



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2011112

of 16 March 2018

Opponent: British American Tobacco (Brands) Limited

Globe House, 4 Temple Place
London WC2R 2PG, England
Great-Britain

Representative: Novagraaf Nederland B.V.

Hoogoorddreef 5
1101 BA Amsterdam
The Netherlands

Invoked right 1: EU trademark 14246921

CLICK 4 MIX

Invoked right 2: EU trademark 14169734

DOUBLE CLICK COLD

Invoked right 3: International registration 1211446

DOUBLE CLICK

Invoked right 4: International registration 1108191

CLICK ON

Invoked right 5: EU trademark 9505348

CLICK

Invoked right 6: EU trademark 9492828

CLICK & ROLL

Invoked right 7: **International registration 1052888**

CLICK SWITCH REFRESH

against

Defendant: **Philip Morris Products S.A.**

Quai Jeanrenaud 3

2000 Neuchâtel

Switzerland

Representative: **HOYNG ROKH MONEGIER LLP**

Nerviërslaan 9-31

1040 Brussels

Belgium

Contested trademark: **International application 1249287**

CLICLOK

I. FACTS AND PROCEEDINGS**A. Facts**

1. On 8 April 2015 the defendant filed an international trademark application, having effect in the Benelux, for the word mark CLICLOK for goods in class 34. This application was processed under number 1249287 and was published on 4 June 2016 in the WIPO Gazette of International Marks 2015/21.

2. On 4 August 2015 the opponent filed an opposition against the registration of the application. The opposition was initially based on the following earlier trademarks:

- EU trademark 14246921 of the word mark CLICK 4 MIX filed on 11 June 2015 and registered on 11 January 2016 for goods in class 34;
- EU trademark 14169734 DOUBLE CLICK COLD filed on 27 May 2015 and registered on 14 October 2015 for goods in class 34;
- International registration 1211446 of the word mark DOUBLE CLICK, designating among others the European Union, filed and registered on 16 May 2014 for goods in class 34;
- International registration 1108191 of the word mark CLICK ON, designating among others the European Union, filed and registered on 27 January 2012 for goods in class 34;
- EU trademark 9505348 of the word mark CLICK filed on 8 November 2010 and registered on 26 April 2011 for goods in class 34;
- EU trademark 9492828 of the word mark CLICK & ROLL filed on 3 November 2010 and registered on 17 March 2011 for goods in class 34;
- International registration 1052888 of the word mark CLICK SWITCH REFRESH, designating among others the European Union, filed and registered on 8 September 2010 for goods in class 34.

3. After the introduction of the opposition, the opponent explicitly renounced the right invoked 1211446 as a basis for this opposition. The opposition is therefore based on the remaining six rights invoked.

4. According to the registers the opponent is the actual holder of the trademarks invoked.

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

6. The grounds for opposition are those laid down in article 2.18 in conjunction with 2.14, 1 (a) the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

7. The language of the proceedings is English.

B. Chronological order of the proceedings

8. The opposition is admissible and was notified to the parties on 6 August 2015. 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"). In addition the proceedings were suspended several times at the request of the parties and twice on a motion from the Office itself, the first time because one of the rights invoked had not yet been registered and the second time because an

invalidation/revocation action had been instituted in respect of one of the rights invoked which action was withdrawn again later. The administrative phase was completed on 30 June 2017.

9. In the notice of opposition that the Office sent to the parties, it erroneously left out two of the seven rights invoked. These two rights were however taken into account later in the analysis on the merits of the case (see paragraph 41).

II. ARGUMENTS

10. The opponent filed an opposition at the Benelux Office for Intellectual Property (hereinafter: "the Office") under article 2.18 in conjunction with 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. Arguments of the opponent

11. The opponent argues that the contested sign should be refused for all goods in class 34. The contested sign is highly similar to the rights invoked and applied for identical and similar goods. Thus, there exists a likelihood of confusion.

