

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2013150
of 11 February 2019

Opponent: **MERITEM, S.A.**
Pol. Ind. Les Comes C. d'Irlanda 4, Parcela 188
08700 Igualada (Barcelona)
Spain

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

Invoked right 1: **EU trademark 99333**



Invoked right 2: **EU trademark 10070878**



against

Defendant: **GENERALE BISCUIT, société par actions simplifiée**
6 Av. Réaumur
92140 Clamart
France

Representative: **HGF B.V.**
Gedempt Hamerkanaal 147
1021 KP Amsterdam
Netherlands

Contested trademark: **Benelux application 1351346**

PAILLE D'OR


I. FACTS AND PROCEEDINGS

A. Facts


1. On 31 March 2017 the defendant filed an application for a trademark in the Benelux for the wordmark PAILLE D'OR for goods in class 30. This application was processed under number 1351346 and was published on 6 April 2017.

2. On 6 June 2017 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:



- EU trademark 99333, the combined word/figurative mark , filed on 1 April 1996 and registered on 29 April 1998 for goods and services in classes 21, 29, 30, 42.



- EU trademark 10070878, the combined word/figurative mark , filed on 23 June 2011 and registered on 22 December 2011 for goods and services in classes 29, 30 and 39.

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

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

5. The grounds for opposition are those laid down in article 2.14, 1 (a) the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 7 June 2017. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 28 February 2018.

II. ARGUMENTS

8. The opponent filed an opposition at the Office under article 2.14, 1 (a) BCIP, in accordance with the provisions of article 2.3 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. The opponent argues that in the trademarks invoked, the figurative elements are not dominant. The verbal element 'PAELLADOR' is clearly perceptible, as it constitutes a significant part in both signs compared to the figurative element. According to the opponent, the words PAELLADOR and PAILLE D'OR are visually similar.

10. With regard to the aural comparison, the opponent states that the pronunciation of the signs coincides in the sound of the first two syllables, as well as the last syllable. For this reason, the signs are aurally similar.

11. The opponent states that both signs, as a whole, do not have any meaning. However, in this case, both signs share the suffix DOR/D'OR. The opponent argues that for the French speaking part of the public in the Benelux, it will be very clear that this element refers to gold/golden. Furthermore, it will not be unlikely that the Dutch speaking part of the public will also know the meaning of DOR/D'OR. According to the opponent, the French speaking part of the public will also understand that the word paella refers to a Spanish rice dish and that the word paille is French for 'straw'. For this reason, the opponent concludes that for part of the public the signs share the conceptual reference to gold/golden and are therefore conceptually similar to a certain extent. With regard to the part of the public for which the element DOR/D'OR, or maybe the entire sign, has no meaning, a conceptual comparison is not relevant. The opponent also states that in this case, the visual and aural similarities are not neutralized by semantic differences, because the signs do not have a clear and fixed meaning which will be immediately understood by the relevant public.

12. According to the opponent, the goods and services of the trademarks invoked are identical or (highly) similar to the goods of the contested sign.

13. With regard to the distinctiveness of the trademarks invoked, the opponent argues that the signs, considered as a whole, have no meaning in relation to any of the goods concerned. For this reason, the distinctiveness of the trademarks invoked must be seen as normal.

14. The opponent concludes that there exists a risk of confusion and requests that the Office upholds the opposition and refuses the registration of the contested sign.

15. At the request of the defendant, the opponent filed proof of use for both trademarks invoked.

B. Defendant's arguments

16. With respect to the proof of use the defendant states that the documents submitted by the opponent are insufficient to prove use for the goods and services in the relevant territory, the European Union. According to the defendant, the documents mainly show that the trademark invoked is mentioned as a company name. The defendant also argues that it has not been proven that the packaging of the goods concerned depicts the trademark invoked. Furthermore, the defendant states that a significant part of the evidence does not contain any indication of the place, time, extent and manner of use of the earlier trademarks. In the unlikely event that it is determined that the evidence submitted does show use of the trademarks invoked, the defendant is of the opinion that this is, at best, use in respect of the goods 'paella' only.

