

BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2012318

of 12 December 2017

Opponent: **THE HERSHEY COMPANY**

100 Crystal A Drive
Hershey, PA 17033
United States of America

Representative: **ARNOLD & SIEDSMA**

Meir 24 Bus 17
2000 Antwerp
Belgium

Invoked right: **European Union trademark 11239506**



against

Defendant: **LIMITED LIABILITY COMPANY "ANYKISS"**

vul. Rishelyevska, 5, Odeska obl.
Odesa 65000
Ukraine

Representative: **Bastiaan van den Bogaard h.o.d.n. Bastion IP**

Lange Heul 193
1403 NJ Bussum
The Netherlands

Contested trademark: International application 1302999

KISS
Chocolaterie

I. FACTS AND PROCEEDINGS

A. Facts

1. On 2 March 2016 the defendant filed an international trademark application, having effect in the Benelux,

KISS

for the complex trademark **Chocolaterie** for goods in class 30. This application was processed under number 1302999 and was published on 14 July 2016 in the WIPO Gazette of International Marks 2016/27.

2. On 13 September 2016 the opponent filed an opposition against the registration of the application. The opposition is based on the European Union trademark 11239506 of the following complex trademark filed on 4



October 2012 and registered on 7 May 2013 for goods in class 30:

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 of the goods of the trademark invoked.

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

6. The language of the proceedings is English.

B. Chronological order of the proceedings

7. The opposition is admissible and was notified to the parties on 16 September 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 was completed on 14 February 2017.

II. ARGUMENTS

8. 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

9. The opponent explains that he is a leading manufacturer of quality chocolate and non-chocolate confectioneries. The Hershey Kisses chocolates are one of the most popular brands of candies in the US, according to the opponent.

10. As for the comparison of the signs, the opponent argues that the relevant public will not consider the graphical element in the trademark invoked as dominant as it describes the goods at issue. Given the small letter font the word "Hershey's" is less dominant than the word "KISSES", which is represented six times as big. The word "KISSES" has an independent dominant role in the complex trademark. As for the contested sign, the word "chocolaterie" is a descriptive element with respect to the goods concerned and it will therefore not be considered as being part of the sign. The opponent explains that the contested sign is identical to the dominant element of the right invoked. The signs at issue are thus visually highly similar. Aurally the signs are highly similar as well as the right invoked will be pronounced as "KISSES" and the contested sign as "KISS". Conceptually the signs are identical as they both refer to "kiss(es)".

11. Furthermore the opponent finds that the goods of the defendant are partially identical and partially highly similar to the goods of the opponent.

12. The opponent is of the opinion that the goods found to be identical and similar are directed at the public at large. The degree of attention is rather low, since the goods are daily consumption products, purchased very often and of relatively low prices, according to the opponent.

13. Following the above, the opponent requests the Office to reject the contested sign in its entirety and to refer all costs to the applicant.

B. Arguments of the defendant

14. The defendant states that he is a manufacturer of Belgian-style chocolates in Ukraine. Both signs at issue are trademarks for chocolates. The relevant public here is the general public and they will display a normal level of attentiveness, according to the defendant.

15. As for the comparison between the goods, the defendant states that it is not contested that the goods "chocolate, chocolate confectionery" of the contested sign are identical to the goods "chocolate; cocoa products" of the right invoked.

16. The defendant argues that there is no aural similarity between the signs. It cannot be denied that the word element "Hershey's" plays an independent distinctive role in the complex right invoked. This because "Hershey's" is a household name, both in North America and in Europe. As such the Benelux consumers will interpret "Hershey's" as a reference to the commercial origin of the goods under the right invoked. Therefore, an aural comparison of the signs should be made between HER-SHEY'S-KISS-ES for the right invoked and KISS-CHO-CO-LA-TE-RIE for the contested sign. The signs have a different number of syllables. They only share one syllable KISS which is not in the same place. Even the word "kisses" is not reproduced identically in the contested sign, as the word used there is KISS in a singular form. The defendant also finds that the degree of visual similarity between the signs is low. The right invoked consists of three visual elements, two words and one depiction, placed in a particular arrangement. The contested sign only consists of two verbal elements. Two out of three elements composing the right invoked are completely absent in the contested sign and furthermore the word

