

BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2011979
of 24 August 2017

Opponent: **Unity AG**
Lindberghring 1
33142 Büren
Germany

Representative: **24 IP Law Group France**
48 rue Saint-Honoré
75001 Paris
France

Invoked right: Unity (European Trademark 10839793)

against

Defendant: **MIP METRO Group Intellectual Property GmbH & Co. KG**
Metro-Straße 1
40235 Düsseldorf
Germany

Representative: **Novagraaf Nederland**
Hoogoorddreef 5
1101 BA Amsterdam
Netherlands

Contested trademark:  (International registration 1292668)

I. FACTS AND PROCEEDINGS

A. Facts

1. On 20 November 2015 the defendant made an international trademark application, having effect in the Benelux, for the complex trademark  for goods and services in classes 9, 38, 41 and 42. This application was processed under number 1292668 and was published on 17 March 2016 in the WIPO Gazette of International Marks 2016/10.

2. On 17 May 2016 the opponent filed an opposition against this registration in the Benelux. The opposition is based on the European trademark 10839793 for the word mark Unity, filed on 26 April 2012 and registered on 27 November 2013 for goods and services in classes 9, 16, 35 and 42.

3. According to the register the opponent is the actual holder of the trademark 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 trademark 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 19 May 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 26 October 2016.

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. According to the opponent, the goods and services at issue are targeted at both the general public and professionals. Therefore, the likelihood of confusion must be assessed against the perception of the general public having a low degree of attentiveness.

10. In assessing the similarity of the goods and services concerned, the opponent is of the opinion that the goods and services in classes 9 and 42 are identical. The services in classes 38 and 41 are in his view at least extremely similar, taking into account their intended purpose, their method of use and their usual origin.

Furthermore, these services are complementary to and in competition with the goods and services of the right invoked.

11. The opponent observes that both signs start with the identical four letters UNIT. Since the letters at the beginning of a sign are considered decisive, there exists a high degree of visual similarity between the signs. As for the conceptual comparison, the opponent points out that the word *unity* means the state of being united or joined as a whole, whereas *united* means that something is joined together for a common purpose. Consequently, in the opinion of the opponent there exists a very high degree of conceptual similarity between the signs.

12. In consideration of the above, the opponent concludes that the contested sign is not sufficiently distant from the right invoked to preclude a likelihood of confusion. The opponent therefore requests that the Office rejects the contested sign in the Benelux and obliges the defendant to bear the fees and the costs of the present opposition proceedings.

B. Defendant's arguments

13. According to the defendant, the figurative element of the contested sign is eye-catching and has a major impact on the overall impression of the sign. Furthermore, the use of the colours and the overall graphic presentation lead to a dissimilar overall appearance of the signs.

14. Phonetically the accent is on the first syllable in the right invoked, whereas it is on the second in the contested sign. Furthermore, the sound of the ending of the word elements is highly dissimilar, as the right invoked ends with the shrill sound Y and the contested sign with a clearly noticeable D. In an overall comparison, the signs are therefore phonetically dissimilar, according to the defendant.

15. In the defendant's opinion, the word elements of both signs have clear and distinctive meanings and should be recognized by the Benelux consumer. The term UNITY is a noun and is understood as defined in various dictionaries as a thing forming a complex whole. The word UNITED is an adjective, meaning joined together politically, for a common purpose or by common feelings. The Benelux public is likely to associate the term UNITED with commonly used terms such as "United Kingdom", "United Nations" or "United States of America". According to the Oxford dictionary, the term UNITED is also often used in the names of soccer and other sports teams formed by amalgamation and the Benelux public will therefore be likely to associate the term with sports teams such as Manchester United.

16. Whilst the terms UNITY and UNITED may be related by definition, according to the defendant they have a clear and separate meaning. The terms therefore are conceptually dissimilar and further conceptual dissimilarity is clear from the presence of the figurative element in the contested sign, which consists of a globe and an arrow.

17. As the trademarks are not similar, the defendant thinks it is not necessary to assess the similarity of the goods and services.

