



**BENELUX-OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2011578**  
**of 18 March 2019**

**Opponent :** **Wan Thai Foods Industry Co., Ltd.**  
2/4 Moo 14, Bangchan Industrial Estate, Serithai Road, Minburi  
10510 Bangkok  
Thailand

**Representative:** **Octrooibureau Vriesendorp & Gaade B.V.**  
Koninginnegracht 19  
2514 AB Den Haag  
Netherlands

**Invoked right 1:**  (European Union trademark 6495428)

**Invoked right 2:**  (European Union trademark 12834991)

*against*

**Defendant:** **FNU Management Limited**  
Ingles Manor Castle Hill Avenue  
CT20 2RD Folkestone  
Great Britain

**Representative:** **Trademarkers Merkenbureau C.V.**  
Amersfoortsestraatweg 33b  
1401 CV Bussum  
Netherlands



**Contested trademark:** **Yum.me** (Benelux application 1321311)

## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 17 November 2015 the defendant filed a Benelux trademark application for the word trademark **Yum.me** for goods and services in classes 29, 30 and 43. This application was processed under number 1321311 and was published on 24 November 2015.

2. On 12 January 2016 the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:

- European Union trademark 6495428 for the combined word/figurative trademark , filed on 7 December 2007 and registered on 13 November 2008 for goods in classes 29 and 30;
- European Union trademark 12834991 for the combined word/figurative trademark , filed on 30 April 2014 and registered on 23 September 2014 for goods in classes 29 and 30.

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 and services of the trademarks invoked.

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

6. The language of the proceedings is English.

### B. Proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 13 January 2016. During the administrative phase of the proceedings both parties filed arguments. All of the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase of the procedure was completed on 24 March 2017.

## II. ARGUMENTS OF THE PARTIES

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 trademarks and the identity or similarity of the goods or services concerned.

### A. Opponent's arguments

9. Given the size of the letter Y in each element of the rights invoked and the fact that consumers read from left to right, the opponent is of the opinion that the consumer's attention will first be drawn to the first word element YUM.

10. According to the opponent, the rights invoked and the contested sign are visually similar to the extent that they coincide in three out of six letters in each sign, namely the first three letters YUM. Furthermore, both the rights invoked and the contested sign contain the letter M in the second element. Due to the identical position of the first three letters, the rights invoked and the contested sign are visually highly similar.

11. Aurally, both the prior rights and the contested sign are composed of two word elements of which the first, YUM, are identical. The signs only differ in their last three letters. In terms of pronunciation, the signs have the same rhythm and intonation, and therefore the opponent is of the opinion that the signs are aurally highly similar.

12. According to the opponent, the rights invoked can be understood by the public as a reference to the qualities, “delicious”, “tasty” or “delightful”. Although the contested sign is not a word that can be found in the dictionary, the opponent thinks that it is most likely to be understood by the public as a reference to the word “yummy”, as do the rights invoked. The opponent concludes that the signs are therefore to be considered as conceptually highly similar.

13. The opponent observes that some goods of the contested sign are identical to those of the rights invoked. Others are at least similar, as they can be ingredients in the preparation of the goods of the rights invoked.

14. The services of the contested sign in class 43 (which, apparently, the opponent erroneously mentions in class 35) are to be considered complementary, according to the opponent.

15. Bearing all the foregoing in mind, the opponent concludes that a likelihood of confusion exists and he therefore requests that the Office justifies the underlying opposition and rejects the registration of the contested sign.

## **B. Defendant’s arguments**

16. The defendant observes that the rights invoked are highly stylized, with a unique font and a bold yellow colour. In addition, the repeated YUM elements create a visual impression which will be instantly remembered by the relevant consumer. After all, only three characters of the signs are the same. Therefore, the defendant is of the opinion that the signs are not visually similar.

17. Aurally, the rights invoked consist of two syllables, whereas the contested sign consists of three syllables [yum-dot-me]. As such, the signs only coincide in the initial syllable and the repetition in the earlier trademarks will be highly noticeable. Therefore, the trademarks are aurally dissimilar, according to the defendant.

