

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY**  
**OPPOSITION DECISION**  
**N° 2018061**  
**of 28 June 2024**

**Opponent:** **FrieslandCampina Nederland B.V.**  
Stationsplein 4  
3818 LE Amersfoort  
Netherlands

**Representative:** **HGF B.V.**  
Gedempt Hamerkanaal 257  
1021 KP Amsterdam  
Netherlands

**Invoked trademark:** **Benelux registration 934863**



*against*

**Defendant:** **GRUPO CACAOLAT, S.L.**  
Avda. Francesc Macia 225-233  
08924 SANTA COLOMA DE GRAMANET (Barcelona)  
Spain

**Representative:** **Inaday Merken B.V.**  
Piet Heinstraat 12  
7511 JE Enschede  
Netherlands

**Contested sign:** **International trademark application 1650099**



## I. FACTS AND PROCEEDINGS

### A. Facts

1. On 15 December 2021, the defendant filed an International trademark application, designating inter alia the Benelux, for the combined verbal/figurative trademark



for goods in class 30. This application was processed under number 1650099 and was published on 17 March 2022.

2. On 16 May 2022, the opponent filed an opposition against the registration of the application. The opposition is based on the earlier Benelux trademark registration 934863 of the colour mark



Yellow (PMS 116 Uncoated)

filed on 15 March 2013 and registered on 10 June 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 covered by the contested application and is based on all goods covered by the trademark invoked.

5. The language of the proceedings is English.

### B. Proceedings

6. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 18 May 2022. Subsequently, the proceedings were suspended by request of the parties. On 21 November 2022, the opposition proceedings commenced. During the administrative phase of the proceedings both parties filed arguments and the defendant requested proof of use. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 25 July 2023.

## II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

7. 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 his own in accordance with Article 2.2ter BCIP. The opponent claims that the contested sign should not be registered based on the following grounds:

- Article 2.2ter(1) BCIP, likelihood of confusion: *"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."*
- Article 2.2ter(3)(a) BCIP, reputation: *"a trademark shall, in case an opposition is filed, not be registered (...) where: a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark"*.

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

8. The opponent explains that the company FrieslandFoods took over the Chocomel brand from Nutricia in 2001. In 2008, FrieslandFoods and Campina continued together as one company and the Chocomel brand became from that moment part of FrieslandCampina. Under the CHOCOMEL (Netherlands) and CÉCÉMEL (Belgium) brand, the opponent's chocolate milk products are available in the Benelux since 1932 and according to the opponent, the colour yellow (PMS 116U) has been consistently used on its products and in advertisements since.

9. The opponent argues that as a consequence of this intensive and extensive use over many years, this colour gained wide recognition and strong reputation over the past 90 years in relation to chocolate milk for which the trademark invoked is registered.

10. The opponent refers to several documents to substantiate the reputation of the trademark invoked, stating that the trademark invoked is clearly connected and particularly recognised in relation to chocolate milk. According to the opponent, the products containing the trademark invoked are distributed through nearly all major supermarkets in Netherlands and Belgium and is as well served in a vast majority of the cafes and restaurants in Benelux. In addition, the colour mark is used on structures to display the product in the supermarket, as well as on machines to make chocolate milk. The opponent also refers to examples of advertising and media exposure, the extent of advertising costs, as well as sales figures.

11. The opponent also refers to a study that shows that in the Netherlands in 2012 the "top of mind" awareness of the name Chocomel was 66%, while the total spontaneous awareness concerned 78% of the public. With regard to the name Cécémel, the "top of mind" awareness is 21%, while the total spontaneous awareness is 45% of the Belgian public. The opponent further states that the awareness of specifically the invoked colour mark has been researched as well. This report (dated January 2013) shows that the average spontaneous recognition of the Chocomel/Cécémel brand on the basis of solely the colour yellow on a packaging was 40% in the Netherlands and Belgium together. In the light of the evidence submitted, the opponent concludes that the trademark invoked has a strong reputation in the Benelux.

12. With regard to the similarity of the signs, the opponent states that the colour yellow is (nearly) identical in both signs. Since this colour is the only element of protection of the trademark invoked, the opponent argues that the trademark invoked is entirely copied in the contested sign. In addition, the colour yellow is the most eye-catching element in the contested sign. For this reason, according to the opponent,

the signs are visually highly similar. The opponent further states that an aural and conceptual comparison cannot be made.