18. Contrary to what the opponent states, the defendant establishes that even the average consumer is deemed to be reasonably well-informed, observant and circumspect, and thus the average level of attention must be deemed to be normal.

19. The defendant finds that both the right invoked and the word element of the contested sign have a weak distinctiveness, as also shown by the registries, where there seems to be a rather large number of trademarks containing the element UNITY or UNITED. According to the defendant, that is why the figurative element in the contested sign has a significant impact on the overall appearance of the trademark.

20. In conclusion, the defendant requests that the Office rejects the opposition and decides that all costs incurred by him in relation to this matter be borne by the opponent.

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 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; 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


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).

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). 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).

27. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
Unity	

Visual comparison

28. The right invoked is a word mark, consisting of one word of five letters, "Unity". The contested sign is a combined word/figurative trade mark, comprising the word UNITED in blue, somewhat square letters, followed by an incomplete yellow globe, containing white meridians and a blue upwards-pointing arrow on its right side below.

29. 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). In the contested sign, the figurative elements are not negligible (see in this sense *Gerechthof 's-Gravenhage, 4move*, 200.105.827/01, 11 September 2012), but the word element on the other hand takes up by far the greatest part of the sign and moreover, this element is situated at the beginning of the sign, on which in general the consumer's mind is focused (see CJEU, *Mundicor*, T-183/02 and T-184/02, 17 March 2004).

30. The first four letters of the trademark and the sign are identical and appear in the same order, taking into account that the difference in the use of capitals and lower-case letters is irrelevant for the purposes of a visual comparison of the signs (see EGC, *babilu*, T-66/11, 31 January 2013). The only differences, in the final letter of the right invoked and the two final letters of the verbal element of the contested sign, are of less importance, firstly because these letters appear at the very end of these words and secondly because they will be perceived as word endings.

31. Visually, the trade mark and the sign are similar.

Aural comparison

32. 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).

33. Both the right invoked and the contested sign number three syllables, so they have the same length and rhythm. Although the first four letters are identical from a visual point of view, their pronunciation does not

completely coincide. The right invoked will be pronounced as [ˈyü-nə-tē], the contested sign on the other hand as [yü-ˈnī-təd] (see <https://www.merriam-webster.com/dictionary>). The first syllable is phonetically identical, as are the letters N and T. Furthermore, there is a slight similarity in the last syllable, as it contains the sound [e] and the last letter of the contested sign will be pronounced weakly.

34. Overall, the signs are aurally similar in a certain degree.

Conceptual comparison

35. The right invoked is a noun whilst the contested sign is an adjective. Notwithstanding these different grammatical categories, the consumer will easily recognise the common prefix UNI and its meaning (one, single). According to <https://www.merriam-webster.com/dictionary/uni>, UNITY means (among other things) “the quality or state of being made one: UNIFICATION”. One of the meanings of UNITED is “made one: COMBINED”.

36. Although the signs do not have exactly the same meaning, they refer to more or less the same concept and are therefore conceptually similar in a certain degree.

Conclusion

37. Visually, the signs are similar. Aurally and conceptually they are similar in a certain degree.

Comparison of the goods and services

38. 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).

39. 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.

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

Opposition based on:	Opposition directed against:
Class 9 Compact discs (read-only memory); Compact discs (audio, video); Computer operating programs (recorded); Computer programs, recorded; Computer programs (downloadable); Computer software (recorded); Floppy disks; Electronic publications (downloadable).	Class 9 Recorded data files; recorded data; information technology and audiovisual equipment; navigation, guidance, tracking, targeting and map making devices; computer software; databases [electronic]; digital maps; electric or electronic data index; data recorded electronically; computer programmes [stored in digital form]; computer programs [downloadable].
Class 16 Pamphlets; Diagrams; Graphic representations; Catalogues; Instructional and teaching material (except apparatus); Publication.	
Class 35 Cost-price analysis; Business information; Business management and organization consultancy services; Business management consultancy; Business consultancy and advisory services; Computerised file managing; Development of usage concepts for real estate with	