18. Conceptually, the rights invoked represent the qualities, “tasty” or “delicious”. In contrast, the element “.me” of the contested sign can either be a reference to “me” (a person) or to the universal top-level domain name indicator for Montenegro. This additional element alters the meaning of the sign in such a way that it cannot be confused with the earlier trademarks.

19. The defendant acknowledges that there are some similarities in the specifications of the signs in class 29. On the other hand, there are some clear differences between the specifications, such as *jellies*, *jams*, *compotes*, *eggs*, *milk*, *milk products*, *edible oils* and *fats*, which fall outside the reach of the rights invoked and the same applies to the goods of the contested sign in class 30.

20. Furthermore, it is reasonable to assume that these goods may be sold in different sales outlets, have a different intended purpose, be produced by different manufacturers or be directed at a different public.

21. In the defendant's opinion, the claim of the opponent regarding the complementarity of the goods in classes 29 and 30 on one hand and the services in class 43 on the other, is totally unfounded. These goods are by no means indispensable or highly important for the services at hand.

22. In conclusion, the defendant states that the opponent has failed to provide evidence of a likelihood of confusion and therefore it is requested that the opposition at hand be rejected as unfounded and that the contested sign be granted protection. It is further requested that the opponent shall bear all costs and fees arising in connection with these proceedings.

### **III. DECISION**

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

23. 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 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.

24. 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."*

25. 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; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999; 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; Brussels, N-20060227-1, 27 February 2006).

#### **Comparison of the signs**


26. 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).

27. 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).

28. 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, Limoncello, C-334/05 P, 12 June 2007). 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 and El Charcutero Artesano, T-242/06, 13 December 2007).

29. The signs to be compared are the following:

*With regard to the first right invoked (European Union trademark 6495428):*

| Opposition based on:  | Opposition directed against: |
|---|------------------------------|
|  | Yum.me                       |

*Conceptual comparison*

30. Yumyum (also yum) is an informal exclamation used to express pleasure at eating, or at the prospect of eating, a particular food.<sup>1</sup> The right invoked and the first part of the contested sign have thus the same signification.

31. The addition “.me” in the contested sign is the internet country code top-level domain for Montenegro and will therefore not be perceived as the dominant element of the sign, since it is restricted to suggesting the idea that the goods and services covered by the trade mark applied for can be consulted or bought over the internet.

32. The part of the public that would pronounce the contested sign as [yummie], could see it as a reference to “yummy”, meaning “delicious” (of food; <https://en.oxforddictionaries.com/definition/yummy>). Even in that case the signs have the same connotation.

33. Conceptually, the signs are similar to a high degree.

*Visual comparison*

34. The right invoked is a combined word/figurative trademark, consisting of one word of six letters with a double outline and a shadow effect. The word could also be read as two words, written together, given the use of the capital Y's. The contested sign is a purely verbal trademark, consisting of the words “Yum” and “me”, separated by a dot.

35. 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 or services in question by quoting their name than by describing the figurative element of the trademark (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). The graphical aspect of the right invoked can be qualified as rather marginal, merely consisting of a specific layout of the letters, which the consumer will perceive as adornment (see EGC, Dieselit, T-186/02, 30 June 2004). In any case, the relevant public will without any doubt perceive the word “YumYum” (or two times the word “Yum”) as the dominant element of the right invoked.

<sup>1</sup> [https://en.oxforddictionaries.com/definition/yum\\_yum](https://en.oxforddictionaries.com/definition/yum_yum).

36. The consumer normally attaches more importance to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004). In this case the first parts of the signs are identical. This concerns the first three letters or, depending on how one reads the right invoked, the first word of that mark and in any case the first word of the contested sign. More than half of the sign is thus identical to the beginning of the right invoked and in addition the letter M appears in the second part of both the trademark and the sign, albeit not in the same position.

37. Visually, the trade mark and the contested sign are similar in their overall impression.

#### *Aural comparison*

38. 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 and Thai Silk, T-361/08, 21 April 2010).