17. The defendant states that the word elements of the trademarks invoked contain several differences compared to the contested sign. Furthermore, the figurative elements cannot be disregarded. According to the defendant, the signs are not similar from a visual perspective.

18. Aurally, the difference lies within the pronunciation of the first element of the signs, namely [paɛlja] for “paella” and [paije] for “paille”. Furthermore, the second trademark invoked also contains the word ‘group’ which is not present in the contested sign. According to the defendant, these differences are sufficient to render the marks aurally different.

19. The defendant states that it is highly probable that the relevant public will be able to recognize the term ‘paella’, which is present only in the trademarks invoked and not in the contested sign. The defendant points out that the word PAELLADOR is for the most part 100% descriptive of paella. The only elements that stand out are thus the figurative elements, which have no respective counterpart in the contested sign. According to the defendant, the contested sign has a completely different semantic content, because the relevant public will associate the term ‘paille’ with ‘straw’ and the term ‘d’or’ with ‘golden’. For this reason, the signs are conceptually different.

20. With regard to the comparison of the goods and services, the defendant argues that the opponent has not proven that the goods and services of the trademarks invoked have genuinely been used in the relevant period. At the very best, use may have been shown in relation to the goods ‘paella’. According to the defendant, paella is a product or dish of a completely different nature to all of the contested goods in class 30. For this reason, the goods are not similar.

21. The defendant further argues that the opponent has not explicitly claimed that the trademarks invoked are particularly distinctive by virtue of intensive use or reputation. The defendant therefore states that, since the trademarks invoked clearly refer to ‘paella’, for which the signs are registered (and used on a very small scale), the distinctiveness of these signs must be considered as low. Furthermore, the element ‘D’OR’ in both signs is also not particularly strong, because of its laudatory meaning.

22. The defendant also argues that, in general, the beginning of a trademark has more impact on the consumer in terms of impression and perception, than the ending of it. Therefore, the relevant consumer will concentrate more on the first part of the signs concerned, which are the elements ‘paella’ and ‘paille’, and will not believe that the mark PAILLE D’OR is derived from the marks PAELLADOR or PAELLADOR GROUP.

23. In the light of the above, the defendant concludes that there exists no likelihood of confusion and requests that the Office rejects the opposition.

III. DECISION

A.1 Proof of use

24. Articles 2.16, 3 (a) and 2.26, 2 (a) BCIP and rule 1.29 IR stipulate that the right invoked should be put to genuine use within the Benelux territory for a continuous period of five years prior to the publication date of the sign against which the opposition is lodged. The contested sign was published on 6 April 2017. Therefore the opponent was required to show use of the trademarks invoked during the period from 6 April 2012 to 6 April 2017 (‘the relevant period’).

25. Given the fact that the rights invoked were registered more than five years prior to the publication date of the contested sign, the defendant’s request that proof of use is submitted is legitimate.

26. Following rule 1.29 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the earlier trademark for the goods and services on which the opposition is based.

In general

27. In accordance with the decision of the European Court of Justice (hereinafter referred to as “ECJ”) of 11 March 2003 (ECJ, Ansul, C-40/01, ECLI:EU:C:2003:145) there is genuine use of a trademark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered. This is done in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (see also General Court of the European Union (hereinafter referred to as “EGC”), Silk Cocoon, T-174/01, 12 March 2003, ECLI:EU:T:2003:68; EGC, Vitafruit, T-203/02, 8 July 2004, ECLI:EU:T:2004:225; EGC, Charlott, T-169/06, 8 November 2007, ECLI:EU:T:2007:337).

