of a mark. Visually the disputed sign is almost identical to, or at least highly similar to, the UNREAL trademarks.

12. Aurally the signs are identical. After all, the sound 'ea' and 'ee' are identically pronounced.

13. The English word 'unreal' is a relatively simple English word and will be understood by the English speaking Benelux public. It means: *"as if imagined; strange and dream-like (adjective)"* and *"extremely or surprisingly good (adjective)"*. The word 'unreel', however, will have no fixed meaning for the majority of the Benelux public. Both the Cambridge Dictionary and the Oxford Learner's Dictionary do not even give a definition of the word 'unreel', but give as a first suggestion a reference to the word 'unreal'. Collins English Dictionary does give a definition of the verb 'to unreel', however, the use of this word in the English language is very limited. It is therefore unlikely that the average Benelux consumer will be familiar with the meaning of the verb. It is much more likely that the public will take 'unreel' as a misspelling of the word 'unreal'. This part of the public will attach the same meaning to the disputed sign as to the invoked trademarks. Thus, for this part of the public there is a conceptual similarity between the disputed sign and the invoked trademarks. The part of the public that is familiar with the meaning of the verb 'to unreel' or does not perceive the disputed sign as a misspelling, are less likely to notice any possible conceptual differences due to the high degree of visual and aural similarity.

14. Given the (almost) identical visual and aural similarity and the conceptual similarity for at least the largest part of the Benelux public, it can only be concluded that the disputed sign is similar to the invoked UNREAL trademarks.

15. According to the opponent the services for which the disputed sign was filed are identical and some (very) similar to the services for which the invoked trademarks are registered. Opponent provides a detailed explanation for each class.

16. In view of the very high degree of similarity between the disputed sign and the UNREAL trademarks and the high degree of recognition of the UNREAL trademarks, which gives them a higher level of distinctive character and a greater scope of protection, there is an increased likelihood of confusion on the part of the public. Any potential lower degree of similarity between the services of the disputed sign and the services of the UNREAL trademarks will therefore be offset. In conclusion, any differences between the services cannot eliminate or preclude the confusing similarity in the overall impression and thus the likelihood of confusion on the part of the relevant public. The public will perceive the services in question as originating from the same or economically linked companies, or as a new line of services from the opponent, or at least being related to, sponsored by or marketed with the consent of the opponent.

17. Opponent explains that any use of the disputed sign would also take unfair advantage of, or be detrimental to, the distinctive character and reputation of the UNREAL trademarks. Any use of the disputed sign would evoke a clear link with the UNREAL trademarks. This is even more the case given the incredibly popular development platform of Unreal that can be used for numerous applications. Unreal is already being used in a variety of advertising applications. Thus, the relevant public, even when confronted with advertising and marketing services, in other words the services for which the disputed sign was filed in class 35, offered under a virtually identical sign, will immediately establish a link with the UNREAL trademarks. Defendants are trying to ride the coattails of the UNREAL trademarks in order to benefit from their attractiveness, reputation and prestige and to take advantage of the commercial efforts made by the opponent to create and maintain the image and goodwill of the UNREAL trademarks, without the defendants having to pay any financial compensation or having to make the appropriate efforts themselves. In addition, by using the disputed sign, the defendants also undermine the distinctive character of the UNREAL trademarks.

18. Opponent concludes by asking the Office to grant the opposition in full, not to register the disputed sign and order the defendants to pay the costs of these proceedings.

## **B. Defendants' arguments**

19. Defendants first address the relevant public. According to defendants the relevant public of opponent's trademarks is a very specific and niche public, namely EU creators of (augmented/virtual reality) games who have very specific knowledge on real-time technology and 3D creations. This public has a high level of attention. The relevant public of applicant's trademark is a Benelux business who is looking for a business that takes care of their marketing for them. This public also has a high level of attention. It is clear from this analysis that there is no overlap between the relevant public. Thus, there can be no likelihood of confusion between these trademarks.