<p>regard to professional business matters (facility management); Business investigations; Accountancy; Compilation of statistics; Drawing up of business expert reports; Economic forecasting; Commercial information services; Statistical information; Assistance to commercial or industrial firms in the conduct of their business; Business information services; Market research; Marketing, including on digital networks; Business research; Business organisation consultancy; Organisational consultancy; Organisational project management in the field of electronic data processing; Maintenance of data in computer databases; Planning and monitoring of business developments with regard to organisational matters; Planning (assistance) regarding management; Systematic ordering of data in computer databases; Business consultancy; Business appraisals; Collating of data in computer databases.</p>	
	<p>Class 38 Telecommunications; transmission of data or audio visual images via a global computer network or the internet; transmission of video films for selected user groups; electronic file transfer; providing access to a worldwide computer network; providing of worldwide computer network access services; providing user access to the internet (services providers); providing access via internet for social networking; access to content, websites and portals; providing chatroom services for social networking; provision of email services; providing access to interactive Internet forums; providing Internet chatrooms; internet service provider services; interactive communication services via computer; communications via a global computer network or the internet; on-line communication services; transfer of information and data via online services; distribution of data or audio visual images via a global computer network or the internet; providing online forums for communication on topics of general interest.</p>
	<p>Class 41 Education; entertainment; providing online electronic publications; electronic publication; on-line publication of journals or diaries [blog services].</p>
<p>Class 42 Updating of computer software; EDP consultancy; Development of usage concepts with regard to technical matters (facility management); Research and development (for others); Implementation of computer programs on networks; Technical consultancy; Technical project studies; Technical project management in the field of electronic data processing.</p>	<p>Class 42 Computer software design; updating of computer software for databases; designing and developing of computer databases; design services for computer software; software development, programming and implementation; planning, design, development and maintenance of online web sites for third parties; design and development of computer networks; web hosting services; software as a service [SaaS]; rental of software; IT consultancy, advisory and information services; IT security services in the nature of protection and recovery of computer data; computer network configuration services; rental and maintenance of computer software.</p>

Class 9

41. The goods *computer software* and *computer programs [downloadable]* appear *expressis verbis* in both lists and are thus identical.

42. The goods *computer programmes [stored in digital form]* of the contested sign belong to the goods *computer programs, recorded* and *computer software (recorded)* of the right invoked and are therefore identical to them. 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 to be 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).

43. The goods *recorded data files*, *recorded data* and *data recorded electronically* of the contested sign are similar to the goods *electronic publications (downloadable)* of the right invoked. Indeed, electronic publications consist of recorded data and, in a broader sense, of recorded data files.

44. The goods *information technology and audiovisual equipment* of the contested sign are to some extent similar to the goods *compact discs (audio, video)* of the right invoked. Indeed, the latter are mainly used to store and reproduce information, sound and images.

45. The goods *databases [electronic]* and *electric or electronic data index* of the contested sign are to a certain extent similar to the services *maintenance of data in computer databases* and *systematic ordering of data in computer databases* in class 35 of the right invoked. These goods and services have the same purpose and may be provided by the same kind of undertakings, so that the consumer can think that they have the same origin.

46. The goods *navigation, guidance, tracking, targeting and map making devices* of the contested sign are similar to the goods *computer programs, recorded, computer programs (downloadable)* and *computer software (recorded)* of the right invoked as they can coincide in end user and distribution channels. Nowadays, many devices can be equipped with appropriate software for navigation purposes, and therefore the consumer could think that these products have the same manufacturers.

47. The goods *digital maps* of the contested sign are identical to the goods *electronic publications (downloadable)* of the right invoked (see cases Fifties, Arthur et Félicie and Prozol, already cited).

Class 38

48. The services of the contested sign in this class are telecommunication services by means of computer networks. The nature and purpose of these services are different from those of the goods and services of the right invoked, which don't target specifically telecommunication purposes. The latter services are rendered by specialized undertakings which are not the same as the ones who provide the goods and services of the right invoked. Furthermore, these services target a different public and have different distribution channels. For these reasons, these services are not similar to any good or service of the right invoked.