28. The EGC held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (EGC, Hipoviton, T-334/01, 8 July 2004, ECLI:EU:T:2004:223; EGC, Sonia-Sonia Rykiel, T-131/06, 30 April 2008, ECLI:EU:T:2008:135). The purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trademark protection to the cases where large-scale commercial use has been made of the mark (EGC, Vitafruit, already referred to above).

29. In addition the EGC held that genuine use of a trademark cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned (see EGC, Hiwatt, T-39/01, 12 December 2002, ECLI:EU:T:2002:316; EGC, Vitakraft, T-356/02, 6 October 2004, ECLI:EU:T:2004:292 and EGC, Sonia-Sonia Rykiel, already referred to above).

30. The trademark invoked is an EU trademark (previously: Community trade mark), hence the obligation to use the trademark is administered by article 15 of Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015. This article, entitled “Use of European Union trademarks”, stipulates: *“If, within a period of five years following registration, the proprietor has not put the European Union trade mark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the European Union trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for nonuse.”*¹

¹ Regulation (EC) No 207/2009 of the Council of 26 February 2009 on the European Union trade mark (hereinafter EUTMR) has been adapted by the Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015. This did not change the first paragraph of article 15, except for the replacement of the terms “Community trade mark” and “Community” by respectively “European Union trade mark” and “Union”.

31. In its decision of 19 December 2012 (case C-149/11, Onel, ECLI:EU:C:2012:816), the ECJ explained this provision. The ECJ considers regarding the concept “in the Community” that there is a difference between the territorial extent of the protection conferred on national trademarks and the extent of the protection conferred on EU trademarks. From a territorial point of view, an EU trademark enjoys a more extensive scope of protection than a national trademark. As a consequence it may reasonably be expected that an EU trademark can be used in a larger area, except for the (exceptional) case where the market for the goods and services at issue has been territorially restricted. Abstraction should be made here of the boundaries of the territory of the Member States. The ECJ concludes:

“A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

32. The threshold for genuine use of an EU trademark is therefore in principle higher than that for genuine use of a national (or Benelux) trademark. It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU and taking into account all relevant facts and circumstances.

Analysis of the proof of use

33. The opponent submitted the following exhibits in order to demonstrate the genuine use of the trademarks invoked in the European Union:

- 1) Copies of cardboard covers for dishes with preparation instructions for paella, not dated;
- 2) Leaflets and posters displaying the trademarks invoked, not dated;
- 3) Several online news articles and print-outs from the opponent’s website containing information about the opponent during 2013-2015;
- 4) Photos of opponent’s exhibition stand at trade fairs, not dated;
- 5) Photos of prepared meals which are displayed on Google ®;
- 6) Copies of menus, showing paella dishes, from various restaurants in the European Union;
- 7) Copies of 52 invoices sent to clients in several different countries in the European Union, such as Spain, Italy, France, United Kingdom and Portugal, dated between April 2012 and April 2017;
- 8) Photos of sticker labels which show the indication PAELLADOR, as well as a description of a paella dish, a date and a product number.

34. The Office firstly points out that a substantial part of the evidence is not dated and/or does not clearly show the extent, place and duration of use of the trademarks invoked with regard to the goods and services concerned (exhibits 1, 2, 4, 5 and 6). However, the invoices and general company information show that the opponent is active in numerous European Union member states, namely Spain, Italy, France, United Kingdom, Portugal, Ireland, Belgium and Hungary (exhibits 3 and 7). Furthermore, several products described on the invoices refer to various foodstuffs of which the product numbers correspond to the number and description mentioned on the sticker labels (exhibit 8). These sticker labels also show the word PAELLADOR, as well as a description of a certain type of paella dish. The exhibits further show that the issue at hand concerns precooked paella dishes that are sold to restaurants and which only need to be reheated before serving to customers. The Offices therefore finds that the pieces of evidence, considered in relation to each other, sufficiently show that in the European Union around 4800 prepared paella dishes², have been sold under the indication PAELLADOR during the relevant period.

