

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018445
of 12 October 2023

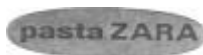
Opponent: **FFAUF ITALIA S.P.A.**
Via Castellana 34
31039 RIESE PIO X (TV)
Italy

Representative: **Noordzij Partners B.V.**
Postbus 76842
1070 KC Amsterdam
Netherlands

Trademark invoked 1: **International trademark 525926**



Trademark invoked 2: **International trademark 540729**



against

Defendant: **INDUSTRIA DE DISEÑO TEXTIL S.A., en abrégé**
INDITEX S.A., société anonyme
Avda. De la Disputacion
15142 Arteixo (A Coruna)
Spain

Representative: **BAKER & MCKENZIE CVBA**
Borsbeeksebrug 36 box 8
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Belgium

Contested sign: **Benelux application 1470753**
ZARA

I. FACTS AND PROCEEDINGS

A. Facts

1. The opposition is directed against the Benelux trademark application for the word trademark ZARA which was filed as an EU trademark on 5 March 2010, converted into a Benelux trademark and published by the Office on 23 September 2022.

2. On 21 November 2022, the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:

- International trademark 525926 designating, among others, the Benelux territory, filed and registered on 22 August 1988 for goods in class 30, for the semi-figurative trademark



- International trademark 540729 designating, among others, the Benelux territory, filed and registered on 25 July 1989 for goods in class 30, for the semi-figurative trademark



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

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

5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 23 November 2022. During the administrative phase of the proceedings both parties filed arguments. All the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 8 May 2023.

II. 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 the relevant trademarks and of the goods or services concerned.

A. Opponent's arguments

8. Regarding the comparison of the goods and services covered by the trademarks concerned, the opponent, having analysed them in detail, considers these goods and services to be similar.

9. Regarding the comparison of the trademarks concerned, the opponent considers that even though the figurative elements are co-dominant in size and will catch the consumer's attention, the representation of a woman with a sheaf of wheat or a rural landscape or field for foodstuffs including the descriptive word

"pasta" in relation to goods in class 30, does not have any degree of distinctiveness, and the circle and oval merely play a background function. Even though the different figurative elements of the trademarks invoked create certain minor visual differences, these features are insufficient to counterbalance the high visual similarity created by the identical common dominant and very distinctive word element "ZARA", which is the most distinctive element of the trademarks invoked and is the only element of the contested sign. The opponent finds that the word "pasta" in the trademarks invoked is descriptive and is not the dominant element. Therefore, since the trademarks concerned all consist of the dominant and most distinctive element "ZARA", the signs are visually highly similar.

10. Phonetically, the opponent considers that the figurative elements of the trademarks invoked have no bearing since the relevant public has no reason to refer to them in addition to the word elements. Since the only word element of the contested sign is identical to the most distinctive word element in the trademarks invoked, the opponent finds the signs to be almost identical. According to the opponent, the descriptive character of the first word element "pasta" of the trademarks invoked is of less importance. This difference does not detract from the overall aural high similarity, due to the identical distinctive word ZARA. The opponent concludes that the signs are phonetically highly similar.

11. Conceptually, the opponent states that the word element "ZARA", even if perceived as a female name by part of the relevant public, does not have any meaning in relation to the goods and services concerned and is the most distinctive and dominant element of both trademarks invoked. Therefore, the conceptual comparison is not possible or remains neutral.

12. In light of the above, the fact that the average consumer normally perceives a trademark as a whole and does not proceed to an analysis of its various details and the principle of interdependence, the opponent is of the opinion that there is a likelihood of confusion.

13. For the above-mentioned reasons, the opponent requests the Office to reject the contested sign and to order that the defendant shall bear the costs.

B. Defendant's arguments

14. The defendant considers that despite certain overlaps and potential connections, many of the goods and services in question are dissimilar or only slightly similar. The defendant claims that many of the goods in Class 29 (e.g., preserved, frozen, dried, and cooked fruits and vegetables) are dissimilar to Class 30 goods (e.g., pasta). The defendant argues that the nature, intended purpose, and method of use for these goods differ significantly, making them unlikely to be found together in a supermarket. The defendant contends that "jellies, jams, compotes" in Class 29 are also dissimilar to pasta due to their different characteristics and uses. These products are typically used for desserts or breakfast, unlike pasta.

