

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**

**OPPOSITION DECISION**

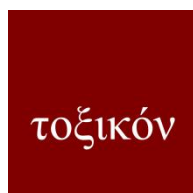
**N° 2013295**

**of 3 April 2019**

**Opponent:** **Toxicon srl**  
via Robolini 1  
27100 Pavia  
Italy

**Representative:** **Studio Legale Dell'Arte**  
via Minghetti 14  
10093 Collegno  
Italy

**Invoked right:** **EU Trademark 14748032**



*against*

**Defendant:** **Toxikon Corporation, Massachusetts domestic profit corporation**  
Wiggins Avenue 15  
Bedford MA 01730  
United States of America

**Representative:** **De Clercq & Partners**  
Edgard Gevaertdreef 10 a  
9830 Sint-Martens-Latem  
Belgium

**Contested trademark:** **Benelux accelerated registration 1015919**

## I. FACTS AND PROCEEDINGS

### A. Facts


1. On 15 June 2017 the defendant filed an application for a trademark in the Benelux for the combined



word/figurative mark for services in classes 41, 42, 44 and 45. In accordance with article 2.8, 2 of the Benelux Convention on Intellectual Property (hereinafter: "BCIP"), the defendant requested an accelerated registration. This was processed under number 1015919 and was published on 15 June 2017.

2. On 25 July 2017 the opponent filed an opposition against the registration of the application. The



opposition is based on EU trademark registration 14748032 of the combined word/figurative , filed on 28 October 2015 and registered on 11 February 2016 for services in classes 41, 42, 44 and 45.

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

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

5. The grounds for opposition are those laid down in article 2.14, 1 (a) 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 26 July 2017. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). In addition the proceedings were suspended at the request of the parties. The administrative phase was completed on 17 May 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 both signs, the dominant element is the word 'toxikon'. In the trademark invoked, this word is written in Greek letters and in the contested sign this word is written in Latin characters. According to the opponent the differences between the signs are not distinctive and do not affect the similarity between the signs. Although the word element of the trademark invoked is written in Greek letters, the opponent states that the public will recognize this word because it is written in simple script. Only the third letter is slightly different from the letter X as it is written in Latin. The opponent argues that this difference is negligible. The opponent states that the word elements of the signs share a significant number of letters in the same position. Furthermore, the signs share the same number of syllables, have the same phonetic sequence and the same stress. Therefore, the signs are visually and aurally similar.

10. According to the opponent, the two signs have the same semantic content, because both have the same meaning deriving from the ancient Greek word 'toxikon', which means something that is dangerous to health. For this reason, the signs are conceptually identical.

11. Regarding the comparison of the goods and services the opponent states that they are precisely the same and are therefore identical.

12. The opponent requests that the Office upholds the opposition and rejects the contested sign.

**B. Defendant's arguments**

13. The defendant states first and foremost that the services for which the trademark invoked is registered cannot be identified with sufficient clarity and precision to determine the extent of the protection conferred by the trademark. For this reason, the defendant states that the similarity of the services and of the likelihood of confusion should in any case be interpreted to the benefit of the defendant and not to the benefit of the opponent.

14. Subsequently, the defendant proceeds with a detailed comparison of the services concerned. The defendant concludes that the services are partly identical, partly similar to an average degree and partly dissimilar.

15. The defendant states that the trademark invoked consists of the element "τοξικόν", written in Greek script and positioned in a red/burgundy square. The contested sign is a figurative mark consisting of the word elements TOXIKON ADVANCING YOUR INNOVATION, written in stylized Latin script. According to the defendant, the signs do not coincide in any element taking into account that the relevant public will recognise the trademark invoked at most as a string of letters written in Greek script, whereas the contested sign is written in recognisable Latin script. The defendant argues that the fact that the signs may coincide in some characters should be considered irrelevant, because these are hardly visually perceptible as separate elements, but are hidden in the different elements of the contested sign. Furthermore, the stylization of the letter X of the contested sign is not present in the trademark invoked. Therefore, the signs are not visually similar.

16. Regarding the aural comparison, the defendant argues that the relevant public will not be able to pronounce the trademark invoked. For this reason, an aural comparison is not possible.

17. The defendant also states that neither of the signs has a clear meaning for the public in the relevant territory. According to the defendant, both words are derived from an ancient Greek word and its meaning is irrelevant in the Benelux territory. Therefore, a conceptual comparison is not possible.

18. With regard to the relevant public, the defendant argues that the services which are assumed identical are directed at the public at large and also at business customers with specific professional knowledge or expertise and the degree of attention will vary from average to relatively high.

