



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018035
of 24 April 2023

Opponent: **Dirtea GmbH**
Baruther Strasse 23
15806 Zossen
Germany

Representative: **BANNING N.V.**
Spinhuiswal 2
5211 JG 's-Hertogenbosch
Netherlands

Invoked right: **International registration 1641811**

DIRTEA

against

Defendant: **Dirtea Limited**
2 Television Centre
101 Wood Lane
Shepherd's Bush
London W12 7FR
Great Britain

Representative: **Landmark B.V.**
Nijverheidsweg-Noord 86
3812 PN Amersfoort
Netherlands

Contested sign: **Benelux part of international application 1649464**

DIRTEA

I. FACTS AND PROCEEDINGS

A. Facts

1. On 21 August 2021 the defendant filed an International trademark application designating, amongst others, the Benelux for the wordmark DIRTEA for goods in classes 3, 5, 29, 30, 32 and 33 and services in class 35. This application, with priority date 25 May 2021, was processed under the number 1649464 and was published on 10 March 2022.

2. On 3 May 2022 the opponent filed an opposition against the registration of the application. The opposition is based on the international registration with number 1641811 designating the European Union of the word mark DIRTEA, filed on 3 September 2021, with priority date 13 April 2021, and registered on 22 June 2022 for goods in classes 33 and 34 and services in classes 35 and 43.

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

4. The opposition is directed against all goods in classes 29, 30, 32 and 33 and some of the services in class 35 covered by the contested application and is based on all the goods in class 33, some services in class 35 and all services in class 43 covered by the trademark 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 11 May 2022. The opposition proceedings were suspended until the invoked right was registered. 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 January 2023.

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, a and b BCIP:

- Identity of trademark and sign and identity of goods and services concerned;
- 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 is a joint venture between the artist and influencer Shirin David and the Krombacher brewery and has been successfully marketing alcoholic and non-alcoholic flavoured ice tea products in various countries under the trademark DIRTEA.

9. With regard to the comparison of the signs opponent argues that there are no differences between the signs whatsoever. Both signs solely consist of the word DIRTEA and are therefore visually identical. Both signs are pronounced in an identical manner. Both signs include a wink to "dirty" and "tea", leading

also to conceptual identity between the signs. The signs are therefore visually, aurally and conceptually identical.

10. The goods "alcoholic beverages (except beer)" in class 33 and "Retail services connected with the sale of alcoholic beverages" in class 35 are mentioned in both lists and are identical.

11. Opponent subsequently explains in detail that the other goods and services in classes 29, 30, 32 and 35 are similar also referring to relevant case law.

12. Under the heading 'Global assessment of likelihood of confusion' opponent states that the goods and services in this case are everyday consumer goods that are aimed at the public at large. The level of attention will be average. According to opponent the trademark invoked has a normal distinctiveness.

13. Opponent concludes that since the signs are visually, aurally and conceptually identical and the goods and services are identical or similar to a certain degree, the conclusion can be no other than that there exists a high likelihood of confusion between the signs on the part of the relevant public.

B. Defendant's arguments

14. Defendant first mentions that he would like to limit the specification of goods/services of the contested sign by:

- "Limiting class 32 to the following goods: "soft drinks without alcohol; mineral and aerated waters; non-alcoholic drinks, excluding non-alcoholic beer, non-alcoholic wine, non-alcoholic spirits and liqueurs, non-alcoholic mocktails and flavoured carbonated beverages; fruit drinks and fruit juices; syrups for making beverages."
- Class 33 deleting total class.
- And class 35 by deleting the following services: "Retail services connected with the sale of soft drinks, mineral and aerated waters, non-alcoholic drinks, excluding non-alcoholic beer, non-alcoholic wine, non-alcoholic spirits and liqueurs, non-alcoholic mocktails and flavoured carbonated beverages, fruit drinks and fruit juices, syrups for making beverages."

15. Subsequently, defendant introduces its company by referring to its website. Defendant indicates that its products, powdered mushrooms, are not intended for a professional audience such as caterers or restaurants, but that the products are intended for individuals concerned about their health.