20. Defendants argue that conceptually the signs concerned are entirely not similar. The meaning of 'unreal' is "*as if imagined; strange and dream-like*". This conceptual meaning of opponent's trademarks is a clear reference to the goods and services covered by the trademarks in question, which are all related to augmented/virtual reality games. Defendants' trademark consist entirely of the English verb 'unreel', which means "*to unwind from a film reel*", a purely technical act. Knowledge of this verb is very much prevalent

in the EU, most notably through modern-day uses of the verb, for example the widely infamous Instagram 'Reels' which are short digital videos. The conceptual meaning should be assessed from the viewpoint of the relevant public, which in this case not only has a high level of attention, but also a very good understanding of English including regarding terms on technical aspects of media. Since the conceptual meanings are so different from each other, these differences entirely counteract any visual and phonetical similarities between the trademarks in question. In the event the Office were to take the view that defendants' trademark does not have a conceptual meaning in light of the relevant public's linguistic understanding of the sign, the requirements for the conceptual differences to entirely counteract any visual and phonetic similarities (namely that at least one of the signs has a fixed, clear and specific conceptual meaning) are still fulfilled. Thus, in any case, any likelihood of confusion is ruled out.

21. With regard to the comparison of the services, defendants mention that the services covered by opponent's trademarks are entertainment services, software services, online retail services and telecommunication services all specifically relating to (augmented/virtual reality) games. The services of defendants' trademark, on the contrary, are marketing services. Clearly, there are no links whatsoever between the services. The services are not similar.

22. The fact that conceptually the signs are entirely different, in combination with the fact that there is no similarity between the services at hand, counteracts any visual and phonetic similarities of the signs. Thus, there is no likelihood of confusion.

23. Defendants also note that opponent's trademarks are not distinctive at all, since they are entirely descriptive of the goods and services they cover. Thus, no detriment to distinctive character is possible whatsoever, nor is taking unfair advantage of distinctive character. Defendants' public is not aware of any repute the opponent's trademarks might have. Therefore there is no reason why defendants would try to cause detriment to or take unfair advantage of any repute the opponent's trademarks might have.

24. According to defendants, opponent has not given any evidence whatsoever about any change in economic behaviour of the average consumer of its services, let alone as consequence of the use of defendants' trademark. Opponent also has not evidenced that the power of attraction of opponent's trademarks is diminished. On the contrary, opponent has evidenced that the services covered by its trademarks keep being popular and grow more popular with consumers every day. Also from a commercial point of view, it would not make any sense that defendants would have intentionally used opponent's trademarks for free-riding on its coattails, since the non-similarity of the trademarks would prevent the opponent's trademarks being brought up in the mind of defendants (potential) consumers in the first place, and thus all efforts of trying to ride the coattails of the opponent's trademarks would clearly be fruitless and thus a strange and illogical commercial branding choice.

25. Defendants conclude by asking the Office to accept the Benelux trademark unreel for all services applied for in classes 35, 41 and 42.

### **III. DECISION**

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

26. 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>*

27. 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>

28. 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.<sup>3</sup>

### **Comparison of the signs**

29. To assess the degree of similarity between the conflicting signs, their visual, aural 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>

30. 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>

31. 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.

32. The signs to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
UNREAL	unreel

<sup>1</sup> 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.

<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 and the case-law mentioned there (Equivalenza).

<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).

*Visual and aural comparison*

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

34. The trademarks invoked consist of six letters: UNREAL.

35. The contested sign also consists of six letters: unreel.

36. Five of the six letters are identical and placed in the same order: UNRE\*L. Only the fifth letter differs: A versus E.

37. Aurally the signs are pronounced identical.

38. Considering the above, the signs are visually highly similar and aurally identical.

*Conceptual comparison*

39. The word 'unreal' means "*so strange that it is more like a dream than reality*" or "*not related to reality*".<sup>8</sup> The Office agrees with the parties (see paragraphs 13 and 20) that the Benelux public will know the meaning of the English word 'unreal'.

40. Defendants argue that 'unreel' is an English verb which means "*to unwind from a film reel*" (see paragraph 20). Although the Benelux public generally has more than average knowledge of the English language, it must be doubted whether the meaning of this verb is generally known. After all, it is not a verb that is part of basic everyday vocabulary. Defendants also have not demonstrated that a significant part of the relevant Benelux public knows the meaning of the verb 'unreel'. According to the Office, only a small part of the relevant public will know the meaning of the English verb. Furthermore, the Office is not convinced that the public will take 'unreel' as a misspelling of the word 'unreal' as argued by opponent (see paragraph 13). According to the Office most of the relevant Benelux public will not assign any meaning to the word 'unreel'. A small part of the public will know the meaning of the English verb.