19. According to the defendant the distinctiveness of the trademark invoked is average.

20. The defendant concludes that since the signs are dissimilar, there is no likelihood of confusion, nor is this a case of double identity. The defendant subsequently requests that the Office rejects the opposition and decides on an apportionment of costs in favour of the defendant.

### **III. DECISION**

#### **A.1 Likelihood of confusion**

21. 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.

22. 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.”*

23. According to case law of the Court of Justice of the European Union (hereinafter: the “CJEU”) 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 (CJEU, 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 signs***

24. 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 (CJEU, Sabel, C-251/95, 11 November 1997, ECLI:EU:C:1997:528).

25. 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 (CJEU, *Sabel and Lloyd*, already cited).

26. 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 (CJEU, *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).

27. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

28. According to relevant case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, inter alia the visual, aural and conceptual aspects (reference is made to *Matratzen* and *Sabel*, already cited).

#### *Visual comparison*

29. Both signs are combined word/figurative trademark. The trademark invoked consists of the word “toxikon” written in Greek characters. This word element is depicted in white letters and positioned in a dark red square. The contested sign consists of the word “TOXIKON”, written in blue capital letters, except for the stylized letter X, which is partly green. The sign also contains the slogan “ADVANCING YOUR INNOVATION”, positioned below the word “TOXIKON” and displayed in a smaller font, also in blue letters.

30. Where a sign consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark (EGC, *SELENIUM-ACE*, T-312/03, 14 July 2005, ECLI:EU:T:2005:289). In this case, the figurative elements of both signs are limited. Although the stylized letter X, as well as the slogan “ADVANCING YOUR INNOVATION” in the contested sign will not be ignored by the public (Appeal Court of The Hague, *MOOVE-4MOVE*, 200.105.827/0, 11 September 2012, ECLI:NL:GHSGR:2012:BX8916), due to its central position and size, the Office finds that the word element TOXIKON is the most eye-catching element of the contested sign. The other word elements are displayed less strikingly and are therefore visually of minor importance. The figurative elements in the rights invoked merely consist of a simple geometric figure and one colour.

31. Although the word elements of the signs are written in different alphabets, the Office considers that the trademark invoked contains characters which will be recognised by the public in the Benelux because these characters resemble letters of the Latin alphabet. Both signs coincide in their first two letters, 'TO', and also have the letters 'IKO' in the same position. Although the second letter O in the trademark invoked has an acute accent, visually this does not make very much difference. The signs differ in the third and last letters of the word 'toxikon', the third letter of which in the trademark invoked causes a notable difference, because this character does not clearly resemble any letter in the Latin alphabet. However, this does not change the overall similarity caused by the fact that five of the seven letters are the same and are positioned in the same order.

32. 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).

33. In the light of the above, the Office finds that the signs are visually similar.

#### *Aural comparison*

34. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their 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-361/08, 21 April 2010, ECLI:EU:T:2010:152).

35. With complex signs, the Office points out that, when referring to a trademark, the average consumer will usually not pronounce a caption or legend (EGC, Green by Missako, T-162/08, 11 November 2009, ECLI:EU:T:2009:432). Moreover, 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 contested sign, will not pronounce the slogan "advancing your innovation".

36. The Office considers that the general public in the Benelux is not familiar with the pronunciation of the trademark invoked. When a sign contains foreign-language words, it should be assumed, in principle, that the relevant public is unfamiliar with how native speakers of a foreign language pronounce their own language. Accordingly, the public will tend to pronounce a foreign-language word in accordance with the phonetic rules of their native language. Regarding the fact that five of the seven letters coincide, the Office considers that the attempted pronunciation of the trademark invoked by the public will be similar to a certain extent to the pronunciation of the first word element of the contested sign. As for the part of the public that is familiar with the Greek alphabet, the pronunciation of the words is identical.

37. Considering the above, the signs are at least aurally similar to a certain extent.

*Conceptual comparison*

38. Parties agree that the word 'toxikon' derives from an ancient Greek word (paragraphs 10 and 17). This word refers to poison for the use on arrows.<sup>1</sup> Although the general public in the Benelux is not familiar with ancient Greek and will not know the exact meaning of this word, the Office considers that the public will associate both signs with either the English word 'toxic', the Dutch word 'toxisch' or the French word 'toxique', which are all a reference to poison, because of the etymological relationship between Greek and the English, Dutch and French languages. For this reason the signs are also conceptually similar to a certain degree.

*Conclusion*

39. Trademark and sign are visually similar and aurally at least similar to a certain extent. Conceptually, the signs are similar to a certain extent.