13. According to the opponent, the goods '*cocoa-based beverages, chocolate-based beverages; chocolate beverages containing milk; beverages made with a base of chocolate; drinking chocolate; cocoa for use in making beverages cocoa-based products; cocoa-based foodstuffs, powdered beverages containing cocoa; preparations for making beverages based on cocoa; powdered preparations containing cocoa for making beverages; preparations for chocolate beverages; chocolate-based products; cocoa beverage with milk*' in the contested sign are identical or are at least including the goods as covered by the trademark invoked. Further, the contested goods '*cocoa; chocolate; chocolate powder; cocoa powder; cocoa-based creams in the form of spreads; chocolate confectionery; chocolates*' are highly similar to '*chocolate milk*', since all these goods concern cocoa or are cocoa based products, sharing the same main ingredient and thus the same nature, as well as the same manufacturers and distribution channels. The opponent also argues that the remaining goods '*coffee; sugar, pastry and confectionery; biscuits and cookies; edible ices; pastries, cookies, biscuits, brioches (buns)*' are similar to '*chocolate milk*', as they share the same purpose or are complementary as they are often served and consumed together.

14. With regard to the relevant public, the opponent argues that in the present case, the goods are directed at the public at large and at customers without specific professional knowledge or expertise. The relevant public's level of attention is therefore to be considered average.

15. With regard to the distinctive elements of the signs, the opponent argues that the word element in the contested sign is descriptive in relation to the goods chocolate milk, as the relevant Benelux public will clearly recognise the descriptive wording '*cacao*' (the main ingredient of chocolate milk) and '*lat*', short for '*latte*', the Italian word for milk, which is widely known in Benelux due to the common use of the word '*latte*' in relation to coffee with milk. As such, the word '*lat*' will be immediately understood as referring to milk. Moreover, in particular for the French speaking part of the Benelux public, there is also the strong similarity of '*lat*' with the French word for milk: '*lait*'. Consequently, when used in relation to chocolate milk, no doubt that the word element will be perceived as '*cocoa milk*' by the Benelux public, and is therefore merely descriptive. Furthermore, the letters are written in the colour brown, which colour is non-distinctive and generally used in relation to cocoa or chocolate products. Therefore, according to the opponent, the most striking, distinctive and dominant element of the contested sign is the colour yellow, identical to the only element of the earlier sign. The opponent states that in the trademark invoked, the colour yellow has acquired enhanced distinctiveness as well as a reputation in the Benelux, which results in an increased risk of confusion.

16. The opponent also argues that the background colour yellow is used by the defendant for the entire packaging of identical products, in the same way that the opponent's colour mark is used. According to the opponent, in the light of the similarity of the signs and the goods, as well as the reputation of the trademark invoked and the manner of use in practice, the public in the Benelux will easily make a link between the signs. The opponent further states that there is unfair advantage in the sense that 'some sort of boost' would be given to the contested sign as a result of this link. Not only are the signs highly similar, the relevant public is the same and the trademark invoked has a very strong reputation and distinctive character through its continuous and extensive use and promotion over 90 years. In addition, the opponent argues that the trademark invoked has an image of being a high-quality brand with a natural taste and focus on healthiness. For this reason, the public is prepared to pay a higher price for its products. According to the opponent it is obvious that the defendant seeks to take advantage of this.

17. The opponent points out that in 2014 the defendant already applied for a Benelux trademark, using



a different shade of yellow: (IR 1207804). Now suddenly, the defendant chooses to change the yellow background to a colour yellow that is strikingly close to the trademark invoked. The defendant also produces chocolate milk and for this reason it must surely have been aware of the existence and reputation of trademark invoked in the Benelux before adjusting its trademark.

18. Furthermore, since confusion is to be expected, this will necessarily mean that detriment is done to the distinctive character of the trademark invoked. In the case of confusion, the primary function of the earlier mark – i.e. an indication of origin – is impaired, and this will also result in impairment of (detriment to) the distinctive character, because the mark is no longer (or at least to a lesser extent) associated (only) with the opponent. There is also a serious risk that the economic behaviour of the average consumers of the goods covered by the trademark invoked will change, as a consequence of the use of the contested sign. After all, the consumer will no longer (immediately) associate the brand with the opponent and will therefore also no longer, or at least to a lesser extent, purchase the products of the opponent through the pulling force of its colour mark.

19. According to the opponent, it goes without saying that the use of the contested sign in relation to products that do not match with the image of the opponent can seriously damage the opponent's mark's repute. This particularly applies to the situation where the products bearing the contested sign are of lesser or even of poor quality.