16. Contrary to what opponent states, the goods in class 29 and 30 are not complementary to the catering services in restaurants because these services also concern food products. In the present case, the goods covered by the contested mark have a nature, destination, public and distribution channel that are quite distinct from the catering services of the earlier mark. Moreover, the powdered mushrooms are essentially food supplements, much more than cooking ingredients. The public targeted is absolutely not the same and the distribution channels are very different (sale online against services offered in establishments open to the public).

17. The contested products in class 32 are not similar to the goods in class 33 "alcoholic beverages". Preparations for making of alcoholic beverages in class 33 include extracts, essences for making alcoholic drinks. Taking into account the differences between the sectors of alcoholic drinks and non-alcoholic beverages, it is unlikely that producers of non-alcoholic beverages would also be engaged in production of essences for making alcoholic beverages and vice versa. These products are sold in different sections of supermarkets and they target different consumers.

18. As the defendant limited its services in class 35 and the fact that "alcoholic beverages" are not considered similar to non-alcoholic beverages in class 32, also the retail services connected with the sale of non-alcoholic drinks should not be similar to retail services connected with the sale of alcoholic beverages. As far as the alleged similarity of the services in class 35 to the catering, bar and restaurant services, the services in question are essentially different, even though they both concern food and drinks.

19. Considering the lack of similarity between the goods and services covered, there can be no likelihood of confusion between the trademarks. Therefore, the opposition is not well founded and should be rejected completely. Defendant furthermore invites the Office to order opponent to bear the fees and costs incurred by the defendant.

III. DECISION

A Likelihood of confusion

20. 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.

21. 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

22. 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

23. 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

24. 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

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.

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 and the case-law mentioned there (Equivalenza).

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

25. 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

26. The assessment of the similarity between the signs, regarding the visual, phonetic 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.

27. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
DIRTEA	DIRTEA

28. Visually, phonetically and conceptually the signs are 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.⁷

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.⁸

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.⁹

32. The goods and services to be compared are the following:

Opposition based on:	Opposition directed against:
	Class 29 Dried edible mushroom in powdered form; processed mushroom and mushroom mycelium in powdered form; fresh, preserved, tinned, chilled, frozen and cooked meat, fish, poultry and game; meat and fish

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

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

⁷ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁸ General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

⁹ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

	<p>extracts; seafood, crustaceans and molluscs; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals and snacks made principally from meat, fish, seafood, molluscs, crustaceans, poultry or game; soups; preserved, frozen, dried and cooked fruits, nuts and vegetables; jellies, jams, compotes; dairy products and substitutes for dairy products; crisps; potato crisps; food and prepared snack products made from dried fruits, nuts and processed seeds.</p>
	<p>Class 30 Coffee; tea; cocoa; herbal tea preparations for making beverages; sugar; tapioca; sago; artificial coffee; culinary herbs; herbal infusions; herbal honey; seasonings; sauces; chutneys and pastes; marinades; spices; bakery goods; yeast, baking powder; rice; pasta; pizzas, pies and pasta dishes; spaghetti and spaghetti-based dishes; rice-based dishes; flour and preparations made from cereals; bread; pastry; confectionery, ices; chocolate and desserts; puddings; sandwiches; cereal and energy bars; cereals; biscuits; cakes; snack bars containing grains, seeds, nuts or dried fruit; food mixtures consisting of cereal flakes and dried fruits; nut confectionery; coated nuts [confectionery].</p>
	<p>Class 32 Beers; soft drinks; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy; non-alcoholic beers and wines.</p>
<p>Class 33 Alcoholic beverages, except beer.</p>	<p>Class 33 Alcoholic beverages (except beer).</p>
<p>Class 35 Retail services in relation to alcoholic beverages.</p>	<p>Class 35 Retail services connected with the sale of beers, soft drinks, mineral and aerated waters, non-alcoholic drinks, fruit drinks and fruit juices, syrups for making beverages, shandy, non-alcoholic beers and wines, alcoholic beverages.</p>
<p>Class 43 Catering in restaurants, managing shisha bars, serving food and drink in restaurants and bars, catering in cafés.</p>	