**Comparison of the services**

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. With the comparison of the services of the trademark invoked and the services against which the opposition is filed, the services are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

42. The services to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
CI 41 Education, entertainment and sports.	CI 41 Education; Providing of training; Education services relating to the veterinary profession; Education services relating to pharmacy; Medical education services; Conducting of educational seminars relating to medical matters; Education services relating to medicine; Medical training and teaching; Training in the field of medicine; Teaching services relating to the dental field; Advice relating to medical training; Training services in the field of medical disorders and their treatment; Education services relating to therapeutic treatments; Teaching services relating to the surgical field.
CI 42 Testing, authentication and quality control; Science and technology services.	CI 42 Science and technology services; Research services; Industrial analysis services; Scientific research and development; Product research and development; Scientific research for medical purposes; Design and development of medical technology; Medical and pharmacological research services; Laboratory services;

<sup>1</sup> [https://www.etymonline.com/word/toxic#etymonline\\_v\\_15431](https://www.etymonline.com/word/toxic#etymonline_v_15431)

	<p>Laboratory analysis; Laboratory research; Laboratory testing; Veterinary laboratory services; Optical research laboratory services; Scientific laboratory services; Medical laboratory services; Medical research; Laboratory research services relating to pharmaceuticals; Chemical laboratories; Laboratory analysis in the field of chemistry; Laboratory research in the field of chemistry; Biological laboratory services; Laboratory analysis in the field of bacteriology; Chemical, biochemical, biological and bacteriological research and analysis; Biochemical research and development; Biomedical research services; Research and development in the pharmaceutical and biotechnology fields; Bacteriological research and testing; Bacteriological consultation and research; Consultancy pertaining to pharmacology; Research in the field of pharmacogenetics; Consultancy relating to research and development in the field of therapeutics; Dental research laboratory services; Laboratory research services relating to dermatology; Providing scientific information in the field of medical disorders and their treatment; Provision of information and data relating to medical and veterinary research and development; Consulting services in the fields of biotechnology, pharmaceutical research and development, laboratory testing, diagnostics, and pharmacogenetics; Research relating to medicines; Pharmaceutical research and development; Development of pharmaceutical preparations and medicines; Drug discovery services; Pharmaceutical drug development services; Pharmaceutical products development; Research and development of vaccines and medicines; Services for assessing the efficiency of pharmaceuticals; Conducting early evaluations in the field of new pharmaceuticals; Pharmaceutical product evaluation; Services for assessing the efficiency of veterinary drugs; Clinical trials; Clinical research; Conducting clinical trials for pharmaceutical products; Providing medical and scientific research information in the field of pharmaceuticals and clinical trials; DNA screening for scientific research purposes; Genetic testing for scientific research purposes; Genetic testing of laboratory animals for research purposes; Blood analysis services; Biological development services; Preparation of biological samples for research purposes; Microbiological testing; Biology consultancy; Analysis in the field of molecular biology; Biochemistry services; Biochemistry consultancy; Advisory services relating to biochemistry; Biotechnology research; Biotechnology testing; Preparation of reports in the biotechnology field; Providing information relating to scientific research in the fields of biochemistry and biotechnology; Research and</p>
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	<p>development services in the field of bacteriology; Bacteriological research and testing; Chemical analytical examinations; Preparation of reports relating to chemical research; Provision of scientific information relating to chemicals; Research and development services in the field of immunohistology; Preparation of immunohistological samples for analysis in research laboratories; Research and development services in the field of immunology; Research and development services in the field of cytology; Research and development in the field of microorganisms and cells; Research and development services in the field of antibody technology; Research and development services in the field of gene expression systems; Research and development in the field of diagnostic preparations; Research relating to molecular sciences; Research in the field of gene therapy; Stem cell research; Scientific services relating to the isolation and cultivation of human tissues and cells; Analysis of human tissues for medical research; Animal semen testing services for research purposes; Toxicity testing for research purposes; Compilation of toxicological information; Toxicity analysis; Assessing toxicological information in relation to risks; Assessing chemical information in relation to risks; Engineering; Chemical engineering; Development and test of chemical production methods; Working on and evaluation of chemical analyses; Working on and evaluation of chemical syntheses; Analysis of the mode of action of chemical combinations on animals; Biochemical engineering services; Engineering consultancy relating to testing; Testing, authentication and quality control; Testing services for the certification of quality or standards; Testing, analysis and evaluation of the goods and services of others for the purpose of certification; Design and testing of new products; Testing the functionality of apparatus and instruments; Product testing; Product quality testing; Material testing; Product safety testing services; Development of measuring and testing methods; Inspection of pharmaceuticals; Testing of pharmaceuticals; Testing of chemicals; Research and testing services in the fields of bacteriology and virology; Design services; Design and development of testing and analysis methods; Design services relating to process systems for the biotechnology industry; Providing facilities for scientific research and development; Rental of laboratory apparatus and instruments; Rental of scientific equipment.</p>
<p>CI 44 Human healthcare services; Hygienic care for animals; Agriculture, aquaculture, horticulture and forestry services; Human hygiene and beauty care.</p>	<p>CI 44 Laboratory analysis services relating to the treatment of persons; Human tissue bank services; Medical services; Medical analysis services; Medical screening; Medical</p>