20. In the light of the above, the opponent requests that the Office rejects the contested sign and grants the opponent an award of the costs.

#### *Request for proof of use*

21. The opponent submits evidence of use which includes packaging instructions, advertisements, social media posts, invoices, sales figures and screen prints of websites. In addition, the opponent also refers to the documents submitted previously together with the arguments in support of the reputation of the trademark invoked. According to the opponent, these documents show that the trademark invoked has been genuinely used in relation to the relevant goods within the relevant period in the Benelux.

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

22. The defendant argues that in the contested sign, the word element is the most dominant. According to the defendant, this is the element by which the public will recognize and denominate the contested sign. The public will refer to the trademark by its name, namely CHOCOMEL/CECEMEL and CACAOLAT. The signs CHOCOMEL and CACAOLAT are not very distinctive per se, therefore, in the present case, the public will clearly distinguish the mark CACAOLAT from a mere colour.

23. With regard to the comparison of the goods, the defendant states that the goods are identical insofar as it concerns chocolate drinks. However, the goods '*sugar, pastry and confectionary, chocolate confectionery, chocolates, biscuits and cookies, edible ices, pastries and brioches (buns)*' are not identical, nor strongly similar. For these goods there will be no confusion risk at all at the relevant public, which has an average level of attention. Although the opponent states that these goods are often served and consumed together, that does not constitute a ground for assuming the similarity of such goods.

24. The defendant further argues that the name CHOCOMEL may indeed be a very popular brand for chocolate milk in the Benelux. This name is used as a blue name on a yellow background. Although the opponent provides information about sales numbers and history of the colour yellow, the evidence and information relates to the colour yellow in combination with the word elements CHOCOMEL/CECEMEL. Furthermore, the pictures included in the annexes with the opponent's arguments show that the colour yellow of their brand has changed over the years as well to the various shades of yellow as used now and shown in the evidence in these annexes. As mentioned above, the names CHOCOMEL and CECEMEL are used in blue letters against a yellow background with some brown elements as well. According to the defendant these word elements constitute the dominant part by which the public recognizes and denominates the brand. In addition, many chocolate based drinks or milk based drinks use the colour yellow on their packages and the defendant refers to several pictures relating to trademarks of other parties, including Nesquik. For this reason, the defendant argues that the colour yellow for chocolate milk and other milk based drinks will not be recognized as the origin of the products.

25. The defendant explains that the trademark CACAOLAT has been founded in 1933. The long standing presence of this brand is a clear indication of the quality of the products sold under this trademark. The word mark CACAOLAT has been registered since 1953 and the trademark in stylized brown letters against a yellow background has been registered in 2014 as an international trademark registration designating the Benelux as well.

26. According to the defendant, no confusion has arisen at all between this earlier registration and the trademarks of the opponent. Furthermore, the background colour in the contested sign is slightly darker than the earlier registration, but it is not the same colour as the trademark invoked. The defendant therefore argues that the relevant public, which will mainly recognize the mark by its word part, will consider the new version as a more modern version of the existing trademark and as a brand update. The public will not confuse it with other brands or compare it therewith as they are familiar with the existing brand of the defendant and will recognize it as the defendant's brand.

27. The defendant states that the opponent's allegation that the defendant has changed the shade of the yellow background in order to take unfair advantage of the opponent's trademark is therefore unfounded. The allegation that the defendant's products might be of lesser quality than those of the opponent, or even of poor quality, is also unfounded.

28. Regarding the proof of use, the defendant states that if the colour yellow is present in the evidence, it is not certain if this is indeed the same colour as the trademark invoked. Furthermore, a part of the documents does not contain a date or fall outside of the relevant period. According to the defendant, although several shades of yellow have been used in advertisements relating to the products, these all are in combination with the name CHOCOMEL and/or CECEMEL and never as a colour per se, nor is it clear whether the invoked colour mark is used. For this reason, the defendant states that the evidence is not sufficient to prove genuine use in relation to the goods in the relevant period.

29. Defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition and decides that the opponent should bear the costs.

### III. DECISION

#### A. Proof of use

30. 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 five years prior to the filing or priority date of the trademark against which the opposition is lodged.