35. Although the sales figures themselves are very modest in view of the market for foodstuffs in the European Union, the Office is of the opinion that the figures exceed the threshold for mere token sales and show that this use is more than only symbolic use in a substantial part of the European Union. As mentioned above the purpose of the notion of genuine use is not to assess commercial success or to review the economic strategy of an undertaking. The assessment is made in order to establish if the registered trademark has been put to use to fulfill its essential function as a badge of origin in a way that exceeds mere token use, i.e. use for the sole purpose of preserving the rights conferred by the mark.

36. Therefore, after careful analysis of all of the proof of use provided, the Office concludes that the evidence submitted, at the very most, shows genuine use for the following goods mentioned in class 30 of the second trademark invoked, namely '*Paella, prepared, precooked, preserved*'. The first trademark invoked is not registered for these goods. For this reason the Office will continue with the assessment of the likelihood of confusion based on the second trademark invoked.

A.2 Likelihood of confusion

37. In accordance with article 2.14, 1 BCIP, the applicant or 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 2.3 (a) and (b) BCIP.

38. Article 2.3 (a) and (b) BCIP stipulates that "*In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in: a. identical trademarks filed for identical goods or services; b. identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark.*"

² Around 1400 in Spain, 1200 in the United Kingdom, 1000 in France, 700 in Portugal, 370 in Italy, 60 in Ireland, 50 in Belgium and 20 in Hungary.

39. According to case law of the ECJ concerning the interpretation of Directive 2008/95/EG of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks (hereinafter: "Directive"), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (ECJ, Canon, C-39/97, 29 September 1998, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

Comparison of the goods

40. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. 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 (Canon, already cited).

41. Since the use of the earlier mark has only been proven for '*paella, prepared, precooked, preserved*', these goods shall form the basis for the comparison with the contested goods. Therefore, goods to be compared are the following:

Opposition based on:	Opposition directed against:
Class 30 Paella, prepared, precooked, preserved.	Cl 30 Bakery products, sweet or savoury tarts, sweet or savoury pies, sweet or savoury biscuits, crackers, cookies, cakes, wafers, waffles, pastries and confectionery, chocolate, preparations made of cereals, rusks, cereal bars.

42. The Office finds the contested "*bakery products, sweet tarts, sweet pies, sweet or savoury biscuits, crackers, cookies, cakes, wafers, waffles, pastries and confectionery, chocolate, preparations made of cereals, rusks, cereal bars*" dissimilar to the opponent's "*paella, prepared, precooked, preserved*". Even though they have the same nature of being foodstuffs, this does not make these goods similar. It should be noted that the fact that one ingredient is needed for the preparation of a foodstuff will generally not be sufficient in itself to show that the goods are similar, even though they all fall under the general category of foodstuffs (EGC, Naty's, T-72/10, 26/10/2011, EU:T:2011:635). In addition, in the present case the contested goods are not common ingredients of the opponent's paella dishes. Furthermore, they do not fall under the same category of foodstuffs. Paella is a main course dish and the contested goods such as biscuits, pastries and confectionery are considered to be a snack or dessert. They serve other purposes and are not complementary or in competition. They can normally be found in different areas of supermarkets and are usually produced by different kinds of undertaking.

43. With regard to the contested "*savoury tarts and pies*", the Office considers that these goods are in competition with paella, because this could also concern (part of) a main course dish. It is not unlikely that savoury tarts such as quiche and precooked paella could originate from the same companies and can be consumed on the same type of occasions. For this reason, the Office finds that the goods are similar, only to a low degree.

