



BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2009903
of 17 January 2017

Opponent: **GRE Grand River Enterprises Deutschland GmbH**
Rietzer Berg 28
14797 Kloster Lehnin/OT Rietz
Germany

Representative: **Novagraaf Nederland B.V.**
Hoogoorddreef 5
1101 BA Amsterdam
Netherlands

Invoked right: **European registration 9148628**

MARK ADAMS NO 1

against

Defendant: **Philip Morris Brands Sàrl**
Quai Jeanrenaud 3
2000 Neuchâtel
Switzerland

Representative: **Hoyng Rokh Monegier LLP**
Nerviërslaan 9-31
1040 Brussels
Belgium

Contested trademark: **International application 1201181**

MARKTEN

I. FACTS AND PROCEEDINGS

A. Facts

1. On 29 November 2013 the defendant filed an international application for the word mark MARKTEN for goods in class 34, indicating inter alia the Benelux. This international application was processed under number 1201182 and was published on 1 May 2014 in the *Gazette OMPI des marques internationales* 2014/16.

2. On 30 May 2014 the opponent filed an opposition against the registration of the application. The opposition is based on European registration 9148628 of the word mark MARK ADAMS NO 1, filed on 2 June 2010 and registered on 15 November 2010 for goods in class 34.

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

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

5. The grounds for opposition are those laid down in article 2.14, 1 (a) of 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 3 June 2014. 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 several times at the request of the parties. The administrative phase was completed on 12 April 2016.

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 all goods in class 34 of the contested sign are identical or highly similar to the goods in class 34 for which the trademark invoked has been registered.

10. According to the opponent, the word element MARK is the most distinctive element in both signs.

11. With regard to the comparison of the signs the opponent states that the signs are visually and aurally similar to the extent that they both start with the element 'MARK'. The opponent also claims that both signs will be associated with a person named Mark and a numeral containing '1' or '10' (TEN). For this reason the signs are conceptually similar.

12. The opponent argues that it is common in the tobacco industry that companies use sub brands (signs that derive from the principal mark and which share a common dominant element) in order to distinguish its various lines from one another.

13. The opponent concludes that there is a likelihood of confusion and requests that the Office grants the opposition and orders that the opponent is awarded the fixed costs.

B. Defendant's arguments

14. The defendant refers to earlier decisions from other trademark authorities regarding opposition proceedings involving the same signs, in which the opposition has been rejected.

15. According to the defendant, notwithstanding any finding by the Office of identity or similarity in the goods covered by the contested sign compared to the trademark invoked, the opposition should be rejected because the signs are not similar.

16. The defendant argues that even though both signs share the word MARK, this cannot be seen as the most distinctive and dominant component. In the trademark invoked, the element MARK is merely a common Anglo-Saxon first name, ancillary to the Anglo-Saxon sounding family name ADAMS. The defendant states that the family name is likely to be perceived by consumers as more important. Alternatively, the defendant also argues that because it concerns a first name/surname combination, the word elements MARK ADAMS together, will be perceived as the most essential and dominant element of the sign.

17. With regard to the visual comparison of the signs, the defendant argues that the signs differ in the number of elements and letters, as well as in the overall length. In the light of all these differences, the signs are visually dissimilar. Aurally, the pronunciation, the number and sequence of different syllables, as well as the intonation, also leads to the conclusion that the signs are dissimilar. The defendant argues that the trademark invoked will be perceived as a person's first name and family name, in contrast with the contested sign MARKTEN. This term will be perceived as a Dutch or German word, which has a meaning that is completely absent in trademark invoked. Furthermore, the defendant argues that the element TEN will not be perceived by the public as the numeral 10, because English is not an official language in the Benelux. For this reason, according to the defendant, the signs are conceptually dissimilar.

18. The defendant also argues that tobacco smokers are usually very loyal to the brand they smoke and therefore show a higher degree of attention when purchasing tobacco products. Furthermore, according to the defendant the trademark invoked has a low degree of distinctiveness, because it contains a personal name and the element NO 1.

19. The defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition and orders that the defendant is awarded reimbursement of the fixed costs.

III. DECISION

A.1 Likelihood of confusion

20. 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.

21. 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.”*

22. 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

23. 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).

24. 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).

25. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
MARK ADAMS NO 1	MARKTEN

26. Both signs are purely verbal marks. The trademark invoked consists of the words ‘MARK ADAMS’, the abbreviation ‘NO’ and the numeral ‘1’. The contested sign consists of the word ‘MARKTEN’.

27. In both signs, the first element MARK is identical. Although the consumer will normally attach more importance to the first part of a sign (see General Court of the European Union “EGC”, Mundicor, T-183/02 and T-184/02, 17 March 2004), the Office is of the opinion that it will be clear to the public that the trademark invoked refers to a family name. For this reason, the word MARK will not be perceived separately by the public, but as a forename/surname combination together with the word ADAMS (see, by way of analogy with, EGC, Marcorossi, T-97/05, 12 July 2006).

28. As confirmed by the EGC in the case ENZO FUSCO, it is possible that in a sign composed of a forename and a surname, the relevant public will perceive the surname as the distinctive element. However, this may vary from country to country within the European Union (see EGC, Enzo Fusco, T-185/03, 1 March 2005). The Office is of the opinion that the relevant public in the Benelux will generally also perceive a surname as more distinctive than a first name. For this reason, the word element ADAMS is considered to be the dominant element in the trademark invoked, which causes a significant visual and aural difference between the signs.