31. The contested sign is an international application based on an earlier Spanish basic application. The priority date of the contested sign is 21 October 2021. Given that the trademark invoked is registered for more than five years prior to the contested sign's priority date, the defendant's request for proof of use regarding these invoked rights is legitimate. The opponent was required to show use of the invoked trademark during the period from 21 October 2016 – 21 October 2021 ('the relevant period').

#### *In general*

32. In accordance with the case-law of the European Court of Justice (hereinafter: "CJEU") there is genuine use of a trademark if the mark, in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, is used in order to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.<sup>1</sup> When assessing whether use of the trade mark is genuine, regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.<sup>2</sup> In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly.<sup>3</sup>

33. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.<sup>4</sup> In interpreting the concept of genuine use, account should be taken of the fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trademark protection to the case where large-scale commercial use has been made of the marks.<sup>5</sup>

34. Genuine use of a trademark cannot be proven by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.<sup>6</sup>

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<sup>1</sup> CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis) and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

<sup>2</sup> CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:-80, point 83 (Pandalis) and CJEU 11 March 2003, C40/01, ECLI:EU:C:2003: 145, point 43 (Ansul).

<sup>3</sup> General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

<sup>4</sup> General Court (EU) 8 July 2004, T-334/01, ECLI:EU:T:2004:223, point 36 (Hipoviton) and General Court (EU) 30 April 2008, T-131/06, ECLI:EU:T:2008:135, point 41 (Sonia Sonia Rykiel).

<sup>5</sup> General Court (EU) 4 April 2019, T-910/16 and T911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

<sup>6</sup> General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

35. Following rule 1.25 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the trademarks invoked for the goods or services on which the opposition is based.

*Analysis of the proof of use*

36. The opponent submitted the following proof of use:

1. Photos of chocolate milk products (document dated 20 January 2023);
2. Identity guidelines for Chocomel/Cécémel (July 2004);
3. Images of advertisements (dated 1984 and 1985);
4. Pictures of use of the name Chocomel/Cécémel and the colour yellow on miniature truck, flag, chocolate milk machine, magazine, mugs, hats and other merchandise;
5. Screenprints social media pages showing advertisements and photos regarding publicity activities;
6. Several publications regarding Chocomel and the packaging (dated 2005 and 2014);
7. Market research dated January 2013 regarding the extent to which the public is able to identify chocolate milk from FrieslandCampina purely on the basis of the colour yellow;
8. Copy of the Wikipedia-page concerning Chocomel;
9. Overview of advertisement video's for Chocomel on YouTube;
10. Social media posts on Facebook with advertisements;
11. Invoices directed to different customers in Belgium, Netherlands and Luxembourg (dated between April 2017 and October 2021);
12. Screenprints of online sales offers of Chocomel/Cécémel products (dated between April 2017 and October 2021);
13. Screenprints of the websites cecemel.be and chocomel.nl.

37. Several documents do not contain a date or concern documents dated before the start of the relevant period. However, this does not necessarily mean that the documents should be disregarded as they may support the other evidence submitted. Accordingly, the Office will always assess the totality of the documents submitted on a case-by-case basis to determine whether there is genuine use.

38. The Office is of the opinion that the various ways of advertising (online and also by ways of promotional activities and merchandise) show that the colour yellow, that is identical to or highly resembles the invoked colour mark, is overtly present and used in a predominant way in advertisements to promote the chocolate milk products of the opponent (numbers 4, 5, 9, 10 and 12). Furthermore, the colour is used very consistently on the packaging, covering almost the entire carton, bottle, or cup in an eye-catching way (numbers 1, 5, 9, 10 and 12). In addition, the invoices (number 11) show the sales of the chocolate milk products in the Benelux during the relevant period.

39. The fact that the indication Chocomel or Cécémel is also present on the products does not mean that the colour is not used as a trademark. In this case, the Office finds that even in combination with a word element, the evidence shows trademark use of the colour mark, due to the striking and consistent way the colour is used on packaging and in promotional messages.

40. For this reason, considering the proof of use as a whole, the Office finds that genuine use is demonstrated for the trademark invoked.



**B. Likelihood of confusion**

41. 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.

42. Article 2.2ter (1) BCIP stipulates insofar as relevant 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."*<sup>7</sup>

43. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.<sup>8</sup>

44. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.<sup>9</sup>

**Comparison of the signs**

45. To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.<sup>10</sup>

46. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.<sup>11</sup> The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.<sup>12</sup>

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<sup>7</sup> Art. 2.2ter (1)(b) BCIP implements art. 5 (1)(b) Directive (EU) 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. A similar provision can be found in art. 8 (1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

<sup>8</sup> CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

<sup>9</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.