41. Given the above, the Office is of the opinion that the signs are conceptually different.

*Conclusion*

42. The signs are visually highly similar and aurally identical. Conceptually the signs are different.

43. Unlike the defendants argue (see paragraph 20), the Office finds that the conceptual difference between the signs cannot neutralize or counteract the high degree of visual similarity and aural identity. Based on the overall impression, the signs are similar.

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

<sup>8</sup> <https://www.oxfordlearnersdictionaries.com/definition/english/unreal?q=unreal>

**Comparison of the goods and services**

44. 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>

45. 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.<sup>10</sup>

46. 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>

47. In his arguments, the opponent explicitly only compares the services in classes 35, 38, 41 and 42 of the trademarks invoked with the services of the contested sign (see paragraph 4). 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 these services.

48. The services to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
<p><i>EU trademark 018055566</i> Class 35 Online retail store services relating to virtual goods, namely, avatars, clothing, vehicles, tools, and emotes for use in online virtual worlds; online retail store services relating to computer software, games software, video games, computer games, game programs, recorded and downloadable media, audio-visual and multimedia devices, communication equipment, information technology devices, clothing, footwear, headgear, toys, games, luggage, bags, wallets, printed matter, jewellery, time instruments, and stationery.</p> <p><i>EU trademark 015972524</i> Class 35 Computerised on-line retail services in the field of games and games related merchandise namely game related apparel, artwork, drinkware, books, movies, videos, DVDs, CDROMs, toys and compact discs; electronic commerce services, namely, providing on-line retail, mail order services, relating to computer</p>	<p>Klasse 35 Digitale marketing; Marketing via digitale netwerken; Reclame; Reclamebureaus; Reclame en marketing; Reclamestudies; Reclamediensten; Reclameagentschappen; Reclame voor anderen; Reclame-onderzoek; Reclame en publiciteit; Reclame via het Internet; Reclame per televisie; Reclame via radio en televisie; Reclamediensten via televisie; Reclame voor zakelijke websites; Reclamemateriaal (verspreiding van); Reclame- en verkooppromotiediensten; Marketing; Marketingbureaus; Marketingstudies; Marketinganalyses; Marketingcampagnes; Marketing onderzoek; Marketingassistentie; Marketing van producten; Marketing van onroerend goed; Marketingdiensten via zoekmachines; Marketingadvisering voor fabrikanten; Marketing in de handel [anders dan verkopen]; Direct marketing; Reclame, marketing en promotionele diensten; Reclame, marketing en promotionele consultancy, advisering en assistentie; Gerichte marketing; Affiliate marketing; Reclame- en marketingdiensten, verleend via sociale media; Reclame- en marketingdiensten,</p>

<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).