Classes 29 and 30

33. According to the Office the food and drinks for which the contested sign is applied for in classes 29 and 30 are complementary to the services "serving food and drink in restaurants and bars" for which the invoked trademark is registered in class 43. The food and drinks of the contested sign are closely connected in the sense that they are indispensable for "serving food and drink in restaurants and bars", so that consumers may think that the same undertaking is responsible for both (see paragraph 30 above). In view of this complementarity, the Office finds that there is a limited degree of similarity.¹⁰

Class 32

34. The "Beers" and "shandy" for which the contested sign is applied for in class 32 are in the opinion of the Office similar to the "Alcoholic beverages (except beer)" for which the trademark invoked is registered in class 33. It all concerns beverages containing alcohol.

35. The Office finds the "soft drinks; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; non-alcoholic beers and wines" complementary to the services "serving food and drink in restaurants and bars" for which the invoked trademark is registered in class 43. The drinks, water, juices and syrups of the contested sign are closely connected in the sense that they are indispensable for "serving food and drink in restaurants and bars", so that consumers may think that the same undertaking is responsible for both (see paragraph 30 above). In view of this complementarity, the Office finds that there is a limited degree of similarity.¹¹ In addition, the "soft drinks; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; non-alcoholic beers and wines" have a limited degree of similarity with the "Alcoholic beverages, except beer" for which the trademark invoked is registered in class 33.¹² It concerns all liquids for human consumption that are increasingly in competition. In addition, the beverages can be mixed. The beverages are also often sold side by side in shops and bars and on drinks menus. Although the production methods and ingredients of alcoholic and non-alcoholic beverages can be different, the Office finds that there is a limited degree of similarity.

Class 33

36. The "Alcoholic beverages (except beer)" for which the contested sign is applied for in class 33 occur *expressis verbis* in class 33 of the trademark invoked. These goods are identical.

Class 35

37. The contested "Retail services connected with the sale of beers, shandy, alcoholic beverages" are identical to the "Retail services in relation to alcoholic beverages" for which the trademark invoked is registered in class 35.

38. The other contested retail services in class 35 are similar to the services "catering in restaurants, serving food and drink in restaurants and bars, catering in cafés" for which the invoked trademark is registered in class 43. Both types of services concern the provision of drinks and are frequently offered together. Given the overlap in nature and purpose, the Office considers these services similar.

¹⁰ General Court (EU) 8 December 2021, T-595/19, ECLI:EU:T:2021:866, points 54-58 (GRILLOUMI BURGER).

¹¹ General Court (EU) 8 December 2021, T-595/19, ECLI:EU:T:2021:866, points 54-58 (GRILLOUMI BURGER).

¹² Grand Board of Appeal EUIPO 13 April 2022, R 964/2020-G, points 76-87 and 99 (ZORAYA/VINA ZORAYA).

Conclusion

39. The goods and services concerned are partly identical, partly similar and partly similar to a limited degree.

Global assessment

40. 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.¹³ In the present case, the goods and services concerned are aimed at the public at large for which the level of attention is deemed to be normal.

41. 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.¹⁴ In the present case the invoked trademark has to be considered as having normal distinctiveness for the goods and services concerned as it does not describe the characteristics of the goods and services in question.

42. 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.¹⁵

43. In this case the signs are visually, phonetically and conceptually identical. The relevant goods and services are partly identical, partly similar and partly similar to a limited degree. 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 goods and 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

44. Defendant indicates that he wants to limit the contested International trademark application (see paragraph 14 above).¹⁶ However, it has not been shown that defendant actually limited its International trademark application through the designated WIPO form.¹⁷ Since the Office must rely on registry data, the intended limitation cannot be taken into account. The Office furthermore notes that the intended limitation had not affected the outcome of these opposition proceedings.

45. Defendant argues that its products, powdered mushrooms, and (online) services are completely different from the products and services of opponent (see paragraphs 15-16 and 18). However, actual use

¹³ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, punt 59 and the case-law mentioned there (Equivalenza).

¹⁶ It does not follow clearly from defendant's arguments whether it seeks to delete or limit class 35 (see paragraphs 14 and 18 above).