“CHOCOLATERIE” in the contested sign is not reproduced in the right invoked, according to the defendant. The one element that both signs have in common, “KISS”, is not identically displayed in both signs either as the right invoked refers to the plural “KISSES” while the contested sign contains the singular form “KISS”. Additionally, the letter font in which the words “KISSES” and “KISS” are written differs significantly. Finally, conceptually, the defendant finds that the meaning of the word “kiss” will be perceived by the Benelux consumer as “to touch or press with the lips slightly pursed, and then often to part them and to emit a smacking sound, in an expression of affection, love, greeting, reverence, etc.” or “an act or instance of kissing”.

17. Given the well-known character of the brand “HERSHEY’S”, the defendant finds that the average consumer will interpret the presence of this name as a clear indication that the goods under the right invoked come from the opponent’s enterprise. On the other hand, no reference to the opponent’s business can be found in the contested sign. Therefore, the presence of the word “HERSHEY’S” clearly distinguishes the two signs. Overall the impressions conveyed by both signs are insufficiently similar to lead a reasonable well-informed and circumspect consumer to believe that he is dealing with products from one and the same company, or even economically-linked businesses. In support of his argument, the defendant refers to a similar opposition decision of the European Union Intellectual Property Office (hereinafter “EUIPO”).

18. The defendant concludes that the opposition should be rejected in its entirety and he requests that the opponent is ordered to pay the costs.

III. DECISION

A.1 Likelihood of confusion

19. 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.

20. 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.”*

21. 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 goods

22. 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).

23. In the comparison of the goods of the trademark 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.

24. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 30 Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice; Allspice; Almond confectionery; Almond paste; Aniseed; Aromatic preparations for food; Artificial coffee; Baking powder; Baking soda [bicarbonate of soda for cooking purposes]; Barley (Crushed -); Barley meal; Bean meal; Bee glue; Beer vinegar; Biscuits; Bread; Bread rolls; Breadcrumbs; Buns; Cake powder; Cakes; Candy; Capers; Caramels [candy]; Celery salt; Cereal-based snack food; Cereal preparations; Cheeseburgers [sandwiches]; Chewing gum; Chicory [coffee substitute]; Chips [cereal products]; Chocolate; Chocolate-based beverages; Chocolate beverages with milk; Chow-chow [condiment]; Chutneys [condiments]; Cinnamon [spice]; Cloves [spice]; Cocoa; Cocoa-based beverages; Cocoa beverages with milk; Cocoa products; Coffee; Coffee-based beverages; Coffee beverages with milk; Coffee flavorings [flavourings]; Coffee (Unroasted -); Condiments; Confectionery; Confectionery for decorating Christmas trees; Cookies; Cooking salt; Corn flakes; Corn meal; Corn, milled; Corn, roasted; Coulis (Fruit -) [sauces]; Couscous [semolina]; Crackers; Cream of tartar for cooking purposes; Cream of tartar for culinary purposes; Curry [spice]; Custard; Dressings for salad; Edible ices; Essences for foodstuffs, except etheric essences and essential oils; Farinaceous foods; Ferments for pastes; Flavorings, other than essential oils; Flavorings, other than essential oils, for cakes; Flavorings, other than	CI 30 Chocolate, chocolate confectionery.