12. The opponent explains that the dominant and striking element of the rights invoked is the word CLICK. The first syllable of the contested sign, CLIC, is almost identical to the rights invoked and will catch the eye. The last syllable, LOK, will not attract the relevant consumer's attention and this addition is thus insufficient to negate a likelihood of confusion between the signs, according to the opponent.

13. Visually, the similarity between the signs is obvious, since the words CLICK and CLIC are nearly identical. For the same reason, the phonetical similarity is high as well, according to the opponent. Conceptually, the signs are identical as they both refer to "a short sharp sound".

14. The opponent states that the goods of the defendant are partly identical and partly highly similar to the goods of the opponent.

15. The opponent points out that the relevant territory for the purposes of the opposition is the Benelux. The signs at issue cover a range of tobacco products and related goods in class 34 which are aimed at the public at large. The relevant public is the average end consumer. Where many of the class 34 goods at issue are concerned, the relevant consumers will have a higher than average level of attention. However, given the high degree of similarity between the signs at issue and the identity of the goods they cover, this in itself is insufficient to rule out a likelihood of confusion.

16. The opponent is of the opinion that there is an undeniable risk that the average consumer, confronted with almost identical signs for identical goods will be confused as to the origin of the goods offered. Therefore the opponent asks that the contested sign should be refused registration and that the defendant is ordered to pay the fees and costs of the opposition.

B. Arguments of the defendant

17. The defendant requests that the Office ignores the rights invoked CLICK 4 MIX and DOUBLE CLICK COLD which are out of the scope of the opposition because they are referred at a later stage during the opposition proceedings and not in the opposition notice.

18. The defendant argues that the goods of the contested sign and the rights invoked are similar goods related to tobacco.

19. The signs are similar to the extent that they share the first letters C-L-I-C. However, there are notable differences. Visually, the contested sign contains two word elements combined in one word. The rights invoked are composed of either one single word or two or three separate words. Phonetically, the second syllable of the contested sign, LOK, is pronounced completely different than the rights invoked. Conceptually, the contested sign has no specific meaning. All earlier rights are well known and easily understandable English nouns. The word CLICK expresses 'a short light often metallic sound' used 'to make a clicking sound'. This word will be understood by the relevant consumer as referring to something that clicks, according to the defendant. Combined with ON, it will be understood as referring to an action to click something that will trigger an action. The verb ROLL means 'to move or cause to move along by turning over and over' and the symbol '&' is the equivalent of the conjunction 'and'. The relevant consumers will therefore understand that it refers to two steps to follow: click on something and roll that same thing or something related to it, according to the defendant. The noun 'SWITCH' means 'a mechanical, electrical or electronic device for opening or closing a circuit or for diverting a current from one part of a circuit to another', the verb meaning 'to shift, change, turn aside, or change the direction of (something)'. The defendant explains that REFRESH means 'to make or become fresh or vigorous, as through rest, drink, or food; revive or reinvigorate'. CLICK SWITCH REFRESH will then be understood by the relevant public as referring to a step and action to get to a specific result: click on something that will activate a change and provide a sensation of freshness.

20. The defendant is of the opinion that the word CLICK, comprised in each of the rights invoked, is the one and only element that supports a finding of similarity. It is however a common descriptive word with an obvious meaning in relation to the class 34 goods as it relates to a specific feature whereby a flavour capsule in the cigarette can be activated ('clicked') to release flavour in the cigarette.

21. The relevant public, smokers, will display a higher degree of attention, according to the defendant, as they are particularly careful and selective about the brand of cigarettes they smoke.

22. Now that the signs only share an element with low distinctiveness, the assessment of likelihood of confusion must focus on the impact of the other components on the overall impression of the signs. The defendant states that CLICLOK will be perceived by the relevant public as a fancy word, while all the earlier rights use the word CLICK and ON, ROLL, SWITCH, REFRESH and the commonly known symbol '&' merely for describing characteristics of the goods.

23. Therefore, the defendant concludes that there is no likelihood of confusion. He requests that the opposition be rejected and that the application be registered.

III. DECISION

A.1 Likelihood of confusion

24. 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.

25. 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.”*

26. According to case law of the Court of Justice of the European Union 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 goods

27. 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).

