

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY  
OPPOSITION DECISION  
N° 2016508  
of 23 December 2021**

**Opponent:** **Rigo Trading S.A.**  
Route de Trèves 6 EBBC Building E  
2633 Senningerberg  
Luxembourg

**Representative:** **Rigo Trading S.A.**  
Route de Trèves 6 EBBC Building E  
2633 Senningerberg  
Luxembourg

**1<sup>st</sup> Invoked right:** **Benelux trademark registration 1420311**

GOLDBEARS

**2<sup>nd</sup> Invoked right:** **Benelux trademark registration 1310098**

GOLD-BEARS

*against*

**Defendant:** **French Panda Holding B.V.**  
Bellevuelaan 349  
2012BX Haarlem  
Netherlands


**Representative:** **N.A**

**Contested trademark:** **Benelux trademark application 1423936**



## **I. FACTS AND PROCEEDINGS**

### **A. Facts**

1. On 31 August 2020 the defendant filed a Benelux trademark application for the semi-figurative mark  for goods in classes 25 and 30. This application was processed under the number 1423936 and was published on the 25 September 2020.

2. On 18 November 2020 the opponent filed an opposition against the registration of the application. The opposition is based on:

- the Benelux trademark application 1420311 of the wordmark "GOLDBEARS", filed on 1 July 2020 and registered on 29 September 2020 for goods in class 25.
- the Benelux trademark application 1310098 of the wordmark "GOLD-BEARS", filed on 5 May 2015 and registered on 25 February 2016 for goods in class 30.

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

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

5. The grounds for opposition are those laid down in article 2.14, 2 (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" or "BOIP") to the parties on 24 November 2020. During the administrative phase of the proceedings both parties filed arguments. Within his arguments the defendant requested that the opponent submits proof of use for the invoked trademarks. Thereafter the opponent submitted a response to the opponent's request stating that the invoked trademarks were not subject to the requirement of use at the filing date of the contested trademark. The administrative phase was completed and a notification to that end was sent to the parties on 4 August 2021. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter "IR").

## **II. ARGUMENTS**

8. The opponent filed an opposition at the Office under article 2.14, 2 (a) BCIP, in accordance with the provisions of article 2.2ter, 1 (b) BCIP: the likelihood of confusion based on the identity or similarity of trademark and sign and the identity or similarity of the goods or services concerned and 2.2ter(3)(a) infringement of a trademark with a reputation.

### **A. Opponent's arguments**

9. The opponent starts his arguments with the comparison of the goods covered by the contested trademarks and notes that these are identical to those covered by the invoked trademarks.

10. Comparing the trademarks, the opponent finds them visually very similar as they are composed of the same structure and coincide in the sequence "GO\_D(-)BEAR". Furthermore, the hyphen in the invoked right will, according to the opponent be perceived as a space between verbal elements by the consumer and the letter "S" at the end of the invoked rights merely as a plural form. In addition, the fact that the trademarks coincide in their beginning and ending will reinforce the similarities as the consumer generally pays more attention to these parts. As regards the figurative element present in the contested trademark, the opponent considers that, it being a representation of a bear, it's presence would only strengthen the link created by the customer to the common word element "bear" in the signs.

11. Phonetically the opponent refers to the identical sequence present in both signs previously mentioned, to note the similarity between the trademarks. He notes also that the figurative element present in the contested trademark does not enter into consideration for the aural comparison.

12. As per the conceptual comparison, the opponent notes that both signs refer to bears. Furthermore, the invoked rights contain the word "GOLD" which could refer to a shiny metal, but can also be used to express a positive connotation or something fanciful. Considering this last meaning, the word "GOLD" is thus, according to the opponent, highly similar if not identical to the word "GOOD" contained in the contested trademark. It follows that the trademarks are, according to the opponent, identical or highly similar.