<p>software, games, clothing, books, movies, videos, DVDs, CD-ROMs, toys, audio cassettes, compact discs; provision of information, advice or assistance to customers in the selection and purchase of the aforesaid goods; compilation, retrieval of information and data.</p>	<p>verleend via communicatiekanalen; Promotie marketing; Promotie marketing met behulp van audiovisuele media; Opstellen van marketingplannen; Verschaffen van marketingrapporten; Analyse van marketingtrends; Onlinereclame en -marketing; Verstrekken van marketingadvies op het gebied van sociale media; Ontwikkeling van marketingstrategieën; Verstrekking van marketinginformatie via websites; Onderzoeken inzake marketingstrategieën; Promotie, reclame en marketing van online websites; Verspreiding van advertentie-, marketing en promotiemateriaal; Advisering met betrekking tot marketing; Informatie met betrekking tot marketing; Productie van geluidsopnamen voor marketingdoeleinden; Zakelijke strategiediensten; Ontwikkeling van commerciële strategieën; Consultancy over reclame communicatie strategie; Verstrekken van bedrijfsinformatie op het gebied van sociale media; Analyse van reacties op reclame; Alle voornoemde diensten worden uitsluitend verricht voor reclame- en marketingdoeleinden.</p> <p><i>Class 35</i></p> <p><i>Digital marketing; Marketing via digital networks; Advertising; Advertising agencies; Advertising and marketing; Advertising studies; Advertising services; Advertising agencies; Advertising for others; Advertising research; Advertising and publicity; Advertising via the Internet; Advertising by television; Advertising via radio and television; Advertising services via television; Advertising for business websites; Advertising materials (distribution of -); Advertising and sales promotion services; Marketing; Marketing agencies; Marketing studies; Marketing analyses; Marketing campaigns; Marketing research; Marketing assistance; Marketing of products; Marketing of real estate; Marketing services through search engines; Marketing consultancy for manufacturers; Marketing in commerce [other than sales]; Direct marketing; Advertising, marketing and promotional services; Advertising, marketing and promotional consultancy, advice and assistance; Targeted marketing; Affiliate marketing; Advertising and marketing services provided through social media; Advertising and marketing services provided through communication channels; Promotional marketing; Promotional</i></p>
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	<p><i>marketing provided through audiovisual media; Drafting of marketing plans; Provision of marketing reports; Analysis of marketing trends; Online advertising and marketing; Provision of marketing advice in the area of social media; Development of marketing strategies; Provision of marketing information through websites; Surveys on marketing strategies; Promotion, advertising and marketing of online websites; Distribution of advertising, marketing and promotional materials; Advice related to marketing; Information related to marketing; Production of sound recordings for marketing purposes; Business strategy services; Development of commercial strategies; Consultancy on advertising communication strategy; Provision of business information in the field of social media; Analysis of reactions to advertising; All the aforementioned services are performed exclusively for advertising and marketing purposes.</i></p>
<p><i>EU trademark 018055566</i> Class 38 Telecommunication services; virtual reality content and electronic data transmission services; Computer, electronics and online access to databases; Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the internet; Access to content, websites and portals; Interactive communications services by means of computer; Transmission of interactive entertainment software; Communication services in the nature of text messaging and electronic mail services used in playing on-line computer games; Streaming of audio and video material on the internet featuring virtual reality, augmented reality, and mixed reality content; Information, advisory and consultancy services in relation to all the aforesaid services.</p> <p><i>EU trademark 015972524</i> Class 38 Telecommunication services; telecommunication of computer programmes and electronic, computer and video games; providing telecommunications connections to the Internet and databases; providing telecommunications access to electronic,</p>	

<p>computer and video games; delivery of electronic, computer and video games by telecommunication; transmission of interactive audio and video services; electronic bulletin board services; electronic message and chat services for use in connection with interactive games played over computer networks and global communications networks; operating chat rooms; providing access to on-line publications and information relating to computer games; providing on-line facilities for real-time interaction between and among computer users relating to computer games; provision of information relating to all the aforesaid services.</p>	
<p><i>EU trademark 018055566</i> Class 41 Entertainment services; Entertainment services, namely, providing multi-user access to an online multimedia virtual environment; Virtual reality services provided on-line from a computer network; Virtual reality arcade services; Virtual reality game services provided on-line from a computer network; Entertainment services, namely, providing on-line, non-downloadable virtual environments created for entertainment purposes; Entertainment services, namely, providing on-line, non-downloadable avatars and virtual clothing, pets, vehicles, tools, toys, and emotes for use in virtual environments created for entertainment purposes; Entertainment services, namely, providing virtual environments in which users can interact for recreational, leisure or entertainment purposes; Organizing and arranging exhibitions for entertainment purposes; Organization of games and competitions; Arranging and conducting of competitions [education or entertainment]; Games equipment rental; Providing online electronic publications, not downloadable; Electronic game services and competitions provided by means of the internet; Providing interactive multiplayer games services for games played over computer networks and global communications networks; Organization of electronic game competitions; Arranging and conducting live, interactive gaming tournaments</p>	<p>Klasse 41 Film- en videoproductie; Audio- en videoproductie en fotografie; Fotografie; Fotografielessen; Audio-opname en audioproductie; Audioproductie; Diensten van fotografen; Filmproductie; Filmregie, anders dan reclamefilms; Film- en muziekproducties (Advisering over -); Filmproductie voor ontspanningsdoeleinden; Filmproductie voor educatieve doeleinden; Montage van films; Diensten van filmstudio's; Productie van films; Productie van films in studio's; Productie van films en video's; Projectie van films voor medische doeleinden; Productie van films, anders dan reclamefilms; Televisie-, radio- en filmproductie; Opnamestudio's voor films; Ter beschikking van faciliteiten voor filmstudio's; Montage na productie op het gebied van muziek, video's en films; Ter beschikking stellen van faciliteiten voor de productie van films; Alle voornoemde diensten worden uitsluitend verricht voor reclame- en marketingdoeleinden.</p> <p><i>Class 41</i> <i>Film and video production; Audio and video production and photography; Photography; Photographic lessons; Audio recording and audio production; Audio production; Services of photographers; Film production; Film directing other than advertising films; Film and music production (Consultancy on -); Film production for entertainment purposes; Film production for educational purposes; Film editing; Film studio services; Services for the production of cinefilms; Studio production of films; Film and video</i></p>