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

29. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 34: Cigarettes <i>International registration 1108191</i>	CI 34: Tobacco, raw or manufactured; tobacco products; cigars, cigarettes, cigarillos, tobacco for roll-your-own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); electronic cigarettes; tobacco products for the purpose of being heated; electronic devices and their parts for
CI 34: Tobacco; smokers' articles; matches; absorbent paper for tobacco pipes; ashtrays for smokers; books of cigarette papers; chewing tobacco; cigar cases; cigar cutters; cigar holders; cigarette cases; cigarette filters; cigarette holders; cigarette paper; cigarette tips;	

<p>cigarettes; cigarettes containing tobacco substitutes, not for medical purposes; cigarillos; cigars; firestones; gas containers for cigar lighters; herbs for smoking; humidors; lighters for smokers; match boxes; match holders; matches; mouthpieces for cigarette holders; mouthpieces of yellow amber for cigar and cigarette holders / tips of yellow amber for cigar and cigarette holders; pipe racks for tobacco pipes; pocket machines for rolling cigarettes; snuff; snuff boxes; spittoons for tobacco users; tobacco; tobacco jars; tobacco pipes; tobacco pouches; Cigarettes; tobacco products not including snus; lighters; none of the afore-mentioned goods including pipe cleaners for tobacco pipes.</p> <p><i>EU trademark 9505348</i></p>	<p>the purpose of heating cigarettes or tobacco in order to release nicotine-containing aerosol for inhalation; smokers' articles, cigarette paper, cigarette tubes, cigarette filters, tobacco tins, cigarette cases, ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters, matches.</p>
<p>Cl 34: Tobacco; smokers' articles; matches; absorbent paper for tobacco pipes; ashtrays for smokers; books of cigarette papers; chewing tobacco; cigar cases; cigar cutters; cigar holders; cigarette cases; cigarette filters; cigarette holders; cigarette paper; cigarette tips; cigarettes; cigarettes containing tobacco substitutes, not for medical purposes; cigarillos; cigars; firestones; gas containers for cigar lighters; herbs for smoking; humidors; lighters for smokers; match boxes; match holders; matches; mouthpieces for cigarette holders; mouthpieces of yellow amber for cigar and cigarette holders / tips of yellow amber for cigar and cigarette holders; pipe racks for tobacco pipes; pocket machines for rolling cigarettes; snuff; snuff boxes; spittoons for tobacco users; tobacco; tobacco jars; tobacco pipes; tobacco pouches; Cigarettes, tobacco products, lighters. None of the afore - mentioned goods including pipe cleaners for tobacco pipes.</p> <p><i>EU trademark 9492828</i></p>	
<p>Cl 34: Cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles.</p> <p><i>International registration 1052888</i></p>	
<p>Cl 34: Cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles.</p> <p><i>EU trademark 14246921</i></p>	
<p>CL 34: Cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles.</p> <p><i>EU trademark 14169734</i></p>	

30. The defendant acknowledges that the goods of the rights invoked and the goods of the contested sign are similar goods related to tobacco. As the similarity of the goods is *in confesso* between the parties (paragraph 14 and 18) the Office will not proceed to a further comparison of the goods.

31. However, it should be noted that when it comes to tobacco products, smokers are considered particularly careful and selective as to the brand of cigarettes they smoke so a higher degree of brand loyalty and attention is assumed when tobacco products are involved. However, this will not be the case when smokers buy lighters for example. Therefore, in the case of tobacco products a higher degree of similarity of the signs may be required for confusion to occur (EGC, Kiowa, T-207/08, 18 May 2011).

Comparison of the signs

32. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
CLICK ON	CLICLOK
CLICK	
CLICK & ROLL	
CLICK SWITCH REFRESH	
CLICK 4 MIX	
DOUBLE CLICK COLD	

33. 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).

34. 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).

35. 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).

36. The rights invoked are all word marks. They consist respectively of one (CLICK), two (CLICK ON) or three elements (CLICK & ROLL; CLICK SWITCH REFRESH; CLICK 4 MIX; DOUBLE CLICK COLD). Each of the rights invoked contains the word CLICK, either at the beginning of the sign or as the second word. The contested sign is also a word mark consisting of one word CLICLOK.