	testing; Medical treatment services; Pathology services; Dermatology services; Providing medical advice in the field of dermatology; Advice relating to immunology; Advisory services relating to medical apparatus and instruments; Analysis of human tissues for medical treatment; Drug, alcohol and DNA screening for medical purposes; Consultancy services relating to surgery; Surgery; Genetic testing for medical purposes; In vitro fertilization services; Mammography testing services; Performing diagnosis of diseases; Services for the testing of urine; Vascular screening; Surgical diagnostic services; Surgical treatment services; Services for the testing of blood; Consultancy services relating to orthopaedic implants; Consultancy services relating to prosthetic implants; Dental services; Medical equipment rental; Hiring of surgical instruments; Rental of equipment for medical purposes; Rental of apparatus and installations in the field of medical technology; Provision of medical facilities; Services for the provision of medical facilities; Pharmaceutical services; Veterinary services; Animal healthcare services; Veterinary surgery; Genetic testing of animals; Laboratory analysis services relating to the treatment of animals; Veterinary advisory services; Veterinary assistance.
CI 45 Legal services; Safety, rescue, security and enforcement services.	CI 45 Legal services; Advisory services relating to regulatory affairs; Reviewing standards and practices to assure compliance with laws and regulations; Advisory services relating to the preparation of standards; Advisory services relating to the law; Provision of legal information.

43. The defendant states that the services are for the most part identical. The defendant also argues that certain services are similar to an average degree. For this reason, the Office concludes that it is in confesso that these services are either identical or at least similar to a certain extent. The defendant only disputes the similarity of certain services mentioned in classes 42 and 44 of the contested sign and therefore, for reasons of procedural economy, the Office will only address these services.

44. The Office finds that the contested "*Design services; Design services relating to process systems for the biotechnology industry*", mentioned in class 42 are similar to the "science and technology services" mentioned in class 42 of the trademark invoked. The services of the trademark invoked include research and development in order to improve existing products, processes or services. Therefore, there could be a link with the defendant's broad category of design services, because these services could be applied in several areas, such as the field of technology and science. This link already exists for the contested design services relating to process systems for the biotechnology industry. Furthermore, these services may be offered by the same companies and may be directed at the same public. Consequently, the Office finds these services similar.

45. With regard to the contested services “*Veterinary surgery; Genetic testing of animals; Laboratory analysis services relating to the treatment of animals*”, the Office finds that these services are indeed dissimilar to the services of the trademark invoked. Although the trademark invoked is also registered for “hygienic care for animals” in class 44, the Office finds that the fact that all these services are specifically intended for animals, does not, per definition, mean that these services are similar. The services of the contested sign are performed by specialist physicians or lab assistants in veterinary clinics, whereas the services of the trademark invoked will mostly be performed by people who specialise in dog and cat grooming and are usually provided in a grooming salon or boutique. Furthermore, these services do not have the same purpose and they are neither complementary nor in competition.

46. The services are also dissimilar to the other medical services in Class 44 of the trademark invoked, because the opponent’s healthcare services concern human beings and not animals. Although the nature and purpose of health care for humans and animals are, in principle, similar, there are substantial differences. Hospitals for humans do not provide the same services for animals and the public will not expect that a regular hospital will offer health care for animals. Therefore, these services are neither complementary to nor in competition with the opponent’s services in Class 44.

47. Lastly the services are dissimilar to the other services of the trademark invoked mentioned in classes 41, 42 and 45. Although some of these services can be performed in the same field (e.g. genetic testing, laboratory analysis and science and technology services), their purpose is different and they are not aimed at the same public. They are neither complementary nor in competition. For this reason, the public will not believe that the services originate from the same companies.

### *Conclusion*

48. The services are partly identical, partly similar to a certain extent and partly dissimilar.

## **A.2 Global assessment**

49. 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.