<p>featuring video games; Multimedia publishing; Production of virtual reality media and provision of virtual reality media via communications networks for entertainment purposes; Publication of printed matter in electronic form on the Internet; Video game entertainment services; Provision of online computer games; Publication of computer games; Audio, video and multimedia production, and photography; Education; Sport services; Esport services; Information, advisory and consultancy services in relation to all the aforesaid services.</p> <p><i>EU trademark 015972524</i></p> <p>Class 41</p> <p>Entertainment services; entertainment services, namely, providing on-line computer games, tips and strategies for computer games and news concerning computer games; electronic, computer and video games services; arranging, conducting and presenting competitions, contests and games; providing interactive multiplayer games services for games played over computer networks and global communications networks; providing computer games and video games which can be accessed, played and downloaded over computer networks and global communications networks; provision, production, development, composition, presentation, distribution, syndication and networking of entertainment, films, audio and video recordings, compact discs, CD ROMs, DVDs and programs; publication of games; providing electronic publications; provision of information relating to all the aforesaid services.</p>	<p><i>production; Projection of films for medical purposes; Film production, other than advertising films; Television, radio and television film production; Film recording studios; Provision of film studio facilities; Post-production editing services in the field of music, videos and films; Provision of facilities for film production; All the above services are provided exclusively for advertising and marketing purposes.</i></p>
<p><i>EU trademark 018055566</i></p> <p>Class 42</p> <p>Computer services; Computer services, namely, hosting an on-line multimedia virtual environment; design and development of multimedia and virtual environment software; Design and development of computer game software, multimedia software, augmented and virtual reality software; Computer development and design services for computer game software; Providing temporary use of on-line</p>	<p>Klasse 42</p> <p>Grafisch ontwerpen; Grafisch tekenen; Grafisch ontwerp; Grafische vormgeving; Grafisch ontwerp van promotiemateriaal; Grafisch ontwerp voor het samenstellen van webpagina's op het Internet; Grafische ontwerpers (Diensten van -); Advisering op het gebied van webdesign; Website-ontwerp; Ontwerp van websites; Creëren van websites voor derden; Ontwerp van websites op het Internet; Ontwerp van websites voor reclaimedoeleinden; Onderzoek op het</p>