<sup>10</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

<sup>11</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

<sup>12</sup> General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

47. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, *inter alia*, their distinctive and dominant components.

48. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
	

#### *Visual comparison*

49. The trademark invoked consists of a single colour, namely a contourless shade of dark yellow. The contested sign is a combined figurative/word trademark that consists of the word element Cacaolat, displayed in dark brown letters and in an italic font. The word element is placed in a dark yellow rectangle.

50. 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.<sup>13</sup> For this reason, the signs contain a noticeable visual difference, because the contested sign contains a word element and the trademark invoked does not.

51. The only similarity between the signs is the presence of a dark shade of yellow, almost ochre. The colours are identical at first glance, or at least highly similar. Although it is not a dominant element in the contested sign due to the word element, this colour is still clearly perceivable. For this reason, the Office finds that the signs are visually similar to a certain extent.

#### *Phonetic comparison*

52. Given that the trademark invoked concerns a colour mark, which is not suitable for pronunciation, a phonetic comparison is not possible.<sup>14</sup>

#### *Conceptual comparison*

53. Conceptually, the trademark invoked will be perceived by the public as a somewhat darker shade of yellow, tending towards ochre. The word element Cacaolat in the contested sign contains the words 'cacao' and 'lat'. The Office finds that the public will understand the word 'cacao' and will also perceive the word 'lat' as a reference to milk (as argued by the opponent, see point 15, which has not been disputed by the defendant). The meaning of the word element of the contested sign therefore causes a conceptual difference between the signs.

<sup>13</sup> General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 and the case-law mentioned there (Smarter Travel).

<sup>14</sup> General Court (EU) 12 December 2019, T-266/19, ECLI:EU:T:2019:854, points 38-39 (Gastivo) and the case-law mentioned there.

54. Due to the fact the contested sign contains a word element, the Office finds that the background colour used in the contested sign will not evoke any concept, but will be merely perceived as decoration.

55. In the light of the above, the signs are conceptually different.

#### *Conclusion*

56. The signs are visually similar to a certain extent. An assessment of the phonetic similarity is not possible. Conceptually, the signs are different.

#### **Comparison of the goods**

57. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. 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.<sup>15</sup>

58. Complementarity only exists where the products and/or services are so closely related to each other that one is indispensable or important for the use of the other so that consumers may believe that the same undertaking is responsible for those products.<sup>16</sup>

59. In comparing the goods and services, the goods and services shall be considered in the terms set out in the register and not the actual or intended use.<sup>17</sup>

60. The goods to be compared are the following:

<b>Opposition based on:</b>	<b>Opposition directed against:</b>
CI 30 Chocolate milk.	CI 30 Coffee, cocoa, cocoa-based beverages, chocolate-based beverages; chocolate beverages containing milk; beverages made with a base of chocolate; chocolate; chocolate powder; drinking chocolate; cocoa powder; cocoa for use in making beverages, cocoa-based products, cocoa-based creams in the form of spreads; cocoa-based foodstuffs, powdered beverages containing cocoa; preparations for making beverages based on cocoa; powdered preparations containing cocoa for making beverages; preparations for chocolate beverages; chocolate-based products; cocoa beverage with milk; sugar, pastry and confectionery, chocolate confectionery; chocolates; biscuits and cookies; edible ices; pastries, cookies, biscuits, brioches (buns).

61. The defendant only disputes the similarity between the goods of the trademark invoked and the contested goods *'sugar, pastry and confectionery, chocolate confectionery; chocolates; biscuits and*

<sup>15</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

<sup>16</sup> General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

<sup>17</sup> General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

*cookies; edible ices; pastries, cookies, biscuits, brioches (buns)*' (see point 23). Given the principle of hearing both sides (Article 2.16(1) BCIP and Rule 1.21 IR), the examination of the opposition is limited to the arguments, facts and evidence submitted by the parties. The Office will therefore assume that the other goods are identical or highly similar (as argued by the opponent, see point 13).

62. Furthermore, contrary to what the defendant argues, the Office finds that there are similarities between the opponent's '*chocolate milk*' and the contested goods '*pastry and confectionery, chocolate confectionery; chocolates; biscuits and cookies; edible ices; pastries, cookies, biscuits, brioches (buns)*'. Although the goods of the opponent concern a beverage and the contested goods are foodstuffs, all these goods are of a sweet nature, intended to satisfy the sweet tooth and in which chocolate is usually a common ingredient. For this reason the Office finds that these goods are similar to a low degree.