Conclusion

44. The goods are partly not similar and partly similar to a low degree.


Comparison of the signs

45. The wording of Article 4, 1 (b) of the Directive (cf. article 2.3, (b) BCIP) “there exists a likelihood of confusion on the part of the public” shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (ECJ, *Sabel*, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

46. Global assessment of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (ECJ, *Sabel and Lloyd*, already cited).

47. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (ECJ, *Limonchello*, C-334/05 P, 12 June 2007, ECLI:EU:C:2007:333). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of these components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, *Matratzen*, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and *El Charcutero Artesano*, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

48. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	PAILLE D'OR

Conceptual comparison

49. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd, already cited), the fact remains that, when perceiving a verbal sign, he or she will break it down into elements which, for him or her, suggest a concrete meaning or which resemble words known to him (EGC, *Vitakraft*, already cited; *Respicur*, T-256/04, 13 February 2007, ECLI:EU:T:2007:46; *Aturion*, T-146/06, 13 February 2008, ECLI:EU:T:2008:33; *Galvalloy*, T-189/05, 14 February 2008, ECLI:EU:T:2008:39 and *Ecoblue*, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). The first word element of the trademark invoked, PAELLADOR, has no meaning in its entirety and therefore it is likely that the public will split the word into different parts: PAELLA and DOR.

50. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003, ECLI:EU:T:2003:184). The Office finds that the public will understand the word 'paella' as a reference to the typical Spanish rice dish. The relevant public will know the meaning of this word, due to the popular nature of this dish. This is enhanced by the fact that trademark invoked is only used for prepared paella dishes. For this reason, the Office finds that this element will not be considered as a dominant element in the trademark invoked. Part of the public will perceive the word DOR as an alternative spelling of D'OR and will understand it as 'golden', which is a laudatory indication and therefore also has a weak distinctive character. However, it cannot be excluded that the part of the public in the Benelux which does not speak French does not understand this meaning. The word element 'group' in the trademark invoked is often used to indicate that different businesses belong to the same holding company (see Shorter Oxford English Dictionary, 16th edition) and is therefore considered descriptive.

51. The Office is of the opinion that the contested sign 'paille d'or' will be understood by the French speaking part of the public in the Benelux as 'golden straw'. However, part of the Dutch speaking part of the public will not understand the meaning of the contested sign.

52. Part of the public will understand that both signs refer to the concept of 'golden' which causes a small conceptual similarity. For the part of the public that does not understand the meaning of the contested sign, a conceptual comparison is not possible.

53. Conceptually the signs are either conceptually similar to a low degree or a conceptual comparison is not relevant.

Visual comparison

54. The trademark invoked is a combined verbal/figurative mark and consists of the word element PAELLADOR, displayed in large capital letters and the word element GROUP, placed below the word PAELLADOR and displayed in smaller capital letters. The sign also shows an abstract figure consisting of several roughly stylized circles placed through the letters 'LADO' of the word PAELLADOR. All the word and figurative elements of the sign are depicted in the colour blue. The contested sign is a purely verbal mark consisting of the words 'PAILLE' and 'D'OR'.

55. In complex signs (verbal and figurative elements), word elements often have a greater impact on the public than figurative elements. This is because the average consumer will not always analyse the signs and will often refer to a sign by using the word element (see EGC, Selenium-Ace, T-312/03, 14 July 2005, ECLI:EU:T:2005:289). With regard to the trademark invoked, the first word element, PAELLADOR, has a clear visual position. The public will pay less attention to the second word element, GROUP, because of its descriptive meaning, position and size.

56. The words PAELLADOR and PAILLE D'OR both contain nine letters of which seven are identical and share the same position. This causes a clear visual similarity at the beginning and end. It is also of importance that the consumer normally attaches more value to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79).

57. However, in the light of the descriptive character of first part 'paella', the Office finds that the public will not give much attention to this part of the sign and therefore, in this case, the figurative element will not be ignored by the public. This causes a prominent visual difference between the signs (see Court of Appeal of The Hague, MOOVE-4MOVE, 200.105.827/0, 11 September 2012, ECLI:NL:GHSGR:2012:BX8916).