39. Aurally, the consumer normally attaches more importance to the first part of a sign (EGC, Mundicor, already cited). Again, the beginning of each sign is identical, meaning the first syllable, of two with regard to the right invoked. The contested sign can be pronounced in two or in three syllables: [yum-mie] or [yum-dot-me]. In any case, these differences at the end of the sign cannot outweigh the similarity caused by the identical beginnings.

40. Overall, the signs are aurally similar to a certain degree.

#### *Conclusion*

41. Conceptually, the signs are similar to a high degree: visually they are similar and aurally they are similar to a certain degree.

#### ***Comparison of the goods and services***

42. 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).

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

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

| Opposition based on:   | Opposition directed against:  |
|--|---|
| Class 29 Meat, especially pork and beef; fish, especially shrimps; poultry, especially chicken and duck; preserved, dried and cooked vegetables. | Class 29 Meat; fish; poultry; game; meat extracts; preserved fruits; frozen fruits; dried fruits; cooked fruits; jellies; jams; compotes; eggs; milk; milk products; edible oils and fats.  |
| Class 30 Instant noodles; noodles; spices; instant meals, especially instant noodles meals.  | Class 30 Coffee; tea; cocoa; artificial coffee; rice; tapioca; sago; flour; preparations made from cereals; bread; confectionery; edible ices; sugar, honey, treacle; yeast; baking-powder; salt; mustard; vinegar; Sauces [condiments]; spices; ice. |
|  | Class 43 Hotel services; hotel reservation services; rental of temporary accommodation; business catering services; bar services; cafés; restaurants.   |

#### Class 29

45. The goods *meat*, *fish* and *poultry* appear *expressis verbis* in both lists and are therefore identical.

46. *Game* is the flesh of wild mammals or birds, used as food (<https://en.oxforddictionaries.com/definition/game>) and thus a specification of the broader terms *meat* and *poultry* of the right invoked and therefore identical to the latter. Indeed, according to established case law, if the goods of the earlier trademark also contain goods that are mentioned in the contested sign, these goods are considered identical (see EGC, Fifties, T-104/01, 23 October 2002; Arthur et Félicie, T-346/04, 24 November 2005 and Prazol, T-95/07, 21 October 2008).

47. Meat extract is highly concentrated meat stock, usually made from beef. It is used to add meat flavour in cooking, and to make broth for soups and other liquid-based foods ([https://en.wikipedia.org/wiki/Meat\\_extract](https://en.wikipedia.org/wiki/Meat_extract)). The goods *meat extracts* of the contested sign are therefore similar to the product *meat* of the right invoked. They can have the same use in cooking and for some purposes they are interchangeable, like in preparing soups and stock.

48. There exists an overlap between culinary vegetables and botanical fruits. Examples of culinary "vegetables" that are botanically fruit include cucurbits (e.g. cucumber, pumpkin, and squash), eggplant, legumes (beans, peanuts, and peas), sweet pepper and tomato. In addition, some spices, such as allspice and chili pepper, are fruits, botanically speaking (<https://en.wikipedia.org/wiki/Fruit>). Therefore the goods *preserved fruits*, *frozen fruits*, *dried fruits* and *cooked fruits* of the contested sign are similar to the goods *preserved*, *dried and cooked vegetables* of the right invoked. Many of these goods are interchangeable or used together in cooking. Moreover, these products are generally provided by the same undertakings.

49. Because the culinary distinction between fruits and vegetables is vague, the goods *jellies*, *jams* and *compotes* of the contested sign can be made from fruits as well as from vegetables (fresh or preserved). Therefore, these products are similar to the goods *preserved*, *dried and cooked vegetables* of the right invoked.

50. The goods *eggs, milk, milk products and edible oils and fats* of the contested sign are not similar to any of the goods of the right invoked. The only factor that they have in common is the fact that they are all foodstuffs in a broader sense. However, this is not sufficient to establish any similarity between the goods. They differ in nature, purpose, method of use, distribution channels and producers. They are neither complementary nor in competition.