63. However the contested good '*sugar*' does not have the same nature, function and intended purpose as chocolate milk. For this reason, the Office finds that these goods are dissimilar.

#### *Conclusion*

64. The goods are partly identical, partly highly similar, partly similar to a low degree and partly dissimilar.

#### **Global assessment**

65. The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.<sup>18</sup> In the present case, the goods and services mainly concern everyday consumer products. They are aimed at the general public with an average level of attention.

66. The higher the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.<sup>19</sup> In this context, the opponent has argued that the invoked colour mark enjoys an enhanced distinctive character (see points 10, 11 and 15).

67. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and, in particular, between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.<sup>20</sup>

68. In this case, the goods are partly identical, partly highly similar, partly similar to a low degree and partly dissimilar. However, the signs are only visually similar to a certain extent, where it is important that the visual similarity lies in a less distinctive element of the contested sign. In addition, due to the word element in the contested sign, the signs are conceptually different. Lastly, an aural comparison is not possible.

<sup>18</sup> CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

<sup>19</sup> CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

<sup>20</sup> CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there. (Equivalenza)

69. The Office finds that any low distinctive character of the word element Cacaolat (which both parties refer to, see points 15 and 22), does not change the fact that the signs are conceptually different and contain a noticeable visual difference.

70. In the light of the foregoing, the Office considers that the differences between the trademark and sign are sufficient to conclude that the relevant public with an average level of attention would not assume that the goods bearing the disputed sign originate from the same or from economically-linked undertakings.

71. Even when considering any enhanced degree of distinctiveness or reputation of the trademark invoked, the Office finds that the overall differences between the trademark invoked and the disputed sign are so clearly perceivable and sufficient as to exclude any likelihood of confusion between them.

#### *Conclusion*

72. Based on the foregoing, the Office concludes that there is no likelihood of confusion.

### **C. Reputation**

73. The opponent has based the opposition also on Article 2.2ter, 3 (a) BCIP.

74. Article 2.2ter, 3 (a) BCIP is only applicable when the following conditions are met:

- (i) The conflicting signs are either identical or similar;
- (ii) The earlier trademark has a reputation;
- (iii) The use of the contested sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;
- (iv) There is no due cause for the use of the contested sign.

75. According to the Court, the types of injury mentioned in this article, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them.<sup>21</sup>

76. The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition based on Article 2.2ter, (3) (a) BCIP.

#### *i) similarity between the signs*

77. The Office has already established that the signs are visually similar to a certain extent. The signs are conceptually different and an aural comparison is not possible (see points 49-56).

#### *ii) reputation of the trademark invoked*

78. It must be observed that the expression "has a reputation in the Member State", in Article 5(3) of the Directive, has the same meaning as the identical expression in Article 10(2)(c) of the Directive, which is identical to Articles 8 (5) and 9(2)(c) of the European Union Trade Mark Regulation. In that connection,

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<sup>21</sup> CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 66 (Intel).

according to case law of the Court concerning the interpretation of the Directive and the Regulation, the trademark invoked must be known by a significant part of the public concerned by the goods or services covered by that trademark, in a substantial part of the relevant territory.<sup>22</sup> Such a part may, with regard to both an EU trademark or a Benelux trademark, in some circumstances, correspond to the territory of a single Member State.<sup>23</sup>

79. This assessment concerns the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect.<sup>24</sup> The public amongst which the earlier trademark must have acquired a reputation is that concerned with that trademark, that is to say, depending on the product or service marketed, either the public at large or a more specialist public, for example traders in a specific sector.<sup>25</sup>

80. In examining the degree of knowledge amongst the relevant public all the relevant facts of the case, in particular the market share held by the trademark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it, must be taken into consideration.<sup>26</sup>

81. The relevant point in time to establish that the earlier trademark has acquired a reputation is the filing date or, where appropriate, the priority date of the contested sign.<sup>27</sup> The relevant point in time in this case is 21 October 2021, namely the date of the priority of the contested sign.