13. The opponent argues that the likelihood of confusion is further increased due to the highly distinctive character the invoked trademarks enjoy as a result of their reputation. To that end the opponent submits evidence showing the long-standing use related to candies and the vast popularity of the jelly candies sold under that name. The proof submitted by the opponent shows that the company Haribo has produced candy using the protected name for almost 100 years with extensive media promotion and commercial success. The trademarks have also been used in the Benelux since the 1980s. Due to its commercial success the opponent has decided to expand its line of activities to merchandising and submits as means of proof illustrations and excerpts of their offering in that sector. The opponent notes that it is not uncommon for companies in the food and beverage industry to expand their activities to clothing and merchandise and thus the consumers would likely export the reputation the opponent enjoys in the former sector to the latter. The opponent argues that this is further reinforced by the marketing and quality efforts made by means of associating themselves with celebrities and selecting established partner companies in the clothing industry.

14. In addition to the likelihood of confusion, the opponent argues that the invoked trademarks enjoy a reputation in the Benelux and that the contested trademark should be rejected on the basis of Article 2.2ter(3)(a).

15. As regards the reputation of the invoked trademarks and the similarity with the contested trademark and the goods covered, the opponent refers to his prior reasoning made concerning likelihood of confusion.

16. The opponent argues that there exists a risk of potential harm to the invoked trademarks since the contested trademark covers the same goods. In addition, the contested trademark would, according to the opponent, take unfair advantage of the reputation which the invoked trademarks enjoy and lead the consumers to creating a mental link with the latter. The opponent states that the defendant has no possible due cause justifying the use or registration of his application.

17. As a result of the above, the opponent considers that there exists a likelihood of confusion for the consumer and that the contested application is infringing on the reputation of the invoked trademarks. He asks the Office to grant the opposition, not to register the contested trademark and to order that the costs be borne by the defendant.

18. Following the request by the defendant, the opponent has not submitted proof of use. Instead the opponent submitted arguments outlining, among other things, that the invoked trademarks were not subject to the use requirement at the date of the filing of the contested trademark.

## **B. Defendant's arguments**

19. The defendant starts his arguments by comparing the activities of the parties. In that respect he notes that the defendant merely sells cookies in Utrecht as well as items of clothing, the profits of the latter being donated to charities. In comparison, the defendant notes that the opponent uses merely the translations of the invoked trademarks in the Benelux and requests the other party to provide proof of use for the invoked trademarks.

20. Comparing the trademarks in question, the defendant notes that the contested application contains a figurative element not present in the invoked trademarks. Furthermore, the defendant notes that both trademarks differ in length and composition, one being a nine letter word with the letter "L" and the other consisting of two 4 letter words without the letter "L".

21. The defendant notes further that the opponent made farfetched assumptions in his reasoning, namely, that the letters "S" and "L" and the figurative element in the signs in question can be ignored, that the trademarks sound the same, that the consumers in the Benelux do not understand the English word "bear" and that the words "good" and "gold" are synonyms. The defendant disagrees with those assumptions and notes that no proof for these was submitted.

22. Comparing the goods covered by the trademarks the defendant argues that they do not cover confectionary, nor do they plan to sell candy in the future. Concerning the goods covered in class 25, the defendant notes that there exists no likelihood of confusion due to the differences between the trademarks.

23. The defendant notes that the use of the trademarks by both parties differs with the opponent being a large scale commercial undertaking whereas the defendant uses his trademark in one single shop. There is thus no reason to believe that the consumer would create a link between both companies. Furthermore, the defendant notes that the look and feel of the GOLDBEARS and Good Bear are completely different and that the defendant does not seek to draw any competitive advantage from a resemblance to the invoked trademarks. Also the defendant notes that the opponent did not provide any proof of the claimed risk of confusion.

24. The defendant states that the contested application was done in good faith.

25. In that regard and considering the arguments above, the defendant finds that there exists no risk of confusion for consumers between the trademarks. Thus, he asks the Office to register the contested trademark and to order that the costs be borne by the opponent.

## **III. DECISION**

### **A.1 Proof of use**

26. In accordance with Article 2.16bis BCIP, the opponent, at the request of the defendant, shall furnish proof that the trademark invoked has been put to genuine use as provided for in Article 2.23bis BCIP or that proper reasons for non-use existed. The evidence must show genuine use in a period of five years preceding the filing or priority date of the trademark against which the opposition is lodged.

27. The filing date of the contested trademark is 31 August 2020. Therefore, the opponent was required to show use of the invoked trademark during the period from 31 August 2015 to 31 August 2020 ('the relevant period'). Given the fact that the trademarks invoked were registered less than five years prior to the filing date of the contested trademark, the defendant's request that proof of use is submitted is not legitimate.