essential oils, for beverages; Flour-milling products; Fondants [confectionery]; Frosting [icing] (Cake -); Frozen yogurt [confectionery ices]; Fruit jellies [confectionery]; Garden herbs, preserved [seasonings]; Ginger [spice]; Gingerbread; Glucose for culinary purposes; Gluten additives for culinary purposes; Gluten prepared as foodstuff; Golden syrup; Groats for human food; Gruel, with a milk base, for food; Halvah; Ham glaze; High-protein cereal bars; Hominy; Hominy grits; Honey; Husked barley; Husked oats; Ice cream; Ice cream (Binding agents for -); Ice for refreshment; Ice, natural or artificial; Iced tea; Infusions, not medicinal; Ketchup [sauce]; Leaven; Linseed for human consumption; Liquorice [confectionery]; Lozenges [confectionery]; Macaroni; Macaroons [pastry]; Malt biscuits; Malt extract for food; Malt for human consumption; Maltose; Marinades; Marzipan; Mayonnaise; Meal; Meat gravies; Meat pies; Meat tenderizers, for household purposes; Mint for confectionery; Molasses for food; Mousses (Chocolate -); Mousses (Dessert -) [confectionery]; Muesli; Mustard; Mustard meal; Noodle-based prepared meals; Noodles; Nutmegs; Oat-based food; Oat flakes; Oatmeal; Oats (Crushed -); Pancakes; Pasta; Pasties; Pastries; Pastry; Peanut confectionery; Pepper; Peppermint sweets; Peppers [seasonings]; Pesto [sauce]; Petit-beurre biscuits; Petits fours [cakes]; Pies; Pizzas; Popcorn; Potato flour for food; Powders for ice cream; Pralines; Puddings; Quiches; Ravioli; Relish [condiment]; Rice; Rice-based snack food; Rice cakes; Royal jelly; Rusks; Saffron [seasoning]; Sago; Salt for preserving foodstuffs; Sandwiches; Sauces [condiments]; Sausage binding materials; Sea water for cooking; Seasonings; Semolina; Sorbets [ices]; Soya bean paste [condiment]; Soya flour; Soya sauce; Spaghetti; Spices; Spring rolls; Star aniseed; Starch for food; Stick liquorice [confectionery]; Stiffening whipped cream (Preparations for -); Sugar; Sushi; Sweeteners (Natural -); Sweetmeats [candy]; Tabbouleh; Tacos; Tapioca; Tapioca flour for food; Tarts; Tea; Tea-based beverages; Thickening agents for cooking foodstuffs; Tomato sauce; Tortillas; Turmeric for food; Unleavened bread; Vanilla [flavoring] flavouring; Vanillin [vanilla substitute]; Vegetal preparations for use as coffee substitutes; Vermicelli [noodles]; Vinegar; Waffles; Weeds [condiment]; Wheat flour; Wheat germ for human consumption; Yeast.

25. Both parties agree that the goods of the contested sign are either identical or highly similar to the goods of the right invoked (see paragraphs 11 and 15). As the identity, or high similarity of these goods is already *in confesso* between the parties, the Office will not proceed to a comparison of these goods.



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, 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).

29. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

Conceptual comparison

30. The word “HERSHEY’S” in the right invoked is a fanciful term with no precise meaning. The word “KISSES” will be perceived by the Benelux public as the plural of the noun “kiss” meaning “the act of kissing; a caress with the lips”¹. The Office considers that the Benelux public has sufficient knowledge of the English language to understand the meaning of this basic word.

31. The contested sign also refers to the English word “kiss”. Furthermore, the word “Chocolaterie” will be perceived as the Dutch or French word for a chocolate shop. Generally, the public will not consider a descriptive

¹ <https://www.collinsdictionary.com/dictionary/english/kiss>.

element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003). As for the contested sign, the Office considers that the public will perceive the element "Chocolaterie" as merely descriptive in relation to food articles in class 30 that can all originate from a chocolate shop. Therefore, the public will consider the word "KISS" as the dominant element of the contested sign, meaning "the act of kissing".

32. Both the right invoked and the contested sign refer to the same concept of a kiss. The signs differ because of the reference to the word "HERSHEY'S" in the right invoked and to the word "chocolaterie" in the contested sign.

33. Conceptually the signs are similar to a certain degree.

Visual comparison

34. The right invoked is a complex trademark. It consists of two words "HERSHEY'S" and "KISSES". The word element "KISSES" is represented in a large bold black typeface. The word "HERSHEY'S" is placed above the word "KISSES" in a much smaller typeface. On the same level as the word "HERSHEY'S" appears a black and white photo of two wrapped candies. The contested sign is a complex trademark consisting of two words "KISS" and "Chocolaterie". The word element "KISS" appears as the first element of the sign in a bold dark grey typeface. Underneath is placed the word element "Chocolaterie" in a much smaller typeface.