#### *Analysis of the evidence*

82. The opponent submitted the following documents in order to demonstrate reputation of the trademarks invoked:

1. Photos of chocolate milk products (document dated 20 January 2023);
2. Identity guidelines for Chocomel/Cécémel (July 2004);
3. Images of advertisements (dated 1984 and 1985);
4. Pictures of use of the name Chocomel/Cécémel and the colour yellow on miniature truck, flag, chocolate milk machine, magazine, mugs, hats and other merchandise;
5. Screenprints social media pages showing advertisements and photos regarding publicity activities;
6. Several publications regarding Chocomel and the packaging (dated 2005 and 2014);
7. Market research dated January 2013 regarding the extent to which the public is able to identify chocolate milk from FrieslandCampina purely on the basis of the colour yellow.

83. The defendant agrees that Chocomel is a popular brand, however he disputes that the invoked colour mark has a reputation or enjoys an enhanced distinctive character (see point 24). The Office however finds that the submitted evidence shows that the opponent uses the dark shade of yellow (identical to or highly resembling the shade of the trademark invoked) over a long period of time in a dominant way. This colour consistently appears in all advertisements, promotional action and on product packaging and consequently, the colour has acquired a familiar character. In addition, market research from 2013 shows

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<sup>22</sup> CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 31 (General Motors) and 6 October 2009, C-301/07, ECLI:EU:C:2009:611, point 24 (Pago International).

<sup>23</sup> CJEU 6 October 2009, C-301/07, ECLI:EU:C:2009:611, point 30 (Pago International and CJEU 3 September 2015, C-125/14, ECLI:EU:C:2015:539, point 29 (Iron & Smith/Unilever)

<sup>24</sup> CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 36 (Intel).

<sup>25</sup> CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 24 (General Motors).

<sup>26</sup> CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 27 (General Motors).

<sup>27</sup> See Article 2.2ter (2) and, by analogy, Article 2.30sexies BCIP.

that a significant part of the public in the Netherlands and Belgium recognises the colour as belonging to the products of the opponent (see point 11). The outcome of this research has not been disputed by the defendant.

84. In the light of the above, especially considering that when marketing the products of the invoked colour mark, this colour is so overtly present as representing the chocolate milk product of the opponent, the Office concludes that on the priority date of the contested sign, the trademark invoked has a reputation in the Benelux for chocolate milk.

*(iii) Unfair advantage of, or detriment to, the distinctive character or the repute of the earlier trademark*

85. The opponent argues that the relevant public will establish a link between the signs and that there is an unfair advantage, because the contested sign will benefit from the opponent's promotional investments and image (see point 16). Furthermore, according to the opponent, detriment is done to the distinctive character of the trademark invoked (see point 18) and lastly the opponent states that the use of the contested sign damages the opponent's mark's repute (see point 19).

*The link between the trademarks?*

86. As indicated above (see point 75), to establish the existence of a risk of injury, it is necessary to demonstrate that the relevant public will establish a link (or association) between the trademarks. In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.<sup>28</sup> The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case.<sup>29</sup>

87. With regard to the goods '*coffee, cocoa-based creams in the form of spreads; cocoa-based foodstuffs, sugar, pastry and confectionery, chocolate confectionery; chocolates; biscuits and cookies; edible ices; pastries, cookies, biscuits, brioches (buns)*' the Office finds that due to the difference in nature of the goods and the fact that the reputation of the trademark invoked is specifically only for chocolate milk, the public will not make a connection with the trademark invoked when the contested sign is used for these products. Therefore, regarding these goods, the use of the contested sign does not enable unfair advantage to be taken of, and is not detrimental to, the distinctive character or repute of the earlier mark.

88. With regard to the other goods, namely '*cocoa, cocoa-based beverages, chocolate-based beverages; chocolate beverages containing milk; beverages made with a base of chocolate; chocolate, chocolate powder; drinking chocolate; cocoa powder; cocoa for use in making beverages, cocoa-based products, powdered beverages containing cocoa; preparations for making beverages based on cocoa; powdered preparations containing cocoa for making beverages; preparations for chocolate beverages; chocolate-based products; cocoa beverage with milk*', the Office finds that because of the visual similarity between the signs and the strength of the reputation of the invoked colour mark for chocolate milk, the public will think of the trademark invoked if the contested sign is used for these goods, because it concerns chocolate based beverages or ingredients to make chocolate based beverages. The Office will therefore further examine below only for these goods of the contested mark whether there is an unfair advantage taken of or detriment to the distinctive character or reputation of the trademark invoked.

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<sup>28</sup> CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 31 (Intel).

<sup>29</sup> CJEU 23 October 2003, C-408/01, ECLI:EU:C:2003:582, point 30 (Adidas/Fitnessworld).