¹⁷ https://www.wipo.int/madrid/en/how_to/manage/limitation.html

cannot be considered in opposition proceedings, as the comparison of the goods and services is solely based on the trademark and sign as registered (see paragraph 31 above).

46. On 11 January 2023 and 17 April 2023 opponent filed recent decisions of the EUIPO and INPI and asked the Office to provide parties the opportunity to provide further arguments. Rule 1.14 IR strictly regulates when parties have an opportunity to submit arguments. In view of this, the decisions and the request of opponent which were submitted after the administrative phase was completed will be disregarded.

B. Conclusion

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

48. Since the opposition will be granted on the basis of article 2.2ter, 1, b BCIP the Office will not judge the opposition on the basis of article 2.2ter, 1, a BCIP (see article 1.14, 1, i IR).

IV. DECISION

49. The opposition with number 2018035 is justified.

50. The International application with number 1649464 will not be granted for the Benelux for the following goods and services:

- Class 29 (all goods)
- Class 30 (all goods)
- Class 32 (all goods)
- Class 33 (all goods)
- Class 35: "*Retail services connected with the sale of beers, soft drinks, mineral and aerated waters, non-alcoholic drinks, fruit drinks and fruit juices, syrups for making beverages, shandy, non-alcoholic beers and wines, alcoholic beverages.*"

51. The International application with number 1649464 will be granted for the Benelux for the following goods and services as the opposition was not directed against these goods and services:

- Class 3 (all goods)
- Class 5 (all goods)
- Class 35: "*Advertising, marketing and sales promotions; online ordering services; retail services connected with the sale of skin care preparations, make-up, moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts containing make-up, sunscreen creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes, pharmaceuticals and natural remedies, herbal beverages for medicinal use, dietary supplements, nutritional supplements, probiotic supplements, protein dietary supplements, vitamins, health food supplements made principally of minerals or vitamins, nutritional supplement meal replacement bars for boosting energy, vitamin drinks, disinfectants and antiseptics, anti-viral agents, anti-bacterial preparations, anti-viral and anti-bacterial gels, medicated and sanitising soaps and detergents, sanitizing wipes, mobile apps, recorded content, media content, computer software, CD ROMs, DVDs, audio and audio-visual recordings, pre-recorded videos, electronic publications, podcasts, downloadable publications, parts and fittings for the aforesaid goods, clothing, footwear, headgear, dried edible mushroom*"

in powdered form, processed mushroom and mushroom mycelium in powdered form, fresh, preserved, tinned, chilled, frozen and cooked meat, fish, poultry and game, meat and fish extracts, seafood, crustaceans and molluscs, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, prepared meals and snacks made principally from meat, fish, seafood, molluscs, crustaceans, poultry or game, soups, preserved, frozen, dried and cooked fruits, nuts and vegetables, jellies, jams, compotes, dairy products and substitutes for dairy products, crisps, potato crisps, food and prepared snack products made from dried fruits, nuts and processed seeds, coffee, tea, cocoa, herbal preparations for making beverages, sugar, tapioca, sago, artificial coffee, culinary herbs, herbal infusions, herbal honey, seasonings, sauces, chutneys and pastes, marinades, spices, bakery goods, yeast, baking powder, rice, pasta, pizzas, pies and pasta dishes, spaghetti and spaghetti-based dishes, rice-based dishes, flour and preparations made from cereals, bread, pastry, confectionery, ices, chocolate and desserts, puddings, sandwiches, cereal and energy bars, cereals, biscuits, cakes, snack bars containing grains, seeds, nuts or dried fruit, food mixtures consisting of cereal flakes and dried fruits, nut confectionery, coated nuts [confectionary], fresh herbs, fresh fruits and vegetables, raw and unprocessed agricultural, aquacultural, horticultural and forestry products, raw and unprocessed grains and seeds, unprocessed rice, natural plants and flowers, foodstuffs for animals; business management; business franchise services; data management services; consultancy, information and advisory services to all the aforesaid services.”

52. 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, 24 April 2023

Marjolein Bronneman
(*rapporteur*)

Pieter Veeze

Tineke Van Hoey

Administrative officer: Rémy Kohlsaet