29. The other elements are also different. The element NO in the trademark invoked will be perceived as the abbreviation of the word ‘number’. Together with the numeral 1, the public will understand that this combination refers to the quality or ranking of the goods concerned, in other words, these are ‘number 1’ products, which indicates that the products are of excellent quality. Even though these elements could be considered descriptive, and are therefore not distinctive, they still cause a significant difference between the signs.

30. The Office is of the opinion that the public in the Benelux will not, as the opponent seems to suggest (paragraph 11), perceive the contested sign as a combination of the words MARK and TEN, because the word ‘markten’ is the Dutch plural of the word ‘markt’ (which is also a German word and means ‘market’). The Office is of the opinion that the general Benelux consumer will understand the word ‘markten’. As a result, the contested sign will be perceived as a whole and is therefore conceptually different. However, even if part of the Benelux public perceives the contested sign as combination of the words MARK and TEN, this does not constitute any stronger similarity between the signs. If the public perceives the last part of the contested sign (TEN) as the numeral 10, it is more likely that the public will think that it refers to a certain product line or perhaps quantity of products present in a package than any reference to a type of ranking, which also causes a conceptual difference between the signs.

31. The fact that a sign contains a family name does not mean that it has a certain meaning (see BOIP, Rachel, opposition decision 2002674, 1 July 2009), except in the case that it concerns a very well-known name (CJEU, Picasso, C-361/04, 12 January 2006 en BOIP, Amadeus Fire, opposition decision 2002041, 30 July 2010). However in the matter at hand, this is not the case. Furthermore, it is likely that the word ‘MARK’ in the contested sign, without any surname following, will be perceived by the public as a synonym for the word ‘trademark’, which also constitutes a conceptual difference between the signs.

Conclusion

32. The Office is of the opinion that in this case, the visual and aural similarities between both signs are outweighed by the differences. Viewed as a whole, trademark and sign are different, because of the important place of the surname ADAMS and because this word will be perceived a part of a family name, as well as the

differences caused by the other elements, especially the conceptual differences. As a result, the limited visual and aural similarity is neutralized (CJEU, Picasso, already cited and EGC, IKEA-IDEA, T-112/06, 16 January 2008). Therefore, the Office concludes that the overall impression given by the marks is not similar, at least not sufficiently so as to determine the existence of a likelihood of confusion.

Comparison of the goods

33. For reasons of procedural economy, the Office will not conduct a comparison of the goods. This comparison would not influence the outcome of this decision. Even if the goods are identical, there would be no likelihood of confusion, because the signs are dissimilar. Only for the purpose of the readability and the scope of this opposition are the goods concerned listed below.

Opposition based on:	Opposition directed against:
CI 34 Unprocessed tobacco, processed tobacco and tobacco products, included in class 34, in particular cigarettes, cigars, cigarillos, fine cut tobacco, pipe tobacco, chewing tobacco, snuff, cigarettes containing tobacco substitutes, not for medical purposes; smokers' articles, in particular tobacco tins, cigarette cases, cigarette holders, ashtrays (all the aforesaid goods not of precious metal or coated therewith), cigarette papers, cigarette tubing, cigarette filters, smoking pipes, pocket apparatus for rolling cigarettes, lighters, included in class 34; matches; cigarette cases of precious metal; cases (cigarette -), of precious metal; cigarette holders of precious metal; cigar cases of precious metal and wood; boxes (cigar -), of precious metal; cigar holders of precious metal.	CI 34 Tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll-your-own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters; matches; electronic apparatus for tobacco, particularly electronic cigarettes, tobacco products and tobacco substitutes; electric vapor generators for tobacco, tobacco products and tobacco substitutes; heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products; electric heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products.

34. Regarding the goods concerned in the present case, it must be pointed out that the average consumer who purchases tobacco products, is generally more alert and better informed in comparison with the purchase of other common consumer products, because this consumer demonstrates loyalty to marks covering products habitually purchased by him/her and, consequently, has a greater degree of care at the time of choosing the goods in question (reference is made to EGC cases, Turkish Power, T-34/04, 22 June 2005 et Kiowa, T-207/08, 18 May 2011). This only strengthens the conclusion above that the signs are not similar enough to conclude an existence of a likelihood of confusion on the part of the public concerned.

B. Other factors

35. Regarding the defendant's references to decisions from other trademark authorities with regard to opposition proceedings concerning the same signs (paragraph 14), the Office points out that it is obliged to render a decision based on regulation and case law applicable in the Benelux. The Office is not bound by decisions from other offices, whether they refer to similar cases or not (see, by analogy with, EGC decision, Curon, T- 353/04, 13 February 2007).

C. Conclusion

36. The overall impression of the signs is not similar. For this reason, it is not necessary that the Office conducts a comparison of the goods. After all, there could not exist a likelihood of confusion if the signs are not similar, even if the goods were to be found to be identical (see EGC decisions, easyHotel, T-316/07, 22 January 2009 en YOKANA, T-103/06, 13 April 2010).

IV. DECISION

37. The opposition with number 2009903 is rejected.

38. International application with number 1201181, having effect in the Benelux, will be registered for all goods for which it has been applied.

39. The opponent shall pay the defendant 1,000 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, 17 January 2017

Eline Schiebroek
(*rapporteur*)

Saskia Smits

Pieter Veeze

Administrative officer: Raphaëlle Gérard