Class 41

49. The services *providing online electronic publications, electronic publication* and *on-line publication of journals or diaries [blog services]* of the contested sign are highly similar to the goods *electronic publications (downloadable)* in class 9 and *publication* in class 16 of the right invoked. They have the same purpose and they share the same providers, distribution channels and target the same public.

50. The other services for which the contested sign is applied in this class (*education* and *entertainment*) are of a different nature and their purpose is different from that of the right invoked. Furthermore, these services are not in competition with the opponent's goods and services, nor are they complementary. Therefore, these services are not similar to the goods and services on which the opposition is based.

Class 42

51. The service *updating of computer software for databases* of the contested sign belongs to the broader category *updating of computer software* of the right invoked and is therefore identical to it.

52. The services *designing and developing of computer databases* of the contested sign belong to the broader category of the services *research and development (for others)* of the right invoked and are thus identical to them.

53. The service *software implementation* of the contested sign covers the service *implementation of computer programs on networks* of the right invoked and is thus identical to it.

54. The services *IT consultancy, advisory and information services and IT security services in the nature of protection and recovery of computer data* of the contested sign belong to the broader category of the services *technical consultancy, technical project studies and technical project management in the field of electronic data processing* of the right invoked and are therefore identical to them.

55. The services *computer software design, design services for computer software, software development and programming, planning, design, development and maintenance of online web sites for third parties, design and development of computer networks, software as a service [SaaS], rental of software, computer network configuration services and rental and maintenance of computer software* of the contested sign are similar to a certain degree to the goods *computer operating programs (recorded), computer programs, recorded, computer programs (downloadable) and computer software (recorded)* in class 9 of the right invoked. These services are inherent to computer software and programs, which need permanent development and updating. These goods and services are commonly furnished by the same enterprises and they target the same consumers.

56. The *web hosting services* of the contested sign are intended to allow organizations and individuals to serve content to the internet. These services are intertwined with the other internet services of the sign in class 38, rather than with any good or service of the right invoked. The nature and purpose of these services is different: they do not share the same distribution channels, are generally not offered by the same companies and do not target the same public. Therefore, these services are not similar to any good or service of the right invoked.

Conclusion

57. The goods and services at issue are partly identical, partly similar and partly not similar.

A.2 Global assessment

58. 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.

59. 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 goods and services at hand are intended for a professional public with either an average or above average level of attention, depending on the goods and services in question.

60. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken in 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).

61. 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.

62. 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 level of distinctiveness, as it is not descriptive of the goods and services concerned. The defendant on the other hand points out that the distinctiveness of the right invoked is rather weak. It should be borne in mind, however, that a likelihood of confusion cannot be precluded where the distinctive character of the earlier mark is weak. Even in a case involving an earlier 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 CEU, Kompressor, C-43/15, 8 November 2016 and the case law cited there).

63. The signs are visually similar and aurally and conceptually 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 and services originate from the same undertaking or from economically-linked undertakings.

B. Other factors

64. Both parties ask that all the costs of these proceedings be borne by the opposing party (see above points 12 and 20). 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

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

IV. DECISION

66. The opposition with number 20011979 is partially upheld.

67. The international registration with number 1292668, having effect in the Benelux, will not be registered in the Benelux for the following goods and services:

Class 9 All goods.

Class 41 Providing online electronic publications; electronic publication; on-line publication of journals or diaries [blog services].

Class 42 Computer software design; updating of computer software for databases; designing and developing of computer databases; design services for computer software; software development, programming and implementation; planning, design, development and maintenance of online web sites for third parties; design and development of computer networks; software as a service [SaaS]; rental of software; IT consultancy, advisory and information services; IT security services in the nature of protection and recovery of computer data; computer network configuration services; rental and maintenance of computer software.

68. The international registration with number 1292668, having effect in the Benelux, will be registered in the Benelux for the following goods and services, which were found not to be similar:

Class 38 All services.

Class 41 Education; entertainment.

Class 42 Web hosting services.

69. 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, 24 August 2017

Willy Neys
(*rapporteur*)

Eline Schiebroek

Saskia Smits

Administrative officer: Raphaëlle Gérard