28. There is no obligation for the opponent to prove the use of the invoked trademarks.

## **A.2 Likelihood of confusion**

29. In accordance with article 2.14 BCIP, the 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 2.2ter BCIP.

30. Article 2.2ter, para. 1 BCIP stipulates that, *"A trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*

31. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 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, ECLI:EU:C:1998:442; Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; 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, ECLI:NL:HR:2003:AK4818; Court of Appeal Brussels, N-20060227-1, 27 February 2006).


### **Comparison of the trademarks**

32. The wording of Article 5, 1 (b) of the Directive (cf. article 2.2ter, 1 (b) BCIP) according to which "there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark" 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, ECLI:EU:C:1997:528).

33. 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).

34. 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, ECLI:EU:C:2007:333). 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, ECLI:EU:T:2002:261 and *El Charcutero Artesano*, T-242/06, 13 December 2007, ECLI:EU:T:2007:391).

35. The trademarks to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
GOLDBEARS	
GOLD-BEARS	

#### *Visual comparison*

36. The invoked trademarks consist of the word elements "GOLD" and "BEARS" composed of 4 letters and 5 letters respectively, once written together, once separated by a hyphen. The contested trademark is composed of the word elements "Good" and "Bear" composed of 4 letters each as well as a figurative element representing a bear preceding the word elements.

37. 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, ECLI:EU:T:2005:289). The figurative element of the contested trademark in this case would probably not go unnoticed to the average customer. Nonetheless, the Office is of the opinion that the relevant public will perceive the verbal element as the dominant element of the contested trademark, due to its prominent position.

38. The consumer normally attaches more importance to the first part of a sign (EGC, *Mundicor*, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79). In the case at hand, the verbal elements of the trademarks concerned have the same beginning. The trademarks share 7 out of their 8 or nine respective characters, positioned identically in the invoked trademarks and the contested trademark, namely "GO" and "DBEAR".

39. The fact that the invoked trademarks are either written as one word or separated by a hyphen, contain only capital letters and end in the letter "S" present minor differences which are not sufficient to alter the global perception of the trademarks by the consumer.

40. The trademarks are visually similar.

*Aural comparison*

41. 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, ECLI:EU:T:2005:176 and Thai Silk, T-361/08, 21 April 2010, ECLI:EU:T:2010:152).

42. The trademarks consist of two word elements and are each composed of 2 syllables [GOLD] [BEARS] and [GOOD] [BEAR]. In addition to the previously mentioned point that consumers generally pay more attention to the beginning of a trademark (paragraph 38), the trademarks in this case are composed of very similar syllables both starting the same way. Furthermore, both signs share the same rhythm and cadence in their pronunciation.

43. Thus, the Office considers the trademarks to be aurally similar to a high degree.

*Conceptual comparison*

44. The invoked trademarks word elements "GOLD" and "BEARS" originate from the English language and will be understood by the Benelux consumers in their meaning, referring respectively to a valuable metal of a distinct yellow colour, and to an animal.

45. The contested trademark consists of the word elements "Good" and "Bear" which will be understood by the Benelux consumers as referring to a positive quality and to an animal respectively.

46. Both parties agree that the trademarks in question refer to bears. Furthermore, while the words "gold" and "good" do not have the same meaning, they can both be perceived as referring to the quality of the products offered and can thus be understood as conveying a similar message to consumers.

47. The trademarks are conceptually similar to a high degree.

*Conclusion*

48. The trademarks in question are visually similar, and phonetically and conceptually similar to a high degree.

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

49. 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 (CJEU, Canon, already cited).

50. With 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.

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

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
Cl 25 Clothing; footwear; headgear.	Cl 25 Beanies; Wristbands [clothing]; Aprons [clothing]; Jerseys [clothing]; Infants' clothing; Babies' clothing; Jackets [clothing]; Knitwear [clothing]; Kerchiefs [clothing]; Ladies' clothing; Men's clothing; Casual clothing; Infant clothing; Girls' clothing; Boys' clothing; Parts of clothing, footwear and headgear.
Cl 30 Confectionery.	Cl 30 Pastries, cakes, tarts and biscuits (cookies).