15. Regarding class 30, the defendant highlights that complementarity does not apply when one ingredient, like flour or salt, is needed to produce another foodstuff, such as pasta. Complementarity concerns the use of goods, not their production process. Furthermore, the mere fact that the compared goods are both foodstuffs does not make them similar. They have different methods of use, are not in competition, are typically sold in different sections of supermarkets, and are produced by different manufacturers. Additionally, they are primarily ingredients used to prepare dishes rather than foodstuffs for immediate consumption. The defendant also mentions a recent decision by the China National Intellectual Property Administration confirming that not all goods in Class 30 are similar. The defendant concludes that most of the contested goods in Class 30 are used as ingredients for foods, while the goods of the opponent are finished products. The mere fact that one good may be needed for the preparation of another is not sufficient to establish similarity.

16. Regarding class 35, the defendant explains that the contested services involve retail and wholesale services related to some of the goods in Classes 29 and 30. According to established case law, complementary goods or services are those closely connected, where one is indispensable or important for the use of the other, suggesting that they are produced by the same entity. However, the defendant argues that merely offering retail services for some goods covered by the trademarks invoked does not automatically make those services similar to the goods in Class 30 of the trademarks invoked. Consequently, the defendant asserts that there is no similarity between the goods covered by the trademarks invoked and the contested services in Class 35.

17. According to the defendant, the contested services in class 43 (catering services) are not similar to the goods in Class 30 of the trademarks invoked. The defendant argues that consumers do not perceive them as a uniform service package. The defendant emphasizes that the mere fact that food and drinks are consumed in a restaurant is not enough to establish similarity between them. While there can be situations where they are complementary, the defendant argues that consumers do not automatically assume that the same entity is responsible for producing both goods and providing restaurant services. Additionally, the defendant mentions a judgment by the Swiss Federal Administrative Court, which granted a trademark for "ZARA" in a similar case, highlighting differences between pasta products and catering/restaurant services.

18. The defendant is of the opinion that the Zara brand does distinguish high-quality goods at affordable prices and therefore targets consumers in the medium economic bracket. The far from exclusive character of the marked products means the targeted public is a wide range of consumers over the world and specifically in the Benelux. Therefore, the defendant concludes that the level of attention will be low or rather average depending on the price, specialised nature, or terms and conditions of the goods and services purchased, as well as the capacity in which the relevant public is acting.

19. The trademarks invoked are found to be partly descriptive by the defendant, leading to a lower-than-average level of distinctiveness.

20. Visually, the defendant states that the trademarks invoked consist of both word and figurative elements, while the contested sign only contains a word element. The defendant highlights that the word element in a trademark is generally considered more distinctive than the figurative element because consumers tend to refer to goods by their name rather than their visual appearance. The defendant also refers to similar cases where trademark applications were refused due to visual differences despite sharing an identical word element. The defendant concludes that there is a visual similarity between the trademarks invoked and the contested sign to an average degree, primarily due to the shared word element "ZARA".

21. Phonetically, the defendant notes the trademarks concerned are identical for the word "ZARA". However, a notable difference arises because the trademarks invoked contain the word "pasta" preceding "ZARA". Despite "pasta" being descriptive, the defendant finds that it will likely be pronounced by consumers, creating an aural contrast with the contested sign. As a result, the signs are considered phonetically similar but to an average degree.

22. Conceptually, the defendant argues that the opponent's assertion that a conceptual comparison is not possible or remains neutral is incorrect. He emphasizes that the word "ZARA" has a powerful conceptual impact and a specific semantic content for the public due to its exceptional reputation as a leading fashion brand. The defendant quotes various sources and rankings to support the claim of ZARA's widespread recognition and reputation. Ultimately, the defendant concludes that the signs in question are conceptually dissimilar to a significant degree due to the strong conceptual association of the word "ZARA" with the well-known fashion brand.

23. In the context of an overall assessment of the similarity of the sign, the defendant highlights the rule of conceptual neutralization, where a conceptual difference between marks can counteract their visual and phonetic similarities, leading to dissimilarity. Several cases are cited to support this principle. The defendant finds the word "ZARA" has a clear and specific meaning for the relevant public, referring to the well-known fashion and lifestyle company of the defendant. The opponent's trademarks invoked do not have such a meaning. Therefore, conceptual neutralization applies, and there is no likelihood of confusion between the marks. The reputation of the "ZARA" brand reinforces this argument. The fact that "ZARA" does not coincide with the defendant's legal name (INDITEX, S.A.) is deemed irrelevant, as the public associates the company itself with "ZARA".