#### *Class 30*

51. The goods *spices* appear in both lists of goods and are thus identical.

52. The goods *preparations made from cereals* of the contested sign include the goods *instant noodles and noodles* of the right invoked and are therefore identical. Indeed, according to established case law, if the goods of the contested sign also contain goods that are mentioned in the earlier trademark, these goods are considered identical (see EGC, *Metabiomax*, T-281/13, 11 June 2014).

53. The remaining goods of the contested sign are not similar to any of the goods of the right invoked. The fact that some of these goods can be ingredients in preparing the meals of the right invoked, is not sufficient to qualify these goods as similar. Contrary to the opponent's argument, the Office is of the opinion that these goods are not complementary as they are not indispensable or highly important for each other. Furthermore, these goods differ in nature, purpose, method of use, distribution channels and producers.

#### *Class 43*

54. The services of the contested sign are not similar to any of the goods of the right invoked. Obviously, restaurants and caterers need food ingredients to prepare their meals, but this does not mean that the goods of the right invoked are indispensable or highly important for these services. Moreover, the providers of these services are not the manufacturers of these products and generally these services and products are not commercialized under the same trademark. The relevant public is aware of this and is therefore not likely to be confused as to the origin of these goods and services.

#### *Conclusion*

55. The goods and services at issue are partly identical, partly similar and partly dissimilar.

### **A.2 Global assessment**

56. 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.

57. 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 in accordance with the category of goods or services in question. The present case concerns goods and services which are targeted at the public in general. For these goods and services the average level of attention of the public concerned may be deemed normal.

58. 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).



59. It should also be taken into consideration here that normally, the average consumer perceives a mark as a whole and does not proceed to an analysis of 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 trademarks but must place his/her trust in the imperfect picture of them that he/she has kept in his/her mind.

60. 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 rather weak level of distinctiveness, given its meaning and the marginal graphical elements. The finding of a weak distinctive character for the earlier trade mark does not prevent a finding that there is a likelihood of confusion in the present case. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier trade mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see EGC, Pages Jaunes, T-134/06, 13 December 2007).

61. The signs are conceptually similar to a high degree, visually they are similar and aurally they are similar to a certain degree. Some of the goods and services concerned are identical or similar and some are not similar. Based on these grounds, and given the interdependence between all the circumstances to be taken into account, the Office finds that the relevant public might believe that the identical and similar goods originate from the same undertaking or from economically-linked undertakings.

#### **B. Other factors**

62. The defendant asks that all the costs of these proceedings be borne by the opposing party (see above point 22). However, rule 1.32 (3) IR clearly stipulates that the costs referred to in article 2.16 (5) BCIP are determined at an amount equalling the basic opposition fee (in the case that the opposition is totally upheld or rejected). The requests of the parties can therefore not be honoured.

#### **C. Conclusion**

63. The Office holds that there exists a likelihood of confusion for the identical and similar goods.

64. The opposition (partly) succeeds based on the first right invoked. No comparison to the second right invoked has been made by the Office, as it would not alter the outcome of the proceedings, because of the fact that the goods pertaining to both rights invoked are identical.

#### **IV. DECISION**

65. The opposition with number 2011578 is partially upheld.

66. The Benelux application 1321311 will not be registered for the following goods:

Class 29 Meat; fish; poultry; game; meat extracts; preserved fruits; frozen fruits; dried fruits; cooked fruits; jellies; jams; compotes.

Class 30 Preparations made from cereals; spices.

67. The Benelux application 1321311 will be registered in the Benelux for the following goods and services, which were found to be dissimilar:

Class 29 Eggs; milk; milk products; edible oils and fats.

Class 30 Coffee; tea; cocoa; artificial coffee; rice; tapioca; sago; flour; bread; confectionery; edible ices; sugar, honey, treacle; yeast; baking-powder; salt; mustard; vinegar; Sauces [condiments]; ice.

Class 43 (*All services*).

68. 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 only partly justified.

The Hague, 18 March 2019

Willy Neys  
*rapporteur*

Diter Wuytens

Tomas Westenbroek

Administrative officer: Etienne Colsoul