37. Generally, the public will not consider a descriptive element forming part of a mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003). This is the case for the word element CLICK, which all rights invoked have in common. The word CLICK is an English

term meaning to strike, move or produce with a click (indicating a short, sharp sound); to turn (something) on or off by pushing a button or moving a switch¹. This term belongs to the basic knowledge of English of the Benelux consumer and will thus be understood by the relevant public. In relation to smokers' articles and tobacco products the word CLICK is descriptive. Flavours can be released in cigarettes through clicking a flavour capsule embedded in the filter. In light of the foregoing, the word CLICK can thus be perceived as an indication that a click has to be performed on these tobacco products in order to activate a certain function, like releasing a flavour.

38. As for the contested sign, the Office states that the sign will be perceived by the public as a whole and thus as a fanciful term that has no meaning.

39. Even though, by analogy to the case law of the European Court of Justice in the case F1-LIVE (C-196/11 P, 24 May 2012), the distinctive character of an EU trademark or an international trademark with validity in the EU, that serves as the basis for an opposition, cannot be deemed null, the Office considers that the rights invoked only have a very low distinctive character for the smokers' articles and tobacco products concerned given the descriptive nature of the element CLICK in relation to the goods concerned.

40. Taking into account the low degree of distinctive character of the rights invoked and the higher level of attention with the relevant public for tobacco products, the Office considers that there will be no likelihood of confusion even if the goods are deemed similar. The Office finds that a risk of confusion between the signs at issue can only exist here if the signs would be identical, which is not the case. The element CLICK in the rights invoked has a precise meaning, while the contested sign is a fanciful term. This clear conceptual difference between the signs is sufficient to neutralize the points of similarity. As for the rights invoked consisting of the word CLICK and one or more other words, the addition of these other words makes the differences between the signs even bigger. Therefore, the Office concludes that the overall impression of the signs is different.

B. Other factors

41. The defendant requests that the rights invoked CLICK 4 MIX and DOUBLE CLICK COLD be ignored as they are referred at a later stage during the opposition proceedings and not in the opposition notice (paragraph 17). The Office acknowledges that these two rights were rightfully invoked by the opponent at the time of the introduction of this opposition, however they were erroneously left out of the notice of opposition (paragraph 9). This was only noticed at the time of the examination on the merits of the opposition. The Office established however when analysing the case at hand that the two rights invoked, that were left out, are of a very similar composition as the rights invoked that were mentioned in the notice of opposition (they also consist of the word CLICK combined with one or more other words: CLICK 4 MIX and DOUBLE CLICK COLD). Furthermore, these two rights are also registered for identical goods in class 34 as the remaining rights invoked that were mentioned in the notice of opposition. Taking into account the foregoing, the Office decided that it was not necessary to reopen the debates and that the two rights invoked that were originally left out of the notice of opposition can be taken into consideration in the examination on the merits of the opposition here. Given the similar composition and the identity/similarity of the goods, the Office finds on the one hand that the arguments the defendant raised regarding the rights invoked that were mentioned in the notice of opposition can be transposed here and also apply to the two rights invoked that were left out and on the other hand that taking into account these two rights does not affect the outcome of the decision.

¹ <https://www.merriam-webster.com/dictionary/click>.

42. The opposition proceedings with the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.16, 5 BCIP and rule 1.32, 3 IR only stipulates in this respect that an amount equalling the basic opposition fee shall be borne by the losing party (paragraph 16).

C. Conclusion

43. Based on the foregoing and taking into account the higher level of attention with the relevant public for tobacco products, the Office is of the opinion that there is no likelihood of confusion.

IV. DECISION

44. The opposition with number 2011112 is rejected.

45. Benelux application with number 1249287 will be registered.

46. 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, 16 March 2018

Tineke Van Hoey
(*rapporteur*)

Diter Wuytens

Camille Janssen

Administrative officer: Etienne Colsoul