*Unfair advantage or detriment?*

89. The holder of the earlier mark who invokes Article 2.2b(3)(a) of the BCIP is obliged to prove that the use of the later trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark. To this end, the holder of the earlier trademark is not required to demonstrate actual and present injury to an earlier mark. However, the holder of the earlier mark must prove that there are elements on the basis of which it may be concluded that there is a serious risk that such an injury will occur in the future<sup>30</sup> or, with other words, submit elements from which it can be prima facie concluded that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future.<sup>31</sup>

90. It has been established that the invoked colour mark has a strong reputation with regard to chocolate milk. In view of this reputation and the visual similarity between the signs, it is likely that the image associated with the invoked colour mark may transfer to the contested goods mentioned in point 88. Consequently, this facilitates the marketing of these goods bearing the contested sign which could promote their sales, thereby reducing the defendant's investment in advertising and allowing it to benefit from the opponent's efforts and reputation in the market, also known as 'free-riding'. Therefore, it is to be expected that the defendant is able to take unfair advantage of the strong image of the famous colour mark of the opponent.<sup>32</sup>

91. Having already established that unfair advantage of the distinctive character or the repute of the trademark is taken, there is no need to assess the detriment to the distinctive character or the repute of the earlier trademark.<sup>33</sup>

*iv) valid reason*

92. The defendant has not argued that there is a valid reason for the contested sign's use. For the sake of completeness, the Office considers that the reference to the defendant's earlier 'Cacaolat' trademark and the argument that different shades of the colour yellow are widely used in the chocolate drink market cannot constitute a valid reason, because it does not explain why the shade of yellow in the contested sign is (nearly) identical to the trademark invoked. It is also not clear why the defendant has changed the original colour of the previous Cacaolat registration to one that is almost identical to the colour used by the opponent for years. After all, as stated by the opponent (point 17) which has not been disputed, the defendant – a competitor of the opponent – must have been familiar with the opponent's colour mark for chocolate milk.

*Conclusion*

93. On the basis of the foregoing, the Office concludes that the contested mark takes unfair advantage of the distinctive character and reputation of the invoked colour mark for the goods '*cocoa, cocoa-based beverages, chocolate-based beverages; chocolate beverages containing milk; beverages made with a base of chocolate; chocolate, chocolate powder; drinking chocolate; cocoa powder; cocoa for use in making beverages, cocoa-based products, powdered beverages containing cocoa; preparations for making beverages based on cocoa; powdered preparations containing cocoa for making beverages; preparations for chocolate beverages; chocolate-based products; cocoa beverage with milk*'.

<sup>30</sup> GEU 22 May 2012, T-570/10, ECLI:EU:T:2012:250, point 51 (Wolf).

<sup>31</sup> GEU 7 October 2015, T-534/13, ECLI:EU:T:2015:751, point 76 (Krispy Kreme DOUGHNUTS).

<sup>32</sup> CJEU 18 June 2009, C-487/07, ECLI:EU:C:2009:378, point 49 (L'Oréal/Bellure).

<sup>33</sup> CJEU 18 June 2009, C-487/07, ECLI:EU:C:2009:378, point 42 (L'Oréal/Bellure).



**D. Conclusion**

94. Based on the foregoing the Office concludes that there is no likelihood of confusion.

95. For part of the goods the Office finds that the contested sign takes unfair advantage of the distinctive character and reputation of the trademark invoked.

**IV. CONSEQUENCE**

96. The opposition with number 2018061 is partly justified.

97. The International application with number 1650099 will not be registered in the Benelux for the following goods:

- Class 30 Cocoa, cocoa-based beverages, chocolate-based beverages; chocolate beverages containing milk; beverages made with a base of chocolate; chocolate, chocolate powder; drinking chocolate; cocoa powder; cocoa for use in making beverages, cocoa-based products, powdered beverages containing cocoa; preparations for making beverages based on cocoa; powdered preparations containing cocoa for making beverages; preparations for chocolate beverages; chocolate-based products; cocoa beverage with milk.

98. The International application with number 1650099 will be registered in the Benelux for the following goods:

- Class 30 coffee, cocoa-based creams in the form of spreads; cocoa-based foodstuffs, sugar, pastry and confectionery, chocolate confectionery; chocolates; biscuits and cookies; edible ices; pastries, cookies, biscuits, brioches (buns).

99. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP, as the opposition is partly justified.

The Hague, 28 June 2024



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