<p>non-downloadable software development tools; Development and design services relating to virtual reality software; Development of computer hardware for computer games; Software as a service (SaaS) services featuring software for computer games; Software as a service (SaaS) services, namely, hosting software for use by others for use in computer gaming; Software as a service (SaaS) services featuring software for watching audio and video material featuring virtual reality, augmented reality, and mixed reality content; Computer programming; Computer programming services, namely, content creation for virtual worlds and three dimensional platforms; Updating of computer software; Maintenance of computer software; Graphic arts design; Computer services, namely, hosting an interactive website for on-line discussions and blogs, sharing on-line content, new media content, and on-line web links to other websites; writing, designing, developing, production of computer software, computer programs and computer games; electronic storage of information and data; Website design services; Website design consultancy; Design, creation, hosting and maintenance of websites for others; Hosting of digital content; Providing temporary use of non-downloadable computer software for use in the creation and publication of on-line journals and blogs; Information, advisory and consultancy services in relation to all the aforesaid services.</p> <p><i>EU trademark 015972524</i></p> <p>Class 42</p> <p>Computer services; writing, designing, developing, production of computer software, computer programmes and computer games; computer programming services; updating computer software, computer programmes and computer games; providing information and advice in relation to the aforesaid services; electronic storage of information and data.</p>	<p>gebied van sociale media; Ontwerp en grafisch kunstontwerp voor de creatie van websites; Ontwerp en grafisch kunstontwerp voor de creatie van webpagina's op het internet; Alle voornoemde diensten worden uitsluitend verricht voor reclame- en marketingdoeleinden.</p> <p><i>Class 42</i></p> <p><i>Graphic design; Graphic drawing; Graphic design; Graphic design; Graphic design of promotional material; Graphic design for the compilation of web pages on the internet; Graphic designers (Services of -); Consultancy services in the field of web design; Website design; Creation of websites for third parties; Design of websites on the internet; Design of websites for advertising purposes; Research in the field of social media; Design and graphic art design for the creation of websites; Design and graphic art design for the creation of web pages on the internet; All the aforementioned services are provided exclusively for advertising and marketing purposes.</i></p>
	<p>N.B. The original classification language of the Benelux trademark application is Dutch. The English translation has been added solely to improve the readability of the decision.</p>

### Class 35

49. The Office finds that the marketing and advertising services performed exclusively for advertising and marketing purposes for which the contested sign is applied in class 35 are not similar to the services of the trademarks invoked. The services in classes 35, 38, 41 and 42 of the trademarks invoked have another nature and purpose and are not focused on marketing or advertising. In addition the end-users of the services are different as correctly argued by defendants (see paragraph 19). The services are also not in competition with each other or complementary in the sense that consumers may think that the same undertaking is responsible for both services.

### Class 41

50. The film and video production services and photography services performed exclusively for advertising and marketing purposes in class 41 of the contested application all fall within the broad category of "Audio, video and multimedia production, and photography" for which the invoked trademark 1 (nr. 018055566) is registered in class 41. The "Photographic lessons" of the contested sign fall within the broad category of "Education" for which the invoked trademark 1 (nr. 018055566) is registered in class 41 and the services "Projection of films for medical purposes" of the contested application fall within the broad category of "provision, production, development, composition, presentation, distribution, syndication and networking of entertainment, films, audio and video recordings, compact discs, CD ROMs, DVDs and programs" for which the invoked trademark 2 (nr. 015972524) is registered in class 41. After all, projection is a form of presentation. The services in class 41 of the contested sign are thus considered to be identical.<sup>12</sup>

### Class 42

51. The graphic design and website design services performed exclusively for advertising and marketing purposes in class 42 of the contested application all fall within the broad categories of "Graphic arts design" and "Website design services" for which the invoked trademark 1 (nr. 018055566) is registered in class 42. These services are thus considered to be identical.<sup>13</sup> The services "Research in the field of social media" of the contested sign are similar to the "Computer services, namely, hosting an on-line multimedia virtual environment; design and development of multimedia and virtual environment software" and "Information, advisory and consultancy services in relation to all the aforesaid services" for which the invoked trademark 1 (nr. 018055566) is registered in class 42.

### Conclusion

52. The services in class 35 of the contested application are not similar. In so far the opposition is directed against these services of the contested sign the opposition cannot succeed, because there can be no likelihood of confusion if there is no similarity between the goods and services involved.

53. The services in class 41 and 42 of the contested application are partly identical and partly similar. As regards these services, the Offices proceeds below with the global assessment of the likelihood of confusion.

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<sup>12</sup> General Court (EU) 2 February 2022, T-694/20, ECLI:EU:T:2022:45, point 31 and the case-law mentioned there (Labello).

<sup>13</sup> General Court (EU) 2 February 2022, T-694/20, ECLI:EU:T:2022:45, point 31 and the case-law mentioned there (Labello).