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 in question by quoting their name than by describing the figurative element of the trademark (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). Although the figurative element of the wrapped candies in the right invoked will not be overlooked (see *Gerechtshof 's Gravenhage, MOOVE-4MOVE*, 200.105.827/0, 11 September 2012), it is not likely to be perceived by the public as the visually dominant element of the right invoked as it is a descriptive image for the food articles at issue in class 30. The word element "KISSES" on the other hand will particularly attract the consumer's attention as it is represented centrally in the sign in a big, bold typeface. The word "HERSHEY'S" appears in a much smaller typeface and will be perceived as of a secondary nature in the sign as a whole. Even though the consumer normally attaches more value to the first part of a sign (EGC decision, *Mundicor*, T-183/02 and T-184/02, 17 March 2004), the Office considers in this case that the word element "KISSES" clearly stands out compared to the word element "HERSHEY'S" because of its position and size and therefore the public will identify the word "KISSES" as the dominant element in the sign.

36. The graphical aspect of the contested sign can be qualified as rather marginal (see EGC, *Dieselit*, T-186/02, 30 June 2004). It only consists of the image of the two words of the sign in an ordinary black and white typeface. Such a graphical representation will not allow the consumer to focus his attention on any other figurative element than the letters of which the sign is composed. The word element "KISS" is the dominant element as it appears first in the sign and in a big, bold typeface which immediately catches the eye. The word element "chocolaterie" appears in a much smaller, finer typeface under the word "KISS".

37. Both signs share the four letters "KISS". They differ because of the addition of the word element "HERSHEY'S", the letters -ES at the end of "KISS" and the graphical element in the right invoked and because of the addition of the word "Chocolaterie" in the contested sign.

38. Visually the signs are similar to a certain degree.

Aural comparison

39. In the strict sense, the aural reproduction of a complex sign corresponds to that of all of 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).

40. The right invoked can be pronounced as HER-SHEY's KIS-SES, the contested sign as KISS CHO-COLA-TE-RIE. When referring to a trademark, the average consumer will not pronounce a caption or legend (EGC, Green by Missako, T-162/08, 11 November 2009) and a trademark comprising a number of terms will generally be abbreviated in order to make it easier to pronounce (EGC, BROTHERS by CAMPER, T-43/05, 30 November 2006). For this reason, the Office considers that at least part of the public could pronounce the right invoked as KIS-SES and the contested sign as KISS, also taking into account the descriptiveness of the element "Chocolaterie". In any case the pronunciation of the signs coincides in the element KISS.

41. Aurally the signs are similar to a certain degree.

Conclusion

42. The right invoked and the contested sign are conceptually and visually similar to a certain degree. Aurally the signs are either similar to a certain degree or similar.

A.2 Global assessment

43. 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.

44. 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 at issue are intended for the public at large with an average level of attention.

45. 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).

46. 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 trust in the imperfect picture of them that he has kept in his mind.

47. 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 concerned.

48. Based on the circumstances mentioned above, the Office finds, given the interdependence between the identity and high similarity of the goods and the certain degree of conceptual, aural and visual similarity of the signs, that the relevant public might believe that the goods in question originate from the same undertaking or from economically-linked undertakings.

B. Other factors

49. Regarding the defendant's reference to a decision by EUIPO concerning, in the defendant's view, a similar opposition (paragraph 17), 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 of other offices, whether they refer to similar cases or not (see, by analogy with, EGC, Curon, T- 353/04, 13 February 2007).

50. With reference to the defendant's request that the opponent should bear all costs of the proceedings (see paragraph 18), it must be recalled that opposition proceedings before the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.16, 5 BCIP, as well as 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

C. Conclusion

51. Based on the foregoing the Office concludes that there exists a likelihood of confusion.

IV. DECISION

52. The opposition with number 2012318 is justified.

53. Benelux application with number 1302999 will not be registered

54. The defendant shall pay the opponent 1,000 euros in accordance with article 2.16 (5) BCIP in conjunction with rule 1.32 (3) IR, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.

The Hague, 12 December 2017

Tineke Van Hoey
(*rapporteur*)

Pieter Veeze

Camille Janssen

Administrative officer: Rudolf Wiersinga