50. 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 services in class 41 are aimed at both the average consumer and the professional public, such as doctors and other medical professionals. Although the level of attention of the professional public could be higher than normal, that of the average consumer will only be average. For this reason, the lowest level of attention must be taken into account, which means that the public is deemed to have a normal level of attention. With regard to the services in classes 42, 44 and 45, the Office finds that the level of attention is high. The services mentioned in class 42 are specifically aimed at the professional public and they will display a high degree of attentiveness, because these specialised services are very complicated and expensive. With regard to the medical services in class 44, also the average consumer will pay more attention, because a person’s physical or mental health are concerned. This also applies to legal services, because these services are considered to be expensive and the public will therefore invest more time in deciding which specific legal service provider will be engaged. Therefore, for some services the level of attention is normal and for the other services the public is deemed to have a high level of attention.

51. 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). In this case, the signs are visually similar and aurally and conceptually similar to a certain extent and some of the goods are identical or similar to a certain extent.

52. 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 trademark invoked has a normal distinctiveness, as it is not descriptive of the services concerned.

53. Account must also be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.

54. In the light of the abovementioned circumstances, notwithstanding the high level of attention of the public with regard to some of the services, the Office is of the opinion that the relevant public might believe that the identical and (to a certain extent) similar services in question come from the same undertaking or from economically-linked undertakings.

## **B. Other factors**

55. The defendant argues that the services for which the trademark invoked is registered cannot be identified with sufficient clarity and precision to determine the extent of the protection conferred by the trademark (paragraph 13). The Office points out that in the IP-Translator case (C-307/10, 19 June 2012, ECLI:EU:C:2012:361) the Court determined that:

56. *"(...)some of the general indications in the class headings of the Nice Classification are, in themselves, sufficiently clear and precise to allow the competent authorities to determine the scope of the protection conferred by the trade mark, while others are not such as to meet that requirement where they are too general and cover goods or services which are too variable to be compatible with the trade mark's function as an indication of origin.*

57. *It is therefore for the competent authorities to make an assessment on a case-by-case basis, according to the goods or services for which the applicant seeks the protection conferred by a trade mark, in order to determine whether those indications meet the requirements of clarity and precision.*

58. As a result of the judgement referred to above, the trademark offices of the European Union have worked together – in an effort to create certainty within the trademark system and for its users – to reach a common understanding on the requirements of clarity and precision. The trademark offices have also evaluated the general indications of the class headings of the Nice classification in order to determine which indications are sufficiently clear and precise. This resulted in eleven general indications which are not considered clear and precise. The services for which the trademark invoked is registered are not included in that list of eleven general indications.

59. The Office considers that the list of services is sufficiently clear and precise, which has also been established by the European Union Intellectual Property Office (EUIPO), because the trademark invoked concerns an EU trademark.

### **C. Conclusion**

60. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion for the services which are considered identical or similar.

## **IV. DECISION**

61. The opposition with number 2013295 is partly justified.

62. Benelux accelerated registration with number 1015919 is cancelled for the following services which are identical or similar:

- Class 41 (*all services*)
- Class 42 (*all services*)
- Class 44 Laboratory analysis services relating to the treatment of persons; Human tissue bank services; Medical services; Medical analysis services; Medical screening; Medical testing; Medical treatment services; Pathology services; Dermatology services; Providing medical advice in the field of dermatology; Advice relating to immunology; Advisory services relating to medical apparatus and instruments; Analysis of human tissues for medical treatment; Drug, alcohol and DNA screening for medical purposes; Consultancy services relating to surgery; Surgery; Genetic testing for medical purposes; In vitro fertilization services; Mammography testing services; Performing diagnosis of diseases; Services for the testing of urine; Vascular screening; Surgical diagnostic services; Surgical treatment services; Services for the testing of blood; Consultancy services relating to orthopaedic implants; Consultancy services relating to prosthetic implants; Dental services; Medical equipment rental; Hiring of surgical instruments; Rental of equipment for medical purposes; Rental of apparatus and installations in the field of medical technology; Provision of medical facilities; Services for the provision of medical facilities; Pharmaceutical services; Veterinary services; Animal healthcare services; Veterinary advisory services; Veterinary assistance.
- Class 45 (*all services*)

63. Benelux accelerated registration with number 1015919 is upheld for the following services which are not similar:

- Class 44 Veterinary surgery; Genetic testing of animals; Laboratory analysis services relating to the treatment of animals.

64. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP in conjunction with rule 1.32(3) IR, as the opposition is partly justified.

The Hague, 3 April 2019

Eline Schiebroek  
(*rapporteur*)

Pieter Veeze

Willy Neys

Administrative officer: Etienne Colsoul