24. In conclusion, considering all these factors, especially the exceptional reputation, notoriety, and clear meaning associated with the ZARA brand, the defendant finds that the degree of similarity between the trademarks concerned is not significant enough for the relevant public to believe that the goods and services in question originate from the same undertaking or from economically related undertakings.

25. For the above-mentioned reasons, the defendant requests the Office to declare the opposition unfounded, to allow the registration of the contested sign for all goods and services, to order the opponent to pay the costs in accordance with article 2.16 (5) BCIP.

III. DECISION

A.1 Likelihood of confusion

26. 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.

27. 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

28. 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

29. 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

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 and the case-law mentioned there (Equivalenza).

Comparison of the goods and services

30. 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.⁴

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.⁵

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

Opposition based on:	Opposition directed against:
CI 30 Fresh, dry, preserved, deep-frozen, ready-to-use pasta.	CI 29 Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; milk products; edible oils and fats.
	CI 30 Rice, tapioca, sago, flour and preparations made from cereals (with exception of pasta), bread, pastry, yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; rice-based snack food.
	CI 35 Retailing and wholesaling in shops, selling via global computer networks, by catalogue, by mail order, by telephone, by radio and television and via other electronic means of preserved, frozen, dried and cooked fruits and vegetables, edible oils, rice, flour and preparations made from cereals, bread, vinegar, sauces (condiments).
	CI 43 Restaurant services (food), self-service restaurants, cafeterias.

Classes 29 and 30

33. The contested *rice* is similar to a certain degree to the opponent's goods as they have the same purpose. They all consist of staple food. The goods serve the same nutritional purposes, have the same method of use and target the same consumers. They are in competition as they may be consumed as alternatives. Moreover, they can be found in the same shops or sections of supermarkets and can be produced by the same undertakings.

34. The contested *preparations made from cereals (with exception of pasta); rice-based snack food* are similar, at least to a low degree, to *fresh, dry, preserved, deep-frozen, ready-to-use pasta* since these goods can be offered in ready-to-eat form and are, for that reason, similar to *ready-to-use pasta* covered by the trademark invoked. The goods have the same purpose and similar natures and can have the same

⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁵ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

origin and distribution channels. Moreover, these goods target the same public, can be in competition and are substitutable and compete with each other.⁶

35. The contested *preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; milk products; edible oils and fats; bread, pastry; tapioca, sago, flour, yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices* are dissimilar to all goods covered by the trademarks invoked. According to case-law, no similarity can generally be established between an ingredient and a foodstuff prepared thereof⁷, let alone between two ingredients used for the preparation of a foodstuff. The fact that the goods can be categorised as foodstuffs is insufficient and adopting such a broad criterion would mean considering a very large number of food products to be similar to one another, even though they have specific features that clearly distinguish them from one another. The fact that these goods can be combined with the opponent's goods does not render them similar. They have different natures, purposes, distribution channels and are usually manufactured by different undertakings with specific expertise and know-how. They are neither complementary to, in the sense that each of them is not indispensable or essential to the consumption of the others, nor in competition with each other.

Class 35

36. In general, goods and services are different in nature. While goods are tangible merchandise (that can be passed from one person to another), services are activities carried out by professionals. The use to which products and services is put also differs. However, both goods and services can be entirely complementary: indeed, certain services cannot be performed without the use of certain goods.

37. In this context, it should be remembered that complementarity only exists when the goods and/or services are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may believe that the same undertaking is responsible for both.⁸

38. In the present case, there is no question of complementarity. Indeed, the contested sign's retail services do not relate to the products covered by the trademarks invoked. In other words, the goods of the trademark invoked are in no way important or indispensable for retail services.

39. These goods and services are therefore neither complementary nor similar.

Class 43

40. The opponent's goods are similar to a low degree to the contested services as they can coincide in producer/providers and distribution channels and are complementary.

41. It follows from the case-law that foodstuffs, broadly speaking, including goods in Classes 29 and 30, on the one hand, and restaurant services, on the other, have, despite their differences, a certain degree of similarity, since (i) the foodstuffs concerned are used and offered in the context of restaurant services, so that there is complementarity between those goods and services, (ii) the restaurant services can be offered in the same places as those in which the foodstuffs concerned are sold and (iii) the foodstuffs concerned may originate from the same undertakings or from economically linked undertakings which market packaged goods, or from restaurants which sell ready-made food to take away.⁹

⁶ General Court (EU) 4 octobre 2016, T-549/14, EU:T:2016:594, point 90 (CASTELLO).