58. For the reasons mentioned above, the Office concludes that the signs are visually similar to a certain extent.

Aural comparison

59. With regard to the aural comparison, it must be remembered that, in the strict sense, the phonetic reproduction of a complex sign corresponds to that of all its verbal elements, regardless of any specific graphic features, which fall more within the scope of the analysis of the sign on a visual level (EGC, PC Works, T-352/02, 25 May 2005, ECLI:EU:T:2005:176 and Thai Silk, T-361/0821, April 2010, ECLI:EU:T:2010:152).

60. With complex signs, the Office points out that, when referring to a trademark, the average consumer will not pronounce a caption or legend (EGC, Green by Missako, T-162/08, 11 November 2009, ECLI:EU:T:2009:432) and a trademark comprising a number of terms will generally be abbreviated in order to make it easier to pronounce (EGC, BROTHERS by CAMPER, T-43/05, 30 November 2006, ECLI:EU:T:2006:370). For this reason the Office considers that the public, when it aurally refers to the trademark invoked, will not pronounce the second word 'Group'.

61. The first word of the trademark invoked consists of four syllables: PA-EL-LA-DOR and will be pronounced as [pa-e(l)-ja-dor]. The contested sign consists of two words and two syllables and will be pronounced as [pqj-dor]. In both signs, the first syllables are similar and the last syllables are identical. However, the second and third syllable of the trademark invoked, EL-LA, causes a significant aural difference, due to the prominent A-sound, compared to the pronunciation of the contested sign. As also indicated with the visual comparison, the Office considers that, in the light of the descriptive character of the first part of the trademark invoked, the public will pay less attention to the similarities at the beginning of the signs.

62. For this reason, the Office finds that that signs are aurally similar to a certain extent.

Conclusion

63. Trademark and sign are either conceptually similar to a low degree or a conceptual comparison is not relevant. Visually and aurally the signs are similar to a certain extent.

A.2 Global assessment

64. 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 signs are important factors.

65. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question. The present case concerns consumer goods that are targeted at the public in general. These goods may be purchased on a regular basis by the average consumer without, necessarily, incurring high costs. Therefore in this case the average level of attention of the public concerned may be deemed normal.

66. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). In the present case, the opponent has not argued that the trademark invoked has a high distinctive character. The Office finds that the trademark invoked, considered as a whole, does not exclusively describe the goods concerned. The defendant argues that the trademark invoked has a weak distinctive character, because the sign clearly refers to paella (paragraph 21). The Office points out that, according to European case law, a weak distinctive character does not, by definition, mean that there is no likelihood of confusion. Although the distinctive character of the marks must be taken into account with the assessment of the likelihood of confusion, it is only one of a number of elements concerning that assessment (ECJ, Ferromix, C-579/08, 15 January 2010, ECLI:EU:C:2010:18).

67. Furthermore, the global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors 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 (Canon and Lloyd, already cited).

68. However, in the present case this is not the case. The goods are either dissimilar or only similar to a low degree. Conceptually, the signs are either similar to a low degree or a conceptual comparison is not possible and the signs are visually and aurally similar to a certain extent. In addition, the beginning of the trademark invoked, which includes the word 'paella', is merely descriptive of the goods for which the trademark invoked has been used. The most notable visual and aural similarities lie within this descriptive beginning. As mentioned above, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (paragraph 50). The Office also takes into account that the trademark invoked contains a figurative element, which is not present in the contested sign. This figurative element causes a striking difference between the signs.

69. Based on the abovementioned circumstances, the Office concludes that the differences between the signs are sufficient to neutralize the similarities which lie within the last part of the signs.

B. Conclusion

70. Based on the foregoing the Office is of the opinion that there is no likelihood of confusion.

IV. DECISION

71. The opposition with number 2013150 is rejected.

72. Benelux application with number 1351346 will be registered.

73. The opponent shall pay the defendant 1,030 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 Implementing Regulations, as the opposition is rejected in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 11 February 2019

Eline Schiebroek
(*rapporteur*)

Pieter Veeze

Diter Wuytens

Administrative officer: Etienne Colsoul