#### *Class 25*

52. The goods covered by the contested trademark within this class fall within the broader categories of "Clothing" of the invoked trademark. In addition, the goods "footwear; headgear" are explicitly named in both lists of goods. As a result the goods in this class are to be considered identical (see ECG Arthur et Félicie, T-346/04, 24 november 2005, ECLI:EU:T:2005:420).

53. The office concludes that the goods covered in class 25 are identical.

#### *Class 30*

54. The goods "Pastries, cakes, tarts and biscuits (cookies)." are considered highly similar to "confectionery" as they belong to the same broad category of sweets, that is food products characterised by a high sugar content, typically consumed as a dessert or sweet snack. Furthermore, these goods may be produced by the same manufacturers, can be found in the same sections of supermarkets and are in competition.

55. Thus, the goods covered by the trademarks in class 30 are similar to a high degree.

#### *Conclusion*

56. The goods covered by the contested trademark are in part identical and in part similar to a high degree to the goods covered by the trademarks invoked.

### **A.3 Global assessment**

57. 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.

58. 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 according to the category of goods or services in question. In the present case, the goods and services in question concern clothes and sweet food products. The Office considers that the level of attention of the relevant public can be considered normal for these goods.



59. 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 they cover. A lesser degree of similarity between the relevant goods can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited).

60. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). In the present case, it is not disputed that the trademark invoked has a normal inherent distinctiveness. As regards the elements submitted by the opponent concerning an acquired higher level of distinctiveness, the Office considers that the outcome of that assessment can be disregarded in this case considering that such a finding would not alter the outcome of the present decision. Thus, the Office considers that the earlier trademarks have a normal distinctiveness.

61. Account must also be taken of the circumstance that normally, the average consumer perceives a mark as a whole and does not proceed to analyse 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 marks but must place his trust in the imperfect picture of them that he has kept in his mind.

62. Based on the abovementioned circumstances, the Office finds that due to the in part identical, in part highly similar goods and the high degree of aural and conceptual similarities between the trademarks, as well as the visual similarities, the relevant public might believe that the goods in question would come from the same undertaking or from economically-linked undertakings.

## **B. Reputation**

63. Since the Office concludes that the trademarks in question are sufficiently similar as to establish likelihood of confusion, it will not - for reasons of procedural economy - carry out an assessment as to the infringement of a trademark with a reputation.

## **C. Other factors**

64. The defendant argues that the contested trademark will not be used for the same goods for which the trademarks invoked are used and is not aimed at the same audience (paragraphs 19, 22 and 23). The Office points out that the opposition procedure leaves no room for considerations concerning the actual or future use of the trademarks concerned. The comparison of the trademarks is solely based on the trademarks as registered (see to that effect: CJEU, Quantum, C-171/06, 15 March 2007, ECLI:EU:C:2007:171; 02 Holdings Limited, C-533/06, 12 June 2008, ECLI:EU:C:2008:339 and EGC, Ferromix e.a., T-305/06-T-307/06, 15 October 2008, ECLI:EU:T:2008:444).

65. In view of the legal basis of this opposition solely the assessment whether there exists likelihood of confusion for the relevant public is decisive. The defendant's argument that the contested trademark was filed in good faith (paragraph 24) is irrelevant for the outcome of the present decision.

66. In an opposition procedure there is no question of the other party being ordered to bear the costs incurred (see paragraphs 17 and 25). Only a referral of the costs set at the established opposition fee in case the opposition is totally justified (or rejected) is provided for.

67. Considering other arguments made by the opponent in his letter in response to the request for proof of use (paragraph 18), the Office notes that any points raised as regards the substance of the opposition or in response to the arguments of the defendant will not be considered in order to safeguard the principle of equal treatment of the parties during the proceedings.

**D. Conclusion**

68. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

**IV. DECISION**

69. The opposition with number 2016508 is justified.

70. The Benelux application with number 1423936 will not be registered.

71. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.



The Hague, 23 December 2021

*François Châtellier*  
(*rapporteur*)

*Pieter Veeze*

*Eline Schiebroek*

Administrative officer: Raphaëlle Gerard