⁷ General Court (EU) 26 October 2011, T-72/10, EU:T:2011:635, points 35-36 (Naty's).

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

⁹ General Court (EU) 1 December 2021, T-467/20, ECLI:EU:T:2021:842, points 128-131 (ZARA).

42. In the present case, the Office finds that the goods covered by the trademarks invoked could be sold in the same places as those in which the services relating to the sale of the goods were offered. Consumers are likely to be the same and the goods and services in question are in competition with each other, as the consumer had the choice between purchasing foodstuffs and consuming them at home or visiting a restaurant, including a self-service restaurant or a cafeteria.

Conclusion

43. The goods and services covered by the contested sign are partly identical and partly similar to the goods covered by the trademarks invoked.


Comparison of the signs

44. 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.¹⁰

45. 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.¹¹ 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 of 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.¹²

46. The assessment of the similarity between the signs, regarding the visual, phonetical 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.

47. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	ZARA

¹⁰ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

¹¹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

¹² 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 comparison

48. The first trademark invoked is a semi-figurative trademark containing the word elements "PASTA" and "ZARA" in an oval shape, inside a circle also containing the representation of a woman with a sheaf of wheat or a rural landscape or field. The second trademark invoked is a semi-figurative trademark containing the word elements "PASTA" and "ZARA" in an oval shape.

49. The contested sign is a verbal trademark consisting of the word element "ZARA".

50. The Office recalls that the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression produced by the trademark.¹³ Since the trademarks invoked only designate pasta in class 30, the term "PASTA" is clearly not a dominant element, making the term "ZARA" the only dominant verbal element.

51. Where a sign is composed of verbal and figurative elements, the former should be, in principle, regarded as more distinctive than the latter, since the average consumer will more readily refer to the goods and/or services in question by citing the name than by describing the figurative elements of the sign.¹⁴ In the present case, although the figurative elements in the first trademark invoked are not negligible¹⁵, the consumer's attention will be directed primarily to the word elements "PASTA ZARA", given its size and position within the sign. Regarding the second trademark invoked, the figurative elements will be perceived merely as decorative elements emphasizing the words "PASTA ZARA".

52. Two trademarks are generally similar if, from the point of view of the relevant public, they are at least partly similar as regards one or more relevant aspects.¹⁶ This is particularly true if the element common to the trademarks retains an independent distinctive place in the composite sign.¹⁷ In the present case, the single word of the contested sign "ZARA" is an integral part of the trademarks invoked and retains an independent distinctive place in them.

53. Visually, the signs coincide in the word "ZARA" and differ in the non-dominant word "PASTA" and the figurative element of the trademarks invoked. The trademarks are visually similar to a certain degree.

Phonetical comparison

54. As regards the phonetic comparison, it should be borne in mind that, strictly speaking, the phonetic reproduction of a complex sign consists of the reproduction of all its verbal elements, irrespective of their graphic specificities, which are more a matter for the visual analysis of the sign.¹⁸

55. The pronunciation of the signs coincides in the word "ZARA", present identically in both signs. As explained above, it constitutes the entirety of the contested sign and the most distinctive element of the trademarks invoked. The pronunciation differs in the word "PASTA", which is secondary in the sign.

56. The trademarks are phonetically similar.

¹³ General Court (EU) 3 July 2003, T-129/01, ECLI:EU:T:2003:184, point 53 (Budmen).

¹⁴ General Court (EU) 14 July 2005, T-312/03, ECLI:EU:T:2005:289, point 37 (SELENIUM-ACE).

¹⁵ Court of Appeal of The Hague 11 September 2012, 200.105.827/0, ECLI:NL:GHSGR:2012:BX8916 (MOOVE-4MOVE).

¹⁶ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, point 30 (Matratzen) ; CJEU 11 November 1997, C-251/95, ECLI:EU:C:1997:528, point 6 (Sabel).

¹⁷ CJEU 6 October 2005, C-120/04, ECLI:EU:C:2005:594, point 37 (Thomson Life).