**Global assessment**

54. 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>14</sup> In the present case, the services of the trademarks invoked in classes 35, 38, 41 and 42 are aimed at both the general public and the professional public. The contested services in classes 41 and 42 target a professional public. Therefore the only public likely to confuse the signs in question is formed of the professional public.<sup>15</sup> The degree of attention of this public is deemed to be higher than average.

55. 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.<sup>16</sup> In the present case the Office considers that the trademarks invoked have an increased distinctiveness. Opponent has sufficiently substantiated that the trademarks have acquired enhanced distinctiveness among the relevant public through frequent and substantial use in the European Union and Benelux.

56. 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.<sup>17</sup>

57. In this case the signs are visually highly similar and aurally identical. Conceptually the signs are different. The contested services in classes 41 and 42 are partly identical and partly similar to services of the trademarks invoked. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers, notwithstanding the enhanced level of attention, that there is a likelihood of confusion in the sense that the public may believe that the services designated by the trademarks relied on and the services in classes 41 and 42 of the contested sign come from the same undertaking or, as the case may be, from undertakings which are economically linked.

**Conclusion**

58. Based on the foregoing, the Office concludes that there is a likelihood of confusion for the contested services in classes 41 and 42.

**B. Reputation**

59. The opponent has based the opposition also on Article 2.2ter, 3 (a) BCIP. The Office will proceed with the assessment of this claim, only with regard to the services in class 35 for which no similarity has been established.

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<sup>14</sup> CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

<sup>15</sup> General Court (EU) 14 July 2005, T-126/03, ECLI:EU:T:2005:288, point 81 (Aladin).

<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).

*Legal framework*

60. Article 2.2ter, 3 (a) BCIP is only applicable when the following conditions are met:

- (i) The conflicting signs are either identical or similar;
- (ii) The earlier trademark has a reputation;
- (iii) The use of the contested sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;
- (iv) There is no due cause for the use of the contested sign.

61. According to the CJEU, the types of injury mentioned in this article, where they occur, are the consequence of a certain degree of similarity between the earlier trademark and the sign applied for, by virtue of which the relevant section of the public makes a connection between the trademark and the sign, that is to say, establishes a link between them even though it does not confuse them.<sup>18</sup> The existence of such a link in the mind of the relevant public is therefore an implied essential precondition for the application of Article 2.2ter, 3 (a) BCIP.

62. The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition based on Article 2.2ter, 3 (a) BCIP.

*Link?*

63. The existence of a link between the trademarks invoked and the contested sign must be assessed globally, taking into account all factors relevant to the circumstances of the case. Those factors include:

- the degree of similarity between the conflicting signs,
- the nature of the goods or services for which the conflicting signs were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public,
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.<sup>19</sup>

64. In the present case the nature and purpose of the contested services in class 35 are different from the services of the trademarks invoked. The services also target different publics and there is no likelihood of confusing (see paragraphs 49 and 52). Even assuming that the trademarks invoked have a strong reputation and taking into account that the signs are visually highly similar and aurally identical, the Office finds that the relevant public will not establish a link between the signs given the conceptual difference (see paragraph 39-41) and the specific nature and public of the contested services in class 35 (paragraph 49).<sup>20</sup>

**Conclusion**

65. In light of the above, it cannot be established that there will be a link in the mind of the relevant public between the trademarks invoked and the contested sign. Therefore, one of the necessary conditions for the application of article 2.2ter, 3 (a) BCIP is not fulfilled and the opposition on the basis of this article must be rejected.

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<sup>18</sup> CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 30 (Intel).

<sup>19</sup> CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 41-42 (Intel).

<sup>20</sup> General Court (EU) 21 December 2022, T-4/22, ECLI:EU:T:2022:850, point 67 (Puma/Puma).



**IV. DECISION**

66. The opposition with number 2018021 is partly justified.

67. The Benelux application with number 1460532 will not be registered for the following services:

- class 41 (all services)
- class 42 (all services)

68. The Benelux application with number 1460532 will be registered for the following services that are not similar:

- class 35 (all services)

69. 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, 14 March 2023

Marjolein Bronneman  
(*rapporteur*)

Eline Schiebroek

Camille Janssen

Administrative officer: Raphaëlle Gerard