¹⁸ General Court (EU) 25 May 2005, T-352/02, ECLI:EU:T:2005:176, point 42 (PC Works) ; and 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

Conceptual comparison

57. The Office recalls that the public will not consider a descriptive element forming part of a complex trademark as the distinctive and dominant element of the overall impression produced by the trademark.¹⁹ Regarding the word "PASTA" in the trademarks invoked, it refers to the covered products in class 30.

58. Both signs contain the word "ZARA" as a dominant element, which will be perceived by the Benelux public as a feminine first name Benelux public. In principle, a first name has no specific meaning. This is only the case when the name in question has become a conceptual symbol, for example due to the familiarity of the person bearing the name, or when the name in question has a clear and immediately.²⁰

59. Given that the trademarks at issue contain as a dominant element the identical first name "ZARA", the Office considers that, despite the other elements included in the trademarks invoked which have no equivalent in the contested sign, a certain conceptual similarity must be retained.

Conclusion

60. The trademarks are phonetically similar, and visually and conceptually similar to a certain degree.

A.2 Global assessment

61. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the trademarks are important factors.

62. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. It should also be considered that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question and that the average consumer only rarely has the chance to make a direct comparison between the different trademarks but must place his trust in the imperfect picture of them that he has kept in his mind.²¹ In the case at hand, the goods and services considered identical/similar are everyday consumer products and services. They are aimed at the general public with an average level of attention.

63. The more distinctive the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than trademarks with a less distinctive character.²² In the present case, the Office is of the opinion that the trademarks invoked has normal distinctive character, given that they do not describe a characteristic of the goods in question.

64. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors that have to be taken into account, particularly between the level of similarity of the signs and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa.²³

¹⁹ General Court (EU) 3 July 2003, T-129/01, ECLI:EU:T:2003:184, point 53 (Budmen).

²⁰ The Hague Court of Appeal 30 June 2015, 200.158.420-01, ECLI:NL:GHDHA:2015:1845 (Dean Rich).

²¹ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

²² CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

²³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there (Equivalenza).

65. The trademarks are visually, phonetically and conceptually similar to varying degrees. The goods and services in question are partly similar to different degrees and partly dissimilar. Based on the aforesaid and in view of their correlation, the Office considers that the relevant public may believe that the goods and services, considered similar, come from the same undertaking or from economically linked undertakings.

B. Other factors

66. The defendant considers that the contested sign has a clear meaning because of its reputation and, therefore, this meaning neutralizes the visual and phonetic similarities between the trademarks. In this respect, he invokes the reputation of the contested sign, which he believes will eliminate any likelihood of confusion (see points 22-24). This argument cannot prosper because reputation is relevant in assessing whether there is a likelihood of confusion as regards the earlier trademark, but that is not the case in respect of the assessment of the distinctiveness of the contested sign. It follows from the case-law that the highly distinctive character of a sign is relevant only in respect of the earlier trademark and not the later trademark.²⁴

67. With regard to the defendant's reference to the case law of other jurisdictions (see points 15, 17 and 23), the Office points out that it is obliged to render an independent decision based on regulation and case law applicable in the Benelux. The Office is not bound by decisions from other offices/jurisdictions, whether they refer to similar cases or not.

²⁴ General Court (EU) 1 December 2021, T-467/20, ECLI:EU:T:2021:842, points 145 (ZARA).

C. Conclusion

68. Based on the foregoing the Office concludes that there exists a likelihood of confusion.

IV. CONSEQUENCE

69. The opposition with number 2018445 is partially justified.

70. Benelux application with number 1470753 is not registered for the following goods and services:

Class 30: Rice; preparations made from cereals (with exception of pasta); rice-based snack food.

Class 43: Restaurant services (food), self-service restaurants, cafeterias.

71. Benelux application 1470753 is registered for the following goods and services:

Class 29: Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; milk products; edible oils and fats.

Class 30: Tapioca, sago, flour, yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; bread, pastry.

Class 35: Retailing and wholesaling in shops, selling via global computer networks, by catalogue, by mail order, by telephone, by radio and television and via other electronic means of preserved, frozen, dried and cooked fruits and vegetables, edible oils, rice, flour and preparations made from cereals, bread, vinegar, sauces (condiments).

72. Since the opposition is partially justified, neither party is liable for costs pursuant to article 2.16 (5) BCIP in conjunction with rule 1.28 (3) IR. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.

The Hague, 12 October 2023



Flavie Rougier
rapporteur

Tineke Van Hoey

Pieter Veeze

Administrative officer:

Vincent Munier